Paper 13
Filed: November 21, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
PETITIONER,

v.

GOTV STREAMING, LLC,
PATENT OWNER.

CASE IPR2023-00757
PATENT 8,989,715

PATENT OWNER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

CURRENT EXHIBIT LIST iii

I. INTRODUCTION 1

II. RELIEF REQUESTED AND BASIS FOR ITS ENTITLEMENT 2

III. LEGAL STANDARD 2

IV. NEW EVIDENCE FOR THE BOARD'S CONSIDERATION 4

V. GOOD CAUSE FOR NEW EVIDENCE 7

VI. MATTERS THE BOARD MISAPPREHENDED OR OVERLOOKED AND THE PLACE WHERE EACH MATTER WAS PREVIOUSLY ADDRESSED IN A REPLY 10

VII. THE PARTIES CLEARLY CONTESTED THAT THE APPLICATION MUST RUN ON THE SERVER, AND PETITIONER'S CONCESSION THAT IT DOES UPENDS THE BASIS FOR THE BOARD'S INSTITUTION DECISION 10

VIII. CONCLUSION 15

TABLE OF AUTHORITIES

Cases

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019-11 (PTAB Mar. 20, 2020) (precedential) 14, 15

Canadian Solar Inc. v. The Solaria Corp.,
IPR2021-00095-17 (PTAB Sept. 24, 2021) 3

Conopco, Inc. v. Procter & Gamble Co.,
IPR2014-00506-25 (PTAB Dec. 10, 2014) (informative) 2

Facebook, Inc. v. Sound View Innovations,
IPR2017-00998-13 (PTAB Sept. 5, 2017) 7

Facebook, Inc. v. Sound View Innovations,
IPR2017-01003-14 (PTAB Sept. 1, 2017).....13

Ford Motor Co. v. MIT,
IPR2021-00341-17 (PTAB Nov. 21, 2022) 3

GTNX, Inc. v. INTTRA, Inc.,
789 F.3d 1309 (Fed. Cir. 2015) 3

OpenSky Indus., LLC v. VLSI Tech. LLC,
IPR2021-01064-102 (Oct. 4, 2022) (precedential) 2

Resmed Corp. v. Cleaveland Med. Devices Inc.,
IPR2023-00565-13 (PTAB Sept. 25, 2023).....14

Samsung Elecs. Co. v. Smart Mobile Techs. LLC,
IPR2022-01248-13 (PTAB Jan. 24, 2023) 6

Vector Flow, Inc. v. HID Global Corp.,
IPR2023-00353-11 (PTAB Aug. 10, 2023) (Director Review).....3, 9

Rules

37 C.F.R. § 42.11(a).....7

37 C.F.R. § 42.51(b) 8

37 C.F.R. § 42.71(c).....2

37 C.F.R. § 42.71(d) 3

Other Authorities

Consolidated Trial Practice Guide (Nov. 2019) 3, 8

CURRENT EXHIBIT LIST[1]

No.	Brief Description
1001	U.S. Patent No. 8,989,715
1002	Expert Declaration of Ben Bederson ("Bederson")
1003	Curriculum Vitae of Benjamin B. Bederson, Ph.D.
1004	File History of U.S. Patent No. 8,989,715
1005	File History of U.S. Patent No. 8,478,245
1006	U.S. Patent Application Publication No. 2007/0150617 ("Hariki")
1007	U.S. Patent Application Publication No. 2003/0023755 ("Harris")
1008	U.S. Patent No. 7,447,486 ("Tamura")
1009	U.S. Patent No. 6,996,627 ("Carden")
1010	U.S. Patent No. 6,669,564 ("Young")
1011	U.S. Patent No. 6,732,183 ("Graham")
1012	U.S. Patent No. 6,507,727 ("Henrick")
1013	Webpage excerpt from Computer History Museum at https://www.computerhistory.org/tdih/april/6/ (last accessed March 29, 2023)
1014	https://www.webdesignerdepot.com/2009/05/the-evolution-of-cell-phone-design-between-1983-2009/
1015	Excerpts from Dan R. Olsen, Jr., Developing user interfaces (1998)
1016	Alok Sinha, Client-server computing, in Communications of the ACM, 35, 7 (1992)
1017	Tim Berners-Lee, Robert Cailliau, Ari Luotonen, Henrik Frystyk Nielsen, and Arthur Secret, The World-Wide Web, Communications
1018	Eric Kasten, HTML: A Gentle Introduction, Linux Journal (July 1995), available at https://www.linuxjournal.com/article/1081
1019	U.S. Patent Application Publication No. 2013/0124961 ("Linburn ")

[1] Relevant portions of exhibits may be highlighted to help the Panel locate cited sections.

No.	Brief Description
1020	U.S. Patent No. 8,111,326 ("Talwar")
1021	Order re Scheduling Conference, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. Feb. 13, 2023) (Doc. 61)
1022	Complaint in *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556-RGK-SHK (C.D. Cal. Oct. 17, 2022) (Doc. 1)
1023	Netflix's Memorandum in Opposition to GoTv Streaming, LLC's Motion for Judgment as a Matter of Law, No. 2:22-cv- 07556-RGK-SHK (C.D. Cal. Oct. 26, 2023) (Doc. 406)
2001	CAMPBELL-KELLY ET AL., Mainframes to Smartphones: A History of the International Computer Industry, Ch. 11 (Harvard Univ. Press 2015)
2002	GALAZZO, Timeline from 1G to 5G: A Brief History on Cell Phones (Sept. 21, 2020), *available at* https://www.cengn.ca/information-centre/innovation/timeline-from-1g-to-5g-a-brief-history-on-cell-phones/
2003	Cingular MEdia Mall Games and Motorola Page (March 23, 2006), *available at* https://web.archive.org/web/20060323054853/http://www-xl.cingularextras.com/fuel/enduser/portal/endUserHTMLDir?c1=3&dc=0 and https://web.archive.org/web/20060323054841/http://www-xl.cingularextras.com/fuel/enduser/portal/endUserHTMLSelectPhone?makeName=motorola&dc=0
2004	Suite, Definition & Meaning - Merriam-Webster, *available at* https://www.merriam-webster.com/dictionary/suite
2005	U.S. Patent No. 7,380,205 to Bezrukov et al.
2006	TUTENEL ET AL., Rule-Based Layout Solving and Its Application to Procedural Interior Generation, Netherlands Organization for Scientific Research and the Netherlands ICT Research and Innovation Authority (2009)
2007	KRÖNER, Adaptive Layout of Dynamic Web Pages, Deutsches Forschungszentrum fur Künstliche Intelligenz GmH (2000)

No.	Brief Description
2008	Scheduling Order, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. Feb 14, 2023) (Doc. 62)
2009	Klausner Decisions re Motions to Stay Pending IPR, Docket Navigator (generated June 8, 2023)
2010	Order Granting Stipulated Stay Pending IPR, *Flexstent, LLC v. Abbott Labs.*, No. 5-18-cv-02479 (C.D. Cal. Oct. 18, 2019) (Doc.77)
2011	Order Denying Renewed Stipulated Stay Pending IPR, *Shenzhen Gooloo E-Commerce Co., Ltd. v. Pilot, Inc.*, No. 2-22-cv-02219 (C.D. Cal. Jan. 12, 2023) (Doc. 95)
2012	Renewed Joint Stipulation to Stay Case Pending Resolution of *Inter Partes Reviews* of '653 Patent, *Shenzhen Gooloo E-Commerce Co., Ltd. v. Pilot, Inc.*, No. 2-22-cv-02219 (C.D. Cal. Jan. 11, 2023) (Doc. 94)
2013	Klausner Time to Trial in Patent Cases, Docket Navigator (generated June 8, 2023)
2014	U.S. District Court—Judicial Caseload Profile for Central California from Federal Court Management Statistics–Profiles (Mar. 31, 2023), *available at* https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf
2015	Order Denying Netflix's Motions, including for Invalidity under § 101, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. May 24, 2023) (Doc. 109)
2016	Order re Scheduling Conference, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. Feb. 13, 2023) (Doc. 61)
2017	Excerpts from Redacted and De-designated Corrected Declaration of Dr. John Villasenor Regarding Invalidity of U.S. Patent Nos. 8,989,715; 8,478,245; and 8,103,865, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. served June 23, 2023)
2018	Declaration of Joshua S. Wyde regarding authentication of exhibits (Aug. 10, 2023)

No.	Brief Description
2019	Excerpts from Trial Transcript Day 2, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. Oct. 18, 2023)
2020	Excerpts from Trial Transcript Day 3, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. Oct. 19, 2023)
2021	Excerpts from Defendant Netflix, Inc.'s Notice of Motion and Rule 50(a) Motion for Judgment as a Matter of Law, *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556 (C.D. Cal. Oct. 19, 2023) (Dkt. 389)

I. INTRODUCTION

Petitioner materially changed its claim construction position during the District Court trial a little over two weeks before the Institution Decision, and now agrees with Patent Owner that the claims require the application to be executing remotely on the server. Petitioner's new construction cannot support that Hariki's web browser—the only "application" the Board found met all the limitations for claims 1–2, 4–10, and 12–16—satisfies the claim limitations. Or, at a minimum, Petitioner's new claim construction position introduces enough of a question such that there is not compelling evidence of unpatentability.

As explained herein, Petitioner's adoption of a diametrically opposed claim construction from the one Petitioner required for its arguments is a factual change of status that the Board can—and should—consider in deciding this request for rehearing. There is good cause for the Board to consider this new evidence, at least because: (1) this inconsistent position is the type that the rules say should be considered as a matter of course; (2) Petitioner's about-face did not occur until after Patent Owner filed its Preliminary Response; and (3) the material change goes to the very heart of both the discretionary denial and merits decision.

While Patent Owner believes the Petition should be denied because Petitioner's change of position precludes a factual finding supported by substantial evidence—i.e., that Hariki's web browser could be the claimed application—the

Board should at least find the weakened Petition (in light of the agreed-upon claim construction) cannot meet the much higher compelling evidence standard, and reverse the discretionary denial decision.

II. RELIEF REQUESTED AND BASIS FOR ITS ENTITLEMENT

Patent Owner requests that the Board reverse its decision instituting trial. *See* Paper 11 ("Inst. Dec."). The basis for this relief is that the only "application" the Board identified as meeting the limitations of independent claims 1 and 9 (and dependent claims 2, 4–8, 10, and 12–16) is Hariki's "web browser," *id.* 65; however, the web browser in Hariki is not running on a server, remote from the "wireless device," as both Parties agree is required by the claims. Relatedly, there is at least a question as to whether a claim is obvious, so the Board should reverse its compelling evidence finding and discretionarily deny the Petition. *See OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064-102, at 49 (Oct. 4, 2022) (precedential).

III. LEGAL STANDARD

When deciding a request for rehearing, the Board will reverse if it finds an "abuse of discretion." 37 C.F.R. § 42.71(c). "An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors." *Conopco, Inc. v. Procter & Gamble Co.*, IPR2014-00506-25, at 2–3 (PTAB Dec. 10, 2014) (informative) (citations omitted).

Additionally, the Board has inherent authority to reverse an institution decision based upon changed facts. *Canadian Solar Inc. v. The Solaria Corp.*, IPR2021-00095-17, at 7–8 (PTAB Sept. 24, 2021) (citing *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1313 (Fed. Cir. 2015)). A factual change in a parallel proceeding, such as a party's complete reversal of a claim construction, is a change of status that the Board should consider. Director Review, *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353-11, at 2 & 7 (PTAB Aug. 10, 2023) (reversing institution decision and mandating the Board allow additional briefing regarding changes in the parallel district court proceeding, including a party's inconsistent claim construction); *see also Ford Motor Co. v. MIT*, IPR2021-00341-17, at 2–3 (PTAB Nov. 21, 2022) (granting request for rehearing upon claim construction reversal in parallel litigation); Consolidated Trial Practice Guide ("TPG"), 48 (Nov. 2019) ("The Board, in its claim construction determinations, will consider statements regarding claim construction made . . . by a petitioner filed in other proceedings.").

"The burden of showing a decision should be modified lies with the party challenging the decision." 37 C.F.R. § 42.71(d).

IV. NEW EVIDENCE FOR THE BOARD'S CONSIDERATION[2]

In the Petition, Petitioner said "POSITAs would have understood that the 'application' is ***not limited to one residing only on a client or only on a server***." Pet. at 36 n.10 (emphasis added). Subsequent, during trial, Petitioner and its expert materially changed its claim construction position, arguing that the claims ***do require*** that the application execute exclusively on a server.[3] Ex. 2019, Trial Testimony of Netflix's Technical Expert, 209:12–14 ("The claimed application—it's very clear in the claims in the patent—the application has to be executing on the server."); *id.* 216:8–10 ("So the patents, the asserted claims require an application that's executing on a server."); *id.* 222:10–12 ("So it's important to emphasize that the claims require they recite an application, and that application has to be executing on the server."); *id.* 225:11–12 ("Well, according to the patent, the application is—needs to be executing on the server."); *id.* 228:6–9 ("Yeah. The—it has to be for an application, the claimed application. And the claimed application in the patents has to be executing on the server."); *id.* 229:4–6 ("And that application has to be the same application that I discussed before, the one that's executing on the server.");

[2] The Board authorized Patent Owner to submit the cited exhibits and to argue that good cause exists for admitting the new evidence by email on November 16, 2023.

[3] During trial, Patent Owner asserted Claim 4 of the '715 Patent, which is dependent on Claim 1.

Ex. 2020, Netflix Closing Arguments, 42:12–13 ("[R]emember, the application in the claims is what's on the server."); *id.* 46:10–17 ("[F]ocus[ing] on where that application lives . . . Again, Dr. Malek and Dr. Villasenor both agree that the application lives on the server, on the back end. No dispute about that.").

Netflix and its expert explicitly differentiated the claimed application from anything that could be called an application on the wireless device:

> Q. The device has its own software application on it, correct?
>
> A. It has software on it.
>
> Q. Is that software not an application?
>
> A. Well, I just want to be careful to make sure that the word application is not misused. It is not the claimed application. . . .
>
> Q. So you have an application, claimed application on the server, correct?
>
> A. There must be an application on the server. That's right.
>
> Q. Then the app—a different application on the wireless device renders a user display, correct?
>
> A. Well, it renders a display that shows the application that's running on the server, yeah."

Ex. 2019, 243:4–24; *see also* Ex. 2020, 39:7–13 ("So remember, I showed you

the evidence that both experts agree that the application that's in the claim is a back-end application. In fact, you remember I asked Dr. Malek: If I download the Netflix app on my phone, is that the application in the claim? He said no. He agreed with me. Both experts agree. The application must be on the back end.").

Then, in a preview of the claim construction that Petitioner will argue to this agency's reviewing court on appeal, Petitioner filed a Motion for Judgment as a Matter of Law that there is no infringement of the '715 Patent because "[t]he 'application' required by the claims is on the server." Ex. 2021, p. 6, ll. 2–3 (citing Ex. 2019 209:12–14, 216:8–9, 222:7–16).

In short, there is no question that Petitioner has changed its position and now agrees with Patent Owner that "it's very clear in the claims in the patent—the application has to be executing on the server." Ex. 2019, 209:12–14. The Institution Decision cited a routine decision, *Samsung Elecs. Co. v. Smart Mobile Techs. LLC*, IPR2022-01248-13, at 58 (PTAB Jan. 24, 2023), for the proposition that a petitioner can advance "different constructions" in District Court and before the Board. Inst. Dec. 105. However, *Samsung* merely permitted a petitioner to maintain that "no formal claim construction" was necessary instead of using the specific construction proposed in district court, or that Petitioner could adopt a construction "advanced by a patent owner that is seeking to broadly construe the claims to prove infringement," which is not being done here. IPR2022-01248-

13, at 58. Nothing in *Samsung* permits a petitioner to advance a construction that is diametrically opposite from the construction it advanced during trial. A Petitioner cannot reasonably state that a claim requires *X* in the district court and, simultaneously, state that the same claim means does not require *X* in the PTAB. Offering such contradictory positions necessitates that is being untruthful[4] or advancing a position with which it expressly disagrees. *Hologic, Inc. v. Enzo Life Sciences, Inc.*, IPR2018-00019-21, at 2 (PTAB Nov. 28, 2018) (finding a petitioner may not "satisfy its obligations under our rules by conducting unpatentability analysis only under a claim construction with which it expressly disagrees"); *CommScope Techs. LLC v. Dali Wireless Inc.*, 10 F.4th 1289, 1299 (Fed. Cir. 2021) (prohibiting "simultaneously argu[ing]" "incongru[ous] . . . claim[] requirements for infringement versus invalidity").

V. GOOD CAUSE FOR NEW EVIDENCE

There is good cause to allow Patent Owner to submit new evidence. First, Petitioner would have been obligated to provide this relevant, non-privileged, information inconsistent with its position in its Petition had it existed at the time the

[4] "Petitioner's failure to inform [the PTAB] of its differing claim construction arguments before the district court raises the specter of lack of candor." *Facebook, Inc. v. Sound View Innovations*, IPR2017-00998-13, at 17–18 (PTAB Sept. 5, 2017) (citing 37 C.F.R. § 42.11(a)).

Petition was filed. TPG 47 (citing 37 C.F.R. § 42.51(b)). This rule demonstrates that the Board has a policy that inconsistent evidence—in this case created by Petitioner itself—is important to a fair proceeding, and Petitioner is not harmed by admitting the evidence. This supports finding good cause.

Second, the evidence goes to the heart of the related substantive and procedural matters that the Board relied upon in making its Institution Decision as described above and below. The highly relevant nature of the evidence—that the Board should have when reconsidering its decision—also supports good cause.

Third, the new evidence was not available when Patent Owner filed its Preliminary Response, so Patent Owner could not have included the evidence in its prior filing. That Patent Owner did not choose to omit evidence available to it also marshals for finding good cause.

Fourth, Patent Owner did not delay in bringing its request. Patent Owner sought a call for permission to include new evidence with the Board approximately 8 days after the Institution Decision was issued, and the Board instituted only 12 business days after the trial. This is reasonable given that Patent Owner needed time to appreciate the change vis-à-vis the Petition, analyze the Institution Decision, research the caselaw to determine whether there was a strong basis to bring a request, and to meet and confer with opposing counsel. The lack of delay also militates for a good cause finding.

Fifth, the evidence is minimal and focused. Patent Owner is only providing and citing a few pages from the trial transcript, and two lines from Petitioner's post-trial motion, which collectively and unambiguously show that Petitioner has changed its position. As such, it is not burdensome to consider the evidence, or evidence that is open to interpretation—again supporting good cause.

Indeed, the material change in Petitioner's claim construction position—between the filing of the Preliminary Response and the Institution Decision—is the type of factual change that warranted "good cause" to present new evidence in a similar case, where "Petitioner sought authorization to file a reply addressing the Patent Owner's arguments for discretionary denial and alleged inconsistencies in claim construction positions taken in the pending litigation." *Vector Flow*, IPR2023-00353-11, at 2. The Director reversed the institution decision and ordered the Panel to allow additional briefing because "[t]he Board's reasoning in denying Petitioner's request to file a reply did not take into account the change in status of the parallel district court proceeding that occurred between the Petition and the Preliminary Response." *Id.* 7. In a similar manner, the changed factual circumstances that occurred after the Preliminary Response was filed and before the Institution Decision was issued demonstrate good cause to present new evidence in this request for rehearing.

VI. MATTERS THE BOARD MISAPPREHENDED OR OVERLOOKED AND THE PLACE WHERE EACH MATTER WAS PREVIOUSLY ADDRESSED IN A REPLY

While the Board could have taken judicial notice of the Petitioner's change of position as it did with other activities in the District Court, *see, e.g.*, Dec. Inst. 22 (citing Ex. 3003, Jury Verdict); *see also* Ex. 3004 (Order re MSJ); Nov. 2, 2023 Email from PTAB (explaining that "the Board may take judicial notice of information available from those [district court] docket entries," such as filed Ex. 1023, Netflix's Memorandum in Opposition to GoTV Streaming, LLC's Motion for Judgment as a Matter of Law), the Board could not have overlooked Petitioner's change of position in the Petition or Preliminary Response because the reversal did not occur until after those documents were filed. Patent Owner is asking the Panel to base its decision upon the after-arising factual changes as allowed under its inherent authority as explained above.

VII. THE PARTIES CLEARLY CONTESTED THAT THE APPLICATION MUST RUN ON THE SERVER, AND PETITIONER'S CONCESSION THAT IT DOES UPENDS THE BASIS FOR THE BOARD'S INSTITUTION DECISION

The claim construction issue of whether an application must be remotely executing on a server as Patent Owner contended, or whether the claimed application "is not limited to one residing . . . only on a server" as Petitioner argued, Pet. at 36 n.10, was clearly at issue for claims 1–2, 4–10, and 12–16. Patent Owner said of Petitioner's construction: "[t]his is incorrect." Paper 8 ("POPR"), at 9 n.3.

Petitioner agreed Hariki's browsers run on the client. *See, e.g.*, Pet. at 10 ("Web browsers are client applications."), 39 ("[T]he application (e.g., a web browser) [is] executed on the mobile device."), 43 ("[T]he mobile device 'executes' the application, i.e., web browser."). Petitioner then relied upon this claim construction by identifying "the web browser" running on the wireless devices as the application. *See, e.g.*, Pet. 36.

The Board agreed with Petitioner that "Hariki teaches 'an application' *on a mobile device*, i.e., a web browser program." Inst. Dec. 65 (emphasis added).

From the very first page of the Preliminary Response, Patent Owner argued that the claims only covered "a ***remotely executing*** application on a wireless device." POPR, at 1 (emphasis added). Patent Owner noted that, at the time of the patent, "wireless devices generally ran 'application[s] locally,'" *id.* at 7 (citing Ex. 1001, at 2:3–5), that these local applications had problems that the inventor sought to overcome, *id.* at 7–8, and, therefore, the '715 Patent's solution was to run "applications centrally," *id.* at 8. Patent Owner specifically noted that "[t]he Patent-at-Issue's applications are 'stored' and 'executed' 'on the remote server,' in contrast to traditional applications that were downloaded and locally run on wireless devices." *Id.* at 9 (citing Ex. 1001, at 2:37–38; 2:63–64; 3:8–9; 5:54–56; 6:6–7; 16:44–45). Patent Owner provided Figure 5 from the '715 Patent to show that the application is located on the server, and explained that "the server 'locate[s] and

execute[s] the requested application.'" *Id.* at 10 (citing Ex. 1001, at 16:39–42 & Fig. 5). Patent Owner described the remote applications' compiled pages as "sent to the wireless client device." *Id.* at 12 (citing Ex. 1001, at 18:11–14).

In contrast, Patent Owner noted that the "software on the wireless devices that interacts with the server," and renders the remotely running application, was called the "client" by the '715 Patent. *Id.* at 14–15.

For limitations [1c]/[9c], Patent Owner argued that "Hariki does not speak of the browser running remotely from a wireless device and having its interface, including any 'pages,' sent to a device" or that the "locally running browser and its pages were transmitted from server 120." *Id.* at 35. Rather, Patent Owner noted that Hariki, at best, intimated that the device manufacturers locally installed the mobile device browser on the wireless device. *Id.* at 35 n.7. Patent Owner argued that "[t]he web browser running on the wireless device in Hariki may be analogous to the Patent-at-Issue's client 210 that consumes pages of an application but is not the claimed application." *Id.* at 36.

For limitations [1d]/[9d], Patent Owner asserted that a browser could not be the application that generates the identified compiled page content because "[t]he requested application is executed on the server" and "that it is the server that 'produces dynamic or static pages' 'during execution of an application [on] the server.'" *Id.* at 40 (citing Ex. 1001, at 3:4–9; 3:29–31).

Petitioner anticipated the Patent Owner's position that the application must be remote, and implicitly conceded the web browser is not remote, by arguing "[t]o the extent that the Patent Owner might contend that the 'associated application' ***must be remote to the mobile device***" . . . the UI content package w[as] associated also with the ***web server***." Pet. 36–37 (emphasis added).

Ultimately, the Board tacitly adopted Petitioner's construction that the claimed application "is not limited to one residing . . . only on a server," because the Board identified Hariki's "web browser"—that everyone agrees is solely executing on wireless devices—as the "application" of claims for which the Board found a likelihood of unpatentability, i.e., claims 1–2, 4–10, and 12–16. *See, e.g.*, Inst. Dec., at 65 ("Hence, based on the current record, Petitioner establishes sufficiently that Hariki teaches 'an application' on a mobile device, i.e., a web browser program . . . however, we disagree with Petitioner's alternative assertion that Hariki teaches 'an application' on a server.").

Given Petitioner's concession during trial that the application ***must*** run on the server, there is no longer substantial evidence to support a finding that Hariki's web browser is the claimed application. *See Facebook, Inc. v. Sound View Innovations*, IPR2017-01003-14, at 22 (PTAB Sept. 1, 2017) (explaining that Petitioner's failure to "offer[] any explanation as to why now these terms may be interpreted . . . [i]n light of [its expert's] conflicting testimony and Petitioner's reliance on

that conflicting testimony [in District Court], we are not persuaded Petitioner has established a reasonable likelihood of prevailing in its assertion that [a] claim . . . would have been obvious").

Finally, Petitioner's prior polar opposite position from that in the related litigation was also key to the procedural, *Fintiv* discretionary denial determination. Patent Owner argued such inconsistent positions—though not the location of the application, as Petitioner had not yet reversed its position—should be considered when considering Factor 6 of *Fintiv*, POPR 65, for which the Board said, "Patent Owner does not explain how Petitioner's proposed explicit constructions for certain claim terms in the California case conflict with how Petitioner applies those claim terms to the asserted references in this proceeding." Inst. Dec. 32. It is now clear that Petitioner's construction that the application must run on the server directly conflicts with Petitioner's position that a browser—that does not run on the server—can be the claimed application. This conflict at least diminishes the Petition to the point where there is insufficient basis to find the Petition meets the "substantial evidence" standard to trump the other *Fintiv* factors that favor discretionary denial. *See Resmed Corp. v. Cleaveland Med. Devices Inc.*, IPR2023-00565-13, at 16–18 (PTAB Sept. 25, 2023) ("Petitioner's strategy [of asking us to review the unpatentability arguments under a construction it already asserted in district court is wrong]

undermines its argument that the Petition presents a compelling unpatentability challenge.").

VIII. CONCLUSION

Regardless of whether the Board's decision granting institution was appropriate under the facts as they existed at the time, Petitioner now agrees with Patent Owner's position that the application must be running remotely on a server, and this change in circumstances warrants rehearing of the Board's decision based on Hariki's browser as the claimed application. Patent Owner requests that the Board modify its earlier decision and exercise its *Fintiv* discretion to deny institution or deny institution on the merits.

Dated: November 21, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on the twenty-first day of November, 2023, a complete and entire copy of the foregoing "PATENT OWNER'S REQUEST FOR REHEARING," including exhibits, if any, was served on the date below on the following counsel of record shown below via email per Petitioner's consent to electronic service, see Paper 2 at 79:

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