

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2023-00628
Patent No. 7,233,790 B2

**PETITIONER'S MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION
PURSUANT TO 37 C.F.R. § 42.123(a)**

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.123(a), and as authorized by the Board on October 31, 2023, Petitioner respectfully moves to submit EX1026 (“Supplemental Declaration of Mr. Wechselberger”) and any materials cited therein, as supplemental information.

Petitioner’s motion to submit supplemental information in the form of Mr. Wechselberger’s supplemental declaration should be granted because this motion meets both requirements of §42.123(a). Consistent with the first requirement of §42.123(a), Petitioner requested authorization to file this motion within one month of the Institution Decision. Mr. Wechselberger’s supplemental declaration is also relevant to a claim for which trial has been instituted, as per the second requirement of §42.123(a). As explained below, EX1026 includes supplemental information confirming that the Petition and evidence cited therein including Mr. Wechselberger’s original declaration (EX1002) demonstrate that the prior art asserted in the Petition’s grounds anticipates and renders obvious the limitations of claims 1 and 8 that were amended as a result of *Ex Parte* Reexamination, Control No. 90/015,063 (“063 Reexam”). *See* Paper 17 (Institution Decision), 20-21 (“encourag[ing] the parties, during the course of the trial, to explain whether the grounds and supporting evidence show that claims 1 and 8 as amended are

unpatentable.”). Therefore, Petitioner submits that this motion should be granted and requests entry of EX1026 into evidence.

II. BACKGROUND

On February 23, 2023, Petitioner filed a Petition for *inter partes* review of claims 1-14 of the '790 patent.

After the Petition was filed, the Patent Owner twice amended claims 1 and 8 of the '790 patent on March 31, 2023 and again on June 5, 2023, as part of the 063 Reexam proceedings. *See* EX2008, EX2010.

Although the 063 Reexam request was filed over a year earlier on June 23, 2022, Patent Owner waited until July 5, 2023, the day it filed its Preliminary Response to notify the Board of the 063 Reexam proceeding. *See* Paper 17 at 3, n. 1. By then, a Notice of Intent to Issue *Ex-Parte* Reexamination Certificate had already been issued. *See* Ex. 2011 (dated June 20, 2023).

Shortly thereafter, on August 11, 2023, the Reexamination Certificate for the '790 patent issued. *See* Ex. 2018. The only claims that were amended as part of the 063 Reexam proceeding were claims 1 and 8 of the '790 patent.

On October, 3, 2023, the Board instituted a trial on the '790 patent on both grounds presented in the Petition after determining that Petitioner had demonstrated a reasonable likelihood of prevailing with respect to at least one claim. With respect to original claims 1 and 8, the Board determined that they no

longer exist because they were replaced by amended claims 1 and 8 as specified in the Reexamination Certificate. Thus, the Board instituted on both grounds advanced in the Petition and all claims challenged, which are claims 1-14, where claims 1 and 8 are the currently existing claims as amended in the Reexamination Certificate. *See* Paper 17, 18.

In its decision to institute trial, the Board encouraged the parties to address the following:

- (1) whether the Petition puts the Patent Owner on notice of how the prior art asserted in the grounds anticipates or teaches the limitations of amended claims 1 and 8,
- (2) whether considering arguments already presented in the Petition when analyzing amended claims 1 and 8 amounts to adding a new ground,
- (3) whether considering arguments already presented in the Petition when analyzing amended claims 1 and 8 amounts to amending the Petition, and

(4) whether filing supplemental information to clarify that the Petition as originally filed shows that amended claims 1 and 8 are unpatentable amounts to a new analysis of the claims.

Paper 17, 20-21.

EX1026 confirms that the Petition and evidence relied on therein demonstrate that the prior art asserted in the Petition's grounds anticipates and renders obvious the limitations of amended claims 1 and 8. Petitioner timely requested authorization to file this motion on October 27, 2023, within one month of the institution decision of October 3, 2023. The Board subsequently authorized Petitioner to file a motion to submit supplemental information. Pursuant to the Board's authorization, Petitioner hereby moves to submit EX1026.

III. ARGUMENT

EX1026 should be moved into evidence pursuant to 37 C.F.R. § 42.123(a). A party may file a motion to submit supplemental information if the following two requirements of 37 C.F.R. § 42.123(a) have been met: (1) "[a] request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted"; and (2) the "information must be relevant to a claim for which the trial has been instituted."

This motion meets both requirements. First, Petitioner satisfies the first requirement because it timely requested authorization to file this motion on October 27, 2023, within one month of the institution decision. Second, EX1026 provides testimony from Mr. Wechselberger that simply confirms that the evidence relied on in the Petition also demonstrates that the limitations in amended claims 1 and 8 are anticipated or rendered obvious based on the asserted prior art that forms the bases for the grounds in the Petition. Thus, EX1026 is relevant to at least amended claims 1 and 8 for which trial has been instituted, satisfying the second requirement of 37 C.F.R. § 42.123(a). *See, e.g., Valeo v. Magna Elecs.*, IPR2014-01204, Paper 26 at 5 (PTAB Apr. 10, 2015); *Motorola Solutions, Inc. v. Mobile Scanning Tech.*, IPR2013-00093, Paper 37 at 2-3 (PTAB Jun. 28, 2013).

Like the supplemental information admitted in *Valeo* and *Motorola*, EX1026 does not change the grounds of unpatentability authorized in the proceeding. EX1026 simply confirms that the evidence relied on in the Petition and supporting evidence establishes that the limitations in amended claims 1 and 8 are anticipated and rendered obvious based on the prior art already asserted in the grounds in the Petition. As explained in EX1026, claims 1 and 8 were amended during the 063 Reexam merely to include identical or nearly identical limitations that were already in other claims of the '790 patent and analyzed under both grounds in the Petition.

Thus, EX1026 confirms that Patent Owner was on notice of how the prior art as cited in the Petition and in Mr. Wechselberger's original declaration would anticipate and render obvious the limitations in amended claims 1 and 8.

Because the Petition addresses all 14 claims of the '790 patent including those claims whose limitations are identical or nearly identical to amended claims 1 and 8, no additional analysis of the prior art is required at this stage of the proceeding as confirmed by EX1026. Accordingly, EX1026 does not present any new analysis of the prior art to the claims nor would admitting EX1026 amount to amending the Petition as no new grounds are being added. *See Eizo Corp. v. Barco N.V.*, IPR2014-00358 (PTAB July 23, 2014) (Paper 11) (holding that the Board can consider arguments already presented in the Petition with respect to limitations from other claims to determine the patentability of claims amended during a parallel reexamination proceeding).

While Petitioner could enter an affidavit addressing these issues with its Petitioner's Reply, Petitioner requests entry of EX1026 at this time to facilitate full and early consideration by the Patent Owner and the Board of the issues addressed. By admitting EX1026 now, Patent Owner will be in possession of the supplemental information with this motion's filing, which is more than one month before the December 22, 2023 due date of the Patent Owner's Response. Thus,

entry of this supplemental information into the record will not prejudice or burden the Patent Owner. Rather, the Patent Owner stands to benefit in being able to address the testimony early in the proceeding including in its Patent Owner Response and its Sur-Reply. Such a thorough vetting is warranted given the issues the Board has requested the parties address in its Institution Decision. Similarly, entry of EX1026 now would not hinder the Board's ability to complete this proceeding in a timely manner.

Moreover, Petitioner does not seek to rely upon new prior art nor does Petitioner need to rely on uncited portions of the same prior art at this stage of the proceeding to demonstrate that the grounds and evidence presented in the Petition would also render amended claims 1 and 8 unpatentable. Accordingly, EX1026 does not add new grounds to the Petition nor does it amend the Petition.

IV. CONCLUSION

For the foregoing reasons, Petitioner requests that this motion is granted and to allow EX1026 to be submitted as supplemental information.

Respectfully submitted,

Dated: November 17, 2023

By: // Aliza George Carrano //
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on November 17, 2023 a complete and entire copy of the foregoing Petitioner's Motion for to Submit Supplemental Evidence was served via email directed to the following counsel of record and distribution list:

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