

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,

Petitioner

v.

VIDEOLABS, INC.,

Patent Owner

IPR2023-00628
U.S. Patent 7,233,790

**PATENT OWNER'S OPPOSITION
TO PETITIONER'S MOTION
TO SUBMIT SUPPLEMENTAL INFORMATION**

Pursuant to 37 C.F.R. § 42.23(a), Patent Owner opposes Petitioner's Motion to Submit Supplemental Information. Patent Owner's opposition is timely, pursuant to 37 C.F.R. § 42.25(a)(1).

I. INTRODUCTION

Petitioner's attempt to submit a supplemental expert declaration (EX1026) should be denied because Petitioner's new information would change the arguments and evidence relied upon in the Petition. *See* 35 U.S.C. § 312(a)(3) ("the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.") While 37 C.F.R. § 42.123(a) allows a party to file a motion to submit supplemental information, the Board can deny that motion where the supplemental information would "effectively change the argument and evidence originally relied upon in the petition." *Nanobebe US Inc. v. Mayborn (UK) Ltd.*, IPR2023-00465, Paper 22 at 2 (June 13, 2017) (citing *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445, 446-447 (Fed. Cir. 2015), which held "the PTAB has discretion to grant or deny motions as it sees fit."). Here, the supplemental expert declaration (EX1026) addresses claims that did not exist at the time of the Petition, providing a new analysis with respect to claim 1 and 8 that was not included in Grounds 1 or 2 of the Petition, inherently "chang[ing] the argument

and evidence originally relied upon in the petition.” The Board should thus use its discretion to deny Petitioner’s motion.

II. ARGUMENT

Petitioner’s EX1026 is outside the contours of the Petition, and therefore improper. The Petition must “[p]rovide a statement of the precise relief requested for each claim challenged,” including “how the challenged claim is to be construed,” “[h]ow the construed claim is unpatentable,” “where each element of the claim is found in the prior art,” and identify “specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b). The *Supreme Court in SAS Inst., Inc. v. Iancu* held that petitioner alone “gets to define the contours of the proceeding.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). The contours of the proceeding are defined in the Petition. *See Koninklijke Philips N.V. v. Google LLC, et al.* 948 F.3d 1330 (Fed. Cir. 2020); *see also In re Magnum Oil Tools Int’l, Ltd.* 829 F.3d 1381 (Fed. Cir. 2016).

Using this reasoning, the Board has denied motions for submitting supplemental information in similar situations. For example, the Board in *Nanobebe US Inc. v. Mayborn (UK) Limited et al.* denied Petitioner’s motion to submit supplemental evidence because it “effectively change[d] the argument and evidence originally relied upon in the petition.” IPR2023-00465, Paper 21 at 4 (August 17, 2023). Furthermore, the Board in *Am. Well Corp. v. TelaDoc Health, Inc.* held that

“[d]enying entry of supplemental information that effectively changes the evidence originally relied upon in a petition – whether inadvertent or not – is in accord with the statutory requirement that a petition must identify, with particularity, the evidence supporting the challenge to each claim. 35 U.S.C. § 312(a)(3) ... Petitioner identifies no statute, regulation, or Board decision as precedent permitting it to use supplemental information to fill the type of evidentiary void (whether inadvertent or not) left open by the Petition.” IPR2021-00748, Paper 23 at 13.

Here, claims 1 and 8 were amended during a concurrent *Ex Parte Reexamination* proceeding ('063 Reexam) and claims 1 and 8, as amended, (the Amended Claims) were not addressed in the Petition or Petitioner's original expert declaration (EX1002). *See* EX2008, EX2010. Petitioner argues that the “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.” Paper 20 at 6. Petitioner's argument is flawed for at least two reasons.

First, if Petitioner is correct that the Petition and Mr. Wechselberger's original declaration already adequately addresses the Amended Claims, then Petitioner does not need EX1026 to address those claims and there is no basis for submitting supplemental information. *See Redline Detection* 811 F.3d at 444 (Fed. Cir. 2015)

(confirming that the PTAB is authorized to conclude that “Redline did not establish a sufficient basis for submitting new evidence.”)

Second, as Petitioner admits, the limitations addressed in the Petition are only “*nearly identical*” to the Amended Claims. *See id.* (emphasis added). Some of the Amended Claims’ limitations were not addressed in the Petition. To cure this, Petitioner’s EX1026 attempts to identify where each element of the Amended Claims is found in the prior art and how the Amended Claims are unpatentable with respect to the limitations of the Amended Claims that were addressed in the Petition, *as well as the limitations that were not*. For example, Petitioner notes the following differences between claims 1 and 2:

1[d] <i>in response to the request, selecting a portion of the product catalog to be presented on the one wireless communication device, based in part on device capabilities of the one wireless communication device; and</i>	2[d] <i>in response to the request, selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber; and</i>
1[e] <i>presenting the selected portion of the product catalog to the one wireless communication device, such that the selected portion, as presented, provides a single description of each item of digital content in said portion, regardless of a number of implementations that are available for each said item.</i>	2[e] <i>presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.</i>

EX1026, 8. As another non-limiting example, Petitioner notes the following differences between claims 8 and 2:

<i>8[e] in response to the request, select a portion of the product catalog to be presented on the one wireless communication device, based in part on device capabilities of the one wireless communication device; and</i>	<i>2[d] in response to the request, selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber; and</i>
<i>8[f] present the selected portion of the product catalog to the one wireless communication device, such that the selected portion, as presented, provides a single description of each item of digital content in said portion, regardless of a number of implementations that are available for each said item.</i>	<i>2[e] presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.</i>

EX1026, 16. While Petitioner asserts that its new evidence “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,” Paper 20 at 5, addressing limitations not addressed in the Petition inherently involves a new analysis with respect to those limitations. As such, contrary to the requirements of 35 U.S.C. §§ 312(a)(3) and 42.104(b), Petitioner’s new analysis in EX1026 attempts to add evidence of “[h]ow the construed claim is unpatentable,” “where each element of the claim is found in the prior art,” and the “specific portions of the evidence that support the challenge” outside of the Petition. *See* 37 C.F.R. § 42.104(b).

III. CONCLUSION

For the reasons stated above, Petitioner’s Motion to Submit Supplemental Information should be denied.

Dated: December 14, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document was served on, via electronic mail, as agreed to by counsel, upon the following counsel for Petitioner:

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