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.

IPR2024-01311

U.S. Patent No. 11,039,218

PATENT OWNER PRELIMINARY SUR-REPLY

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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TABLE OF AUTHORITIES

Cases:

Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH,
IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) 2

Fasteners for Retail v. RTC Indus.,
(IPR2019-00994, Paper 9 (PTAB Nov. 5, 2019) 2

Medtronic Corevalve LLC v. Speyside Medical, LLC,
IPR2021-00310, Paper 9 (PTAB July 23, 2021) 2

Whitewater West Indus. v. American Wave Machines,
IPR2022-01033, Paper 8 (PTAB Nov. 22, 2022) 2

EXHIBIT LIST

Exhibit	Description
EX-2001	Declaration of Aviel Rubin, Ph.D.
EX-2002	*Curriculum vitae* of Aviel Rubin, Ph.D.
EX-2003	Joint Claim Construction Statement, Dkt. 69
EX-2004	Declaration of Dr. Stephen Wicker, September 13, 2024
EX-2005	Yahoo Finance Tanner Simkins, April 20, 2017
EX-2006	NBA.com, Steve Ashburner April 27, 2017 Article
EX-2007	Sportstechie, Robert Roble, April 22, 2017
EX-2008	Sports Tech Tokyo Award; 2019 Yahoo! Sports Tech Awards; Sports Business Awards
EX-2009	Various Media Reports on the Patented Invention
EX-2010	CNBC, December 20, 2018
EX-2011	https://sportscastr.com/about
EX-2012	https://pandainteractive.com/patents
EX-2013	https://sportscastr.com
EX-2014	https://studiopanda.live/
EX-2015	Genius Sports 2-24-18 Email
EX-2016	Genius Sports 5-7-18 Email
EX-2017	’218 Patent Genius Sports Infringement Claim Chart
EX-2018	https://www.opensourceforu.com/2015/03/a-guide-to-using-raw-sockets
EX-2019	https://learn.microsoft.com/en-us/windows/win32/winsock/tcp-ip-raw-sockets-2
EX-2020	Oracle documentation in 2011: Anatomy of the Client/Server Model. https://docs.oracle.com/cd/E13203_01/tuxedo/tux80/atmi/intbas3.htm
EX-2021	Peng, Gang. "CDN: Content distribution network." arXiv preprint cs/0411069 (2004) https://arxiv.org/pdf/cs/0411069
EX-2022	The History of Streaming Media. https://boyetblog.s3.amazonaws.com/PCPlus/324.Streaming.pdf
EX-2023	RFC 2326: Real Time Streaming Protocol (RTSP) https://www.ietf.org/rfc/rfc2326.txt
EX-2024	Adobe’s Real Time Messaging Protocol https://rtmp.veriskope.com/pdf/rtmp_specification_1.0.pdf
EX-2025	WebRTC 1.0: Real time Communication Between Browsers https://www.w3.org/TR/2011/WD-webrtc-20111027/

Exhibit	Description
EX-2026	HTTP Live Streaming: draft-pantos-http-live-streaming-01 https://datatracker.ietf.org/doc/html/draft-pantos-http-live-streaming-01
EX-2027	Microsoft To Add Smooth Streaming in IIS7 https://virtualizationreview.com/articles/2008/11/04/microsoft-to-add-smooth-streaming-in-iis7.aspx
EX-2028	HTTP Dynamic Streaming. (Archived May 14, 2010) https://web.archive.org/web/20100514170442/http://www.adobe.com/products/httpdynamicstreaming/
EX-2029	MPEG ratifies its draft standard for DASH. (Archived December 14, 2011) https://web.archive.org/web/20111214104626/http://mpeg.chiariglione.org/meetings/geneva11-1/geneva_press.htm
EX-2030	Mogulus Rebrands With A Killer Domain: Livestream.com https://techcrunch.com/2009/05/18/mogulus-gets-a-killer-domain-for-rebranding-livestreamcom/
EX-2031	How to watch Obama's inauguration (and the parties) online https://www.cnet.com/tech/tech-industry/how-to-watch-obamas-inauguration-and-the-parties-online/
EX-2032	Twitch is 4th in Peak US Internet Traffic https://blog.twitch.tv/en/2014/02/05/twitch-is-4th-in-peak-us-internet-traffic-90b1295af358/
EX-2033	Twitch Engineering: An Introduction and Overview https://blog.twitch.tv/en/2015/12/18/twitch-engineering-an-introduction-and-overview-a23917b71a25/
EX-2034	*Proceedings of the 25th ACM workshop on network and operating systems support for digital audio and video*, pp. 55-60, 2015 https://arxiv.org/pdf/1502.04666
EX-2035	U.S. Patent 11,039,218 Certified File History
EX-2036	Ellis *et al*. U.S. App. No. 2008/0062318
EX-2037	Shoff *et al*. US 2001/0001160
EX-2038	DeWeese *et al*. US 2001/00392.09
EX-2039	Bocharov *et al.* US 2011/0083144

The Board should deny institution of this petition seeking IPR of U.S. Patent No. 11,039,218 ("the '218 patent") because "the same or substantively the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d).

I. The Same Or Substantially The Same Prior Art And Arguments Were Previously Presented To The Office

A. Ellis Is Substantively The Same As & Cumulative Of Previously Considered Prior Art

The face of the '218 patent cites both: (i) Ellis-318, a patent publication having an identical technical specification and drawings as Petitioner's Ellis; and (ii) International Search Report and Written Opinion (the "PCT WO"), in which the International Searching Authority found Ellis-318 to be "not considered…of particular relevance." (EX-2035, 207.) Petitioner does not dispute these facts. Nor does Petitioner dispute that ***two*** examiners considered Ellis-318 and the extent of its relevance to Patent Owner's one-to-many socket architecture, which may be paired with a digital content stream. Instead, Petitioner argues that Ellis was not substantively considered because (1) the Examiner did not cite Ellis-318 in a rejection, and (2) the claims subject to the PCT WO differ from those before the PTO Examiner. Neither argument passes muster.

First, whether the Examiner cited Ellis-318 in a rejection is not dispositive. The Board has rejected the same argument: "Petitioner…seems to limit this factor to references that are expressly included in a rejection by the examiner. This factor

is not so limited." *Medtronic Corevalve LLC v. Speyside Medical,* LLC, IPR2021-00310, Paper 9 at 26 (PTAB July 23, 2021) (citing *Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13, 2020)).

Petitioner's attempt to dismiss Ellis-318 for its "mere inclusion in an IDS" overlooks the depth of analysis found in the '218 patent's file history. Unlike *Fasteners for Retail v. RTC Indus*., which included "*over 1,000 prior art documents*," Ellis-218 is one of only 44 prior art documents listed on the applicant's 2/23/21 IDS. (EX-2035, 356-361.). The Board was "skeptical that the examiner was able to devote sufficient time to evaluate all of the asserted art in detail during prosecution" in *Fasteners for Retail* (IPR2019-00994, Paper 9 at 10 (PTAB Nov. 5, 2019) (emphasis in original). The same skepticism is unwarranted here, where Examiner Chen explicitly stated that she considered "ALL REFERENCES" in the IDS listing Ellis-318 "EXCEPT WHERE LINED THROUGH." (EX-2035, 360.) Examiner Chen did not "line through" Ellis-318, and there is no evidence to suggest that she did not, in fact, consider Ellis-318.

Petitioner's reliance on *Whitewater West Indus. v. American Wave Machines*, in which the prior art "was [not] *applied and discussed during prosecution*" (*Whitewater West Indus. v. American Wave Machines*, IPR2022-01033, Paper 8 at 16 (PTAB Nov. 22, 2022) (emphasis added)), is misplaced. Unlike in that case, here

the PCT Examiner specifically searched for, considered, analyzed, and made a determination as to the relevance of Ellis-318, and Examiner Chen considered this analysis. (EX-2035, 356-360.)

Second, Petitioner's argument regarding the claims subject to the PCT WO disregards Petitioner's rationale for using Ellis to challenge the '218 patent—"Ellis's ***two-part*** delivery method/system." (Petition, 23.) Each claim set includes recitations directed to Patent Owner's one-to-many socket architecture/paired digital content. Examiner Chen would likely have understood the PCT Examiner's finding of Ellis-318 as an A-category document applicable to the '218 patent claims. Just as the two-track architecture of Ellis-318 was not of particular relevance to the architecture of the PCT application, so, too, would the generic two-track architecture of Ellis-318 not have been relevant to the claims of the '218 patent. And Petitioner can point to no authority stating that identical overlap in claims must exist.

B. Ellis, Herzog, and Spivey Are Substantively the Same as Shoff, DeWeese, and Bocharov

In arguing that Shoff, DeWeese, and Bocharov are not substantively the same as Ellis, Herzog, and Spivey, Petitioner ignores the Examiner's analysis of Shoff, DeWeese, and Bocharov.

First, Petitioner fails to address the substantial technical overlap between Ellis and both Shoff and DeWeese, which Patent Owner highlighted in its POPR at 26-31. For example, Ellis's generic, high-level discussion of a ***two-part*** delivery

method/system is found in at least Shoff FIG. 4. (*Compare*, Petition, 26 *with* POPR, 26-27; *see also*, EX-2037, FIG. 4.)

Second, Petitioner argues that there were no "specific teachings that would support a finding that the Examiner had substantially the same teaching before her." (Reply, 4.) For example, Petitioner asserts that none of the references analyzed in the prosecution history taught the recited "control server" (Reply, 3-4), when in fact, the prosecution history includes a detailed analysis, considered by Examiner Chen (EX-2035, 356-360), of the control server. ("***Bocharov discloses***… ***a control server to periodically retrieve, from an event information provider*** [mapping to Bocharov], ***first event information germane to a first live sporting event*** [mapping to Bocharov], ***wherein the first event information includes first score information for the first live sporting event*** [mapping to Bocharov]" (EX-2035, 212, 214 (emphasis added).)

And rather than "fabricate a combination" as alleged by Petitioner, Patent Owner presents the very references that were apparently analyzed together by the Examiner during prosecution of the '218 patent. For example, the '218 patent's prosecution history demonstrates that the Examiner considered at least the two-track architecture of Shoff and DeWeese and Petitioner's interpretation of "webserver," "control server," and "socket server" limitations in Bocharov in a single correspondence—the Non-final Office action mailed April 21, 2021. (EX-2035,

337-349.) Petitioner's suggestion that Examiner Chen did not consider the interoperation of the references enumerated in the Office Action is baseless.

In sum, Petitioner merely uses cumulative prior art and repurposes prior art analysis that has already been considered during prosecution.

II. The Examiner Did Not Err During Prosecution

As discussed above, the Examiner had the benefit of and expressly reviewed the PCT WO analyzing the "integrat[ion] [of] known, generic components, as taught by Spivey" (Reply, 5.) Specifically, the Examiner already considered the disclosure of such alleged "generic components" in Shoff, DeWeese, and Bocharov in allowing the '218 patent. (POPR, 27-31.) And the Examiner expressly analyzed Shoff, DeWeese, and Bocharov in an Office Action, and specifically commented on the allowability of the independent claims over these references. The only logical conclusion is that Examiner Chen was familiar with the content of the prior art.

The Examiner correctly recognized that the '218 patent claims are allowable over the prior art disclosures and the combination of a two-track architecture with generic servers. (EX-2035, 210-229, 337-349.) Accordingly, discretionary denial under Section 325(d) is appropriate.

Dated: February 24, 2025

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CERTIFICATE OF SERVICE

I certify that I caused to be served a true and correct copy of the foregoing: **PATENT OWNER PRELIMINARY SUR-REPLY** were served by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) on February 24, 2025, in its entirety on the following:

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