

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SNAP INC.,

Petitioner,

v.

PLAYVUU, INC.,

Patent Owner.

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Case No. IPR2023-00848

U.S. Patent No. 10,931,911

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**PETITIONER'S REPLY TO  
PATENT OWNER'S PRELIMINARY RESPONSE<sup>1</sup>**

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<sup>1</sup> This Reply was authorized by Board's October 11, 2023 Order (Paper No. 8).

## I. DENIAL UNDER 35 U.S.C. § 325(d) IS INAPPROPRIATE

### A. The Petition References Are Non-Cumulative

While there is no dispute *Cohen* was applied in prosecution (although the Examiner didn't appreciate its full teachings), none of the other Petition references (*Chu*, *Sherman*, *Joslin*, *Lei*, or *Austerberry*) was of record. Thus, §325(d) denial would only *possibly* be proper if, under the first part of the *Advanced Bionics* test (or *Becton*, *Dickinson* factors (a)/(b)/(d)), the Petition references' teachings are substantially the same as the prosecution art (*Cohen*, *Gentile*, *Maigret*, and *Crawford*) *as to material issues (e.g., the relevant claim elements)*, or if the Petition applies its references in substantially the same manner the prosecution art was applied, and distinguished over, in prosecution. But the POPR provides no analysis that this is the case. Instead, it merely: (i) compares only the Petition's *short summaries* (Pet., 19-23) of *Chu*, *Sherman*, *Joslin*, and *Austerberry* with *Gentile* (POPR, 12-15); (ii) compares only its *short summary* of *Lei* (Pet., 22) with *Crawford* (POPR, 15-17); and (iii) conclusorily argues there must be overlap because the Examiner allowed the '911 patent (POPR, 19-21).

PO's approach shows only the references are in the same technical field, but fails to show the Petition references' teachings of *any* claim element is cumulative. In fact, even a cursory review of the record shows the opposite. In [1r], e.g., the Petition shows the *Cohen/Chu/Sherman/Joslin* combination teaches

processing/encoding “in response to the request to publish” (Pet., 62-70), which PO argued to be a key concept missing from the prosecution art (EX1002, 56-57).

Specifically, the Examiner asserted that *Cohen*'s ¶¶[0169]-[0170] and FIG. 7, and/or *Maigret*'s ¶[0081], taught [1r]. EX1002, 82-83. PO argued that neither reference discloses the claimed sequence of: requesting to publish, and processing/encoding in response thereto. *Id.*, 56-57. PO stated *Cohen*'s “general[]” discussion of content-sharing didn't teach the claimed sequence (*id.*, ¶ bridging 56-57), and *Maigret*'s “abstract” formatting disclosure doesn't teach “when [its] formatting might occur—e.g., in response to a request to publish” (*id.*, 57 (1<sup>st</sup> full ¶)). PO also argued a POSITA wouldn't combine *Cohen*/*Maigret*. EX1002, 59. The Examiner allowed claim 1 (with a minor change to [1i]) “in light of” PO's arguments. *Id.*, 17.

Ground 1 of the Petition, in contrast, shows *Cohen*, *Chu*, *Sherman*, and *Joslin* teach [1r] in at least two ways. First, the Petition shows *Cohen*'s “post” request and widget migration functions in its ¶¶[0103]-[0104], [0142], [0144]-[0145], [0208], and FIGS. 1-2, 5B-5E, in view of common art knowledge as explained by Dr. Cooperstock, teach the claimed sequence in [1r]. Pet. 65-68. The file history doesn't show the Examiner appreciated these teachings in the context of Dr. Cooperstock's explanation. The Examiner focused instead on *Cohen*'s ¶¶[0169]-[0170] and FIG. 7's general teachings of intra-system sharing (pre-post/migration), which PO agrees are different (EX1002, 57). This resulted in

Examiner error in finding *Cohen* doesn't teach [1r]. Pet., 16-17, 25, 68-69.

Second, the Petition shows a POSITA would have been motivated to add *Chu's*, *Sherman's*, and *Joslin's* compositing/processing/encoding/sharing teachings to *Cohen* to provide an improved system with more user-selectable content and the ability to create/share streamable multimedia (Pet., 28-32) and that *Chu*, *Sherman*, and *Joslin* teach [1r], expressly confirming Dr. Cooperstock's common-knowledge observations. For example, the Petition shows: (i) how *Sherman's* invitation and *Joslin's* streamable file creation teach [1r]'s processing/encoding (Pet., 69-70); and (ii) how the processing/encoding is in response to publishing requests (*id.*, referring to requests discussed at 64-65). These teachings of [1r] are non-cumulative to *Cohen's*/*Maigret's* teachings cited in prosecution, which PO admits don't teach [1r] (*see above*; and the POPR doesn't otherwise meaningfully compare *Maigret* to the Petition references). Moreover, even if the Examiner was aware of *Cohen's* post/migration function teachings (*see above*) *vis-à-vis* [1r], the *Chu/Sherman/Joslin* teachings are more explicit and detailed as to processing and encoding than those *Cohen* discloses, and thus non-cumulative to this portion of *Cohen* as well. Finally, the Petition states the '911 patent wouldn't have issued if the Examiner was aware of the forgoing teachings. Pet., 16-17, 25.

As for *Gentile*, it wasn't applied against [1r] in prosecution, so PO's arguments (POPR, 12-18) that *Chu/Sherman/Joslin's* teachings are cumulative to it

aren't relevant. Indeed, while PO argues *Gentile's* ¶[0090] teaches file conversion and sharing (POPR, 13, 15), it doesn't explain how *Gentile* teaches [1r]'s features. This is because PO already said *Gentile* doesn't teach [1r]'s sequence. EX1002, 56, §A. Petitioner agrees *Gentile* lacks this teaching. Thus, the explicit teachings of *Chu/Sherman/Joslin* as to [1r] discussed above are also non-cumulative to *Gentile*.

Grounds 3 and 4 of the Petition also show that, should [1r]'s "processing and encoding" require two steps, it would've been obvious to utilize *Austerberry's* pre-processing and encoding in the *Cohen/Chu/Sherman/Joslin* combination (Pet., 87-88). The POPR cites no teachings of such concepts in *Gentile* or *Maigret* (there are none), instead arguing the software mentioned by *Gentile* had preprocessing capability. POPR, 17. PO provides no documentary evidence this is so, or that the Examiner was so aware. Thus, *Austerberry's* teachings of [1r] are non-cumulative.

Finally as to [1r], the Petition's explanation for why a POSITA would have been motivated to combine the Petition references (Pet., 28-32, 87-88) is far more detailed than the prosecution's motivation rationale (EX1002, 82-83). The sum of these references' combined teachings is clearly non-cumulative.

Similar analyses of claim 1's other elements leads to the same conclusion. In [1a]-[1e], [1i], and [1l]-[1n], e.g., while the Petition shows *Cohen* teaches these elements, it also shows that one or more of *Chu*, *Sherman*, and *Joslin* do too. This overlap reinforces the propriety of Ground 1's combination and shows the Petition

applies its references differently, as *Gentile/Maigret* were not similarly applied in prosecution. In [1i], the Petition shows *Chu* teaches the feature added by the Examiner at allowance—audio playback during recording. Pet., 49-52. And in [1f], the Petition cites *Sherman*'s teaching of editing static portions of the selected background (Pet., 47-48) that are non-cumulative to *Gentile*'s general editing or video inserting teachings cited by the Examiner (EX1002, 82) or PO (POPR, 13).

Finally, the Cooperstock Declaration supports the Petition, confirming *Chu*, *Sherman*, *Joslin*, and *Austerberry* were non-cumulative due to their teachings of what was missing from the prosecution references (EX1003, ¶¶159, 166, 175, 184) and discussing the above in detail (*id.*, ¶¶200-418).

## **B. The Petition Shows Error In Allowance of the '911 Patent**

The Petition and record show the Petition references are non-cumulative—as discussed above—and that the '911 patent would not have issued if the references, and Dr. Cooperstock's explanation thereof (including of *Cohen*'s teachings missed by the Examiner), were before the Examiner. Pet., 16-17, 24-25; EX1003, ¶136.

Even if the Petition references *could* be considered cumulative (they can't), the Petition still shows Examiner error as he relied on PO's mischaracterizations of *Cohen*'s teachings of [1b]/[1e]/[1i]/[1r]. Pet., 16-17, 24-25, 35, 44, 51, 68-69; EX1003, ¶¶134-135, 232-233, 238-242, 278-279, 283-286, 306-308, 312-315, 391-392. PO's argument that there is no evidence "the Examiner was convinced by" its

arguments (POPR, 22) ignores that allowance was “in light of” such arguments (EX1002, 17) (and that *Cohen* teaches the feature added to [1i], *see* Pet., 51).

## II. DENIAL UNDER 35 U.S.C. § 314(a) IS INAPPROPRIATE

Contrary to PO's assertions (POPR, 23-28), institution is proper under *Fintiv*. Judge Wu issued a Claim Construction Order (EX1053) on October 10, 2023, that, *inter alia*, invited Snap to re-file its §101-based Motion to Dismiss (previously denied as premature). EX1053, 1, 3, 18-19. Snap will soon renew its Motion and, if—as appears likely based on Judge Wu's comments—it is granted, there will be no trial. Thus, ***Factor 1 favors institution*** as the district court case will either be dismissed or Snap will seek a stay. ***Factor 2 favors institution*** as there will be no trial (at least near-term) if the case is dismissed/stayed. Even if not dismissed/stayed, the average patent case time-to-trial (EX1049)—the proper metric—puts trial in spring 2025, after a final decision here. ***Factor 3 favors institution*** as significant investment remains. EX1048. ***Factor 4 favors institution*** as more claims are challenged here (*compare* Grounds with EX1038) and in view of Petitioner's *Sotera* stipulation (EX1047). ***Factor 5 favors institution*** as a final decision here is likely to issue before any district court trial. ***Factor 6 favors institution*** at least because PO hasn't identified a single substantive deficiency in the Petition, and the Petition and Dr. Cooperstock's unrebutted expert testimony are the type of compelling evidence for which institution should not be denied.

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Respectfully submitted,

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing *Petitioner's Reply to Patent Owner's Preliminary Response* (and Exhibit) was served in its entirety on October 13, 2023, on the Patent Owner at the following addresses of record as listed on the USPTO's Patent Center via Priority Mail Express® or Express Mail:

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The undersigned certifies that on October 13, 2023, a true and correct copy of the foregoing *Petitioner's Reply to Patent Owner's Preliminary Response* (and Exhibit) was sent in its entirety via electronic mail to the attorneys of record for Defendant in the concurrent litigation matter:

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