

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2023-00628
(Patent 7,233,790 B2)

Before JEFFREY S. SMITH, STACEY G. WHITE, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

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

On July 26, 2023, a conference call was held between the parties and the Board to discuss authorizing a reply to Patent Owner's Preliminary Response (Paper 6). Petitioner's request for authorization is **GRANTED**.

Ex Parte Reexamination No. 90/015,063 (the "'063 reexam") was filed June 22, 2022 regarding U.S. Patent No. 7,233,790 ("the '790 patent"). Ex. 2013. The Petition in the instant proceeding was filed February 23, 2023, challenging claims 1–14 of the '790 patent. Paper 1. A Notice of Intent to Issue a Reexamination Certificate issued on June 20, 2023. Ex. 2011. The Reexam Certificate is expected to issue before we issue our decision on whether to institute.

Patent Owner did not reference the pending reexamination in either its original or updated Mandatory Notices. *See* Papers 4, 8; *see also* 37 C.F.R. § 42.8 (b)(2) (requiring the parties to "[i]dentify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding"). Patent Owner, however, did address the '063 reexam and the Notice of Intent to Issue a Reexamination Certificate in its July 5, 2023 Patent Owner Preliminary Response. Paper 6. In its Preliminary Response, Patent Owner states that "newly amended claims are expected to issue soon, making claims 1 and 8 as originally issued (pre-amendment), as a practical matter, extinguished." *Id.* at 1. In light of this, Petitioner seeks authorization for briefing to discuss the impact of this impending issuance of two new amended claims on the pending Petition for *inter partes* review. No decision has been made as to whether to institute *inter partes* review in this proceeding.

As discussed in our July 26, 2023 conference call there are two issues that Petitioner wishes to address in its briefing: (1) whether the Board should institute on all of the original claims as presented in the Petition, and

(2) whether the Board should institute on claims 1 and 8 as amended during the '063 reexam.

In addressing the first issue, the Board requests the parties consider the following questions:

A. Should the Board stay the Reexam Certificate and address original claims 1 and 8 on the merits? *See Weatherford Int'l v. Operations*, IPR2019-00768, 2020 WL 2830017 (PTAB May 29, 2020) (discussing factors to be considered in deciding whether to stay a parallel proceeding involving the same patent).

B. If the Reexam Certificate issues, is there any barrier to the Board treating original claims 1 and 8 as disclaimed claims and addressing the Petition's challenges to claims 2–7 and 9–14 on the merits?

In addressing the second issue, the Board requests the parties consider the following questions:

A. Is there a legal basis for the pending *inter partes* review to consider instituting review of amended claims 1 and 8 based on arguments and evidence already presented in the Petition and applied to original claims 1 and 8 and/or other challenged claims in the Petition?

1. For example, the Federal Circuit has held that “amended or new claims incorporated into reexamined patents do not automatically abate—let alone moot—any pending action against the accused infringer based on the patents if the amended or new claims are ‘substantially identical’ to the original claims.” *SHFL Entertainment, Inc. v. DigiDeal Corp.*, 729 Fed.Appx. 931, 935 (Fed. Cir. 2018). Does the “substantially identical” analysis in *SHFL Entertainment* have relevance in addressing claims 1 and 8 as amended during the reexam proceeding?

2. As another example, would the arguments already presented in the Petition be considered as part of the Petition as originally filed if applied against amended claims 1 and 8, or would such arguments be considered as amending the Petition?

B. Is there a legal basis to permit Petitioner to present unpatentability arguments with respect to amended claims 1 and 8 that are not in the Petition?

1. For example, would it be appropriate for Petitioner to file a motion to submit supplemental information under 37 C.F.R. § 42.123 to address amended claims 1 and 8, and would this be consistent with the Supreme Court's holding in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018)?

2. As another example, does the Board's process for addressing claims amended during an *inter partes* review (i.e., Motion to Amend procedures) have relevance in addressing claims 1 and 8 as amended during the Reexam proceeding in a manner consistent with *SAS*?

3. Is there a time bar or any other bar that prevents Petitioner from filing a new Petition to present new arguments and evidence to challenge amended claims 1 and 8?

Petitioner is authorized to address these issues in a 10-page Reply due **August 4, 2023**. Patent Owner is authorized to file a 10-page Sur-Reply due **August 11, 2023**. The parties are urged to address any pertinent statutes, rules, and/or case law as part of these discussions. The parties' briefing is not limited to the questions presented above.

It is

ORDERED that Petitioner may file a 10-page Reply to address the issues discussed above, due August 4, 2023;

FURTHER ORDERED that Patent Owner may file a 10-page Sur-Reply to respond to Petitioner's Reply and address the issues discussed above, due August 11, 2023;

FURTHER ORDERED that Patent Owner must file, as an exhibit in this proceeding, copies of any action taken or decision made by the USPTO in regards to the pending reexamination certificate in *Ex Parte* Reexamination No. 90/015,063, within 5 business days of the action or decision; and

FURTHER ORDERED that the parties will review their mandatory notices in this proceeding and make any necessary updates to those mandatory notices within 5 business days of this Order.

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