

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner

v.

EQUIL IP HOLDINGS LLC,
Patent Owner

Case IPR2023-00332
U.S. Patent No. 9,158,745

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

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U.S. Patent and Trademark Office
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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE '745 PATENT	2
A.	Background.....	2
B.	Summary	5
C.	Person of Ordinary Skill in the Art (POSITA)	8
D.	Claim Construction.....	9
III.	SAMANIEGO, THE PRIMARY REFERENCE IN FOUR OF SIX GROUNDS, IS NOT PRIOR ART TO THE CHALLENGED CLAIMS.....	9
A.	Patent Owner filed a petition to correct inventorship of the '009 patent, and as corrected the '745 patent “share[s] at least one common inventor” with Samaniego’s application.	11
B.	The claims of the '745 patent are supported by the '904 application and all intervening applications.	13
C.	The other requirements of § 120 are also met.....	19
D.	Conclusion: Samaniego is not prior art.	20
IV.	THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION.	20
A.	Applying <i>Chevron</i> and <i>Deeper</i> favors denying institution because four of the six Grounds rely on Samaniego, which is not prior art.	21
B.	Applying <i>Advanced Bionics</i> favors denying institution of Grounds 1-2 because the Examiner considered the teachings of Tso and Huang during prosecution.....	24
1.	Part 1: Petitioner advances the same or substantially the same art that was previously presented to the Office.....	26
2.	Part 2: Petitioner fails to identify material error in the Office’s previous evaluation of the art and arguments.....	29

V.	THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THE CLAIMS WOULD HAVE BEEN OBVIOUS OVER THE TSO-BASED COMBINATIONS (GROUNDS 1-2).....	32
A.	Overview of Tso	33
B.	Petitioner fails to demonstrate that Tso discloses Element [1.b] because it fails to show that Tso’s transcoding server receives, from Tso’s network client, a request indicating “first content generation operations.”	35
VI.	CONCLUSION	41

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Dr. Mark T. Jones in Support of Patent Owner's Preliminary Response
2002	Curriculum Vitae of Dr. Mark T. Jones
2003	Petition Under 37 C.F.R. § 1.324(a) to Correct Inventorship in a Patent
2004	U.S. Patent No. 8,381,110 to Barger et al.
2005	U.S. Patent No. 8,656,046 to Barger et al.
2006	U.S. Patent No. 6,964,009 to Samaniego et al.
2007	WO 98/43177 (International Publication of PCT/US98/05304) to Tso et al.
2008	Redline comparison of specifications of PCT/US98/05304 (Tso PCT) and U.S. Patent No. 6,421,733 (Tso)
2009	U.S. Patent No. 5,902,846 to Feret et al.
2010	First Amended Complaint for Patent Infringement, 22-677-RGA, <i>Equil IP Holdings LLC v. Akamai Technologies, Inc.</i>
2011	U.S. Patent No. 6,483,851 to Neogi

I. INTRODUCTION

The Board should deny institution of *inter partes* review of claims 1-7 of U.S. Patent No. 9,158,745 (“the ’745 patent”) because (1) Petitioner’s primary reference in four of the six asserted grounds is not prior art and (2) combined discretionary considerations under Sections 314(a) and 325(d) strongly favor denying institution. Instituting review when four of Petitioner’s six asserted grounds are facially deficient is a waste of the Board’s and the parties’ resources.

Petitioner’s primary reference in four of its six grounds, Samaniego, is not prior art. Samaniego is the pre-issuance publication of an earlier application in the ’745 patent’s priority chain. Petitioner’s argument that the ’745 patent is not entitled to the earlier priority date is premised on a lack of overlapping inventors. Patent Owner, however, has petitioned for correction of inventorship of the priority application, which eliminates Petitioner’s argument. Further, Patent Owner demonstrates herein that the requirements of 35 U.S.C. § 120, including that the priority applications provide the required § 112 support for the claims, are met.

Under Section 314(a), the Board should apply its informative *Chevron/Deeper* decisions and deny institution because four of Petitioner’s six grounds are facially deficient, and Board precedent disfavors instituting review when the majority of the challenges fail to satisfy the threshold for institution. Section 325(d) and the precedential *Advanced Bionics* decision compound the case

for discretionary denial because the Office previously considered the primary reference, Tso, asserted in the only two remaining grounds. The Examiner also considered art with substantially the same teachings as the relevant teachings of Huang. The PCT Publication of Tso, which has the identical specification as Tso, was considered by the Examiner during prosecution. Petitioner does not address this PCT Publication in the Petition at all, let alone show material error in the Office's prior consideration thereof, as required by *Advance Bionics*. Thus, the Board's discretionary considerations strongly favor denial, and the Board should deny institution.

On the merits, the Petition fails to meet the reasonable likelihood threshold required for institution. In particular, Petitioner fails to demonstrate that Tso's transcoding server 34 receives, from Tso's network client 12, a "first request [that] contains information . . . indicating . . . first content generation operations," as recited in Element [1.b]. The Petition's deficiencies are not saved by Dr. Madisetti's testimony, whose opinions for Element [1.b] largely repeat Petitioner's conclusory arguments, and thus are not entitled to weight.

II. THE '745 PATENT

A. Background

The technology at issue in the '745 patent traces its roots to the early 1990s when Sean Barger—an inventor on the '745 patent—founded Equilibrium. Equil

IP is the successor-in-interest to Automated Media Processing Solutions, Inc. d/b/a Equilibrium, an industry pioneer and leader in developing patented automated media processing solutions to help its customers manage, modify, and efficiently deploy media-rich content such as images, video, and sound optimized for delivery over the Internet and customized for use on Internet-connected end-user devices such as desktop and laptop computers and mobile phones.

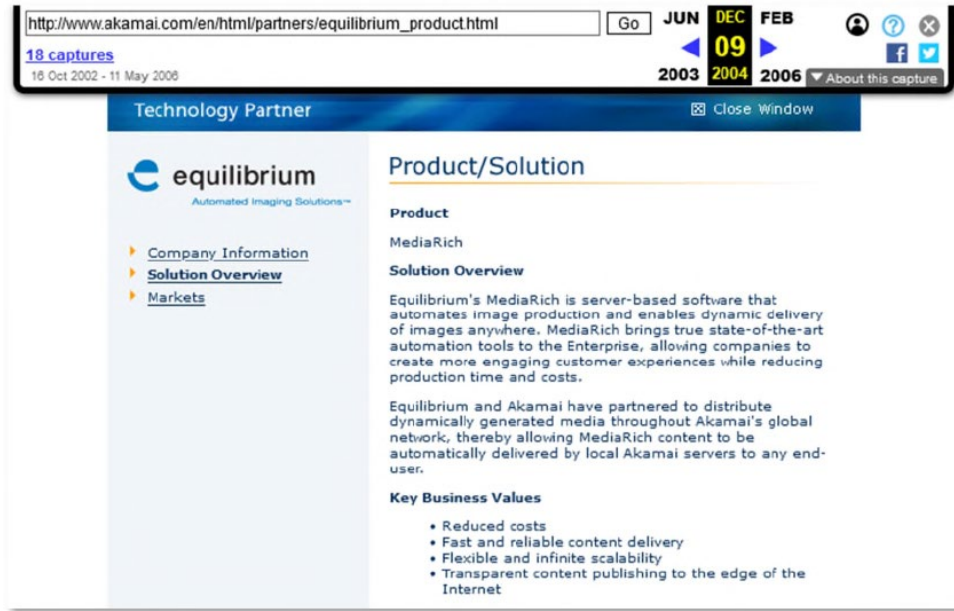
With the growth of the Web in the late 1990s, Equilibrium set out to develop a new kind of Internet-based service that web developers could use to simplify the process of optimizing and maintaining rich media content automatically on websites. Equilibrium envisioned a system that would enable next-generation e-commerce and other applications. The '745 patent is a result of that vision.

The technology disclosed and claimed in the '745 patent was released by Equilibrium in 2000 as the “MediaRich Server.” Since that time, Equilibrium has continuously offered MediaRich Server services in the business-to-business market. MediaRich solves technical problems associated with, for example, delivering rich media content over the Internet that arise from the fact that each type of user device has different parameters that can be used to optimize media for viewing.

Equilibrium has partnered with Internet companies to enhance their services with Equilibrium technology—among them Akamai. In fact, Akamai stated on its

website that Equilibrium was a “*recognized leader* in automated imaging solutions” and that “Equilibrium’s MediaRich is server-based software that automates image production and enables dynamic delivery of images anywhere. *MediaRich brings true state-of-the-art automation tools* to the Enterprise, allowing companies to create more engaging customer experiences while reducing production time and costs.” EX2010, First Amended Complaint, 11-12 (citing December 9, 2004 Internet Archive captures, shown below) (emphasis added throughout).





Over the years, Akamai resisted Equilibrium’s offers to establish a more extensive partnership or more complete integration of Equilibrium’s technology into Akamai’s edge network. Instead, Akamai released an image management service that it called “Image Manager” (today called “Image and Video Manager” or “IVM”) at issue in the related district court action. *See generally* EX2010.

B. Summary

The ’745 patent describes an automatic graphics delivery method that “automat[es] the production of media through content generation procedures controlled by proprietary tags placed within URLs embedded within Web documents.” EX1001, 7:6-11; EX2001, ¶¶17-19. The method “automatically processes the URL encoded tags and automatically produces derivative media for the web site from the original media.” EX1001, 7:13-16.

By way of example, Figure 22, reproduced below, is “a flowchart of the content generation procedure according to a preferred embodiment” of the ’745 patent. EX1001, 20:3-4. A URL with proprietary tags 2200 is parsed at step 2210 to “determine the content generation procedure to execute, any dynamic modifications to the media, user profile characteristics, and proxy-cache control.” *Id.*, 20:5-8. At step 2220, a unique final lookup key is generated for the media. *Id.*, 20:8-9. The media cache is checked at step 2230. *Id.*, 20:9-10. If the indicated media exists, the media is delivered to the browser at step 2295. *Id.*, 20:10-12.

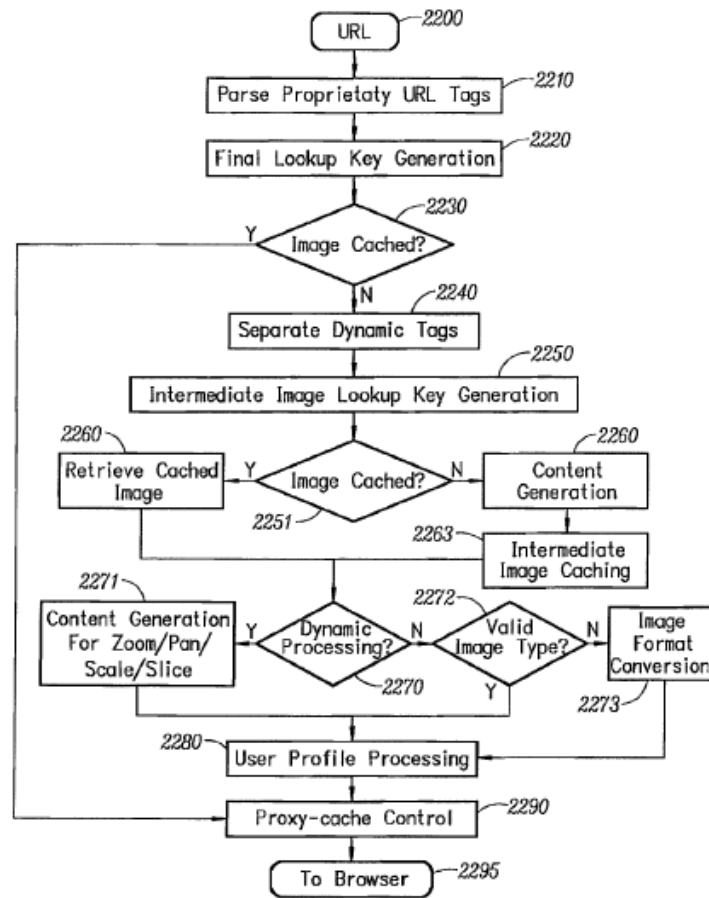


FIG. 22

EX1001, FIG. 22.

If the media does not exist, dynamic media system tags are separated from content generation control tags at step 2240. *Id.*, 20:12-13. A unique intermediate image lookup key is generated at step 2250. *Id.*, 20:14. The cache is checked for

this intermediate media at step 2251.¹ *Id.*, 20:15-16. If the intermediate media is found, it is retrieved at step 2260 and used directly for dynamic processing, if required. *Id.*, 20:16-17, Fig. 22. If the intermediate media is not found, content is generated at step 2262² and cached at step 2263. *Id.*, 20:17-18. The intermediate media is evaluated for dynamic processing at step 2270. *Id.*, 20:18-19. If dynamic processing is required, the dynamic content generator operates on the media at step 2271. *Id.*, 20:19-21. The image is then customized by the user profiling system at step 2280 for specified browser or client attributes. *Id.*, 20:23-25. Any cache-control directives specified are attached to the response at step 2290. *Id.*, 20:25-27. The media is delivered to the browser at step 2295. *Id.*, 20:27.

C. Person of Ordinary Skill in the Art (POSITA)

Patent Owner applies Akamai's definition of a POSITA for purposes of this Preliminary Response.

¹ The specification includes a typographical error. As seen in Figure 22, the cache checking step is 2251.

² There is a typographical error in Figure 22, where the "Content Generation" block is labeled as 2260 rather than 2262.

D. Claim Construction

For purposes of this Preliminary Response, Patent Owner construes the claims according to their plain and ordinary meaning in light of the specification, consistent with the standard established in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) (“*Phillips*”). *See* Pet., 10-11 (proposing the same).

III. SAMANIEGO, THE PRIMARY REFERENCE IN FOUR OF SIX GROUNDS, IS NOT PRIOR ART TO THE CHALLENGED CLAIMS.

The ’745 patent is entitled to priority to at least August 14, 2001—the filing date of the earlier-filed 09/929,904 application (“the ’904 application,” EX1035) in the priority chain. Petitioner’s primary reference in four of its six grounds, Samaniego—the pre-issuance publication of the ’904 application—is, therefore, not prior art.

Under § 120, a patent is entitled to the priority date of an earlier filed application if (1) the written description of the earlier filed application discloses the invention claimed in the later filed application sufficient to satisfy the requirements of § 112; (2) the applications have at least one common inventor; (3) the later application is filed before the issuance or abandonment of the earlier filed application; and (4) the later application contains a reference to the earlier filed application. *In re NTP, Inc.*, 654 F.3d 1268, 1277 (Fed. Cir. 2011). Each of these requirements is met here.

Indeed, regarding (1), Petitioner acknowledges that “Samaniego’s and the ’745’s specifications are substantively identical,” Pet., 2, and admits there is written description support for the ’745 patent claims: “PO cannot dispute Samaniego’s disclosure of the Claims because the ’745’s and Samaniego’s specifications are substantively identical.” *Id.*, 49. The Declaration of Dr. Mark T. Jones confirms that all elements of claims 1-7 of the ’745 patent are supported by the ’904 application, and all intervening applications, such that the requirements of § 112 are satisfied. EX2001, Jones Declaration. And as shown in Section III.C below, filing chain and reference requirements of (3) and (4) are also met. Petitioner’s only argument relates to (2)—that “[t]he ’745 cannot claim priority to the earlier-filed purported priority applications,” including the ’904 application, because “none of the ’745’s named inventors is ‘name[d] ... in the previously filed application[s].” Pet., 5 (citing 35 U.S.C. §120). But that argument is moot because Patent Owner filed a petition to correct the inventorship of U.S. Patent No. 6,964,009 (“the ’009 patent,” which issued from the ’904 application), adding Sean Barger.³ EX2003. Thus, Sean Barger is an inventor of the ’904 application, the

³ Correction of inventorship under Rule 1.324 is “pursuant to 35 U.S.C. 256.” The Federal Circuit has recognized that inventorship corrections under § 256 are “a matter of formality.” *Egenera, Inc. v. Cisco Systems, Inc.*, 972 F.3d 1367, 1379 (Fed.

'745 patent, and each intervening application in the priority chain, satisfying (2).

Accordingly, Petitioner's argument is eliminated.

As explained below, the requirements of 35 U.S.C. § 120, including that the priority applications provide the required § 112 support for the claims, are met.

The challenged claims are, thus, entitled at least to the filing date of the '904 application, and Samaniego is not prior art.

A. Patent Owner filed a petition to correct inventorship of the '009 patent, and as corrected the '745 patent "share[s] at least one common inventor" with Samaniego's application.

Petitioner's contention that Samaniego is available as prior art is based on the assertion that "Samaniego shares no common inventors with the '745 [patent]." Pet., 2, 5-6, 50-51. Patent Owner filed a petition under 37 C.F.R. § 1.324(a) to correct inventorship of the '009 patent. EX2003. In particular, the petition and supporting documents, request a correction to include Sean Barger as an inventor of the '009 patent. *Id.*, 1-3. Every single inventor that was already named on the '009 patent executed a declaration that they "agree and/or have no disagreement to the change of inventorship to add Sean Barger as a co-inventor" of the '009 patent. *Id.*, 6-11. Upon correction, Sean Barger is an inventor named on the '904

Cir. 2020). "[T]he PTO examines a request only for the presence of supporting statements and the required fee." *Id.* at 1380.

application, the '745 patent, and each intervening application in the priority chain.

See EX2003; EX1010, 1090; EX1026, 914; EX1027, 839; EX1002, 278. This meets the requirement of 35 U.S.C. § 120 that the later-filed application must “name[] an inventor or joint inventor in the previously filed application.”⁴

Pointing to changes of inventorship during prosecution of the various applications in the priority chain, Petitioner emphasizes that “Equilibrium ... intentionally identified different inventors in Samaniego and the '745 [patent]” “despite maintaining the same specification.” Pet., 50-51. However, proper inventorship is not determined by the *specification* of a patent, but by the *claims*. *Egenera, Inc.*, 972 F.3d at 1376 (“[I]nventorship is a claim-by-claim question.” (citing *Trovan, Ltd. v. Sokymat SA, Irori*, 299 F.3d 1292, 1302 (Fed. Cir. 2002))).

⁴ As noted, inventorship corrections under § 256 are “a matter of formality.” *Egenera, Inc.*, 972 F.3d at 1379. If the Office has not issued a correction prior to institution, the Board should exercise its discretion under § 314(a) and decline institution of the Samaniego grounds. To institute on these grounds pending a ministerial order from the Office that will render them facially deficient would be a waste of Board and party resources. *See* 37 C.F.R. § 42.1(b) (instructing that the rules “shall be construed to secure the just, speed, and inexpensive resolution of every proceeding”).

Thus, it is entirely proper for inventorship to differ among patents with the same specification, based on each patent's respective claims. This is consistent with the requirements necessary to claim the benefit of an earlier filing date, which include that the later-filed application must "name[] *an* inventor or joint inventor in the previously filed application," and not that *all* inventors must be the same.

35 U.S.C. § 120. Additionally, Sean Barger's declaration accompanying the request to correct inventorship states that "[t]he inventorship error of failing to include [himself]" as an inventor on the '009 patent "occurred without any deceptive intent on [his] part." EX2003, 4.

As noted, correction of the inventorship on the '009 patent means the inventorship requirement of § 120 is met here.

B. The claims of the '745 patent are supported by the '904 application and all intervening applications.

The applications included in the priority chain of the '745 patent back to the '904 application are below.

Appl. No.	Filing Date	Corresponding US Patent/Pub. No.	File History:
13/752,110	January 28, 2013	9,158,745	EX1002
12/238,842	September 26, 2008	8,381,110	EX1027
12/173,747	July 15, 2008	8,656,046	EX1026
11/269,916	November 7, 2005	2006/0265476	EX1010
09/929,904	August 14, 2001	6,964,009	EX1035

As evidenced by Petitioner's redline comparisons, the specification of each application in the priority chain is the same. *See* EX1013, EX1021, EX1028, EX1029. Also, each subsequent application incorporates the '904 application (and all intervening applications) by reference. EX1002, 2; EX1027, 2; EX1026, 2; EX1010, 4.

As detailed in the expert Declaration of Dr. Mark T. Jones, all elements of claims 1-7 of the '745 patent are supported by the '904 application, and all intervening applications, such that the requirements of § 112 are satisfied. EX2001. Dr. Jones, in particular, provided a chart demonstrating support for each limitation of these claims in the '904 application, and in all intervening applications, including the '110 application that issued as the '745 patent. *Id.*, ¶25, Appendix A. The Federal Circuit has recognized that “written description and enablement often rise and fall together.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010). That is the case here. As Dr. Jones testified, “[t]he cited portions demonstrate that the inventors had possession of the claimed subject matter and also enable a POSITA to make and use the invention without undue experimentation.” EX2001, ¶25; *see also id.*, Appendix A.

Furthermore, in the Notice of Allowance of the '110 application (which issued as the '745 patent), the Examiner made an express finding: “support for the

claimed subject matter has been found in 12238842, 12173747, 11269916 and 09929904. Thus, 13752110 receives the priority date of App. 09929904.” EX1002, 165.

Citations pointing to the § 112 support for the challenged claims in each of the priority applications is included in the chart below. *See also* EX2001, Appendix A.

Claim Element	Support ⁵ for Claim Features in:				
	110 Appl.	842 Appl.	747 Appl.	906 Appl.	904 Appl.
[1.P]/[1.pre]	1:7-14, 1:19-21, 5:28-30, 9:30-10:3 (12:22-29, 27:19-25), 10:5-7 (12:31-33, 27:27-29), 12:10-11 (27:18-20), 12:13-14 (28:29-30), 13:15-17, 21:27-28 (Table B), 26:23, 30:21-22, FIG. 21,	1:8-14, 1:19-21, 5:28-30, 9:30-10:3 (12:23-29, 27:19-25), 10:5-7 (12:31-33, 27:27-29), 12:10-11 (30:18-20), 12:13-14 (31:29-30), 13:15-17, 21:27-28 (Table B), 26:23, 30:21-22, FIG. 21,	1:8-13, 1:18-20, 5:27-29, 9:30-10:3 (12:23-29, 27:19-25), 10:5-7 (12:31-33, 27:27-29), 12:10-11 (30:18-20), 12:13-14 (31:29-30), 13:15-17, 21:27-28 (Table B), 26:23, 30:21-22, FIG. 21,	1:8-12, 1:17-19, 5:27-29, 9:30-10:3 (12:23-29, 27:5-11), 10:5-7 (12:31-33, 27:13-15), 12:10-11 (30:4-6), 12:13-14 (31:15-16), 13:15-17, 21:22-23 (Table B), 26:10, 30:7-8, FIG. 21,	1:7-9, 4:31-33, 8:13-18 (10:28-33, 23:25-30), 8:20-22 (10:35-37, 23:32-34), 10:15-16 (26:9-10), 10:18-19 (27:14-15), 11:14-16, 18:23-24 (Table B), 22:34, 26:12-13, 33:13-33, FIG. 21,

⁵ The quotations corresponding to the citations in this chart are included in Appendix A of Dr. Jones’ declaration.

Claim Element	Support ⁵ for Claim Features in:				
	110 Appl.	842 Appl.	747 Appl.	906 Appl.	904 Appl.
	FIG. 22	FIG. 22	FIG. 22	FIG. 22	FIG. 22
[1.1]/[1.a]	8:7-10, 14:2-3, 28:33-29:1, 29:12-13, 30:22-28	8:7-10, 14:2-3, 28:33-29:1, 29:12-13, 30:22-28	8:7-10, 14:2-3, 28:33-29:1, 29:12-13, 30:22-28	8:7-10, 14:2-3, 28:18-20, 28:31-32, 30:8-14	6:34-37, 11:34-35, 24:33-35, 25:8-9, 26:13-19
[1.2]/[1.b]	28:14-19, 29:1-6, 29:12-16, 30:26-34, 31:30-33	28:14-19, 29:1-6, 29:12-16, 30:26-34, 31:30-33	28:14-19, 29:1-6, 29:12-16, 30:26-34, 31:30-33	27:33-28:4, 28:20-25, 28:31-29:1, 30:12-20, 31:16-19	24:14-19, 24:35-30:2, 25:8-12, 26:17-24, 27:15-17
[1.3]/[1.c]	29:17-21, 29:23-25, 29:29-32, 31:5-11, 31:34-32:4	29:17-21, 29:23-25, 29:29-32, 31:5-11, 31:34-32:4	29:17-21, 29:23-25, 29:29-32, 31:5-11, 31:34-32:4	29:2-6, 29:8-10, 29:14-17, 30:25-31, 31:20-24	25:13-16, 25:18-20, 25:24-27, 26:29-34, 27:19-23
[1.4]/[1.d]	29:32-34, 30:7-10, 30:10-11, 31:7-11, 32:3-5, 32:7-9	29:32-34, 30:7-10, 30:10-11, 31:7-11, 32:3-5, 32:7-9	29:32-34, 30:7-10, 30:10-11, 31:7-11, 32:3-5, 32:7-9	29:17-19, 29:26-29, 29:29-30, 30:27-31, 31:23-25, 31:27-29	25:27-29, 25:35-31:1, 26:1-2, 26:31-34, 27:22-24, 27:25-27
[1.5]/[1.e]	29:17-19, 29:29-34, 31:12-17, 32:5-7, 32:7-9, 33:1-3, Table D	29:17-19, 29:29-34, 31:12-17, 32:5-7, 32:7-9, 33:1-3, Table D	29:17-19, 29:29-34, 31:12-17, 32:5-7, 32:7-9, 33:1-3, Table D	29:2-4, 29:14-19, 30:32-31:3, 31:25-27, 31:27-29, 32:19-21, Table D	25:13-15, 25:24-29, 26:36-27:2, 27:24-25, 27:25-27, 28:12-14, Table D
[1.6]/[1.f]	30:2-5, 31:26-27, 32:11-13	30:2-5, 31:26-27, 32:11-13	30:2-5, 31:26-27, 32:11-13	29:21-24, 31:12-13, 31:31-33	25:31-33, 27:10-12, 27:30-31
[2]/ [2.pre, a-g]	8:16-18, 8:27-28, 10:7-9,	8:16-18, 8:27-28, 10:7-9,	8:16-18, 8:27-28, 10:7-9,	8:16-18, 8:27-28, 10:7-9,	7:5-6, 7:15-16, 8:22-23,

Claim Element	Support ⁵ for Claim Features in:				
	110 Appl.	842 Appl.	747 Appl.	906 Appl.	904 Appl.
	13:2-3 (30:31-32), 13:14-17, 28:10-11, 28:19-21, 28:34-29:1, 29:19-21, 30:2-5, 30:10-11, 32:26-31, FIG. 20	13:2-3 (27:31-32), 13:14-17, 28:10-11, 28:19-21, 28:34-29:1, 29:19-21, 30:2-5, 30:10-11, 32:26-31, FIG. 20	13:2-3 (27:31-32), 13:14-17, 28:10-11, 28:19-21, 28:34-29:1, 29:19-21, 30:2-5, 30:10-11, 32:26-31, FIG. 20	13:2-3 (27:17-18), 13:14-17, 27:29-30, 28:4-6, 28:19-20 , 29:4-6, 29:21-24, 29:29-30, 32:12-17, FIG. 20	11:2-3 (23:36-37), 11:13-16, 24:10-11, 24:19-21, 24:34-35, 25:15-16, 25:31-33, 26:1-2, 28:5-10, FIG. 20
[3]	8:27-28, 10:12-15 (13:5-8, 28:1-4), 24:13-16, 24:25-26 (35:32-22), 29:23-27, 29:32-30:2, 30:7-10, 30:13-16, 31:7-11, 31:23-25, 31:30-32:7, 32:10-11, 33:1-3, Tables C, F	8:27-28, 10:12-15 (13:5-8, 28:1-4), 24:13-16, 24:25-26 (35:32-33), 29:23-27, 29:32-30:2, 30:7-10, 30:13-16, 31:7-11, 31:23-25, 31:30-32:7, 32:10-11, 33:1-3, Tables C, F	8:27-28, 10:12-15 (13:5-8, 28:1-4), 24:13-16, 24:25-26 (35:32-33), 29:23-27, 29:32-30:2, 30:7-10, 30:13-16, 31:7-11, 31:23-25, 31:30-32:7, 32:10-11, 33:1-3, Tables C, F	8:27-28, 10:12-15 (13:5-8, 27:20-23), 24:7-10, 24:19-20 (35:18-19), 29:8-12, 29:17-31, 29:26-29, 29:32-30:2, 30:27-31, 31:9-11, 31:16-27, 31:30-31, 32:19-21, Tables C, F	7:15-16, 8:27-30 (11:5-8, 24:1-4), 20:44-21:2, 21:11-12 (31:6-7), 25:18-22, 25:27-31, 25:35-26:1, 26:4-7, 26:31-34, 27:8-10, 27:15-25, 27:28-29, 28:12-14, Tables C, F
[4]	10:12-15 (13:5-8, 28:1-4), 29:23-27, 31:30-32:7, 33:1-3	10:12-15 (13:5-8, 28:1-4), 29:23-27, 31:30-32:7, 33:1-3	10:12-15 (13:5-8, 28:1-4), 29:23-27, 31:30-32:7, 33:1-3	10:12-15 (13:5-8, 27:20-23), 29:8-12, 31:16-27, 32:19-21	8:27-30 (11:5-8, 24:1-4), 25:18-22, 27:15-25, 28:12-14
[5]/	13:2-3 (27:31-32),	13:2-3 (27:31-32),	13:2-3 (27:31-32),	13:2-3 (27:17-18),	11:2-3 (23:36-37),

Claim Element	Support ⁵ for Claim Features in:				
	110 Appl.	842 Appl.	747 Appl.	906 Appl.	904 Appl.
[5.pre, a-b]	29:1-3, 29:16-17, 29:19-21, 31:1-5, 31:5-11, 31:34-32:3	29:1-3, 29:16-17, 29:19-21, 31:1-5, 31:5-11, 31:34-32:3	29:1-3, 29:16-17, 29:19-21, 31:1-5, 31:5-11, 31:34-32:3	28:20-22, 29:1-2, 29:4-6, 30:22-25, 30:25-31, 31:20-23	24:35-37, 25:12-13, 25:15-16, 26:26-29, 26:29-34, 27:19-22
[6]/ [6.pre, a-c]	FIG. 20, 8:16-18, 10:5-7 (12:31-33, 27:27-29), 17:9-22, 24:25-26 (35:32-33), 25:5 (36:10), 24:7-10, 25:16-19, 29:1-3, 34:14-15, Tables B, C, E, F	FIG. 20, 8:16-18, 10:5-7 (12:31-33, 27:27-29), 17:9-22, 24:25-26 (35:32-33), 25:5 (36:10), 24:7-10, 25:16-19, 29:1-3, 34:14-15, Tables B, C, E, F	FIG. 20, 8:16-18, 10:5-7 (12:31-33, 27:27-29), 17:9-22, 24:25-26 (35:32-33), 25:5 (36:10), 24:7-10, 25:16-19, 29:1-3, 34:14-15, Tables B, C, E, F	FIG. 20, 8:16-18, 10:5-7 (12:31-33, 27:13-15), 17:8-21, 24:19-20 (35:18-19), 24:30 (35:30), 24:1-4, 25:4-7, 28:20-22, 33:31-32, Tables B, C, E, F	FIG. 20, 7:5-6, 8:20-22 (10:35-37, 23:32-34), 14:25-37, 21:11-12 (31:6-7), 21:22 (31:18), 20:38-41, 21:33-36, 24:35-37, 29:32-33, Tables B, C, E, F
[7]/ [7.pre, a]	6:1-3, 8:20-22, 23:4-6, 24:20-21, 25:6-7, Tables B, C	6:1-3, 8:20-22, 23:4-6, 24:20-21, 25:6-7, Tables B, C	6:1-3, 8:20-22, 23:4-6, 24:20-21, 25:6-7, Tables B, C	6:1-3, 8:20-22, 22:27-23:1, 24:14-15, 24:31-32, Tables B, C	5:1-3, 7:8-10, 19:44-46, 21:6-7, 21:23-24, Tables B, C

Moreover, Petitioner does not dispute that the '904 application provides support for the '745 patent claims. In fact, Petitioner admits that the “specifications are substantively identical” and that “[t]he Examiner considered and expressly

found that ‘support for the claimed subject matter has be found in’ Samaniego’s [’904] application.” Pet., 49 (citing EX1002, 165); EX1013. Petitioner’s priority dispute is based solely on inventorship. Pet. 8, 49-51. But this issue is now moot. *See* Section III.A.

Thus, Petitioner, the Examiner, and Patent Owner’s expert all agree that, as required by § 120, the written descriptions of the earlier filed applications disclose claims 1-7 of the ’745 patent sufficient to satisfy the requirements of § 112.

C. The other requirements of § 120 are also met.

As shown below, each application in the priority chain was filed before the issuance or abandonment of the earlier filed application.

Appl. No.	Filing Date	Issue Date/ Abandonment Date	Exhibit No. (Issued Patent)
13/752,110	January 28, 2013	October 13, 2015	EX1001
12/238,842	September 26, 2008	February 19, 2013	EX2004
12/173,747	July 15, 2008	February 18, 2014	EX2005
11/269,916	November 7, 2005	October 15, 2009 ⁶	(abandoned)
09/929,904	August 14, 2001	November 8, 2005	EX2006

⁶ Notice of Abandonment. EX1010, 1091-92.

Finally, each subsequent application “contains ... a specific reference to the earlier filed application[s],” as required by § 120. *See* EX1002, 2, 81-87, 119; EX1027, 2; EX1026, 2; EX1010, 4.

D. Conclusion: Samaniego is not prior art.

The ’745 patent properly claims priority to the ’904 application and all of the requirements of § 120 are met. Samaniego, therefore, is not prior art to the challenged claims. Accordingly, Petitioner cannot show a reasonable likelihood of prevailing on Grounds 3-6, which rely on Samaniego as the primary reference.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION.

The combined discretionary considerations under Sections 314(a) and 325(d) strongly favor denying institution. Under Section 314(a), the Board should apply its informative *Chevron/Deeper* decisions because four of Petitioner’s six grounds are facially deficient: Grounds 3-6 rely on Samaniego, which is not prior art. Section III. This means only Grounds 1 and 2 are eligible for consideration on the merits, but Board precedent disfavors instituting review when the majority of the challenges fail to satisfy the threshold for institution.

Section 325(d) and the precedential *Advanced Bionics* decision compound the case for discretionary denial because the Office previously considered the primary reference asserted in Grounds 1 and 2. A PCT Publication (“Tso PCT”) that is substantively the same as the asserted primary reference—Tso—was

considered by the Examiner during prosecution of the '745 patent. In its § 325(d) discussion, Petitioner overlooks the Tso PCT and contends that “[n]one of the cited references was considered as art during prosecution.” Pet., 9. But this is not the proper analysis set forth in § 325(d) or in the Board’s *Advanced Bionics* framework. Rather, § 325(d) and *Advanced Bionics* instruct the Board to consider whether “the *same or substantially the same prior art* or arguments previously were presented to the Office.” The Tso PCT is plainly the same or substantially the same as the asserted Tso reference, which Petitioner fails to address. The Examiner also considered art with substantially the same teachings as the relevant teachings of Huang. Moreover, Petitioner’s superficial allegations of error fall well short of establishing *material* error, as required by Part 2 of the *Advanced Bionics* framework.

Considerations under Section 314(a) and Section 325(d) individually support discretionary denial. Combined, the case for discretionary denial is very strong.

A. Applying *Chevron* and *Deeper* favors denying institution because four of the six Grounds rely on Samaniego, which is not prior art.

Petitioner asserts six grounds against the challenged claims. *See* Pet., 6. Yet four of them—Grounds 3-6—require Samaniego. Pet., 6. But as discussed above in Section III, Samaniego is not prior art to the challenged claims. Accordingly, the four Samaniego grounds must fail, leaving only two grounds remaining.

Even if Petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims—here, Petitioner does not, *see infra* Section V—institution of review remains discretionary. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). Under the circumstances here—where instituting review would require reviewing all challenged claims under all grounds even though two-thirds of the grounds are deficient from the start—it would not be an efficient use of the Board’s time and resources to institute trial. *See Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9, 10–11 (P.T.A.B. Nov. 7, 2018) (informative) (explaining that “the Board may consider the number of claims and grounds that meet the reasonable likelihood standard when deciding whether to institute *inter partes* review under 35 U.S.C. § 314(a)”); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 41–43 (P.T.A.B. Jan. 24, 2019) (informative) (explaining the same); *see also BJ’s Wholesale Club Holdings, Inc. v. Walmart Apollo, LLC*, IPR2022-01561, Paper 11, 28-29 (P.T.A.B. Apr. 12, 2023) (exercising discretion to deny institution where Petitioner showed a reasonable likelihood of success only for 1 of 14 challenged claims on 2 of 4 asserted grounds).

Furthermore, as discussed below, the case for discretionary denial is particularly compelling where, as here, the Office previously considered the primary reference in the remaining two grounds.⁷ *See* Section IV.B. *Pharmacosmos A/S v. American Regent, Inc.*, PGR2020-00009, Paper 17 (P.T.A.B. Aug. 14, 2020) is instructive. In *Pharmacosmos*, the Board declined to institute all but one of Petitioner’s asserted grounds based on § 325(d). *Id.*, 6-28. As to the remaining ground, based on written description, the Board observed that “many of the issues raised by Petitioner with respect to written description overlap with arguments previously before the Office.” *Id.*, 29; *see id.*, 21 (“[T]here is substantial overlap between the arguments made in Petitioner’s written description analysis and those previously presented to the Office.”). Applying *Chevron* and *Deeper*, the Board denied institution, concluding that “instituting a trial with respect to all grounds based on evidence and arguments directed to only one ground, with overlapping issues to those already considered by the Office, would not be an efficient use of the Board’s time and resources.” *Id.*, 29.

The Board should thus exercise discretion under 35 U.S.C. § 314(a) to decline to institute *inter partes* review.

⁷ The Office also already considered teachings cumulative to the reference asserted in combination against the sole independent claim.

B. Applying *Advanced Bionics* favors denying institution of Grounds 1-2 because the Examiner considered the teachings of Tso and Huang during prosecution.

The Director also has the discretion to deny instituting a petition⁸ where “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board’s precedential *Advanced Bionics* decision “restat[ed] the framework in [§ 325(d)’s] statutory language” as a “two-part framework,” clarifying how the *Becton, Dickinson* factors fit within this framework. *Advanced Bionics v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6, 7-11 (P.T.A.B. Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). The policy undergirding “this framework reflects a commitment to defer

⁸ It is appropriate for the Board to apply § 325(d) to only certain grounds in the Petition, where other grounds are denied for different reasons. *See, e.g., Ocado Group PLC v. AutoStore Tech. AS*, IPR2021-00398, Paper 10 (P.T.A.B. July 21, 2021) (denying institution, exercising § 325(d) discretion for three grounds and denying two grounds based on an asserted reference not being shown to be prior art); *Volkswagen Group of America, Inc. v. StratosAudio, Inc.*, IPR2021-00717, Paper 12, (P.T.A.B. Nov. 12, 2021) (denying institution, exercising § 325(d) discretion for two grounds and assessing five on the merits); *Pharmacosmos*, PGR2020-00009, Paper 17.

to previous Office evaluations of the evidence of record unless material error is shown.” *Id.*, 9.

In *Becton, Dickinson*, the Board enumerated six non-exhaustive factors that it evaluates when determining whether to exercise its discretion under § 325(d). *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17-18 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). The first part of the *Advanced Bionics* framework considers “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.” *Advanced Bionics*, Paper 6, 8.

Under the second part of the *Advanced Bionics* framework, “if either condition of [the] first part of the framework is satisfied, [the Board determines] whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Id.*, 8. Examples of material error include “misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims” and “an error of law, such as misconstruing a claim term, where the construction impacts patentability of the challenged claims.” *Id.*, 8-9, n.9.

Petitioner carries the burden of demonstrating material error: “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to

make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Id.*, 8-9; *see also Becton, Dickinson*, Paper 8, 17-18 (factor (e) asks “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art.”).

Petitioner’s Grounds 1-2 are based primarily on a reference—Tso—that is the same or substantially the same as art that was previously presented to the Office, and the teachings of the secondary reference applied against the sole independent claim are cumulative. And Petitioner has failed to meet its burden to show material error in the Office’s prior consideration of the patentability of the claims of the ’745 patent in view of Tso’s disclosure. Accordingly, the Board should deny Grounds 1-2 under § 325(d).

1. Part 1: Petitioner advances the same or substantially the same art that was previously presented to the Office.

Petitioner contends that “[n]one of the cited references was considered as art during prosecution.” Pet., 9. First, this mischaracterizes the *Advanced Bionics* test, which does not merely evaluate whether the Petition references were “considered” during prosecution, but rather whether the same or substantially the same art previously was presented to the Office. *Advanced Bionics*, Paper 6, 7-8.

Second, although Petitioner’s statement is technically accurate, it obscures a critical fact—the Tso patent applied in the Petition is identical to another reference considered during prosecution. Thus, Petitioner’s further assertion is false that

none of the art considered by the Office is substantially similar to the art in the Petition. Pet., 9. (“Even if any art considered by the USPTO was substantially similar to these references (none is)...”). Indeed, Tso—the primary reference in Petitioner’s Grounds 1-2—is the same (or at the very least substantially the same) as WO-9843177 (“Tso PCT”, EX2007), also to Tso, which was previously presented to the Office. In fact, Tso PCT is the international publication of the PCT application corresponding to the Tso patent in the Petition. *See* EX2007, (30).⁹ The drawings and specification are identical. *Compare* EX1004, *with* EX2007; *see* EX2008.

The Applicant cited Tso PCT in an Information Disclosure Statement (“IDS”), EX1002, 71-80, which the Examiner initialed as being considered,

⁹ As shown on its face, Tso PCT claims priority to US 60/041,366, the same provisional application to which Tso claims priority. EX2007, (30); EX1004, (60). The priority listing to US 08/925,275 is a clear typographical error of US 08/925,276, the application that issued as Tso. EX2007, (30). US 08/925,275 is clearly unrelated to Tso PCT; it is titled “High-performance Overprint Varnishes Comprising Composite SMA Latices” and lists entirely different inventors than those listed on Tso PCT. EX2009 (U.S. 5,902,846, which issued from U.S. 08/925,275), (54); *compare id.*, (75), *with* EX2007, (72).

EX1002, 177-185. Citation of a reference to the Office on an IDS satisfies Part 1 of the *Advanced Bionics* framework. *Advanced Bionics*, Paper 6, 7-8 (“Previously presented art includes ... art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.”). Contrary to Petitioner’s suggestion otherwise, it is irrelevant that “[t]he Examiner did not issue any rejections before allowance,” Pet., 9, whether based on Tso PCT or another reference. *See Boragen, Inc. v. Syngenta Participations AG*, IPR2020-00124, Paper 16, 21-22 (PTAB May 5, 2020) (denying Petition under § 325(d) and explaining that “a rejection applying a reference that is later relied upon by a petitioner is not a prerequisite to a finding that such reference was already presented to the Office under § 325(d).”).

Petitioner’s Ground 1, challenging the sole independent claim, additionally relies on Huang. Pet., 6. In particular, Petitioner points to Huang’s teachings of a transcoding process that is partitioned into stages by caching and retrieving partially transcoded versions of a media object using distributed object transcoders (proxy servers). Pet. 16-21 (citing EX1005, 1:17-26, 1:57-58, 2:1-13, 2:37-44, 4:24-39, 5:42-52, 5:60-6:23, 6:56-68, 7:23-8:16, 9:4-14, Fig. 4). The Examiner, however, already considered substantially similar disclosures during prosecution. For example, Neogi, U.S. Patent No. 6,483,851 (EX2011) was cited in an IDS, EX1002, 71-80, which the Examiner initialed as being considered, *id.*, 177-185.

Like Huang, 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. EX2011, 1:14-16, 1:53-60, 2:16-26, 2:52-67, 3:2-4, 3:8-30, 3:60-65. Petitioner's reliance on the cumulative teachings of Huang further demonstrate that the same or substantially the same art was previously presented to and considered by the Office.

In sum, Part 1 of the *Advanced Bionics* framework is satisfied because Petitioner's primary reference, Tso, is the same or at least substantially the same art as Tso PCT considered by the Examiner during prosecution. Further, the Examiner considered art with substantially the same teachings as the relevant teachings of Huang.

2. Part 2: Petitioner fails to identify material error in the Office's previous evaluation of the art and arguments.

As discussed above, Part 1 of the *Advanced Bionics* framework is satisfied. Tso is the same or substantially the same as art that previously was presented to the Office. And the relevant teachings of Huang are substantially similar to Neogi, which also was previously presented. Thus, the Board must turn to *Advanced Bionics* Part 2. See, e.g., *ADT LLC v. Vivint, Inc.*, IPR2022-00612, Paper 8, 10, 21-23 (P.T.A.B. Aug. 22, 2022) (denying institution under § 325(d) and finding Part 1 satisfied when only 2 of 3 references in the asserted Petition ground were substantially the same as art previously presented to the Office). And Petitioner is

required to “demonstrate[] that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6, 8. Here, Petitioner fails to meet its burden.

Indeed, having wrongly concluded without any significant analysis that Part 1 of the *Advanced Bionics* framework is not satisfied, Petitioner does not meaningfully address Part 2. *See* Pet., 9. Rather, Petitioner merely asserts that “the Examiner would have erred in not rejecting the Claims.” *Id.* Petitioner’s generic assertion is not sufficient to show material error. *Advanced Bionics*, Paper 6, 8-9 n.9 (noting that examples of material error include “misapprehending or overlooking specific teachings of the relevant prior art” or “an error of law, such as misconstruing a claim term”); *id.*, 9 (emphasizing the Office’s “commitment to defer to previous Office evaluations of the evidence of record unless material error is shown”).

Petitioner contends that because “[t]he Examiner ‘did not expressly consider’ any cited references as prior art,” it “render[s] it difficult, if not impossible, to explain ‘how the Examiner might have considered the arguments presented in the Petition.’” Pet., 9 (*quoting Bowtech, Inc. v. MCP IP, LLC*, IPR2019-00379, Paper 14, 20 (P.T.A.B. July 3, 2019)). The non-precedential *Bowtech* decision Petitioner cites issued *before* the precedential *Advanced Bionics* decision. There is simply no requirement that a reference was expressly discussed

by the Examiner in order for the Board to exercise discretion under § 325(d). *See Borgen, Inc.*, IPR2020-00124, Paper 16, 21-22.

Part 2 of the *Advanced Bionics* framework also considers “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art” (factor (e)) and “the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments” (factor (f)). *Becton, Dickinson*, Paper 6, 17–18; *Advanced Bionics*, Paper 6, 10. Petitioner does not address these factors, making no specific allegations of error. *See Pet.*, 9.

The Office already considered Petitioner’s primary reference—Tso—in assessing the patentability of the challenged claims; and Petitioner fails to provide any reason why the Office materially erred in doing so. When “the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Advanced Bionics*, Paper 6, 8-9. Petitioner fails to do so here. Thus, the Board should follow its *Advanced Bionics* precedent and deny the Petition under § 325(d).

* * *

The combined discretionary considerations under Sections 314(a) and 325(d) strongly favor denying institution because four of the six Grounds are facially deficient for relying on a primary reference that does not qualify as prior

art and two of the six Grounds are based on the same or substantially the same art that the Office already considered. The merits, discussed below, further demonstrate that institution of review is not warranted.

V. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THE CLAIMS WOULD HAVE BEEN OBVIOUS OVER THE TSO-BASED COMBINATIONS (GROUNDS 1-2).

“Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co.*, 383 US 1, 17 (1966). “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements.” *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). And “conclusory expert testimony is inadequate to support an obviousness determination” *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-16 (P.T.A.B. August 24, 2022) (precedential) (rejecting expert testimony when “the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”).

In Ground 1, Petitioner alleges independent claim 1 and dependent claims 2-5 would have been obvious over the combination of Tso and Huang; and in Ground 2, Petitioner alleges dependent claims 6 and 7 would have been obvious

over the combination of Tso, Huang, and Lawler. Pet., 6. The Board should deny institution of Grounds 1 and 2 on the merits because Petitioner fails to demonstrate a reasonable likelihood that Tso discloses Element [1.b] of independent claim 1. Specifically, Petitioner fails to show that Tso's transcoding server 34 receives, from Tso's network client 12, a "first request [that] contains information . . . indicating . . . first content generation operations."

A. Overview of Tso

Tso discloses "[a] system for dynamically transcoding data transmitted between computers . . . implemented in an apparatus for use in transmitting data between a network server and a network client over a communications link." EX1004, Abstract. "The apparatus includes a parser[,] coupled to a transcode service provider," and that "is configured to selectively invoke the transcode service provider in response to a predetermined selection criterion." *Id.*

Figure 3 of Tso, reproduced below, illustrates the apparatus as "transcoding server 34," which is coupled to "network client 12" via communications link 14 and to the "Internet 18" via communications link 16. EX1004, 3:31-44, FIG. 3. As shown below, the "transcoding server 34 includes an HTTP (HyperText Transfer Protocol) remote proxy 36, capable of accessing Internet 18 over server/network communications link 16," EX1004, 3:32-34, and "a transcoder 20 . . . coupled to HTTP remote proxy 36, EX1004, 3:46-47. Tso discloses that "using transcoder 20,

HTTP remote proxy 36 is capable of changing content received from Internet 18 prior to returning it to a requesting network client 12.” EX1004, 3:40-44.

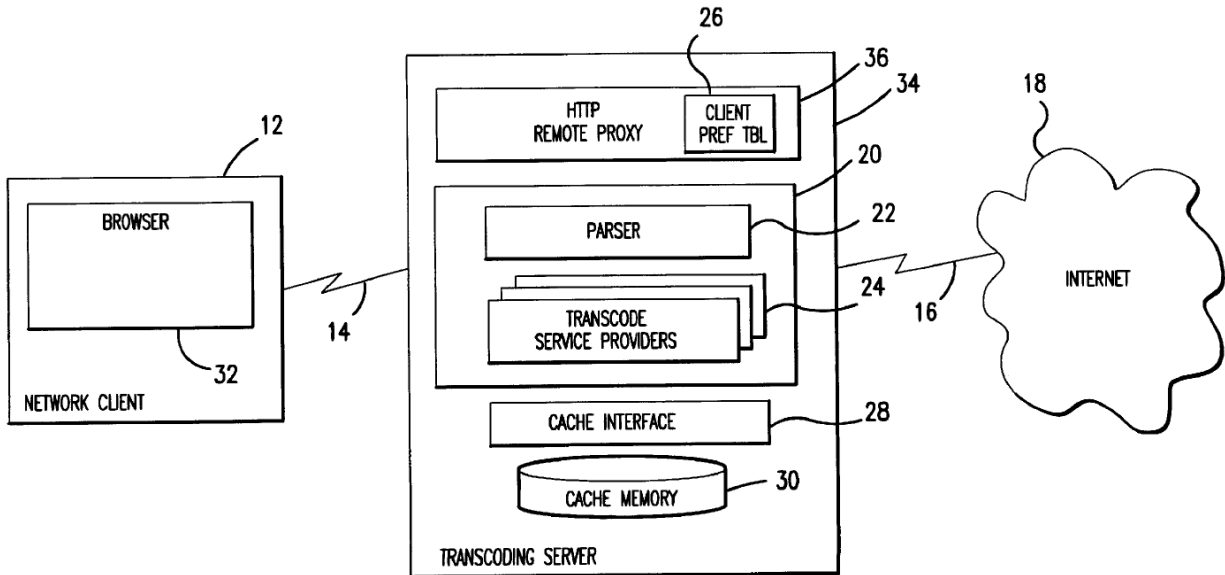


FIG.3

EX1004, FIG. 3.

For example, Tso discloses that “transcode service providers 24 [of transcoding server 34] may provide the capability to compress and/or scale different types of data content, such as image, video, or HTML.” EX1004, 3:51-54. Tso explains that “[p]arser 22 selects an appropriate transcode service provider 24 based, for example, on the content type of the data stream.” EX1004, 6:37-39. And the transcode service provider(s) 24 “transcodes the data stream appropriately, and HTTP remote proxy 26 transmits the transcoded data stream to network client 12.” EX1004, 10:47-49.

B. Petitioner fails to demonstrate that Tso discloses Element [1.b] because it fails to show that Tso’s transcoding server receives, from Tso’s network client, a request indicating “first content generation operations.”

Petitioner alleges that Tso discloses Element [1.b], and does not rely on Huang or Lawler to address this claim element. Pet., 24-26. Element [1.b] recites: “wherein the first request contains information, the information indicating a first original media content, first content generation operations, and first transformation operations.” EX1001, 23:15-18. Element [1.a] provides antecedent basis for “the first request,” reciting “receiving *a first request* from *a first playback device* for media content.” EX1001, 23:13-14. Accordingly, the claimed “first request” must be received from the “first playback device” and include information indicating (at least) three things: (1) “a first original media content,” (2) “first content generation operations,” and (3) “first transformation operations.”

As shown below, in Element [1.a], Petitioner maps Tso’s network client 12 to the claimed “first playback device,” and alleges that Tso’s transcoding server 34 receives the claimed “first request” from Tso’s network client 12. Pet., 23-24 (“Tso also discloses a ‘transcoding server’ receiving a ‘HTTP request’ for image or video data from a ‘network client.’”). Accordingly, to satisfy Element [1.b], Petitioner must demonstrate that Tso’s transcoding server 34 receives a request from Tso’s network client 12 containing information indicating each of the three items recited in Element [1.b].

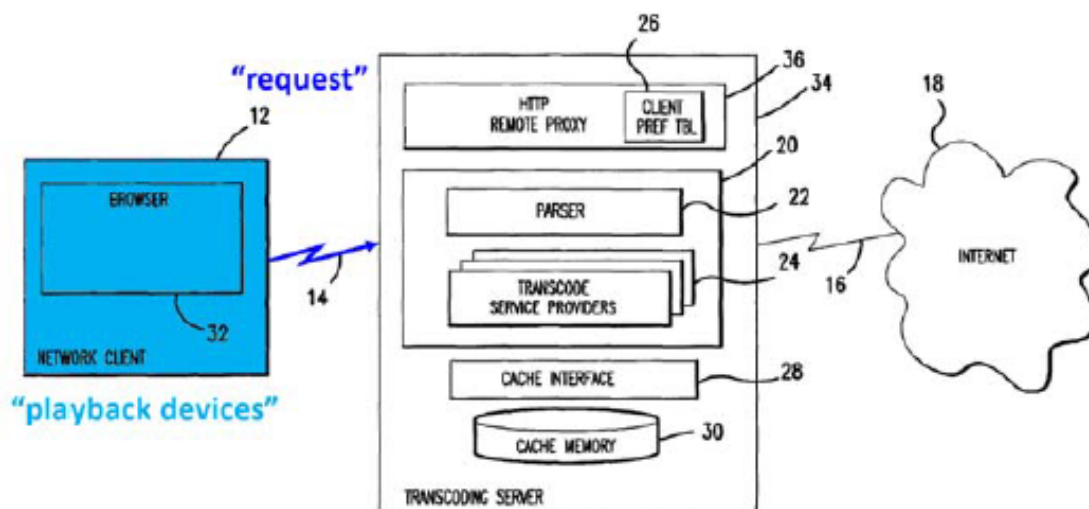


FIG.3

Pet., 24.

Petitioner fails to do so. Specifically, Petitioner fails to demonstrate that Tso’s transcoding server 34 receives, from Tso’s network client 12, a “first request [that] contains information . . . indicating . . . first content generation operations.” Petitioner maps Tso’s content characteristics to the claimed “first content generation operations,” Pet., 24-25, but fails to show that Tso’s transcoding server 34 receives Tso’s content characteristics *from* Tso’s network client 12.

Tso’s transcoding server 34 includes a parser 22 and transcode service providers 24. EX1004, 3:45-51, FIG. 3. Tso discloses that the “parser 22 may selectively invoke one of transcode service providers 24 based upon satisfaction of a predetermined selection criterion” and that “[s]uch selection criterion may comprise, for example, information contained in a header portion of a data packet received by transcoding server 34” or “contained in a data portion of such a data

packet.” EX1004, 6:64-7:7. Tso further discloses nine “examples of the types of information which may be used to dictate which of transcode service providers 24 are invoked,” one of which is “content characteristics, such as its data type, type of encoding/compression, size, and dimension.” EX1004, 7:15-8:9.

But Tso does not disclose, and Petitioner fails to demonstrate, that Tso’s transcoding server 34 receives the content characteristics in a request *from* the network client 12. *See* EX1004, 7:15-8:9. On the contrary, Tso’s express teachings demonstrate that the content characteristics are received from the Internet 18, not from the network client 12. *See* EX1004, 9:49-10:49.

Specifically, Tso provides an example “illustrat[ing] the general operation of the embodiment illustrated in FIG. 3,” which begins when “[n]etwork client 12, via browser 32, transmits an HTTP request for the hypertext object to transcoding server 34 over client/server communication link 14.” EX1004, 9:49-56. When “no entry exists in server-side cache memory 30 [of transcoding server 34] for the requested hypertext object,” the “HTTP remote proxy 36” of transcoding server 34 attempts “to retrieve the hypertext object from Internet 18.” EX1004, 10:28-34. If found, the “HTTP remote proxy 36 begins receiving *an HTTP data stream* representing the hypertext object,” and “passes the handle for this incoming data stream to parser 22.” EX1004, 10:32-36.

Critically, Tso discloses that the “parser 22 may determine the *content type* for the data stream (e.g., image/jpeg, image/gif, video/mpeg) by interrogating a MIME type in the content-type header record that appears *at the beginning of the incoming HTTP data stream.*” EX1004, 10:40-44. The “data type” (such as “image” or “video”) and the “type of encoding/compression” (such as “jpeg,” “gif,” or “mpeg”) are examples of Tso’s content characteristics upon which Petitioner relies: “content characteristics, such as its *data type, type of encoding/compression*, size, and dimension.” EX1004, 7:31-33; *see* Pet., 24-25. But Tso’s example demonstrates that the transcoding server 34 receives these content characteristics from the Internet 18, not from the network client 12. EX1004, 10:32-44 (disclosing that “the incoming HTTP data stream” having the “content-type header record” is received from the Internet 18).

This is consistent with Tso’s disclosure in column 6, line 64 through column 8, line 9, which Petitioner relies on in addressing Element [1.b]. Pet., 24-25. There, Tso discloses the nine example types of information that may be used to invoke the transcode service providers 24, but does not specify from which device the nine types of information are sent. *See* EX1004, 6:64-7:14 (disclosing that the transcoding server 34 receives information included in the header or body of a data packet, but not specifying from where the packet was sent). And, notably, most of the nine examples are characteristics or preferences of devices or entities *other*

than the network client 12, such as “characteristics of the transcoding server” itself; “content characteristics”; “network characteristics”; “proxy characteristics”; “group preferences, including results from collaborative rating systems”; “content provider preferences;” and “other preferences, including software vendor rules or programs for dynamically checking content created or distributed using unauthorized software” EX1004, 7:15-8:9.

The Petition is wholly deficient on this point, glossing over this key distinction in its discussion of Element [1.b]. *See* Pet., 24-26. Indeed, neither Petitioner nor Dr. Madisetti provides any explanation or support for their position that Tso’s transcoding server 34 allegedly receives the content characteristics in a “request ‘packet’” from the network client 12. *See* Pet., 24-25, EX1003, ¶¶91-92. They fail to explain, for example, why a POSITA would have understood that the content characteristics are received from the network client 12 despite Tso’s express and contrary teachings that such information is received from the Internet 18, as discussed above. *See* EX1004, 10:32-44. Indeed, Dr. Madisetti does little more than repeat the block quotes presented in the Petition. *Compare* Pet., 24-26 *with* EX1003, ¶¶91-92. Thus, his opinions are not entitled to weight and do not save the Petition.

Instead, in their general descriptions of Tso, Petitioner and Dr. Madisetti mischaracterize Tso’s disclosure at column 6, line 64 through column 8, line 9,

suggesting that Tso discloses that the network client 12 sends a “request packet [that] stores ‘selection criteria.’” Pet., 13-14; EX1003, ¶¶66-67.¹⁰ But Tso does not disclose a “request packet” or that a request from the network client 12 includes any of the nine example types of information that may be used to invoke the transcode service providers. *See* EX1004, 6:64-8:9.

In sum, Petitioner’s arguments with respect to Element [1.b] fail because Petitioner does not demonstrate that Tso’s transcoding server 34 receives Tso’s content characteristics *from* Tso’s network client 12. Tso expressly teaches that such content characteristics are received from the Internet 18, not from Tso’s network client 12. Accordingly, the Board should deny institution on the merits.

¹⁰ Dr. Madisetti misquotes Tso, using quotes around *request packet* and citing to Tso at 6:64-8:9. EX1003, ¶66 (“The ‘request packet’ sent by the client . . .”). Tso uses the term “data packet” only twice, and does not use the term “request packet.”

VI. CONCLUSION

The Petition fails to show a reasonable likelihood that the challenged claims are unpatentable as anticipated or obvious in view of the cited art and, therefore, the Board should deny institution.

Respectfully submitted,

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A handwritten signature in black ink, reading "Richard M. Bembien". The signature is written in a cursive, flowing style with a large initial 'R'.

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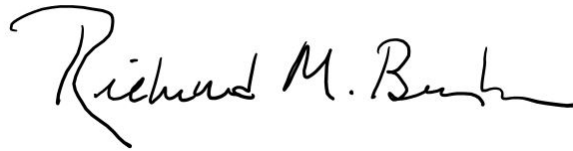
CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER PRELIMINARY
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were served in their entireties on April 26, 2023, upon the following counsel of
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