

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

**PETITIONER'S PRE-INSTITUTION REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

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TABLE OF ABBREVIATIONS

'009	U.S. Patent No. 6,964,009 (Ex. 2006)
'745	U.S. Patent No. 9,158,745 (Ex. 1001)
Claims	Claims 1-7 of U.S. Patent No. 9,158,745
COC	Certificate of Correction
Huang	U.S. Patent No. 6,438,576 (Ex. 1005)
IDS	Information Disclosure Statement
IPR	<i>Inter Partes</i> Review
Neogi	U.S. Patent No. 6,483,851 (Ex. 2011)
Pet./Petition	Petition for <i>Inter Partes</i> Review (Paper 2)
Petitioner	Petitioner Akamai Technologies, Inc
PO	Patent Owner Equil IP Holdings LLC
POPR	Patent Owner Preliminary Response (Paper 8)
PTAB	Patent Trial and Appeal Board
RHI	Receiver Hint Information
Samaniego	U.S. Patent Application No. 2002/0078093 (Ex. 1007)
Tso	U.S. Patent No. 6,421,733 (Ex. 1004)
Tso-PCT	PCT Publication WO 98/43177 (Ex. 2007)
USPTO	United States Patent and Trademark Office

EXHIBIT LIST

Ex. 1001	U.S. Patent No. 9,158,745 (“’745”)
Ex. 1002	File History of U.S. Application No. 13/752,110 (“’745 FH)
Ex. 1003	Declaration of Vijay K. Madiseti in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,158,745
Ex. 1004	U.S. Patent No. 6,421,733 (“Tso”)
Ex. 1005	U.S. Patent No. 6,438,576 (“Huang”)
Ex. 1006	U.S. Patent No. 5,905,522 (“Lawler”)
Ex. 1007	U.S. Patent Application Publication No. US 2002/0078093 (“Samaniego”)
Ex. 1008	U.S. Patent No. 5,420,967 (“Delp”)
Ex. 1009	U.S. Patent No. 5,969,716 (“Davis”)
Ex. 1010	File History of U.S. Application No. 11/269,916 (“’916 FH)
Ex. 1011	(Reserved)
Ex. 1012	U.S. Patent No. 6,792,575 (“’575”)
Ex. 1013	Redline Comparison of specifications from Samaniego and the ’745 patent
Ex. 1014	Loralee Stevens, Internet Video Startup Gets \$3.5 Million, N. Bay Bus. J. (Apr. 14, 2008), https://web.archive.org/web/20080421191837/www.northbaybusinessjournal.com/article/20080414/BUSINESSJOURNAL/19773530/1207/BUSINESSJOURNAL02
Ex. 1015	LinkedIn Profile for Chris Samaniego, https://www.linkedin.com/in/chris-samaniego-18b6a01

Ex. 1016	<i>Equil IP Holdings LLC v. Akamai Technologies, Inc.</i> , 1:22-cv-00677 (D. Del. 2022) First Amended complaint (Aug. 3, 2022)
Ex. 1017	(Reserved)
Ex. 1018	(Reserved)
Ex. 1019	(Reserved)
Ex. 1020	Docket Report for Berger-Great South Ventures LLC v. Equilibrium Techs.
Ex. 1021	Redline Comparison of specifications from Samaniego and Publication No. 2006-0265476 of Application No. 11/269,916
Ex. 1022	(Reserved)
Ex. 1023	(Reserved)
Ex. 1024	(Reserved)
Ex. 1025	(Reserved)
Ex. 1026	File History of U.S. Application No. 12/173,747 (“’046 FH”)
Ex. 1027	File History of U.S. Application No. 12/238,842 (“’110 FH”)
Ex. 1028	Redline Comparison of specifications from Samaniego and Publication No. 2009-0070485 of Application No. 12/173,747
Ex. 1029	Redline Comparison of specifications from Samaniego and Publication No. 2009-0089422 of Application No. 12/238,842
Ex. 1030	(Reserved)
Ex. 1031	(Reserved)
Ex. 1032	(Reserved)
Ex. 1033	Gerald Graef, <i>Graphics Formats for Linux</i> , 23 LINUX J., March 1996, https://dl.acm.org/doi/fullHtml/10.5555/325530.325533

Ex. 1034	File History of U.S. Application No. 09/425,326 (“’575 FH”)
Ex. 1035	File History of U.S. Application No. 09/929,904 (“’009 FH”)
Ex. 1036	Luca Delgrossi et al., <i>Media Scaling in a Multimedia Communication System</i> , 2 MULTIMEDIA SYS. 172 (1994), https://link.springer.com/article/10.1007/BF01210448
Ex. 1037	Armando Fox and Eric A. Brewer, <i>Reducing WWW latency and bandwidth requirements by real-time distillation</i> , COMPUT. NETWORKS & ISDN SYS., PROCS. 5TH INT’L WORLD WIDE WEB CONF. (May 1996), https://www.sciencedirect.com/science/article/abs/pii/016975529600027X
Ex. 1038	U.S. Patent No. 6,144,996 (“Starnes”)
Ex. 1039	Declaration of Jonathan Bradford
Ex.1040	PTAB Email dated May 18, 2023
Ex.1041	<i>Madstad Engineering, Inc. v. U.S. Patent and Trademark Office</i> , 8:12-cv-01589-SDM-MAP (U.S. Dist. Ct., M.D. Fla., Tampa Div. 2012) Defendant’s Motion to Dismiss and Memorandum in Support (Sep. 18, 2012)

PO's inventorship and §325(d) arguments, which are addressed in this Reply (see Ex. 1040), lack merit. IPR should be instituted.

A. PO's Purported Inventorship Correction Does Not Affect Samaniego's Prior Art Status in This IPR Because the '745 Is Not the Patent "In Which Such [Purported] Error Occurred"

There is no dispute that, if Samaniego (Ex. 1007) is prior art, it anticipates the '745's challenged claims. See Pap. 8 ("POPR"), 13-19 ("Petitioner, the Examiner, and [PO]'s expert all agree that ... the written description[of Samaniego] disclose[s] claims 1-7"). And, there is no dispute that Samaniego shared no common inventors with the '745—and therefore qualified as prior art—when the '745 expired and the Petition was filed. See Exs. 1001, 1007; §120. PO's sole substantive argument addressing Samaniego (Grounds 3-6) is that PO's recently-secured Certificate of Correction for the '009 ("'009 COC") somehow disqualifies Samaniego retroactively.¹ POPR 1. But no statute or case supports PO's position.

PO argues that the '009 COC petition retroactively removes the '009 from serving as prior art to the '745, but §256(b), which authorizes the '009 COC, limits its effects to only inventorship errors in the patent being corrected, *i.e.*, the '009:

¹ Petitioner disputes the propriety of the '009 COC, but will address this and related inequitable conduct issues in litigation due to the scope of IPR jurisdiction here. See §318(a). Section references are to 35 U.S.C. Emphasis added unless otherwise noted.

“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 [§256].” §256(b). The section does not authorize retroactive impact on the ’745.²

Rather, §256(b) is a “savings provision” to avoid invalidity under §102(f)—which renders a patent invalid if the named inventor “did not himself invent the subject matter sought to be patented.” §102(f); *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998) (“This section is a savings provision. ... When a party asserts invalidity under §102(f) ... a patentee may invoke section 256 to save the patent from invalidity.”).³ The IPR Petition here addresses prior art unpatentability of the ’745’s claims, not §102(f) inventorship challenges—nor could it. See §311(b).

Moreover, any retroactive effect of a COC must be explicitly authorized by Congress: as a general matter, “[r]etroactivity is not favored in the law,” and “congressional enactments and administrative rules will not be construed to have retroactive effect unless their language requires this result.” *Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988). It is well-established that COCs for USPTO and clerical errors therefore have only a prospective effect on “the trial of actions

² §256(b) also does not provide for any impact on Samaniego.

³ The ’745 is pre-AIA, but even post-AIA, the same inventorship challenges continue to apply. See Ex. 1041, 9-10.

for causes thereafter arising.” *See* §§254-255. §256(b) similarly expressly limits the effect of COCs to only the patent “in which such error occurred,” and therein only to errors of inventorship implicating §102(f). And unlike §254 corrections, §256(b) COCs are not “considered as part of the original patent.” But even if the correction had been made under §§254-255, there are no further “causes thereafter arising” because the ’745 expired on 7/20/2020. Ex. 1001. By statute, the ’009 COC therefore has only a confined effect that does not retroactively impact the ’745.

PO’s arguments about the ’009 COC and its alleged retroactive effect also conveniently overlook PO’s failure to timely raise the alleged inventorship defect. *See Sw. Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1296 (Fed. Cir. 2000) (finding that requiring a patentee to “check a patent when it is issued” is not “asking too much”). PO has known of this purported inventorship issue since at least 2008—before the ’745 was filed—when it filed a related application removing Samaniego’s inventors and replacing them with an entirely new set of inventors. *See* Ex. 1026, 79-87. Yet, PO never sought to correct the ’009’s inventorship during the entire life of the ’745. During that span, the public has been on notice that the ’745 was invalid over Samaniego given the discontinuity in inventorship. Petitioner relied on this discontinuity and filed a petition seeking to invalidate these claims based on this deficiency. *See Sw. Software*, 226 F.3d at 1295–96 (refusing to allow patent holder to sue for pre-COC activities when “a claim would appear invalid to the public”

because it would have been “an illogical result”). The ’745 should be analyzed through that same lens pre-COC. And even if the ’009 COC could have had an impact on Samaniego’s inventorship for causes of action going forward, that is of no moment here because the ’745 expired years before the COC.⁴

For each of these reasons, PO’s COC does not change the fact that Samaniego remains prior art to the ’745—as it was throughout the life of the ’745.⁵

B. The Cited Prior Art Presents Unconsidered Teachings

Initially, the Board should not exercise discretion in light of Samaniego’s anticipatory and unconsidered teachings (Grounds 3-6) as explained above.

PO’s §325(d) arguments for Grounds 1-2 also fail. PO disputes only whether **Tso** and **Huang** or similar teachings were previously considered and whether the examiner erred. **Huang** was not before the USPTO, and PO does not contend that the examiner considered similar arguments during prosecution because the Notice of Allowance issued without rejections. See POPR 26-29; Pet. 8.⁶ Under *Advanced*

⁴ While a correction of inventorship through reissue (MPEP 1402 II) would have provided public notice through a republished revised inventive entity, PO did not avail itself of this vehicle and cannot now because the ’009 has expired.

⁵ PO’s §314(a) argument based on Grounds 3-6 is therefore inapposite.

⁶ PO’s argument that §325(d) findings based on “*arguments*” previously before the

Bionics, **Huang’s** teachings, applied to **Tso**, differ from what the examiner considered—and it was error to overlook any similarity that might have existed.

Huang’s teachings of creating and reusing previously-created intermediate content items were not previously considered. As the Petition explained, the Claims recite “creating” “intermediate media content” using “content generation” operations, and creating “optimized media content” by “performing” “transformation operations” on a previously-generated “intermediate media content” that is “available for reuse.” Pet. 1, 7-8, 26-36 ([1.c]-[1.e]); *see also* POPR 8. Grounds 1-2 rely on **Huang** for its teachings of caching and reusing “intermediate media content.” *See, e.g.*, Pet. 26-36 ([1.c]-[1.e]); *see also id.* 16-18. Specifically, **Huang** teaches using “RHI” information to track “partially rendered” and cached content. Huang, 4:24-39, 6:9-23, 6:63-67, 7:42-8:11; Pet. 30-32. When another request for content arrives, a server uses RHI to retrieve a cached partially-rendered version of content, and further renders that partially-rendered version to “complet[e] the entire rendering process.” *Id.*; Pet. 33. As the Petition explains, applying these teachings to **Tso** yields a system in which, when selection criteria in a request specify the transcode operations dictating the invoked transcode service providers (*e.g.*, Tso, 4:19-29, 6:64-8:9, Pet. 13, 24-26, 33-34), the “partial” transcoding output from each

Office” also support §314(a) discretion are therefore irrelevant. *Cf.* POPR 23.

service provider is cached as intermediate content so it can be reused—and is reused for subsequent requests specifying those transcoding steps. *E.g.*, Huang, 6:63-67, 5:42-44, 7:36-41; Pet. 29-33, 35-36.

Huang’s teachings of these elements markedly differ from those considered during prosecution. PO contends that Neogi (Ex. 2011) and Huang have substantially similar “partitioned” processing teachings (POPR 28), but Neogi does not teach creating and reusing previously-created intermediate content. Neogi teaches transcoding content in “stages,” e.g., by “filtering” and “interpolating” multimedia in stages. Neogi, 1:56-60, 3:18-39. Neogi does not discuss caching, storing, or reusing such transcoded content at all. PO cites Neogi’s “buffer pooling,” but these buffer pools are part of a single “adaptive pipeline” for a “transcoding service” to stage a transcoding process, and are not used to store and reuse previously-created intermediate content. Neogi, 2:52-3:4, Fig. 3. These “buffer pools” are different from Huang’s teachings discussed for [1.c]-[1.e].

As to **Tso**, while Tso-PCT (Ex. 2007) has substantially the same disclosures, the Petition relies on Huang, not Tso, for the [1.c]-[1.e] creating and reusing intermediate content as discussed above. While the POPR notes that the petition did not discuss Tso-PCT, this is of no moment to the presented combination. In any event, Tso-PCT was only identified in an IDS, nothing more. Tso does not identify Tso-PCT and, due to a typo, Tso-PCT does not identify Tso. *See* POPR 27-28 n.9.

Even if the existence of Tso-PCT on an IDS were enough to trigger §325(d), and it is not, the Director recently held that, in these circumstances, it was “not reasonably foreseeable for Petitioner to have anticipated this connection since the references themselves do not point to each other.” *Google LLC v. Valtrus Innovs. Ltd.*, IPR2022-01197, Pap. 12, *5 (Director *sua sponte* vacating exercise of §325(d) discretion). Because **Huang’s** teachings, applied to **Tso**, are not substantially similar to any cited art, §325(d) discretion should not apply here. *Sony v. MZ Audio Scis., LLC*, IPR2022-01544, Pap. 12, *7 (§325(d) discretion improper where “Examiner did not consider the specific combination of references asserted”).

Even if any art or arguments were substantially the same, failure to consider such art was material error. The Examiner did not issue rejections before allowing the ’745. See Pet. 8. In such circumstances, it is “impossible ... to determine the consideration the Examiner gave” to any cited reference and, at the second part of *Advanced Bionics*, “the absence of further evidence of the Examiner’s consideration of” the art supports finding that “the Office erred in a manner material to patentability.” *Ecobee Techs. v. Causam Enterprises, Inc.*, IPR2022-01339, Pap. 20, *20-21 (declining to exercise §325(d) discretion). Such error exists here, as summarized above for Huang and in §IX of the Petition.

Respectfully submitted,

Dated: May 30, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PETITIONER'S PRE-INSTITUTION REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE and EXHIBIT 1041 was served in its entirety by filing these documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as providing a courtesy copy via e-mail to the following attorneys of record for the Patent Owner listed below:

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