UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENIUS SPORTS LTD.,
Petitioner

v.

SPORTSCASTR INC.,
(D/B/A PANDA INTERACTIVE),
Patent Owner.

IPR2024-01310
U.S. Patent No. 11,039,218

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE[1]

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[1] This Reply was authorized by the Board's January 27, 2025 email (Ex.1060).

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I. The Board Should Not Discretionarily Deny Review Under §325(d)

The Board should not exercise its discretion under §325(d) because neither prong of the *Advanced Bionics* framework is met. At step one, Patent Owner ("PO") fails to establish that the three references asserted in the Petition—Ellis, Herzog, and Spivey—are the same as or cumulative of Ellis-318, Shoff, DeWeese, and Bocharov. And at step two, to the extent the Office previously considered the same or cumulative art and argument (it did not), the Office committed material error by mis-appreciating the teachings and motivations of the art.

A. The Petition Presents New Prior Art, Grounds, and Arguments Not Previously Considered by the Office (Step One)

PO does not dispute that Ellis, Herzog, and Spivey are nowhere in the file history. Rather, PO argues that (1) Ellis was before the Office because Ellis is a continuation of Ellis-318, which was cited in a PCT Search Report and considered in an IDS, and (2) Ellis, Herzog, and Spivey are cumulative of the Ellis-318, Shoff, DeWeese, and Bocharov references. POPR, 20-33. The Board should reject these arguments, which mischaracterize the references and prosecution in which the Examiner summarily allowed all claims to issue in a first-action allowance.

1. The Office Did Not Substantively Consider Ellis-318

PO clings to a ***PCT Examiner's*** indication of Ellis-318 as an "A" reference—a "document defining the general state of the art which is ***not*** considered to be of particular relevance"—to argue the ***PTO Examiner*** considered Ellis in allowing the

'218. POPR, 21-26. Other than signing an IDS listing Ellis-318 as one of 41 references, the Examiner did not substantively address Ellis-318 in any correspondence, nor cite it in any rejection. Ellis-318 indisputably "was neither applied against the claims nor discussed by the Examiner," and its mere inclusion in an IDS "does not weigh in favor of exercising [] discretion under §325(d)." *Fasteners for Retail v. RTC Indus.*, IPR2019-00994, Paper 9 at 10 (P.T.A.B. Nov. 5, 2019). This remains true even within the *Advanced Bionics* two-part framework. *See e.g., Whitewater West Indus. v. American Wave Machines,* IPR2022-01033, Paper 8 at 16 (P.T.A.B. Nov. 22, 2022) ("the criteria . . . for denying the petition in *Advanced Bionics* included not only the fact the art was made of record, but also the fact it was applied and discussed during prosecution. Anything less disregards the express reasoning behind the Board's exercise of discretion in that case.").

PO further ignores that the PCT Examiner considered Ellis-318 to be not particularly relevant to claims 1-52 of the PCT application. Moreover, those claims are entirely different from the claims before the PTO Examiner. *Compare* Ex.1061, claims 1-52, *with* Ex.1009, claims 1-30. Indeed, the PCT application is from an entirely different family. Because PO "does not provide any detailed analysis of the related claims" to show how they are materially the same as the instant claims, PO's contention that the PCT Search Report (in which the PCT examiner found Ellis-318 "***not*** … to be of particular relevance") somehow formed the basis for the PTO

Examiner to allow the '218 over Ellis-318 is nonsensical. *See Snap Inc. v. Sanderling Mgmt. Ltd.*, IPR2021-00780, Paper 20 at 24 (P.T.A.B. Nov. 9, 2021). Further, to the extent Ellis-318 was considered by the Examiner and assuming the PCT claims are not materially different from the instant claims, the Examiner erred in allowing the instant claims over Ellis, Herzog, and Spivey. *See* Pet., 19-50; §I.B, *infra*.

2. Ellis, Herzog, and Spivey Are Not Substantively the Same as Shoff, DeWeese, and Bocharov

PO strains to contend that the Petition contains essentially the same art and arguments presented during prosecution because "Shoff, DeWeese, and Bocharov were considered ***extensively*** during prosecution." POPR, 34. But PO ignores that the "over eleven single-spaced pages and 15-plus paragraphs" of the Examiner's first-action allowance contain virtually no analysis of Shoff, DeWeese, and Bocharov. *Id.* (citing Ex.2035, 337-349). The Examiner's allegedly "extensive" analysis amounts to no more than the disfavored practice of copy-pasting independent claim language and appending it to a single-line summary of the reference with a broad indication that the reference is deficient. *See, e.g.,* Ex.1011, 341-342 (Bocharov); *see also id.*, 342-343 (DeWeese); 343-344 (Shoff); 344-348 (same formulation but as applied to Bocharov, DeWeese, and Shoff, with respect to independent claims 12 and 21).

The Examiner did not evaluate art or arguments similar to or cumulative of those asserted in the Petition. Critically, in contrast to Ellis, Herzog, and Spivey, none of the references raised by PO discloses, among other limitations, a control

server to retrieve, via the Internet, first event information germane to a first sporting event, or a socket server having an event socket corresponding to the first event information. Indeed, PO merely highlights general overlap of high-level teachings contained in the references but does not identify specific teachings that would support a finding that the Examiner had substantially the same teaching before her. For example, like nearly every reference in this field, Bocharov generally teaches the concept of "streaming program content to [a] user's device." POPR, 31. PO does not establish that Bocharov also teaches every other limitation taught by the asserted references. The same goes for Shoff and DeWeese. PO also fails to establish that the Office also considered the same motivation to combine and reasonable expectation of success arguments raised in the Petition. PO's approach, highlighting general overlap of teachings to demand institution denial, is incorrect and would create an insurmountable hurdle precluding institution in a crowded field.

PO then tries to fabricate a combination of teachings the Examiner hypothetically could have considered. POPR, 32. The barren file history provides no support for PO's argument. The Examiner never considered any combination of these references as PO proposes. The Examiner never discussed PO's cited passages. Nor do these references, including PO's selected passages, provide the same teachings as Ellis, Herzog, and Spivey, individually or collectively, to render the claims obvious. Thus, PO fails to satisfy prong one.

B. The Examiner Materially Erred in Failing to Consider Ellis in Combination with Other Prior Art (Step Two)

PO fares no better at step two. Assuming, *arguendo*, that the Office substantively considered Ellis during prosecution, it did not consider the combination of Ellis with other prior art such as Spivey and Herzog. As set forth in the Petition, Ellis in view of Spivey and Herzog—neither of which were before the Examiner—renders obvious the alleged allowable subject matter. For example, as set forth in the Petition, although Ellis may not explicitly disclose the claimed control server, socket server, and webserver, a POSA would have found it obvious to integrate these known, generic components, as taught by Spivey (the control server and socket server) and Herzog (the webserver), to implement Ellis's content delivery system with reduced latency. As such, the claimed invention is rendered obvious by Ellis in view of those references—a combination that the Examiner never had the opportunity to consider. Even if Ellis were considered, the Office committed material error by failing to appreciate its significance when combined with other art that was available at the time but not identified in the prosecution history.

PO's argument that Herzog and Spivey provide nothing new because the Office already allowed the '218 after considering Shoff, DeWeese, and Bocharov's disclosure of the claimed control, socket, and web servers, is without merit. As explained, PO has not established that any of these references teaches the same limitations nor provides the same motivation. Accordingly, PO also fails prong two.

Date: February 10, 2025

Respectfully submitted,

/s/ *W. Todd Baker*

W. Todd Baker (Reg. No. 45,265)
todd.baker@kirkland.com
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave., N.W.
Washington, D.C. 20004
(202) 389-5000

Jeanne M. Heffernan (*pro hac vice* admission to be requested)
jheffernan@kirkland.com
Michael T. Dinnella (Reg. No. 82,580)
michael.dinnella@kirkland.com
KIRKLAND & ELLIS LLP
401 Congress Avenue
Austin, TX 78701
Telephone: (512) 678-9123
Facsimile: (512) 678-9101

Attorneys For Petitioner Genius Sports Ltd.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document and Exhibits 1060 and 1061 were served on February 10, 2025, via electronic mail directed to counsel of record for the Patent Owner.

/s/ *W. Todd Baker*
W. Todd Baker