

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HULU, LLC,  
Petitioner,

v.

PIRANHA MEDIA DISTRIBUTION, LLC,  
Patent Owner.

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Case IPR2024-01252  
Patent 11,463,768

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**PATENT OWNER'S UNOPPOSED MOTION TO STAY  
*EX PARTE* REEXAMINATION CONTROL NUMBER 90/019,699  
PURSUANT TO 35 U.S.C. § 315(d) AND 84 FED. REG. 16654**

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| <i>Tesla, Inc. v. Graphite Charging Co., LLC</i> ,<br>IPR2024-00388, Paper 22 (PTAB Oct. 7, 2024).....                | 2              |

| EXHIBIT LIST |                                                                                                                                                                                                    |
|--------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001         | Declaration of Zachariah Higgins in Support of Patent Owner’s Notice of Intent to Designate Provisionally Recognized PTAB Attorney Zachariah Higgins as Backup Counsel Under 37 C.F.R. § 42.10(c)  |
| 2002         | US Patent No. 10,986,403 (Donian) [’403 Patent]                                                                                                                                                    |
| 2003         | US Patent Publication No. 2002/0144262 [Eldering-’262]                                                                                                                                             |
| 2004         | US Patent No. 6,615,039 [Eldering-’039]                                                                                                                                                            |
| 2005         | <i>AviaGames, Inc. v. Skillz Platform Inc.</i> , IPR2022-00530, Paper 12 (Aug. 9, 2022)                                                                                                            |
| 2006         | <i>AviaGames, Inc. v. Skillz Platform Inc.</i> , IPR2022-00530, Paper 14 (Dir. Rvw. Mar. 2, 2023)                                                                                                  |
| 2007         | <i>AviaGames, Inc. v. Skillz Platform Inc.</i> , IPR2022-00530, Paper 15 (Mar. 22, 2023)                                                                                                           |
| 2008         | Excerpts from Prosecution History of USPTO Application No. 09/742,852, Decision on Appeal (Mar. 26, 2009)                                                                                          |
| 2009         | Request for Ex Parte Reexamination No. 90/019,699 of US Patent No. 11,463,768                                                                                                                      |
| 2010         | <i>Piranha Media Distribution, LLC v. Hulu, LLC</i> , 2:24-cv-00498-JLS-KS, Dkt. 23, “Order Granting Defendant’s Motion To Dismiss” (Sept. 11, 2024) [Sep. 11, 2024 final judgment of invalidity]. |
| 2011         | <i>Piranha Media Distribution LLC v. Hulu, LLC</i> , Appeal No. 25-1038, Dkt. 5, “Hulu LLC Docketing Statement” (Oct. 22, 2024) [Petitioner’s Ct. App. dktg. stmt.]                                |
| 2012         | USPTO, Director Memo re Interim Procedure For Discretionary Denials In AIA Post-Grant Prcdgs. With Parallel Dist. Ct. Litig. (June 21, 2022) [Interim Denial Memo]                                 |

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| 2013 | <i>Netflix, Inc. v. DivX, LLC</i> , IPR2020-00052, Paper 42 (May 14, 2020) (Public Version)                                                                                               |
| 2014 | Request for <i>Ex Parte</i> Reexamination Control No. 90/019,699 [Request]                                                                                                                |
| 2015 | Order Granting <i>Ex Parte</i> Reexamination in <i>Ex Parte</i> Reexamination Control No. 90/019,699 [Decision Granting EPR]                                                              |
| 2016 | Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. 84 Fed. Reg. 16,654, 16,657 (Apr. 22, 2019) [2019 Notice] |

Patent Owner requests a stay of EPR 90/019,699 pending resolution of this IPR. Office guidance favors a stay. The EPR and IPR both challenge overlapping claims of the same patent as obvious, based on Wu as the primary reference, and the same or materially similar relied-on disclosures in secondary references. Also, the *second* parallel IPR, challenging the same claims as this IPR, buttresses good cause, since EPR stay decisions find good cause to stay even with *one* parallel IPR.

Petitioner does not oppose this authorized Motion.

**History:** This 1252 IPR, filed August 22, 2024, challenges claims 1-3, 5-12, 14-21, 23-25, 27-29, and 31-33 over Wu (Ex. 1004) in view of Doherty. Pet., 8.

After the IPR was filed, a third party requested EPR of Claims 1, 10, 19, and 27 as obvious, primarily over Wu (Ex. 1004). Ex. 2014, 10-11. On December 13, 2024, the Office ordered the requested EPR, relying primarily on Wu. Ex. 2015. Rosenberg, secondary reference in the EPR, is substantially similar to Doherty.

This IPR was instituted March 4, 2025. A decision is due March 4, 2026.

**The Board Should Stay The EPR Pending The IPR:** “[T]he Board ordinarily will stay a parallel Office proceeding where good cause exists. Good cause . . . may exist if, for example, an on-going AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue . . . .” 84 FR 16,654, 16,657 (“2019 Notice”) (Ex. 2016); *see also* 37 C.F.R. § 42.122(a).

The 2019 Notice (at 9) lists eight factors bearing on good cause, which the Board has routinely considered when granting a stay of EPR. *E.g.*, *Tesla, Inc. v. Graphite Charging*, IPR2024-00388, Paper 22, 3-12 (PTAB Oct. 7, 2024); *BMW of N. Am. v. Foras Techs*, IPR2023-01373, Paper 15, 4-7 (PTAB Jun. 21, 2024); *Juniper Networks v. Monarch Networking Sols.*, IPR2024-00175, Paper 19, 3-7 (PTAB Sept. 11, 2024). This is true even when not every factor favors a stay. *E.g.*, *Google LLC v. EcoFactor, Inc.*, IPR2021-00054, Paper 12, 4 (PTAB Jun. 28, 2021) (granting opposed stay notwithstanding Factor 2); *Lumondi Inc. v. Lennon Image Tech.*, IPR2013-00432, Paper 7, 3 (PTAB Aug. 6, 2013) (similar); *Avaya Inc. v. Network-1 Sec. Sols.*, IPR2013-00071, Paper 9, 2–3 (PTAB Dec. 21, 2012) (same). The factors individually and collectively show good cause to stay the parallel EPR.

**Factor 1**—“Whether the claims challenged in the [IPR] are the same as or depend directly or indirectly from claims at issue in the concurrent parallel [EPR]”:

Factor 1’s express criterion is satisfied. “[T]he claims challenged in the present AIA proceeding” ( 1-3, 5-12, 14-21, 23-25, 27-29, 31-33) “are the same as or depend directly or indirectly from [the] claims at issue in the parallel [EPR]” (1, 10, 19, 27). Specifically, claims 1, 10, 19, and 27 in the IPR “are the same as” claims in the EPR, and the remaining claims in the IPR “depend directly or indirectly from” the claims in the EPR. Factor 1 thus very heavily favors a stay.

**Factor 2**—“Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings”: Both cases’ primary reference is Wu. This alone is more than sufficient for Factor 2 to favor a stay. Furthermore, the *parallel* 1253 IPR and the EPR both rely on Eldering-I. 1253 Pet., iii, 8; Ex. 2014, 29.

If more were needed, both cases rely on similar disclosure and argument for Rosenberg, which combines with Wu in both SNQs found in the EPR, and Doherty combined with Wu in the IPR. Moreover, the arguments for these combinations in IPR and EPR overlap substantially; indeed, arguments in the EPR merely reword arguments in the IPR. For example, the IPR Petition and EPR Request both argue Doherty and Rosenberg, respectively, “chang[e] a predetermined advertisement insertion point in the digital media content to an adapted advertisement insertion point” in response to user input, based on similar disclosures in each. *Compare* Pet., 32, *with* Ex. 2014 [Request], 101. In this IPR, Patent Owner has argued that such teachings do not disclose changing an advertising insertion point as claimed, Paper 10, 36, *also* 45-46. For another example, similar arguments in both cases involve the claimed ad “rotator” (*e.g.*, output compiler) managing requests from the scheduler. The IPR Petition argues (at 49) that *requests* for ad content meet the claimed rotator, and that Doherty “outputs to the output compiler a schedule including a reference to an advertisement, in response to which the output compiler retrieves digital advertising content for presentation.” The EPR Request bases

substantially similar arguments on Rosenberg. Ex. 2014, *e.g.*, 81-82, 83. In short, a stay would simplify the EPR, prevent duplicative effort, and avoid inconsistency.

The Board has found support for a stay under Factor 2 even when the IPR art merely “included passages that were substantially similar to passages” in the EPR art. *Quest Diagnostics v. Ravgen, Inc.*, IPR2021-00791, Paper 25, 6 (PTAB Dec. 15, 2021); *see also Goertek, Inc. v. Knowles Elecs.*, IPR2013-00614, Paper 11 (PTAB May 13, 2013) (“some of the prior art” different). Moreover, the Board will stay even if Factor 2 considerations do not favor it. *E.g.*, *EcoFactor, supra*, 4 (“no overlap”); *see also Lennon, supra*, 3 (“different prior art”); *Avaya Inc. v. Network-1 Sec. Sols.*, IPR2013-00071, Paper 9, 2–3 (PTAB Dec. 21, 2012) (same).

**Factor 3**—“Whether the concurrent parallel Office proceeding will duplicate efforts within the Office”: With overlapping art and claims, duplication risk is very high. *E.g.*, *EcoFactor, supra*, 4; *Avaya, supra*, 2; *Lennon, supra*, 2–3; *Foras Tech., supra*, 5 (“Nearly all the same claims and all the prior art” so to allow “both to proceed concurrently would duplicate efforts”). Factor 3 favors a stay.

**Factor 4**—“Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings”: The IPR and EPR risk inconsistent results. Both may, *e.g.*, rule on the scope of the same claims (and of Wu) and likely must determine whether substantially similar disclosure in Rosenberg and Doherty, respectively render the same claims obvious. In such circumstances Factor 4 favors

a stay. *See, e.g., Mueller Sys. v. Rein Tech*, IPR2020-00100, Paper 11, 4 (PTAB May 14, 2020) (that IPR and EPR have “the same claims and the same prior art . . . raises the possibility of inconsistent results. This factor favors a stay.”).

**Factor 5**—“Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding”: The Patent is expired, and so cannot be amended. Therefore, this factor is neutral or does not favor a stay.

**Factors 6–7**—“The statutory deadlines” and “respective timeline and stage of each proceeding”: The IPR decision is due March 4, 2026. EPR was ordered December 13, and has no set deadlines or number of actions. The Board has found these factors favor a stay where IPR is instituted and, as here, no EPR office action has been issued. *E.g., Lab. Corp. of Am. Holdings v. Ravgen, Inc.*, IPR2021-00902, Paper 24, 9-10 (PTAB Feb. 1, 2022). Factors 6–7 favor a stay.

**Factor 8**—“Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot”: This IPR may simplify or moot the EPR issues, which has overlapping claims and art. The Board has found that this factor favors a stay on similar facts. *E.g., Mueller Sys. v. Rein Tech*, IPR2020-00098, Paper 13 (PTAB May 15, 2020). Here, it favors a stay.

***Conclusion:*** The Board routinely stays overlapping concurrent EPRs in like circumstances. This unopposed Motion to stay the parallel EPR should be granted.

Respectfully submitted,

/ David Alberti /

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Date: April 7, 2025

**CERTIFICATE OF COMPLIANCE**

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing  
**PATENT OWNER’S UNOPPOSED MOTION TO STAY EX PARTE  
REEXAMINATION CONTROL NUMBER 90/019,699 PURSUANT TO 35  
U.S.C. § 315(d) AND 84 FED. REG. 16654**, exclusive of the exempted portions  
as provided in 37 C.F.R. § 42.24(a), contains no more than 5 pages and therefore  
complies with the Board’s order granting briefing by e-mail on April 2, 2025.

Respectfully submitted,

/ Abigael Neufeld/

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Date: April 7, 2025

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the following documents were served  
by electronic service, by agreement between the parties, on the date below:

**PATENT OWNER'S MOTION TO STAY  
*EX PARTE* REEXAMINATION CONTROL NUMBER 90/019,699  
PURSUANT TO 35 U.S.C. § 315(d) AND 84 FED. REG. 16654**

**EXHIBITS 2014-2016**

The names and addresses of the parties being served are as follows:

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Respectfully submitted,

/ Abigael Neufeld/  

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Date: April 7, 2025