

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 REPLY IN SUPPORT OF ITS
MOTION TO SUBMIT SUPPLEMENTAL INFORMATION**

Pursuant to 37 C.F.R. § 42. 23(a), Petitioner respectfully submits a reply in support of Petitioner’s Motion to Submit Supplemental Information. To the extent Patent Owner had authorization to submit an opposition, Petitioner’s reply is timely pursuant to 37 C.F.R. § 42.25(a)(1).¹

I. INTRODUCTION

Petitioner’s motion to submit supplemental information in the form of Mr. Wechselberger’s supplemental declaration (EX. 1026) should be granted. Patent Owner does not dispute that Petitioner’s motion meets both requirements of §42.123(a). Further, Patent Owner does not dispute that Petitioner is not seeking to add a new ground to the Petition or include analysis of the prior art that is not already included in the Petition. Thus, Petitioner’s supplemental information should be allowed as it merely confirms that the Petition already includes evidence and arguments to address amended claims 1 and 8. This is consistent with the holding in *SAS Institute, Inc. v. Iancu* that “the petitioner’s petition, not the

¹ Patent Owner did not seek authorization from the Board to submit an opposition when Petitioner submitted to the Board its request to file a motion for supplemental information nor did the Board authorize an opposition in a briefing schedule. *See* EX. 1028 (Oct. 31, 2023, E-mail from Board).

Director’s discretion, should guide the life of the litigation.” 138 S. Ct. 1348, 1351 (2018).

II. ARGUMENT

The Board should exercise its discretion to allow entry of EX. 1026 into evidence. Patent Owner’s only argument against the entry of Petitioner’s supplemental information is that amended claims 1 and 8 include limitations not addressed in the Petition, which “inherently involves a new analysis with respect to those limitations.” Paper 22 at 5. This argument should be rejected. Petitioner is not attempting to change its theories of unpatentability or add new grounds. Both grounds asserted in the Petition addressed the unpatentability of original claims 1 and 8, and amended claims 1 and 8 added limitations during the Reexamination proceeding that are identical or nearly identical to the original claims challenged in the Petition.

Petitioner’s supplemental evidence does not attempt to include new analysis of the prior art, and Patent Owner does not dispute this. Mr. Wechselberger’s supplemental declaration simply confirms that the claim scope of the nearly identical claim limitations added to the amended claims are similar to the original limitations such that additional analysis of the prior art for these limitations is not required. *See* EX. 1026. The Board has permitted such evidence to be considered and should do so here. *See Apple Inc. v. Telefonaktiebolaget LM Ericsson*,

IPR2022-00343, Paper 14 at 6 (PTAB November 10, 2022) (granting Petitioner’s motion supplemental information on the claim construction of “radio channel” because the supplemental evidence “did not change its theories of unpatentability”); *see also Eizo Corp. v. Barco N.V.*, IPR2014-00358, Paper 11 (PTAB July 23, 2014) (holding that the Board can consider arguments already presented in the Petition to determine the patentability of claims amended during a parallel reexamination proceeding).

Furthermore, Patent Owner does not dispute that the evidence and analysis cited in the Petition satisfies the nearly identical claim limitations added to amended claims 1 and 8. Patent Owner recently filed its Patent Owner Response, and none of the disputes it raised concerned the nearly identical claim limitations added to amended claims 1 and 8. *See* Paper 24. Indeed, during Mr. Wechselberger’s deposition, Patent Owner did not ask him a single question relating to his supplemental declaration or on the portions of the Petition that he opined satisfied the limitations added to amended claims 1 and 8. *See* Ex. 2021. This demonstrates that Petition, as is, sufficiently addresses the limitations added to amended claims 1 and 8 as confirmed by Mr. Wechselberger in his supplemental declaration (EX. 1026).

Patent Owner’s reliance on *Nanobebe US Inc. v. Mayborn (UK) Limited et al.*, IPR2023-00465, Paper 21 at 4 (PTAB August 17, 2023) and *Am. Well Corp. v.*

TelaDoc Health, Inc., IPR2021-00748, Paper 21 at 13 (PTAB February 28, 2022) is misplaced. In *Nanobebe US*, the Petitioner attempted to introduce new analysis and arguments on a claim that was not presently challenged in Ground 1, and in *Am. Well*, the Petitioner tried to add in new opinions from its expert and citations to the prior art to bolster its motivations to combine and invalidity analysis. *See Nanobebe US* at 3; *Am. Well* at 10. In both cases, the Board denied entry of the supplemental information finding that this information should have been included in the Petition and that “Petitioner has not identified any precedent or rule that suggests that we can simply correct errors and omissions in a petition using supplemental information that results in the addition of a new analysis.” *Nanobebe US* at 5 (citing *Am. Well* at 13). This case is distinguishable because Petitioner’s supplemental information does not include new analysis or citations to the prior art that were not included in the Petition. Furthermore, unlike *Nanobebe US* and *Am. Well*, Petitioner could not have addressed the amendments made to claims 1 and 8 in its Petition as these claims were amended after the Petition was filed. *See Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F. 3d 435, 448 (Fed. Cir. 2015) (considering whether the supplemental information was reasonably available to the Petitioner at the time the Petition was filed).

Accordingly, the Board should allow entry of Petitioner’s supplemental information because it does not change the grounds of patentability authorized in

the proceeding and did not change the evidence initially presented in the Petition in support of those grounds.

III. CONCLUSION

For the foregoing reasons, Petitioner requests that its motion is granted and to allow EX. 1026 to be submitted as supplemental information.

Respectfully submitted,

Dated: January 16, 2024

By: // Aliza George Carrano //
Aliza George Carrano
(Reg. No. 70,637)

WILLKIE FARR & GALLAGHER LLP
1875 K Street NW,
Washington, DC 20006
acarrano@willkie.com

Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 16, 2024 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:

Christine E. Lehman
clehman@reichmanjorgensen.com

Michael Matulewicz-Crowley
mmatulewicz-crowley@reichmanjorgensen.com

Jaime F. Cardenas-Navia
jcardenas-navia@reichmanjorgensen.com

Naveed S. Hasan
nhasan@reichmanjorgensen.com

RJ_VideoLabs-Netflix@reichmanjorgensen.com

// Aliza George Carrano //
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