

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C. ET AL.,
Petitioner,

v.

ENTROPIC COMMUNICATIONS, LLC,
Patent Owner.

Case IPR2024-00393
U.S. Patent 7,295,518

**PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO EXCLUDE**

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I. INTRODUCTION

Patent Owner's opposition to Petitioner's Motion to Exclude Ex. 2008 fails to address the fundamental procedural violations and substantive issues that necessitate exclusion. Indeed, the opposition does not establish the relevance of a district court's § 101 analysis to the § 103 issues before the Board. Nor does it justify Patent Owner's unauthorized submission of Ex. 2008 after the close of discovery, in direct violation of the Board's rules. Patent Owner also ignores precedent holding that late submissions for which the opposing party has no opportunity to respond are prejudicial. The Board should exclude Ex. 2008.

II. ARGUMENTS

A. Patent Owner Misapplies the Relevancy Standard and Mischaracterizes the District Court's Findings

Patent Owner argues that Ex. 2008 "supports Patent Owner's position that the '518 Patent is specific to on-premises coaxial networks" and is therefore relevant to the analogous art inquiry. Paper 35 (Opp.) 4. Not so.

A district court's analysis of § 101 subject-matter eligibility is a distinct inquiry, involving different legal considerations, than the Board's § 103 obviousness analysis. Specifically here, a district court's analysis of whether the '518 Patent recites an improvement for § 101 purposes does not inform whether a reference is analogous art for obviousness purposes. The Board's analogous art inquiry follows the Federal Circuit's two-part test: whether the reference is (1)

from the same field of endeavor, or (2) reasonably pertinent to the particular problem the inventor is trying to solve. *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023). The § 101 inquiry does not consider either of these factors. Patent Owner's attempt to use a district court's § 101 eligibility analysis to influence the analogous art inquiry, a factual finding within the Board's purview, is fundamentally flawed.

Although Patent Owner frames its use of Ex. 2008 as merely referencing a legal ruling, Patent Owner's sur-reply tells a different story. It uses Ex. 2008 as evidence in a factual dispute about analogous art without utilizing protocols in place, such as requesting authorization from the Board for submission of evidence after Patent Owner discovery closes. Patent Owner cannot evade the Board's procedures by dressing up factual evidence as a mere legal citation.

Moreover, Patent Owner's characterization of the district court's ruling is misleading. Patent Owner states that Ex. 2008 "confirms that the '518 Patent is indeed specific to coaxial networks," claiming that the court held that the claims "solve[] a specific problem in the coaxial network area." Opp. 4-5 (citing Ex. 2008 at 23-25). This assertion, however, is Patent Owner's own language quoted from its district court briefing, not the court's language.

The district court explicitly noted that "it potentially appears that the applicant did not invent that improvement" (Ex. 2008 at 24), which supports

Petitioner’s position that the claimed techniques are not limited to the coaxial network context. The court recognized that the techniques at issue originated in the context of different networks and were simply applied by the ’518 Patent to a coaxial network, which aligns with Petitioner’s arguments. This finding directly contradicts Patent Owner’s attempt to limit the ’518 Patent to coaxial networks.

B. Patent Owner’s Procedural Violations Cannot be Excused

Patent Owner attempts to justify its unauthorized submission as a “mandatory notice” under 37 CFR §§ 42.51(b) and 42.8(b)(2). *See* Opp. 3. This argument misses the mark. While the parties must identify relevant judicial matters, nothing in these rules authorizes submission of exhibits after the close of discovery without Board approval. Instead, the proper procedure under the relevant rule, 37 CFR § 42.123, would have been to notify the Board of the district court decision and request authorization to submit it as supplemental information. Patent Owner’s actions disrupted the orderly proceeding and undermined the discovery rules that ensure fairness to all parties.

Patent Owner dismissal of Petitioner’s procedural objections as “form over substance” is misplaced. *See* Opp. 2. The Board’s procedural rules exist for a reason—to ensure fairness and orderly proceedings. Patent Owner’s suggestion that it can circumvent these rules ignores the prejudice to Petitioner from Patent Owner’s unauthorized submission of, and subsequent reliance on, Ex. 2008.

Patent Owner's comparison to submitting "the text of *KSR*" is inapt. Opp. 2.

KSR is binding Supreme Court authority available to all parties at the onset of the proceedings. By contrast, Ex. 2008 is a non-binding district court order addressing irrelevant factual questions that Patent Owner attempts to improperly leverage in this proceeding without giving Petitioner a fair opportunity to respond.

C. Patent Owner Ignores Board Precedent on Prejudice

Notably absent from Patent Owner's opposition is any discussion of the Board precedent cited by Petitioner establishing that late submissions are prejudicial when the opposing party has no opportunity to respond. In *Chervon N. Am., Inc. v. Milwaukee Elec. Tool Corp.*, IPR2015-00595, Paper 64 at 8, the Board denied a request to file supplemental information shortly before the final hearing, finding it "unfairly prejudicial" to the petitioner. Similarly, in *PNC Bank, NA v. United Services Automobile Association*, IPR2021-01077, Paper 73 at 83, the Board denied a motion to submit information from co-pending litigation because there was "no opportunity to address the information in the merits briefing."

Patent Owner's silence on these authorities speaks volumes. The submission of Ex. 2008 after the close of discovery and Petitioner's completion of substantive briefing has deprived Petitioner of any meaningful opportunity to address the exhibit. This is precisely the prejudice that both *Chervon* and *PNC Bank* identified as a basis for excluding late-submitted evidence. The Board has consistently

rejected such late submissions, and it should do so here as well.

III. CONCLUSION

For these reasons and those stated in Petitioner's Motion to Exclude, Petitioner respectfully requests that the Board exclude Ex. 2008 from the evidentiary record in this proceeding or, at minimum, disregard Patent Owner's arguments relying on Ex. 2008.

Respectfully submitted,

Date: April 17, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on April 17, 2025, a complete and entire copy of this Petitioner's Reply to Patent Owner's Opposition to Petitioner's Motion to Exclude was provided by email to the Patent Owner by serving the email correspondence addresses of record as follows:

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