

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TVISION INSIGHTS, INC.,

Petitioner,

v.

THE NIELSEN COMPANY (US), LLC,

Patent Owner

Case IPR2023-01014
Patent No. 11,470,243

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

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I. INTRODUCTION

Petitioner's Reply to Patent Owner's Preliminary Response (Paper 7, "Reply") introduces new arguments that could have been included in the Petition for *Inter Partes* Review (Paper 2, "Petition") and that should be disregarded as being waived accordingly. When addressing the topics for which the Reply was granted, Petitioner cannot rebut the Patent Owner's case for discretionary denial.

Fintiv Factor 1 Petitioner argues that Judge Burke's alleged history of granting stays weighs against discretionary denial. In support of this argument, Petitioner cites three cases where Judge Burke purportedly stayed cases based on institution of IPR. However, the parties mutually consented to have Judge Burke conduct all proceedings on November 7, 2022, before the filing of the Petition. Ex. 2005, p. 1. As such, any information relating to Judge Burke's history of granting stays is not evidence that "Petitioner did not have the opportunity to address." *Vector Flow, Inc. v. HID Global Corporation* IPR2023-00353, Paper 11 (PTAB Aug. 10, 2023). Petitioner failed to advance any arguments regarding Judge Burke's likelihood of granting a stay in the Petition. To the extent that two of Petitioner's cited cases antedate the filing of the Petition, Patent Owner respectfully submits that this argument has been waived. *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1368 (Fed. Cir. 2015) ("[T]he challenger [is] obliged to make an adequate case in its Petition and the Reply [is] limited to a true rebuttal role.").

The sole case cited by Petitioner that post-dates the Petition involves a Motion to Stay characterized by Judge Burke as being “a somewhat unusual procedural posture.” *ImmerVision, Inc. v. Apple Inc.*, No. 1:21-cv-1484-MN-CJB, Dkt. 159 (D. Del. Oct. 17, 2023). There, the parties stipulated that two related cases should be stayed but disagreed on a third case involving an unchallenged claim from the patent for which IPR had been granted. Judge Burke granted the stay to have the common issues for that patent addressed only once rather than twice. *Id.* Such an “unusual procedural posture” cannot be said to establish a precedent of granting stays.

Petitioner attempts to distinguish *Topia Technology, Inc. v. Egnyte, Inc.*, cited by Patent Owner, because Judge Burke denied the Motion to Stay before institution of IPR, but admits that Judge Burke also denied a renewed Motion to Stay *after* institution was granted for two of six patents. *Reply* at p. 2. Thus, *Topia Technology* establishes that Judge Burke does deny Motions to Stay even after institution of IPR.

Fintiv Factors 2 and 5 Petitioner provides entirely new arguments and evidence regarding *Fintiv* Factors 2 and 5 in their Reply but adds nothing that could not have been presented in the Petition. Petitioner provides no reason why these arguments or evidence could not have been presented in the Petition, nor any explanation of how they relate to one of the limited issues for which the Reply was granted. As such, Petitioner’s arguments and evidence related to *Fintiv* Factors 2 and 5 should be considered waived and disregarded. *See Ariosa Diagnostics, supra.*

Fintiv Factor 3 Petitioner again provides new arguments and evidence for *Fintiv* Factor 3, which should be considered waived and disregarded. Petitioner made no arguments for Factor 3 in the Petition and now attempts to present a routine stipulation for an Extension of Time as a new fact that somehow changes the investment already made in the parallel litigation. However, there *has* been a significant development since the filing of the Petition: on October 30, 2023 (before Petitioner filed their Reply), the parties agreed not to propose any claim terms for the court to construe, and the *Markman* hearing has been removed from the Scheduling Order. Ex 2013, *Stipulation and Proposed Order Regarding Claim Construction*. In other words, claim construction is substantively complete, and the parties have already invested all the work necessary to resolve claim construction. As such, Petitioner’s citations of cases where the Board weighed a future *Markman* hearing against discretionary denial are irrelevant at best and misleading at worst.

Fintiv Factor 4 Petitioner begins by advancing arguments regarding the trial date that could have been made in the Petition, which should be considered waived and disregarded as not having been made in the Petition. Next, briefly turning to the subject matter for which a Reply was granted, Petitioner points out that a Decision on Institution in *Vector Flow, Inc. v. HID Global Corporation*, IPR2023-00353, cited in the POPR, was vacated by the Director. Patent Owner notes this Decision was cited in support of the proposition that “[b]ecause Petitioner has not offered a

‘stipulation that would diminish the overlap,’ *Fintiv* Factor 4 favors discretionary denial of the Petition.” Patent Owner’s Preliminary Response (Paper 6, “POPR”) at 62. The Decision was vacated because the Board denied Petitioner a Reply to address (1) a change in the status of a parallel district court proceeding; (2) new time-to-trial evidence presented by Patent Owner; and (3) unforeseeable assignor estoppel arguments advanced by the Patent Owner. IPR2023-00353, Paper 11 at 7. Nothing in the Director’s Decision touches on the effect of a *Sotera* stipulation on *Fintiv* Factor 4. In other words, the cited Decision still stands for the proposition for which it was cited. *See, e.g., Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* at 7 (“*Fintiv* factor four looks at the overlap between the issues raised in the IPR petition and in the parallel proceeding ... If the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” (USPTO June 21, 2022) (internal citations omitted)). Notably, Petitioner does not take this opportunity to make *any* stipulation, much less a *Sotera* stipulation, and Factor 4 still favors discretionary denial of institution accordingly. *See Roku, Inc. v. IOENGINE, LLC*, No. IPR2022-01554, Paper 11 (PTAB 2023) (*Sotera* stipulation required to avoid discretionary denial); *Samsung Electronics Co. Ltd. v. California Institute of Tech.*, No. IPR2023-00130, Paper 10 (PTAB 2023) (weaker stipulations weigh less strongly against denial).

Fintiv Factor 6 Petitioner argues that, because Patent Owner disclaimed claims 1, 9, and 16, Patent Owner has “conceded” the merits of the Petition. This is simply untrue: Patent Owner disclaimed these claims solely to streamline the process of confirming the validity of claims 4-6, 8, 11-14, and 18-20, which are the only claims at issue in the parallel litigation. POPR at 2. Institution for even a single ground and a single claim requires institution on all grounds and all challenged claims; however, “[n]o *inter partes* review will be instituted based on disclaimed claims.” *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018); 37 C.F.R. § 42.107(e). By disclaiming the independent claims, Patent Owner has mooted one of the three grounds of the Petition and, as the remaining dependent claims are necessarily narrower than the canceled independent claims, raised the bar for institution on the remaining grounds. As such, the merits of the Petition are necessarily *less compelling* due to Patent Owner’s disclaimer of the broadest claims.

Petitioner then goes on to impermissibly address the merits of the Petition, divorced from the disclaimer. This analysis is beyond the scope of the issues for which a Reply was granted and should be disregarded.

Respectfully submitted,

/Jennifer C. Bailey/

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APPENDIX OF EXHIBITS

Exhibit 2001	Declaration of Dr. Eli Saber
Exhibit 2002	<i>Request for Statutory Disclaimer as Filed</i> , October 09, 2023
Exhibit 2003	<i>Complaint for Patent Infringement</i> , C.A. No. 1:22-cv-01345
Exhibit 2004	<i>TVision's Initial Invalidity Contentions Regarding the '243 Patent</i> , Exhibit A1-A4
Exhibit 2005	<i>Notice, Consent, and Reference of a Civil Action to a Magistrate Judge</i> , Nov. 7, 2022
Exhibit 2006	<i>Docket Report for Case No. 1:22-cv-01345</i>
Exhibit 2007	<i>Topia Technology, Inc. v. Egnyte, Inc.</i> , No. 21-cv-01821 (D. Del. Mar. 6, 2023), <i>Hearing Transcript</i> , 5:4-12, 48:16-22
Exhibit 2008	<i>Curriculum Vitae of Dr. Eli Saber</i>
Exhibit 2009	<i>Facial Expression Recognition: A Brief Tutorial Overview</i> , Claude Chibelushi and Fabrice Bourel, Staffordshire University, 2002
Exhibit 2010	<i>Facial Expression Recognition</i> , Maja Pantic, Springer-Verlag Berlin Heidelberg, 2009
Exhibit 2011	<i>Automatic Analysis of Facial Expressions: the State of the Art</i> , Maja Pantic and Leon Rothkrantz, IEEE Transactions on Pattern Analysis and Machine Intelligence, vol. 22, No. 12, December 2000
Exhibit 2012	<i>Mechanisms of Face Perception</i> , Doris Y. Tsao and Margaret S. Livingstone, <i>Annu Rev Neurosci.</i> 2008, 31, 411-437
Exhibit 2013	<i>Stipulation and Proposed Order Regarding Claim Construction</i> , October 30, 2023

CERTIFICATION OF COMPLIANCE

The undersigned certifies pursuant to 37 C.F.R. § 42.24(d) that the foregoing Patent Owner's Sur-Reply to Petitioner's Reply to Patent Owner's Preliminary Response to Petition for *Inter Partes* Review, excluding those portions excepted by 37 C.F.R. § 42.24(a)(1), complies with the five-page limit specified by the Board.

Dated: November 8, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE was served on November 8, 2023, by email on the following counsel of record for Petitioner:

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