

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.; INSTAGRAM, INC.; WHATSAPP LLC; META
PLATFORMS TECHNOLOGIES, LLC; AND GIPHY, INC.

Petitioners

v.

VL COLLECTIVE IP LLC

Patent Owner

U.S. Patent No. 7,266,682

Case IPR2023-00923

**PETITIONERS' MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	1
III.	ARGUMENT	3
A.	Legal Standard.....	3
B.	Petitioners’ Motion Is Timely and the Supplemental Information Is Relevant.....	4
1.	Handley	4
2.	PacketCable.....	6
C.	Petitioners’ Supplemental Information Satisfies the Other Factors Considered by the Board	7
IV.	CONCLUSION.....	9

TABLE OF AUTHORITIES**Page(s)****Cases**

<i>Apple, Inc. v. VirnetX, Inc.</i> , IPR2015-00810, Paper 21 (P.T.A.B. Nov. 2, 2015).....	3, 6, 7
<i>Baker Hughes Inc. v. Packers Plus Energy Servs., Inc.</i> , IPR2016-00597, Paper 80 (P.T.A.B. Sept. 26, 2018).....	3, 7, 8
<i>Edmund Optics, Inc., v. Semrock, Inc.</i> , IPR2014-00599, Paper 44 (P.T.A.B. May 5, 2015)	4
<i>Hulu, LLC v. Sound View Innovations, LLC</i> , IPR2018-01039, Paper 29 (P.T.A.B. Dec. 20, 2019)	2, 3
<i>Palo Alto Networks, Inc v. Juniper Networks, Inc.</i> , IPR2013-00369, Paper 37 (P.T.A.B. Feb. 5, 2014).....	v, 3, 7, 8
<i>Redline Detection, LLC v. Star Envirotech, Inc.</i> , 811 F.3d 435 (Fed. Cir. 2015)	2
<i>TechSearch LLC v. Intel Corp.</i> , 286 F.3d 1360 (Fed. Cir. 2002)	4
<i>Valeo N.A., Inc. v. Magna Elecs., Inc.</i> , IPR2014-01204, Paper 26 (P.T.A.B. Apr. 10, 2015)	3, 7
<i>VideoLabs, Inc., et al. v. Meta Platforms, Inc. et al.</i> , Civil Action No. 1-22-cv-00680 (D. Del.)	iii

Statutes

U.S.C. §§ 102(a) and 102(b).....	4, 6
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Other Authorities

37 C.F.R. § 42.123(a).....	<i>passim</i>
37 C.F.R. § 42.123(a)(1).....	4
37 C.F.R. § 42.123(a)(2).....	4, 6

TABLE OF EXHIBITS

Ex. No.	Description
1001	U.S. Patent No. 7,266,682 (“the ’682 Patent” or “the Patent”)
1002	Certified File History of U.S. Patent No. 7,266,682
1003	Declaration of Dr. Henry Houh, Ph.D. in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,266,682
1004	Curriculum Vitae of Dr. Henry Houh
1005	M. Handley, J. Crowcroft, & C. Bormann, Very Large Conferences on the Internet: The Internet Multimedia Conferencing Architecture and the MBONE by, https://www.cl.cam.ac.uk/~jac22/otalks/cnisdn-article.pdf (“Handley”)
1006	Erol Basturk, Mihir Bellare, Chee-Seng Chow, & Roch Guérin, Secure Transport Protocols for High-Speed Networks, https://cseweb.ucsd.edu/~mihir/papers/srtp.pdf (“Basturk”)
1007	PacketCable 1.0 Architecture Framework Technical Report, https://community.cablelabs.com/wiki/plugins/servlet/cablelabs/alfresco/download?id=bddae471-01dd-43c8-8e59-d6547fcf4ffd (“PacketCable”)
1008	RTP: A Transport Protocol for Real-Time Application, IETF RFC 1889, https://datatracker.ietf.org/doc/html/rfc1889
1009	Andrew S. Tanenbaum, Computer Networks (3 rd ed. 1996) (“Tanenbaum”)
1010	Declaration of Sylvia D. Hall-Ellis, Ph.D. in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,266,682
1011	Reserved
1012	Complaint, <i>VideoLabs, Inc., et al. v. Meta Platforms, Inc. et al.</i> , Civil Action No. 1-22-cv-00680 (D. Del.)
1013	Internet Protocol – RFC 791, DARPA Internet Program (September 1981)
1014	Carrier Sense Multiple Access with Collision Detection, IEEE Standard 802.3, IEEE Standards for Local Area Networks (1985)

Motion to Submit Supplemental Information

1015	David D. Clark & David L. Tennenhouse, Architectural Considerations for a New Generation of Protocols, Laboratory for Computer Science, M.I.T. (1990), https://dl.acm.org/doi/10.1145/99517.99553 .
1016	Declaration of Dr. Jon Crowcroft
1017	Supplemental Declaration of Dr. Henry Houh
1018	Supplemental Declaration of Dr. Sylvia Hall-Ellis relating to Handley (EX 1005)
1019	Supplemental Declaration of Dr. Sylvia Hall-Ellis relating to PacketCable (EX 1007)
1020	Declaration of Nathaniel E. Frank-White
1021	Web Archive of UCL Web Servers Search (August 16, 2000), available at https://web.archive.org/web/20000816095229/http://www.ucl.ac.uk/search/compass/
1022	Web Archive of Mark Handley's List of Papers, Publications, and Specifications (February 10, 1999) available at https://web.archive.org/web/19990210102149/http://north.east.isi.edu/~mjh/papers.html
1023	Web Archive of Mark Handley's University of Southern California Information Sciences Institute Website (January 30, 1998), available at https://web.archive.org/web/19980130215743/http://north.east.isi.edu/~mjh/
1024	Web Archive of Dr. Jon Crowcroft's List of Papers (August 28, 1999), available at https://web.archive.org/web/19990828053320/http://www.cs.ucl.ac.uk/staff/jon/jons-papers.html
1025	Web Archive of UCL's DARPA FTP Server (February 17, 2001), available at https://web.archive.org/web/20010217183731/http://www.cs.ucl.ac.uk/darpa
1026	Web Archive of Dr. Jon Crowcroft's UCL Website (December 3, 1998), available at https://web.archive.org/web/19981203112130/http://www.cs.ucl.ac.uk:80/s

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1027	M. Handley, J. Crowcroft, C. Bormann, & J. Ott, <i>Very Large conferences on the Internet: the Internet multimedia conferencing architecture</i> , 31 COMPUT. NETWORKS 191 (1999), https://www.sciencedirect.com/science/article/abs/pii/S0169755298002621#preview-section-abstract (last visited Sep 25, 2023).
1028	M. Handley, J. Crowcroft, C. Bormann, & J. Ott, <i>Very Large conferences on the Internet: the Internet multimedia conferencing architecture</i> , 31 COMPUT. NETWORKS, 191 (1999).

Unless otherwise indicated, all emphasis added.

I. INTRODUCTION

Petitioners respectfully move to submit Exhibits 1016-1028 as supplemental information under 37 C.F.R. § 42.123(a). This supplemental information relates exclusively to the prior art status of Exhibit 1005 (“Handley”) and Exhibit 1007 (“PacketCable”) and is relevant to the obviousness grounds for which trial was instituted. *See* Paper 16. The Board routinely allows supplemental information under similar circumstances, and Petitioners respectfully request that it do so here.

II. BACKGROUND

In its Petition filed May 24, 2022 (Paper 3), Petitioners challenged the claims of U.S. Patent No. 7,266,682 on four grounds. Grounds I, II, and IV assert obviousness based on Handley, an article published no later than February 11, 1999. Grounds II, III, and IV assert obviousness based on PacketCable, a technical report published no later than December 1, 1999.

In its Preliminary Response, Patent Owner argued that Petitioners had not demonstrated the public accessibility of Handley and PacketCable. Paper 11. In its Order dated October 5, 2023, the Board subsequently allowed further briefing on the issue, but Petitioners were not permitted to submit supplemental evidence prior to institution. Paper 13.

On December 6, 2023, the Board instituted trial on all challenged claims based on all four asserted grounds. Paper 16 at 38. The Board determined that,

Motion to Submit Supplemental Information

based on the current record, Petitioners had established “. . . that there is a reasonable likelihood that Handley qualifies as a printed publication.” *Id.* at 16. Similarly, the Board determined that based on the current record, Petitioners had established “. . . that there is a reasonable likelihood that PacketCable qualifies as a printed publication.” *Id.* at 27.

In response to Patent Owner’s challenge to the sufficiency of Petitioners’ evidence as expressed in its Patent Owner’s Preliminary Response (Paper 11) (*see also* Paper 14: Petitioners’ Reply to POPR), Petitioners now seek to submit supplemental information further demonstrating the prior art status and public accessibility of both Handley and PacketCable. Petitioners contacted Patent Owner regarding its request on December 13, 2023, and the parties subsequently conferred via email. Patent Owner indicated that it opposes this Request. In an email dated January 4, 2024, the Board authorized Petitioners to file this motion pursuant to 37 CFR § 42.123(a); *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (P.T.A.B. Dec. 20, 2019) (Precedential); and *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435 (Fed. Cir. 2015) within two weeks of said authorization.

III. ARGUMENT

A. Legal Standard

A party may seek to submit supplemental information if: (1) “[a] request for the authorization . . . is made within one month of the date the trial is instituted” and (2) “[t]he supplemental information [is] relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a); *see also Hulu*, Paper 29 at 8, 14 (P.T.A.B. Dec. 20, 2019) (Precedential). To determine whether the moving party met its burden, the Board considers whether the information would: (1) “change the grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability;” (2) interfere with the “just, speedy, and inexpensive” resolution of the proceeding; or (3) otherwise prejudice the nonmoving party. *Palo Alto Networks, Inc v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3-5 (P.T.A.B. Feb. 5, 2014). *Apple, Inc. v. VirnetX, Inc.*, IPR2015-00810, Paper 21 at 6-8 (P.T.A.B. Nov. 2, 2015).

Applying these factors, the Board routinely allows petitioners to submit supplemental information that addresses the public accessibility of a challenged reference. *See, e.g., Apple*, Paper 21 at 3-8; *Palo Alto*, Paper 37 at 2-5; *Baker Hughes Inc. v. Packers Plus Energy Servs., Inc.*, IPR2016-00597, Paper 80 at 3 (P.T.A.B. Sept. 26, 2018); *Valeo N.A., Inc. v. Magna Elecs., Inc.*, IPR2014-01204, Paper 26 at 4 (P.T.A.B. Apr. 10, 2015). As the Board has recognized, “a trial is,

Motion to Submit Supplemental Information

first and foremost, a search for the truth.” *Edmund Optics, Inc., v. Semrock, Inc.*, IPR2014-00599, Paper 44 at 4 (P.T.A.B. May 5, 2015) (granting motion to submit supplemental information) (citing *TechSearch LLC v. Intel Corp.*, 286 F.3d 1360, 1378 (Fed. Cir. 2002)).

B. Petitioners’ Motion Is Timely and the Supplemental Information Is Relevant

Petitioners’ Motion to Submit Supplemental Information meets both requirements of 37 C.F.R. § 42.123(a).

First, Petitioners’ motion is timely under 37 C.F.R. § 42.123(a)(1). After conferring with Patent Owner, Petitioners requested authorization from the Board to file this Motion on December 29, 2023, within one month of the December 6, 2023 institution date.

Second, Petitioners’ supplemental information is “relevant to a claim [at issue in] the trial,” as required by 37 C.F.R. § 42.123(a)(2). Each exhibit submitted with this Motion is relevant to the instituted obviousness grounds, *i.e.*, to the public accessibility of Handley and PacketCable.

1. Handley

Exhibits 1016-1018 and 1020-1028 further confirm that Handley was available to the public and is, therefore, prior art under at least pre-AIA 35. U.S.C. §§ 102(a) and 102(b). In aggregate, these exhibits evidence that Handley was publicly accessible on or before February 11, 1999. Specifically, Exhibit 1018 is a

Motion to Submit Supplemental Information

supplemental declaration from Dr. Sylvia Hall-Ellis, a librarian expert (whom the Board noted “has been involved in the library sciences for over fifty years” (Paper 16 at 18)) testifying that, as of February 11, 1999, Handley was publicly accessible in the COMPUTER NETWORKS journal. Exhibit 1016 is a declaration from Dr. Jon Crowcroft, a named co-author of Handley, testifying that, as of February 11, 1999, Handley was publicly accessible and that he personally uploaded Handley as of January 9, 1998 to the University College London’s (“UCL”) website. Exhibit 1021 is a website printout of UCL’s Web Servers Search tool from the Wayback Machine. Exhibit 1025 is a website printout from the Wayback Machine of UCL’s DARPA File Transfer Protocol Server (“FTP Server”) where Handley was publicly accessible as of at least February 11, 1999. Exhibits 1022-1024 and 1026 are each website printouts from the Wayback Machine of Dr. Crowcroft’s and Mark Handley’s academic websites providing further evidence of Handley’s public accessibility. Exhibit 1020 is a Declaration with attached Exhibits from Nathaniel E. Frank-White at Internet Archive, the operator of the Wayback Machine, testifying that Exhibits 1021-1026 are true and accurate copies of the browser screenshots from the Internet Archive’s records. Exhibit 1017 is a supplemental declaration from Dr. Henry Houh, testifying that Handley was publicly accessible as of February 11, 1999, based on, at least, his personal knowledge. Exhibit 1027 is Elsevier’s ScienceDirect Publication of Handley, titled *Very large conferences on*

Motion to Submit Supplemental Information

the Internet: the Internet multimedia conferencing architecture which includes M. Handley, J. Crowcroft, C. Bormann, and J. Ott as authors, and a publication year of 1999. Exhibit 1028 is a scanned physical copy of Handley, titled *Very large conferences on the Internet: the Internet multimedia conferencing architecture* as authored by M. Handley, J. Crowcroft, C. Bormann, and J. Ott as physically published in COMPUTER NETWORKS, Volume 31, Issue 3 at pages 191-204 on February 11, 1999 and as retrieved from the Karl F. Wendt Engineering Library at the University of Wisconsin – Madison. That is, EX1027 is the online publication version of EX1028.

2. **PacketCable**

Exhibit 1019 demonstrates that PacketCable was available to the public and is, therefore, prior art under at least pre-AIA 35 U.S.C. §§ 102(a) and 102(b). Specifically, Exhibit 1019 is a supplemental declaration from Dr. Sylvia Hall-Ellis, a librarian expert (whom the Board noted “has been involved in the library sciences for over fifty years” (Paper 16 at 18)) testifying that, as of December 1, 1999, PacketCable was publicly accessible.

For both Handley and PacketCable, the Board has previously found similar supplemental information supporting public accessibility to be relevant under 37 C.F.R. § 42.123(a)(2). *See, e.g., Apple*, Paper 21 at 3-8 (finding relevant information included (1) a redline comparison of Petitioner’s exhibit and a

Motion to Submit Supplemental Information

Requests for Comments produced during trial; (2) magazine articles stating the RFC was publicly available through the Internet, and; (3) a declaration and deposition testimony from a designated representative supporting public availability); *Palo Alto*, Paper 37 at 2-5; *Baker Hughes*, Paper 80 at 3; *Valeo*, Paper 26 at 4.

C. Petitioners’ Supplemental Information Satisfies the Other Factors Considered by the Board

Petitioners’ Motion further satisfies the factors considered by the Board in *Palo Alto* and other proceedings assessing supplemental information.

First, the supplemental information does not change “the grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability.” *Palo Alto*, Paper 37 at 3; *Apple*, Paper 21 at 8. Rather, all of the information is relevant to a ground or claim already at issue, as it goes to the limited issue of the public accessibility of Handley—a reference asserted in three instituted obviousness grounds—and PacketCable—a reference also asserted in three instituted obviousness grounds. Accordingly, there is no risk that the supplemental information would create new issues and the supplemental information is consistent with the evidence already submitted with the Petition. *See Apple*, Paper 21 at 6.

Second, the proposed supplemental information would not interfere with the “just, speedy, and inexpensive” resolution of the proceeding. *Palo Alto*, Paper 37 at

Motion to Submit Supplemental Information

4. Accepting Exhibits 1016-1028 at this time would permit early and efficient briefing on these issues. In particular, acceptance of the supplemental information would allow the Parties to brief these issues fully in the principal briefs, rather than having them play out piecemeal in motions to exclude. The current deadline for Patent Owner's Response is not until February 28, 2024 (*see* Paper 17), and Patent Owner has yet to take any depositions. Thus, allowing the information into the record would not disrupt the current schedule.

Finally, there is no prejudice to Patent Owner in allowing the supplemental information. Until Patent Owner challenged the public accessibility of Handley and PacketCable in its Preliminary Response (Paper 11), there was no apparent need for this supplemental information. *See Baker Hughes*, Paper 80 at 3 (“Having submitted evidence of public accessibility sufficient to demonstrate a reasonable likelihood of prevailing, Petitioner’s response to Patent Owner’s attack with additional evidence bolstering its public accessibility contention is foreseeable, reasonable, and not unduly prejudicial to Patent Owner.”). Moreover, the information all speaks to the narrow questions of public accessibility. Patent Owner has yet to take any deposition and should have no difficulty reviewing and responding to the information in the period allotted for its Response. *See Palo Alto*, Paper 37 at 5.

IV. CONCLUSION

Petitioner respectfully requests permission to submit Exhibits 1016-1028.

January 18, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document was served on January 18, 2024, via electronic mail to counsel of record for the Patent Owner at the following:

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