

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

GENIUS SPORTS LTD.,
Petitioner,

v.

SPORTSCASTR INC. d/b/a PANDA INTERACTIVE,
Patent Owner.

IPR2024-01310
Patent 11,039,218 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating-in-Part the Final Written Decision, and
Remanding to the Board for Further Proceedings

SportsCastr Inc. (d/b/a PANDA Interactive) (“Patent Owner”) filed a request for Director Review of the Final Written Decision (“Decision,” Paper 47) in the above-captioned case, and Genius Sports Ltd. (“Petitioner”) filed an authorized response. *See* Paper 48 (“DR Request”); Paper 49 (“DR Response”). Patent Owner argues that the Decision should be vacated-in-part because the Board failed to address Patent Owner’s arguments concerning the “webserver” limitation of claim 1 in finding claims 1–11 unpatentable.¹ DR Request 1, 13. Patent Owner contends that although the Patent Owner Response (“Response”) included arguments relating to the webserver limitation in a section directed to Petitioner’s asserted Ground 2A, the Response also stated that these arguments “*apply equally to all grounds* challenging any one of claims 1-2, 4-5, and 8-10,” i.e., all grounds with the webserver limitation. *Id.* at 5 (quoting Response 52 (emphasis omitted)). Yet, Patent Owner contends, the Board failed to analyze these arguments as to the ground under which it found claims 1–11 unpatentable (Ground 1B).²

Petitioner responds that the Board did not overlook Patent Owner’s webserver arguments because it found claim 1 unpatentable. DR Response

¹ Claim 1 of the challenged patent recites “at least one webserver communicatively coupled to the at least one socket server” (“the webserver limitation”). Ex. 1009, 57:56–58.

² Petitioner’s Ground 1B challenges claims 1–11 while Ground 2A challenges claims 1–9 and 12–14. Paper 1, 6. Petitioner’s Ground 1A challenges claims 12–15. *Id.* Unlike independent claim 1, independent claim 12 does not recite the webserver limitation. Thus, Patent Owner’s webserver arguments apply to Grounds 1B and 2A but not to Ground 1A. *See* Ex. 1009, 57:35–67, 59:43–62.

4. Petitioner argues that Patent Owner confuses the Board’s decision not to write a separate section analyzing the webserver limitation with a failure to consider it. *Id.* Petitioner further argues that Patent Owner has waived its webserver arguments because it failed to present them, or even reference them, in the relevant section of the Response. *Id.* at 7. Petitioner argues that the Board was not obligated to parse the Response and construct arguments that Patent Owner did not specifically present under Ground 1B. *Id.*

I agree with Patent Owner that the Board did not address the webserver limitation of claim 1 as part of its analysis of Ground 1B. *See* Decision 56–58. Because the Board was aware of Patent Owner’s arguments about the webserver limitation, however, the Board should have addressed them in the Decision. To be sure, I agree with Petitioner that the Board is not required to parse through the parties’ papers and construct additional arguments that a party failed to present as to a particular ground. *See Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377 (Fed. Cir. 2023) (“While the Board should not take an overly mechanistic view of a petition and decline to address an argument because the petitioner did not present it with ideal vigor and clarity, the Board should also not have to decode a petition to locate additional arguments beyond the ones clearly made.”); *see also Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371 (Fed. Cir. 2023) (“One cannot reasonably expect the Board to sift through hundreds of documents, thousands of pages, to find the relevant facts.”). But here, although it would have been better had Patent Owner made its arguments as to the webserver limitation when addressing Ground 1B (or cross referenced the argument in that ground), the Board did not need to parse through the Response to construct those arguments. Patent Owner referenced the arguments on the

same page of the Response as Ground 1B and presented them in the detail immediately following the section on Ground 1B. Response 51–59.

Moreover, as Petitioner acknowledges, the discussion during oral argument demonstrates that the Board clearly understood Patent Owner’s arguments directed to the webserver limitation.³ DR Response 5–6 (citing Paper 46, 58:18–25). The Board simply failed to address those arguments when deciding Petitioner’s challenge under Ground 1B. Decision 56–58. Under these circumstances, and although Patent Owner did not present them in an optimal manner, it is appropriate to require the Board to address Patent Owner’s arguments in reaching a decision on patentability.

In view of the foregoing, Director Review is granted, the Decision is vacated-in-part, and this case is remanded to the Board to consider Patent Owner’s arguments as to the webserver limitation in deciding whether Petitioner has established by a preponderance of the evidence that claims 1–11 are unpatentable under Petitioner’s Ground 1B.

Absent good cause, the Board shall issue its decision within 30 days of this Order.

Accordingly, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Final Written Decision (Paper 47) is vacated-in-part; and

FURTHER ORDERED that the case is remanded to the Board for further proceedings consistent with this Order.

³ Petitioner relies on the same reference as teaching the webserver limitation under each of the relevant grounds. Patent Owner’s arguments, therefore, appear to apply to each ground challenging claim 1.

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FOR PETITIONER:

W. Todd Baker
Nikhil Rama Krishnan
Socrates L. Boutsikaris
Michael T. Dinnella
KIRKLAND & ELLIS LLP
todd.baker@kirkland.com
nikhil.krishnan@kirkland.com
socrates.boutsikaris@kirkland.com
michael.dinnella@kirkland.com

FOR PATENT OWNER:

Andrew J. Cochran
Colleen Tracy James
CAHILL GORDON & REINDEL LLP
acochran@cahill.com
ctracyjames@cahill.com