

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C. and DISH TECHNOLOGIES L.L.C.,
Petitioner,

v.

SAFECAST LIMITED LLC,
Patent Owner.

Case IPR2023-01116
Patent 9,392,302 B2

**PETITIONER'S REPLY
TO PATENT OWNER'S RESPONSE**

Pursuant to the Scheduling Order (Paper 10), DISH Network L.L.C. and DISH Technologies L.L.C. (“Petitioner”) hereby submits this Petitioner’s Reply in IPR2023-01116 relating to U.S. Patent 9,392,302 (“the ’302 patent”). The Petition identified two invalidity grounds: (1) Ground 1: Patten in view of Ben-Rubi and Applicant Admitted Prior Art (“AAPA”); and (2) Ground 2: Patten in view of Ben-Rubi, AAPA, and Plotnick. Collectively, these grounds establish that claims 1–4, 6–9, and 12–15 (“the Challenged Claims”) of the ’302 patent are unpatentable. In this proceeding, SafeCast Limited LLC (“Patent Owner”) did not file a Patent Owner Response.

The Board has already determined the Challenged Claims are unpatentable in a parallel proceeding involving the same patent and claims. *See Google LLC v. SafeCast Limited LLC*, IPR2023-00652, Paper 16 (Final Written Decision) at 50 (P.T.A.B. Oct. 3, 2024) (“ORDERED that Petitioner establishes by a preponderance of evidence that challenged claims 1–4, 6–9, and 12–15 are unpatentable”). Patent Owner did not file a notice of appeal in that IPR and all appeal rights are exhausted. All that remains is for the issuance and publication of the certificate confirming the cancellation of all the Challenged Claims. *See* 37 C.F.R. § 42.80 (“After the Board issues a final written decision in an inter partes review, . . . and the time for appeal has expired . . . the Office will issue and

publish a certificate canceling any claim of the patent finally determined to be unpatentable[.]”)

Further, the Petition’s unchallenged arguments in this proceeding demonstrate the unpatentability of the Challenged Claims by a preponderance of the evidence. Although Patent Owner filed a Preliminary Response on April 9, 2024, it did not meaningfully dispute the Petition’s arguments. Paper 8 (“Prelim. Resp.”). The Board correctly found that the Preliminary Response did not contest the Petition’s arguments and sometimes *agreed* with them. *See* Paper 9 (“Institution Decision”) at 9 (“Patent Owner does not dispute Petitioner’s claim constructions.”), *id.* at 17 (“Patent Owner does not specifically address Petitioner’s showing for the preamble.”), *id.* at 18 (“Patent Owner does not contest Petitioner’s showing with respect to this limitation.”), *id.* at 19 (“Patent Owner agrees that Patten ‘generally disclose[s] an advertisement supply means.’”), *id.* at 22 (“This line of argument generally denies Petitioner’s showing without specificity.”), *id.* at 23 (“Similar to the first line of argument, this line of argument fails to address the combined teachings of Patten and Ben-Rubi, and the knowledge of an artisan of ordinary skill, as relied upon in the Petition.”), *id.* at 32 (“Patent Owner generally relies on its arguments with respect to claim 1.”). In light of the Petition’s arguments and Patent Owner’s failure to meaningfully dispute those arguments, the

Board correctly concluded “there is a reasonable likelihood that Petitioner will prevail with respect to at least one challenged claim” and “institute[d] an *inter partes* review of the ’302 patent.” *Id.* at 2.

The Scheduling Order that issued in parallel with the Institution Decision notes that Patent Owner “may file” a response to the Petition by September 19, 2024. Paper 10 at 9, 12. The Scheduling Order further noted that, “[i]f Patent Owner elects not to file a response, Patent Owner must arrange a conference call with the parties and the Board.” *Id.* at 9. On September 19, 2024, Patent Owner did not submit a Patent Owner Response (POR), nor did it arrange the required conference call with the parties and the Board. Patent Owner has still not done so. Because Patent Owner did not raise any arguments challenging the Petition’s evidence and analysis in a POR, this Reply does not address or raise any arguments in reply. *See also* Paper 10 at 9 (“Patent Owner is cautioned that any arguments not raised in the response may be deemed waived.”).

On this record, if the Board has not already issued and published a certificate canceling claims 1–4, 6–9, and 12–15 in the Google proceeding, IPR2023-00652, then, in view of the Petition’s substantial—and largely undisputed—evidence, Petitioner respectfully requests issuance of a Final Written Decision finding all Challenged Claims unpatentable based on the Grounds identified above. Further,

at this time, Petitioner does not intend to request an oral hearing.

Respectfully submitted,

Dated: December 12, 2024

/Adam R. Shartzter/
Adam R. Shartzter, Reg. No. 57,264
Ruffin B. Cordell, Reg. No. 33,487
Timothy Riffe, Reg. No. 43,881
Jack R. Wilson, Reg. No. 75,011
Daniel Y. Lee, Reg. No. 72,848
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

CERTIFICATION UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Petitioner's Reply to Patent Owner's Response totals 703, which is less than the 5,600 allowed under 37 CFR § 42.24(b)(1).

Respectfully submitted,

Dated: December 12, 2024

/Adam R. Shartz/
Adam R. Shartz, Reg. No. 57,264
Ruffin B. Cordell, Reg. No. 33,487
Timothy Riffe, Reg. No. 43,881
Jack R. Wilson, Reg. No. 75,011
Daniel Y. Lee, Reg. No. 72,848
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on December 12, 2024, a complete and entire copy of this Petitioner's Reply to Patent Owner's Response were provided by email to the Patent Owner by serving the correspondence address of record as follows:

Allen J. Oh
Registration No. 42,047
ALLEN J. OH LAW OFFICE
23505 Birch Road
Rogers, Minnesota 55374
Telephone: (763) 242-4401
Email: allen.oh@icloud.com

/Anastasia Renard/
Anastasia Renard
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
renard@fr.com