

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner,

v.

Ericsson AB
Patent Owner.

Case IPR2025-00003
Patent No. 9,313,178

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

I. Introduction

The Board’s Final Written Decision in this proceeding violates foundational principles governing *inter partes* review, rests on clearly erroneous fact findings, and raises important policy issues warranting the Director’s review and reversal.

Under bedrock law, the burden of proof as to obviousness must rest at all times with the petitioner. *In re Magnum Oil Tools*, 829 F.3d 1364, 1377-81 (Fed. Cir. 2016). Thus, to the extent the prior art is *silent* as to a disputed claim element, patent owner must prevail, not petitioner. *See, e.g., IBM v. Iancu*, 759 F. App’x. 1002, 1011 (Fed. Cir. 2019) (reversing Board’s reliance on the prior art’s “silence” as a basis for finding unpatentability). The Board may not weaponize the prior art’s silence against patent owner by finding that patent owner presented “insufficient evidence” of *nonobviousness*. *Id.* (“Nor would that burden be met by merely adding a finding that IBM did not prove the opposite. . . .”). The Board likewise may not rely on its own assumptions to cure the prior art’s silence. *In re Magnum*, 829 F.3d at 1381; *Brand v. Miller*, 487 F.3d 862, 870 (Fed. Cir. 2007).

The Board’s Final Written Decision here violated each of those core principles. Patent Owner demonstrated that the Peterka reference never teaches a client sending a “request” for a “free preview” (as the Petition’s theory requires),

i.e., that Peterka is ***silent*** on that point. The Board, however, found unpatentability on the basis that “Patent Owner has no basis for asserting that the ECMs that are sent during the free preview period are ***not*** sent in response to a request.” Paper 43 at 36 (emphasis added). To the same effect, the Board further supported its decision by stating, “Patent Owner appears to assume that a free preview simply occurs due to some unknown agency without any client request—we see no ***support*** in Peterka for that ***speculation***.” *Id.* at 36-37 (emphasis added). The Board thus found the claims obvious because the prior art purportedly did not state that it does ***not*** teach a disputed claim—flipping the law on its head.

The Board’s decision further attempted to fill the Petition’s evidentiary gap by relying on aspects of Peterka that the Petition itself never cited as teaching a client request for a free preview. Yet although the Board concluded those passages “reasonably encompass” such a teaching, and “support[] the fact” that such a request is taught, Paper 43 at 36-37, those passages neither contain nor “reasonably encompass” any such teaching at all.

The Board’s decision in this proceeding perpetuates the perception that the Board does not consistently administer *inter partes* review proceedings in accordance with the law’s demands. The Director should review and reverse the

Board’s decision, and provide valuable policy guidance against such future conduct.

II. Background

United States Patent 9,313,178 (“the ’178 Patent”), titled “Method and System for Secure Over-The-Top Live Video Delivery,” is directed to, among other things, “streaming distribution” of content using “Web-based delivery of files over the public Internet, referred to as over-the-top (OTT) delivery,” including “HTTP Live Streaming.” Ex. 1001 at 1:18-23. The ’178 Patent explains that the transition of delivering content over public networks—as contrasted to prior methods that relied on private networks—requires advancements in the use of content encryption keys to avoid key compromise. *Id.* at 2:3-10. “A client device handles the secure distribution of content by a process including initiating a media playback request and receiving a playback request response, and parsing content information from the playback request response, the content information including content encryption keys, content encryption key identifiers, and content encryption key expiration times.” *Id.* at 2:15-21.

The Petition’s lead reference, U.S. Pat. App. 2002/0172368 (“Peterka”), titled “Initial Free Preview for Multimedia Multicast Content,” is directed to providing a multicasting network in which a user receives a free “preview” of “a program that

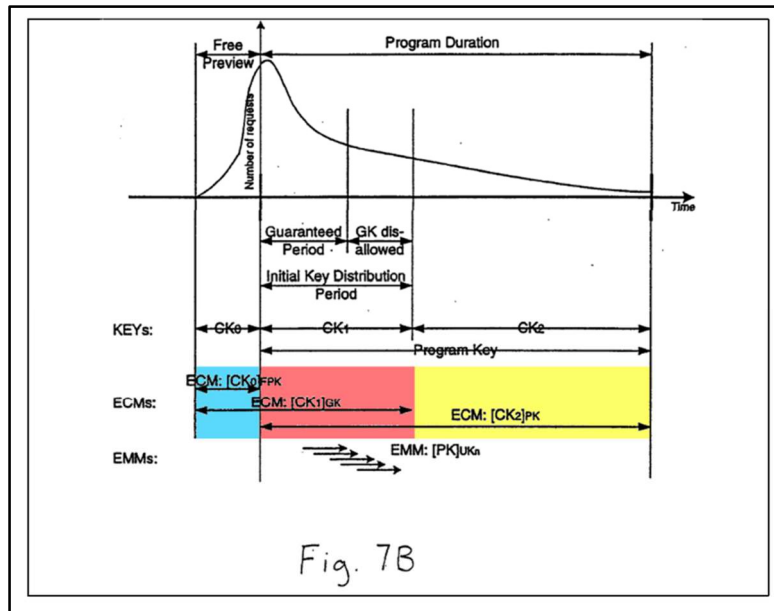
will later become encrypted and unavailable to the user.” Ex. 1005 ¶ 4. Peterka explains that prior systems were limited to multicast transmissions “to a set of clients that are *known* ahead of time to be interested in the program content.” Ex. 1005 ¶ 5 (emphasis added). By contrast, Peterka teaches providing “a free preview of the program content” to users that are **not known** to be interested in the content in order to “entice” such users “into purchasing the program[.]” *Id.* Peterka teaches that a “content key is provided” to clients, which “clients can [] utilize . . . to . . . obtain a free preview of the program content as shown in block 436.” Ex. 1005 ¶ 85. “During this process a user can be prompted via a display on the screen with an offer to purchase the program material 440. At that point in time, the user can indicate acceptance of the offer via a user interface and thereby purchase the program content. At that point in time a new key could be distributed to the user in decrypting the remaining encrypted portion of the program.” *Id.* Peterka’s Figure 6 likewise teaches that clients are *first* provided with a “free preview” at step 612 and *second* “request access to content” at step 614 by purchasing “the remainder of the content.” Ex. 1005 ¶ 90; Fig. 6.

III. The Board flipped the burden of proof to Patent Owner, relied on a theory never presented by Petitioner, and gave two opposite meanings to the same prior art teaching

Limitations 1A and 1B of the ’178 Patent recite “initiating a media playback

request” and “receiving . . . content encryption keys” in response. POR at 5 (emphasis added). It is undisputed that this claim language requires *one* “request” that yields *multiple* “content encryption keys” in response. POR at 6-7; Pet. 19-20, 24; Ex. 1003 ¶¶ 75-76. These limitations thus cannot be met where one request yields only one encryption key in response, or where multiple such requests are required to obtain multiple content encryption keys. And limitations 1A and 1B certainly cannot be met where an encryption key is sent without *any* client request at all.

To meet the above requirement, the Petition presented an annotated version of Peterka’s Figure 7B (reproduced below) and argued that content keys CK0 and CK1 in that figure are provided in response to a single client request made during a “free preview period,” colored in blue. Pet. 20-21. The Petition likewise argued that content keys CK1 and CK2 are also provided in response to a single client request made during an “initial key distribution period,” colored in red. Pet. 20-21.



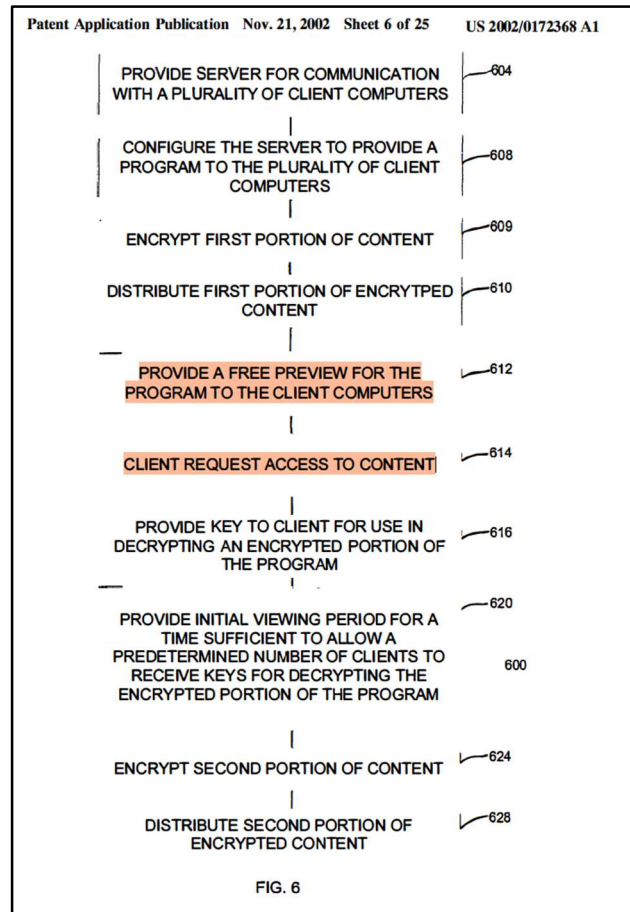
Patent Owner demonstrated, however, that neither Figure 7B nor any other aspect of Peterka teaches *any* client request for content key CK0 or CK1, much less a single request that yields *both* keys in response, as the claims require. POR at 15-22, 26-28; Ex. 2010 ¶¶ 42-53, 58, 61-62; Sur-Reply at 2-4, 6-7, 9-13.

Yet at the oral hearing, the Board challenged *Patent Owner* to explain how Peterka could provide the free preview content key, CK0, *without* a request. Tr. 44:16-20 (Judge Beamer stating: “how could they be sent without some sort of indication that the user wants to start looking at the free preview? I mean, there has to be some, you know, cause-and-effect relationship there.”); 45:13-14 (Judge Beamer stating: “I don’t see how the ECM message could be sent unless the client does something to say, I want to start looking at this free preview.”). The Board did

not identify any teaching in Peterka that CK0 *is* provided in response to a client request. Rather, the Board repeatedly *assumed* the existence of such a request, then asked Patent Owner if it could prove otherwise. *Id.* In other words, the Board placed the burden on Patent Owner to *refute an assumption* of unpatentability. Tr. 46:8-9 (Judge Beamer stating: “*I don’t know*. I can’t dive down into the innards of how it works, *but there has to be some sort of request.*”) (emphasis added).

Patent Owner explained that the Board’s approach was legal error, and that Peterka’s *silence* must weigh against Petitioner, which bears the burden of proving obviousness, not against Patent Owner. Tr. 69:1-11 (Patent Owner’s counsel explaining that “if Peterka doesn’t have anything to say about it, I don’t think it’s appropriate to read into Peterka or interpret into Peterka the very teachings that are missing for it to meet the claim limitations.”).

Patent Owner nonetheless provided evidence that Peterka provides clients with a free preview (and the associated content key CK0) *without* request. In particular, Patent Owner directed the Board to Peterka’s Figure 6, which teaches that the “free preview” (step 612) is provided to clients *before* clients “request access to content” (step 614). Tr. 45:15-19; Ex. 1005 Fig. 6 (annotated).



The Board attempted to dismiss that evidence on the basis that the client request at step 614 of Figure 6 is a request for paid content, ignoring Patent Owner's extensive showing that the *only* type of client content requests taught in Peterka are *requests for paid content*. Tr. 45:20-22; POR at 15-22, 26-28; Ex. 2010 ¶¶ 42-53, 58, 62; Sur-Reply at 2-4, 6-7, 9-13. In other words, the Board simply reiterated its assumption that Peterka's free preview must be provided in response to some untaught request, dismissing all contrary evidence and failing to identify any actual

teaching from Peterka in support. Indeed, the Board went so far as to use its own *personal* experience with *current* systems to argue for obviousness—a clear violation of the rule against hindsight bias. Tr. 45:24-25; *InTouch Techs., Inc. v. VGo Communs., Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (“This hindsight analysis is inappropriate because obviousness must be assessed at the time the invention was made.”) (internal citations and quotations omitted).

24	JUDGE BEAMER: When I sign on to -- when I turn on my TV, I
25	don't suddenly get a free preview. I have to ask for it.

Despite Patent Owner’s warnings that this approach was improper, the Board’s Final Written Decision relied on the same erroneous reasoning to find unpatentability. Paper 43 at 36-37. The Board began by observing that in Peterka, CK0 and CK1 are sent via ECM messages during the free preview period. Paper 43 at 36. The Board then immediately shifted the burden of proof to Patent Owner, stating: “Patent Owner has no basis for asserting that the ECMs that are sent during the free preview period are *not* sent in response to a request.” *Id.* (emphasis added). In so stating, the Board did *not* address or consider Peterka’s Figure 6 or Patent Owner’s extensive showing that Peterka only teaches client requests for *paid* content, not free preview content. Tr. 45:15-19; POR at 16-22, 26-28; Ex. 2010 ¶¶ 42-53, 58, 62; Sur-Reply at 2-4, 6-7, 9-13. The Board’s decision then further

compounded its error, reasoning that unless Peterka affirmatively proves that it provides a free preview *without* a client request, Peterka should be interpreted to *assume* that it provides the free preview based on a client request. Paper 43 at 36-37 (“Apparently Patent Owner assumes that a free preview simply occurs due to some unknown agency without any client request — we see no support in Peterka for that speculation.”). In other words, the Board reasoned that Peterka’s *silence* on the key disputed element is evidence in favor of unpatentability. Conversely, the Board’s decision did not identify any teaching in Peterka that the free preview or CK0 *is* provided in response to a client request. *See* Paper 43 at 36-37. Instead, the Board continued to *assume* the existence of that missing element into Peterka, concluding that other teachings in Peterka “*reasonably encompass* deciding or selecting to accept a free preview period,” Paper 43 at 36 (emphasis added), and “support[] *the fact*” that CK0 is sent in response to a “request,” *id.* at 37 (emphasis added)—a purported “fact” for which the Board could not identify *any actual evidence*.

The Board’s decision is clearly erroneous and requires reversal. In an IPR, “the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ and that burden never shifts to the patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (quoting 35 U.S.C. § 316(e)). The Board cannot find unpatentability on the

basis that the patentee failed to prove nonobviousness. *In re Magnum Oil Tools*, 829 F.3d 1364, 1377-81 (Fed. Cir. 2016) (reversing Board’s decision because it shifted burden of proof to patentee). Nor can the Board “substitute[] its own expertise for record evidence.” *Brand v. Miller*, 487 F.3d 862, 870 (Fed. Cir. 2007). Here, Patent Owner defeated the Petition by demonstrating that Peterka ***never teaches*** providing CK0 in response to any request. Tr. 45:15-19; POR at 16-23, 26-28; Ex. 2010 ¶¶ 42-53, 58, 62; Sur-Reply at 2-4, 6-7, 9-13. Patent Owner’s showing was based on extensive evidence as to what Peterka ***does*** teach regarding client requests for content—i.e., that Peterka only teaches client requests for ***paid*** content—and evidence as to what Peterka does ***not*** teach—i.e., that Peterka provides no teaching of a client request for ***unpaid*** content, including the free preview. *Id.* Patent Owner was not required to do more. *IBM v. Iancu*, 759 F. App’x. 1002, 1011 (Fed. Cir. 2019) (reversing Board’s reliance on the prior art’s “silence” as a basis for finding unpatentability); *In re Magnum*, 829 F.3d at 1376 (“Where, as here, it is clear that the Board did not require petitioner to support its claim of obviousness by a preponderance of the evidence, we must reverse.”); *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1342 (Fed. Cir. 2020) (“[A] patent owner carries no obligation to raise any objection to the petitioner’s challenges at all.”); *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1008 (Fed. Cir. 2018) (“[A]

patentee technically has no ‘burden’ to do anything to defend the validity of its patent other than hold the patent challenger to its own burden of persuasion. . . .”).

Nor did the Board’s citations provide substantial evidence that Peterka teaches a client request for the free preview and CK0. The Board’s findings based on Peterka’s paragraphs 59, 81, 93, 144, and 145 are erroneous because the Petition never relied on any of those paragraphs as teaching or suggesting that Peterka’s free preview or CK0 is provided in response to a client request. *See* Pet. 18-26 (discussing relevant limitations). The Board may not find unpatentability based on arguments and evidence never presented in the Petition. 35 U.S.C. § 312(a)(3); 37 C.F.R. 42.104(b)(4); *In re Magnum*, 829 F.3d at 1381 (“[T]he Board must base its decision on arguments that were advanced by a party. . . .”). Indeed, the Board’s attempt here to rely on its own hindsight-based general assumptions as to how the prior art must have worked—rather than specific prior art teachings set forth in the Petition itself—runs directly afoul of the Office’s memorandum instructing the Board to strictly enforce the particularity requirements of § 312(a)(3) and § 42.104(b)(4). *See* July 31, 2025 Memorandum at 2-3¹. Further, the above paragraphs in no way support the

¹https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf?utm_campaign=subscriptioncenter&utm_medium=email&utm_source=govdelivery)

Board’s finding. None of Peterka’s paragraphs 59, 81, 93, 144, or 145 teaches or suggests that a client **requests** a free preview or CK0. Indeed, paragraphs 81, 144, and 145 do not discuss or mention the free preview at all. Paragraph 144 is explicitly directed to **purchasing** content, and its teachings in no way “reasonably encompass deciding or selecting to accept a free preview.” Paragraph 59 only supports the conclusion that a free preview is provided **without** client request, stating that the free preview is “used to attract users to content,” and is provided “while [the client’s] credentials are being validated.” Paragraph 93 likewise teaches against the Board’s conclusion; that paragraph equates client “requests” with “**a decision to buy**,” which it contrasts with those clients that simply “view a free preview.” The Board’s finding based on Peterka’s paragraphs 59, 81, 93, 144, and 145 thus fails basic standards of substantial evidence review. *See Wireless Protocol Innovations, Inc. v. TCT Mobile, Inc.*, 771 F. App’x. 1012, 1016-18 (Fed. Cir. 2019) (reversing obviousness because the teachings the Board relied upon did not “support the Board’s finding”).

The Board’s additional reliance on Peterka’s paragraph 80 likewise fails to provide substantial evidence for its conclusion, and further requires reversal. Paper 43 at 37 (quoting Ex. 1005 ¶ 80). The Board’s decision concludes—without *any* explanation—that Peterka’s teaching that “each [client] is given keys to the current as well as the next segment” means that both CK0 and CK1 are “sent in response to

a single request.” But Peterka’s paragraph 80 says nothing about client requests at all, and certainly does not state the number of requests that are made to obtain the keys to the current and next segment. *See* Ex. 1005 ¶ 80; POR at 27-28; Ex. 2010 ¶¶ 57-60; Sur-Reply at 1-5, 13-15. Moreover, the Board itself acknowledged during the oral hearing that Peterka’s paragraph 80 can readily be understood to refer to “two separate requests that generate those two keys,” *i.e.*, only one key per request, which cannot meet the challenged claims. Tr. 13:10-11. And the Board’s final written decision in fact contradicts itself and states, in the very next sentence, that Peterka’s paragraph 80 means that only *one* key is provided in response to one request. Paper 43 at 37.

The Director recently intervened to review and reverse such contradictory reasoning as an abuse of discretion. *Interactive Communications Int’l, Inc., v. Blackhawk Network Inc.*, IPR2024-00465 (Oct. 9, 2025), Paper 40 at 3 (Director granting review and reversing final written decision based on internally inconsistent evidence). The Director should do so again here. *IBG LLC v. Trading Techs. Int’l, Inc.*, 757 F. App’x 1004, 1008 (Fed. Cir. 2019) (“[T]he Board's reasoning with regard to the ’132 and ’304 patents is internally inconsistent and therefore arbitrary and capricious.”); *Kan. City v. Dep’t of Hous. & Urban Dev*, 923 F.2d 188, 194 (D.C. Cir. 1991) (“Agency action based on a factual premise that is flatly contradicted by

the agency's own record does not constitute reasoned administrative decisionmaking, and cannot survive review under the arbitrary and capricious standard."); *ANR Storage Co. v. FERC*, 904 F.3d 1020, 1028 (D.C. Cir. 2018) ("Because FERC's decision is internally inconsistent, it is arbitrary and capricious.").

IV. Conclusion

For the reasons above, the Director should review and reverse the Board's finding of unpatentability.

Respectfully submitted,

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Date: April 22, 2026

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW** was served electronically via e-mail on April 22, 2026, on the following counsel of record for Petitioner:

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