

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,

Petitioner,

v.

PLAYVUU, INC.,

Patent Owner.

CASE NO.: IPR2023-00848
U.S. PATENT NO. 10,931,911

PATENT OWNER'S SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY

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EXHIBIT LIST

Exhibit No.	Description
EX2001	Declaration of Michael Shamos, Ph.D.
EX2002	Curriculum Vitae of Michael Shamos, Ph.D.

I. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION PURSUANT TO 35 U.S.C. § 325(d)

A. The Petition References are Cumulative

As an initial matter, Petitioner is incorrect that Patent Owner's arguments that the Petition's references are cumulative are conclusory. The POPR explains how the references are cumulative over multiple pages. *See* POPR, 11-19. On the other hand, the Petition's only discussion of whether the references cited therein are cumulative is a conclusory, one-sentence statement that each reference is "non-cumulative." Petition, 20, 21, 22, 23. No further explanation is given. In its Reply, Petitioner attempts to rely on arguments made only in its expert declaration. *See* Reply, 5 ("the Cooperstock Declaration supports the Petition, confirming *Chu*, *Sherman*, *Joslin*, and *Austerberry* were non-cumulative").

Petitioner should not be permitted to rely on arguments not raised in the Petition. Per 37 CFR § 42.6(a)(3), "[a]rguments must not be incorporated by reference from one document into another document." *See also 3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, 2019 WL 3729475 (P.T.A.B. Aug. 7, 2019), Final Written Decision; *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, 2020 WL 578975 (P.T.A.B. Feb. 4, 2020) (Decision Denying Petitioner's Request for Rehearing at page 3) ("Rehearing Decision"), affirmed by the Federal Circuit in a non-precedential opinion; *see also Fidelity Nat'l Info. Servs., Inc. v. DataTreasury*

Corp., IPR2014-00489, 2014 WL 4059220 (P.T.A.B. Aug. 13, 2014) (PTAB refused to consider evidence in an expert declaration that was not also discussed in the petition). Thus, any arguments made in the Cooperstock Declaration, which were not made in the Petition, should not be considered.

Further, Petitioner fails to rebut Patent Owner's argument that the Examiner considered the same and similar prior art during prosecution. Petitioner concedes that "there is no dispute *Cohen* was applied in prosecution," (Reply, 1), and that Petitioner argues "*Cohen* teaches these elements," but argues that Chu, Sherman, Joslin, and Austerberry are non-cumulative. Petitioner's argument however, is circular and conclusory.

For example, in its Reply, Petitioner argues that "*Sherman's* invitation and *Joslin's* streamable file creation teach [1r]'s processing/encoding and (ii) how the processing/encoding is in response to publishing requests." Reply, 3 (internal citations omitted). As explained in the POPR, this was the precise argument made by the Examiner with respect to Maigret, specifically that Maigret discloses "receiving a request to publish the recorded content; in response to the request to publish, processing and encoding individual components of the recorded content to create a streamable video; and publishing the streamable video by copying the streamable video to a media server." EX1002 at pg. 0083.

Petitioner's argument that Patent Owner "admits" that Cohen/Maigret's teachings cited in prosecution do not teach [1r] misses the point. Reply, 3. In prosecution, Patent Owner successfully distinguished the challenged claims from the referenced prior art, including Maigret. This is not evidence that the references cited by Petitioner are non-cumulative of those considered in prosecution. Rather, it shows that because the references are cumulative, granting institution would serve only to duplicate the work already done by the Examiner during prosecution.

In addition, Petitioner's Reply, similar to the Petition, once again places the burden on the Patent Owner and the Board to unravel its approach of intermingling all of the cited art together to form a twisted knot of what Petitioner refers to as the "sum of these references' combined teachings." Reply, 4. For example, Petitioner alleges that the "*Chu/Sherman/Joslin* teachings are more explicit and detailed as to processing and encoding" than Cohen. Reply, 3. Petitioner fails, however, to set forth what specific "teachings" of each of those reference it is even relying on here, alone or in combination. The burden is not on Patent Owner and the Board to first determine what teachings of *Chu/Sherman/Joslin* Petitioner relies upon, and then try to extract from that what Petitioner considers non-cumulative to the prior art before the Examiner.

B. The Petition Fails to Show Error in Allowance of the '911 Patent

Petitioner's contention that Patent Owner's statements to the Examiner "mischaracterized" Cohen's teachings are unfounded. As set out in detail in the POPR (pgs. 45-49) Patent Owner's arguments during the prosecution of the '911 Patent are not wrong, nor do they mischaracterize Cohen. In fact, it is Petitioner who mischaracterizes the arguments made by Patent Owner during prosecution.

Rather than substantively respond to the arguments raised in the POPR, Petitioner repeats its incorrect and conclusory allegation that Patent Owner mischaracterized Cohen.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION PURSUANT TO 35 U.S.C. §314(a)

Trial in the concurrent litigation is set for August 13, 2024. In its Reply, Petitioner argues that it expects to succeed on an as-yet-unfiled Motion to Dismiss, and if its Motion to Dismiss fails, it will seek a stay. The Board should not grant institution based on Petitioner's subjective expectation of success on its future motions. Although Petitioner argues that based on averages, the trial in the concurrent litigation may not occur until 2025, Petitioner glosses over the fact that trial in the concurrent litigation is set for August 13, 2024 (with fact discovery set to conclude in December 2023)—which is much earlier than when a final written decision in this *inter partes* review will be due, a factor weighing heavily in favor

of denying institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (designated informative July 13, 2020) (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”). Thus, ***Factor 1 and Factor 2 favor denying institution.***

Factor 3 favors denying institution as significant investment has been made by both Parties in the concurrent litigation. As of the date of this filing, the Markman hearing has concluded, claim construction briefing has concluded, and the Parties have invested significant resources in fact discovery, which currently concludes in December 2023.

In light of Petitioner’s stipulation, Factor 4 does not favor denying institution; however, as shown in this Sur-Reply and in the POPR, the other Fintiv factors weigh in favor of denying institution, and thus outweigh any marginal weight toward granting institution from Factor 4.

Factor 5 favors denying institution as Petitioner is the defendant in the concurrent litigation.

Factor 6 favors denying institution as explained in Patent Owner’s Preliminary Response, the Petition lacks merit and relies upon the same primary reference that was previously before, and substantively evaluate by, the Office during the prosecution of the ’911 Patent.

III. CONCLUSION

For the reasons presented above, the Board should deny institution.

Dated: October 20, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of **PATENT OWNER'S
SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY** is being served
by electronic mail this 20th day of October, 2023, on the following counsel of
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