

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' REPLY IN SUPPORT OF MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)**

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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)

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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
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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).
1029	Dr. Henry Houh Deposition Transcript

OTHER EXHIBITS

Ex. No.	Description
2003	Patent Owner's Compare Results (EX1005 versus EX1027)

Petitioners' Reply in Support of its Motion to Submit Supplemental Information

I. PETITIONERS' SUPPLEMENTAL INFORMATION IS SOLELY DIRECTED TO EX1005'S PUBLIC ACCESSIBILITY

Petitioners have satisfied both the timeliness and relevance prongs required to submit supplemental information and Patent Owner ("PO") does not dispute otherwise. *See* 37 CFR § 42.123(a); *see generally* Paper 25. Instead, PO falsely alleges Petitioners are engaged in a "bait and switch." Paper 25 at 1.

Petitioners' supplemental information confirms that EX1005, the author formatted submission of Handley, was published in *COMPUTER NETWORKS* on February 11, 1999. *See generally* EX1017; *see also* EX1016 (Dr. Crowcroft, co-author of EX1005, stated "I uploaded EX1005 to my personal academic website where, after going through the formal publication process, it was subsequently published in *COMPUTER NETWORKS* Vol. 31, Issue 3 at pages 191–204 as EX1028 on February 11, 1999. [] [T]he version published as EX1028 (which is identical to EX1027) is identical to EX1005 for all intents and purposes.").¹

PO's allegation that EX1005 is a "different article" from publisher formatted EXs. 1027 (downloaded from Elsevier) and 1028 (physical scanned copy) is

¹ EXs. 1016–1018 and 1027–1028 were entered as Houh Deposition EXs. 6–10 after PO opened the door and asked Dr. Houh direct questions about his Supplemental Declaration (EX1017). Houh Dep. Tr. 62:9–20 (EX1029).

Petitioners’ Reply in Support of its Motion to Submit Supplemental Information wrong. Paper 25 at 1.² First, Petitioners are not “swap[ping] in new references.” *Id.* To be clear, Petitioners continue—as they have since filing the Petition—to rely on the teachings in EX1005 as a prior art reference, although the teachings in EX1027 and EX1028 are, in any event, the same. Petitioners’ supplemental information is not intended, nor has the effect of, swapping in new references; rather, it solidifies that the teachings of EX1005 were published in COMPUTER NETWORKS on February 11, 1999. Second, Petitioners are not “chang[ing] their theory of public accessibility.” *Id.* Petitioners remain steadfast in their theory that EX1005 was publicly accessible for the reasons set forth in its Reply to the POPR and by the Board in its Decision Granting Institution. *See* Papers 14, 16. PO misuses the phrase “new theory” to apply to what is merely supplemental evidence of Petitioners’ same theory—that the relevant teachings of EX1005 were disclosed in a printed publication before the ’682 Patent’s earliest priority date.

Further, PO erroneously boasts *Duration Media LLC v. Rich Media Club LLC* as analogous to the present case. IPR2023-00953, Paper 21 (PTAB Oct. 12,

² Dr. Houh confirmed in Attachment 1 to EX1016 that the teachings of EX1005 are “fully included” in EXs. 1027–1028. EX1017 at ¶ 12; *see also* Houh Dep. Tr. at 77:16–78:10. PO’s misleading EX2003 does not confirm otherwise; its comparison tool egregiously overstates the number of alleged differences between exhibits by including mere publishing edits and numerous OCR errors.

Petitioners' Reply in Support of its Motion to Submit Supplemental Information 2023). In contrast to *Duration Media*, Petitioners here are not submitting new references that would affect either EX1005's prior art date or what statute EX1005 falls under, *e.g.*, § 102(b) versus § 102(e). *See id.* at 3–4. Put plainly, the effect of Petitioners' Motion if granted is clear—Petitioners' reliance on EX1005, the public accessibility date of EX1005, Petitioners' contention that EX1005 is prior art under § 102(b), and the grounds all stay the same. Unlike in *Duration Media*, Petitioners make clear how they intend to rely on the supplemental information as exemplified above and in their Motion. Thus, they are not “punt[ing] the issue.” *Id.* at 6.

In fact, *Duration Media* cites an analogous case, *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 66 (PTAB Oct. 5, 2021). The Board in *Hulu* “found that reply evidence filed by petitioner regarding other versions of [the prior art reference] from the University of Michigan and Johns Hopkins University were probative of Petitioner's version of [the prior art reference] having been publicly available before the critical date.” *Id.* at 5 (citing *Hulu*, Paper 66 at 47). Similarly, Petitioners' supplemental information is probative of whether EX1005 was publicly available before the '682 Patent's critical date.

Further, Petitioners maintain their position that a POSITA exercising reasonable diligence would have also located EX1005 online, as Dr. Houh did, using the EX1005 URL provided in the Petition and on UCL's FTP server. *See* Paper 14 at 2–3; *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed.

Petitioners’ Reply in Support of its Motion to Submit Supplemental Information Cir. 2006); Houh Dep. Tr. 148:14–149:8. The supplemental information, including Dr. Crowcroft’s declaration, supports Petitioners’ initial theory and evidence by demonstrating that EX1005 was an author formatted submission as evidenced by the title “cnisdn-article.pdf” included in the URL. *See e.g.*, EX1016.

II. PETITIONERS’ POSITIONS HAVE BEEN KNOWN

Petitioners do not take a “wait-and-see” approach; their position is already well laid out in the Petition. Paper 25 at 10. Contrary to PO’s argument, *Am. Well v. Teladoc Health, Inc.* supports Petitioners because the supplemental information simply “bolster[s] a position that had already been taken.” IPR2021-00748, Paper 23 at 11 (PTAB Feb. 28, 2022). Petitioners ***are not*** submitting new testimony establishing a rationale for the combination of references (*id.* at 12), ***are not*** submitting analysis for why the art of record renders the ’682 Patent obvious (*id.* at 15), ***are not*** presenting a new ground of unpatentability (*see W. Digital Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 22 at 9 (PTAB July 23, 2018), ***are not*** introducing new prior art teachings (*see Laboratoire Francais v. Novo Nordisk*, IPR2017-00028, Paper 22 at 4–5 (PTAB June 13, 2017), and ***are not*** submitting an expert declaration that contains new opinions as to how a POSITA would understand the disclosure in the references (*see Nissan v. Diamond Coating*, IPR2014-01548, Paper 37 at 3–4 (PTAB July 15, 2015). The supplemental information solely goes to the public accessibility issue.

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III. GRANTING THIS MOTION WOULD NOT PREJUDICE PO

PO has known of Petitioners' positions, grounds, and theories since the first filing. PO was further aware prior to and during Dr. Houh's deposition, where it inquired about the supplemental information, including EXs. 1016–1018, thereby negating PO's concerns and removing any alleged prejudice. *See* Houh Dep. Tr. 62:9–20, 160:8–180:10.

PO's volume arguments are unpersuasive. Paper 25 at 11. The supplemental information is limited to public accessibility, not the merits of the Grounds. *See Apple Inc. v. Virnetx Inc.*, IPR2015-00810, Paper 21 at 4–7, 9 (granting motion to submit “almost 900 pages” of supplemental information; noting PO need only review and respond to the limited issue of public accessibility).

PO's “just, speedy, and inexpensive resolution” concerns are alleviated on Petitioners' reliance on the grounds and prior art as filed. 37 C.F.R. § 42.1(b). Granting this Motion would allow issues to crystallize early in the trial, provide a more developed record, and secure the just, speedy and inexpensive resolution of trial. *See Nokia of Am. Corp., v. TQ Delta LLC*, IPR2022-00471, Paper 36 at 4 (PTAB Nov. 17, 2022). Further, the very “purpose of 37 C.F.R. § 42.123(a) is to allow the filing of evidence relevant to a claim after the Petition.” *Id.* As *Nokia* noted, *Hulu* “sanctions the supplemental information process.” *Id.* at 4, fn 2.

In conclusion, Petitioners respectfully request the Board grant the Motion.

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Respectfully submitted,

/s/ W. Todd Baker

W. Todd Baker (No. 45,265)
todd.baker@kirkland.com
Postal and Hand-Delivery Address:
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave., N.W.
Washington, D.C. 20004
T: (202) 389-5000
F: (202) 389-5200

Ellisen Shelton Turner (No. 54,503)
ellisen.turner@kirkland.com
Postal and Hand-Delivery Address:
KIRKLAND & ELLIS LLP
2049 Century Park East, 37th Floor
Los Angeles, CA 90067
T: (310) 552-4200
F: (310) 552-5900

Jonathan D. Brit (No. 75,646)
jonathan.brit@kirkland.com
Postal and Hand-Delivery Address:
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, NY 10022
T: (212) 390-4209
F: (212) 446-4900

Attorneys for Petitioners

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document was served on March 13, 2024, via electronic mail to counsel of record for the Patent Owner at the following:

Christine E. Lehman (Reg. No. 38,535)
clehman@reichmanjorgensen.com
Philip J. Eklem (Reg. No. 76,490)
peklem@reichmanjorgensen.com
REICHMAN JORGENSEN LEHMAN
& FELDBERG LLP
1909 K Street, NW, Suite 800
Washington, DC 20006

Jaime F. Cardenas-Navia
jcardenas-navia@reichmanjorgensen.com
Michael Matulewicz-Crowley (Reg. No. 72,220)
mmatulewicz-crowley@reichmanjorgensen.com
REICHMAN JORGENSEN LEHMAN & FELDBERG LLP
400 Madison Avenue, Suite 14D
New York, NY 10017

RJ_VideoLabs-Facebook@reichmanjorgensen.com

/s/ W. Todd Baker
W. Todd Baker (No. 45,265)