UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SPORTRADAR AG,
Petitioner,

v.

SPORTSCASTR INC.
(d/b/a PANDA Interactive),
Patent Owner.

---

IPR2025-00313

U.S. Patent No. 10,425,697

---

**PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

## TABLE OF CONTENTS

I. INTRODUCTION ..... 1

II. *FINTIV* WEIGHS AGAINST INSTITUTION ..... 3

**A. Factor 1: The District Court Has Not Granted A Stay** ..... 4

**B. Factor 2: District Court Trial Is Expected After The Statutory Deadline** ..... 5

**C. Factor 3: The Parties Will Have Invested Significant Resources In The Parallel Proceedings** ..... 6

**D. Factor 4: The Issues Overlap** ..... 7

**E. Factor 5: Both Parties Are Parties In The Parallel Litigation** ..... 8

**F. Factor 6: The Petition Does Not Present Compelling Evidence Of Unpatentability** ..... 9

**G. Additional Factor 1: The Petition And The Genius IPR Relied Heavily On Petitioner's Expert Testimony** ..... 9

**H. Additional Factor 2: Compelling Economic Interests Favor Discretionary Denial Because Of Petitioner's Anti-Competitive Conduct** ..... 11

III. INSTITUTION SHOULD BE DENIED UNDER *GENERAL PLASTIC* ..... 13

**1. Petitioner previously filed a petition directed to the same claims of the same patent.** ..... 16

**2. When Petitioner filed the prior copycat petition, Petitioner knew of the prior art asserted in this additional Petition.** ..... 18

**3. When Petitioner filed this additional Petition, Petitioner had already received Patent Owner's preliminary response to related petitions.** ..... 20

**4. Petitioner waited more than seven months after learning of the asserted prior art before filing this additional Petition.** ..... 22

**5. Petitioner provides no explanation for the time elapsed between the filing of the Genius IPR and this Petition.** ..... 22

**6. The finite resources of the Board favor denial.** ..... 23

**7. The one-year final determination deadline does not support institution.** ..... 24

IV. CONCLUSION ..... 25

# TABLE OF AUTHORITIES

## Cases

**Page(s)**

*Apple Inc. v. Fintiv, Inc.*,
IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)..... 1, 2, 3, 4, 5, 6, 7, 8

*Cimcore Corp. v. Faro Techs., Inc.*,
2007 U.S. Dist. LEXIS 17936 (S.D. Cal. 2007).....19

*Club Champion LLC v. True Spec Golf LLC*,
IPR2019-01569, Paper 9 (P.T.A.B. Mar. 17, 2020).....17

*Commscope Techs. v. Dali Wireless, Inc.*,
IPR2022-01242, Paper 23 (P.T.A.B. Feb. 27, 2023) .....9

*Fujifilm Corp. v. Sony Corp.*,
IPR2018-00060, Paper 8 (P.T.A.B. Apr. 19, 2018) .....17

*General Plastic Indus. Co. v. Canon Kabushiki Kaisha*,
IPR2016-01357, Paper 19 (P.T.A.B., Sept. 6, 2017) .....13

*General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*,
IPR2016- 01357, Paper 19 (P.T.A.B. Sept. 6, 2017) ... 1, 3, 13, 14, 15, 16, 18, 22, 23, 24

*Green Energy Tech. Co. et. al. v. Hanwha Solutions Corp.*,
IPR2020-0047, Paper 18 (P.T.A.B. Apr. 27, 2020) .....20

*Luxshare Precision Industry v. Amphenol Corp.*,
IPR2022-00132, Paper 10 (P.T.A.B. May 3, 2022) .....5

*Masimo Corp. v. Apple Inc.*,
IPR2024-00071, Paper 7 (P.T.A.B. Apr. 25, 2024) ..... 14, 16

*Metall Zug Ag et al. v. Carl Zeiss Meditec AG*;
IPR2020-01074, Paper 8 (P.T.A.B. Jan. 5, 2021) .....17

*NHK Spring Co. v. Intri-Plex Techs., Inc.*,
IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) .....2, 3

*Portsmouth Network Corp. v. Cisco Systems, Inc.*,
No. 2:23-CV-00441, slip op. (E.D. Tex. Oct. 21, 2024) .....5

*SB IP Holdings, LLC v. Vivint, Inc.*,
No. 4:21-cv-00912, slip op. (E.D. Tex. Apr. 6, 2023) .....5

*Sotera Wireless, Inc. v. Masimo Corp.*,
IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020) .....8

*Valve Corp. v. Elec. Scripting Prods., Inc.*,
IPR2019-00062, Paper 11 (P.T.A.B. Apr. 2, 2019) .....23

*VidStream LLC v. Twitter, Inc.*,
981 F.3d 1060 (Fed. Cir. 2020) .....19

# EXHIBIT LIST

| Exhibit | Description |
|---|---|
| EX-2001 | *Reserved for POPR, due May 20, 2025* |
| EX-2002 | *Reserved for POPR, due May 20, 2025.* |
| EX-2003 | *Reserved for POPR, due May 20, 2025* |
| EX-2004 | Memo on Interim Processes for PTAB Workload Management |
| EX-2005 | *Reserved for POPR, due May 20, 2025* |
| EX-2006 | *Exhibit Not Used* |
| EX-2007 | *Exhibit Not Used* |
| EX-2008 | *Exhibit Not Used* |
| EX-2009 | *Exhibit Not Used* |
| EX-2010 | *Exhibit Not Used* |
| EX-2011 | https://sportscastr.com/about |
| EX-2012 | https://pandainteractive.com/patents |
| EX-2013 | https://sportscastr.com |
| EX-2014 | https://studiopanda.live/ |
| EX-2015 | Sportradar August 2019 Email |
| EX-2016 | Guidance on USPTO's recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation." https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf |
| EX-2017 | *Exhibit Not Used* |
| EX-2018 | *Reserved for POPR, due May 20, 2025* |
| EX-2019 | *Reserved for POPR, due May 20, 2025* |
| EX-2020 | *Reserved for POPR, due May 20, 2025* |
| EX-2021 | *Reserved for POPR, due May 20, 2025* |
| EX-2022 | *Reserved for POPR, due May 20, 2025* |
| EX-2023 | *Reserved for POPR, due May 20, 2025* |
| EX-2024 | *Reserved for POPR, due May 20, 2025* |
| EX-2025 | *Reserved for POPR, due May 20, 2025* |
| EX-2026 | *Reserved for POPR, due May 20, 2025* |
| EX-2027 | *Reserved for POPR, due May 20, 2025* |
| EX-2028 | *Reserved for POPR, due May 20, 2025* |
| EX-2029 | *Reserved for POPR, due May 20, 2025* |
| EX-2030 | *Reserved for POPR, due May 20, 2025* |

| Exhibit | Description |
|---|---|
| EX-2031 | *Reserved for POPR, due May 20, 2025* |
| EX-2032 | *Reserved for POPR, due May 20, 2025* |
| EX-2033 | *Reserved for POPR, due May 20, 2025* |
| EX-2034 | *Reserved for POPR, due May 20, 2025* |
| EX-2035 | Third Amended Complaint |
| EX-2036 | *SB IP Holdings, LLC v. Vivint, Inc.,* No. 4:21-cv-00912 (Stay Order) |
| EX-2037 | *Portsmouth Network Corp. v. Cisco Systems, Inc.*, No. 2:23-CV-00441 (Stay Order) |
| EX-2038 | Second Amended DCO, Dkt. 174 |
| EX-2039 | Sportradar Redacted Motion to Amend DCO, Dkt. 144 |
| EX-2040 | Order Granting and Dismissing Motion to Amend DCO in Part, Dkt. 154 |
| EX-2041 | E.D. Texas Patent Timing to Trial |
| EX-2042 | Sportradar Invalidity Contentions, December 9, 2024 |
| EX-2043 | Sportradar Initial Invalidity Contentions, May 6, 2024 |

# I. INTRODUCTION

Pursuant to Acting Director Coke Morgan Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management" (the "Stewart Memo," EX-2004) and in view of the abrogation of the 2022 Vidal Memo (EX-2035), Patent Owner SportsCastr Inc. (d/b/a PANDA Interactive) ("PANDA" or "Patent Owner") respectfully requests that the Director exercise its discretion and deny institution of Petitioner Sportradar AG's ("Sportradar" or "Petitioner") Petition for *Inter Partes Review* of U.S. Patent No. 10,425,697 (the "'697 Patent").[1]

Petitioner asks the Board to commence precisely the kind of wasteful, duplicative Patent Office litigation that the Board's *Fintiv* and *General Plastic* precedents were designed to prevent. Specifically: (1) this Petition is ***one of six IPRs***[2] filed against the '697 patent, four of which were filed by the Petitioner, all relying on identical arguments and prior art references; and (2) this Petition asks the Board to decide the validity of the same '697 patent claims that are already set to be adjudicated in parallel district court litigations scheduled for ***trial in January***

---

[1] Briefs similar to this one are being concurrently filed in IPR2025-00314, IPR2025-00315, and IPR2025-00316.

[2] IPR2024-01309 (Genius); IPR2024-01308 (Genius); IPR2025-00266 (Sportradar); IPR2025-00265 (Sportradar); IPR2025-00314 (Sportradar); IPR2025-00313 (Sportradar). The -268 IPR is a copycat of the -1305 IPR, while the -269 IPR is a copycat of the -1307 IPR. The -1305 and -1307 IPRs are collectively referred to herein as the "Genius IPRs".

***2026—<u>eight months before</u> the Board would reach a final written decision in this proceeding***.

By the time the Board reaches an institution decision in this proceeding, the parties and the district court will have already invested significant time and resources in cases that were filed on October 5, 2023—over ***22 months*** before the institution decision would be due on August 20, 2025. The parties have already completed claim construction disclosures and discovery. A hearing to construe the claims was held on May 9, 2025. And the parties will complete fact discovery and serve opening invalidity expert reports in August 2025.

Section 314(a) gives the Board discretion to deny institution given the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc*., IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (precedential, designated May 7, 2019) ("*NHK Spring*"). The Board set forth six factors for determining whether discretionary denial due to such parallel litigation is appropriate (the "*Fintiv* factors"). *Apple Inc. v. Fintiv, Inc*., IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020). In this case, all six *Fintiv* factors favor discretionary denial.

Likewise, under *General Plastic*, the Board may deny a petition based on the Director's discretionary authority of § 314(a). *See, e.g.*, *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016- 01357, Paper 19 at 17 (P.T.A.B.

Sept. 6, 2017) (precedential as to § II.B.4.i)). The *General Plastic* factors, like the *Fintiv* factors, furnish another independent basis to exercise discretionary denial.

Moreover, as outlined in the Stewart Memo, additional factors in this case, such as "[t]he extent of the petition's reliance on expert testimony" and "compelling economic [interests]" weigh in favor of discretionary denial. (EX-2004, 2.) First, the Board instituted the Genius IPRs, which advances identical arguments and prior art grounds to those raised in this Petition, because the Board chose to "give Dr. Rubin's [Patent Owner's expert] testimony less weight than Dr. Wicker's [Petitioner's expert] testimony at this preliminary stage." (IPR2024-01307, Paper 8 at 38.) Second, compelling economic interests favor discretionary denial because of Petitioner's anti-competitive conduct that deprives consumers of a free market. (EX-2036, ¶¶18-31.)

*Fintiv*, *General Plastic*, and the additional factors outlined in the Stewart Memo strongly favor a discretionary denial under § 314(a).

## II. *FINTIV* WEIGHS AGAINST INSTITUTION

The Board has discretion to deny institution due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring*, IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (precedential, designated May 7, 2019). The Board has set forth six factors for determining whether discretionary denial due to such parallel litigation is appropriate:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

*Apple Inc. v. Fintiv Inc*., IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020). Furthermore, the Stewart Memo identified additional factors, such as "the extent of the petition's reliance on expert testimony" and "compelling economic, public health, or national security interests," relevant to discretionary denial.

As set forth below, the *Fintiv* factors and the additional Stewart Memo factors weigh against institution.

### A. Factor 1: The District Court Has Not Granted A Stay

The first *Fintiv* factor asks "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential). Here, the undisputed answer to both questions is **no**.

To date, no stay in the district court has been granted or requested. Further, the district court does not have a track record of granting stays before institution.

*See, e.g.*, *SB IP Holdings, LLC v. Vivint, Inc.*, No. 4:21-cv-00912, slip op. at 2 (E.D. Tex. Apr. 6, 2023) ("When a motion to stay is filed before the PTAB institutes post-grant review, courts in this district typically refrain from ruling on the motion pending action by the PTAB.") (EX-2037); *Portsmouth Network Corp. v. Cisco Systems, Inc.*, No. 2:23-CV-00441, slip op. at 2 (E.D. Tex. Oct. 21, 2024) ("[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.") (EX-2038).

The Board has found Factor 1 to favor discretionary denial where "Petitioner present[ed] no evidence that it has requested a stay [] or that a stay is likely." *Luxshare Precision Industry v. Amphenol Corp.*, IPR2022-00132, Paper 10 at 9 (P.T.A.B. May 3, 2022). Factor 1 favors discretionary denial.

### B. Factor 2: District Court Trial Is Expected After The Statutory Deadline

Factor 2—the implications of the district court and IPR schedules—also weighs for denial. *Fintiv*, IPR2020-00019, Paper 15 at 11-12, 17 (P.T.A.B. May 13, 2020) (*informative*).

Trial on the '697 patent is scheduled at the district court for January 23, 2026—two months before the Board's final written decision is expected.[3]

---

[3] On March 7, 2025, Petitioner filed a motion to amend the previous docket control order. (EX-2040.) On March 28, 2025, the district court denied Petitioner's request

(EX-2039.) The median time-to-trial for patent cases in EDTX is 721 days (i.e., roughly 24 months). (EX-2042.) Therefore, the new trial date in January 2026 will likely stick, particularly since the median time-to-trial would have put the trial date in October 2025. Accordingly, Factor 2 favors discretionary denial.

### C. Factor 3: The Parties Will Have Invested Significant Resources In The Parallel Proceedings

Factor 3—the resources invested in parallel proceedings—favors denial if, at the time of the institution decision on or around August 20, 2025, the district court has issued substantive orders related to the patent, such as "claim construction orders." *Fintiv*, IPR2020-00019, Paper 11 at 9-10, n.17 (collecting cases).

Both the parties and the district court have invested significant resources in the two parallel proceedings for over 18 months since the filing of the complaints on October 5, 2023. The parties have already completed claim construction disclosures and discovery, and Patent Owner submitted its claim construction brief addressing 40 disputed terms on March 21, 2025. A claim construction hearing in both cases involving the '697 patent was held May 9, 2025—two months before the Board's institution decision deadline. (EX-2039.) Additionally, the parties will have completed fact discovery by August 22, 2025 and served opening invalidity expert

---

for a 7-month extension, granting only a 75-day extension to the previous trial date of November 7, 2025, and denying Petitioner's request to extend patent-related deadlines, including those for claim construction. (EX-2041.)

reports by August 29, 2025—around the same time the Board's institution decision is due. (EX-2039.)

Accordingly, while Petitioner proffers a *Sotera* stipulation, by the time of the Board's institution decision, the parties will have already expended resources to litigate validity of the challenged patent through opening expert reports.

In view of the overlapping schedules here and the redundant resources that will be wasted should IPR be instituted, this Factor favors discretionary denial. *Fintiv* at 6; *NXP USA, Inc. v. Impinj*, Inc., PGR2022-00005, Paper 20 at 7 (P.T.A.B. Aug. 25, 2022) (Board should consider "the duplicative efforts that will occur during the [] duration of [IPR]"); *Regeneron Pharmas. Inc. v. Novartis Pharma AG*, IPR2020-01317, Paper 15 at 17 (P.T.A.B. Jan. 15, 2021).

**D. Factor 4: The Issues Overlap**

Factor 4—the degree of overlap between the issues in the petition and those before the district court—also supports denial. "[C]oncerns of inefficiency and the possibility of conflicting decisions [are] particularly strong" where "the Board [is] presented with substantially identical prior art arguments." *Fintiv*, IPR2020-00019, Paper 11 at 12. There is complete overlap between the petitioned grounds and the parallel litigation.

| Petitioned Prior Art Reference (Petition, 5-6) | Petitioner's Invalidity Contentions (EX-2043, 14, 16.) |
|---|---|
| Ellis | Yes |

| | |
|---|---|
| Spivey | Yes |
| Herzog | Yes |
| Kellicker | Yes |
| Phillips | Yes |

Although Petitioner has submitted a *Sotera* stipulation, Petitioner's stipulation should carry no weight here because the parties will have already expended resources to litigate the same prior art through the completion of opening invalidity expert reports before the Board's institution decision. In view of these parallel tracks, instituting IPR will multiply the burden on Patent Owner and create the possibility of inconsistent decisions between the district court and the Board.

Furthermore, Chief Judge Boalick's March 24, 2025 guidance states a "*Sotera* stipulation… will not be dispositive by itself. Instead, the Board will consider such a stipulation as part of its holistic analysis under *Fintiv*." (EX-2035, 2-3). Because Petitioner's stipulation does not "mitigate[] any concerns of duplicative efforts between the district court and the Board," or "of potentially conflicting decisions," Factor 4 weighs heavily in favor of discretionary denial. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020).

### E. Factor 5: Both Parties Are Parties In The Parallel Litigation

Factor 5 weighs in favor of denial because Petitioner is a defendant in the parallel district court litigation and will have a full, fair opportunity to litigate its invalidity contentions. *See Vizio, Inc. v. Maxell, Ltd.*, IPR2022-01459, Paper 7 at 21-22 (P.T.A.B. Apr. 11, 2023).

### F. Factor 6: The Petition Does Not Present Compelling Evidence Of Unpatentability

Factor 6—the merits of the petition—also weighs against institution because, as will be detailed in Patent Owner's forth coming Preliminary Response, the Petition fails to show a "reasonable likelihood" that Petitioner would prevail on any challenged claim. The Petition certainly does not pass the higher threshold of a "compelling" unpatentability challenge, which requires a determination that Petitioner is "highly likely" to succeed on the merits. *Commscope Techs. v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 3-4 (P.T.A.B. Feb. 27, 2023). Furthermore, even if the unpatentability challenge were compelling, the March 24, 2025 Board guidance states that "compelling merits alone is not dispositive in making the assessment [for discretionary denial]." (EX-2035, 3).

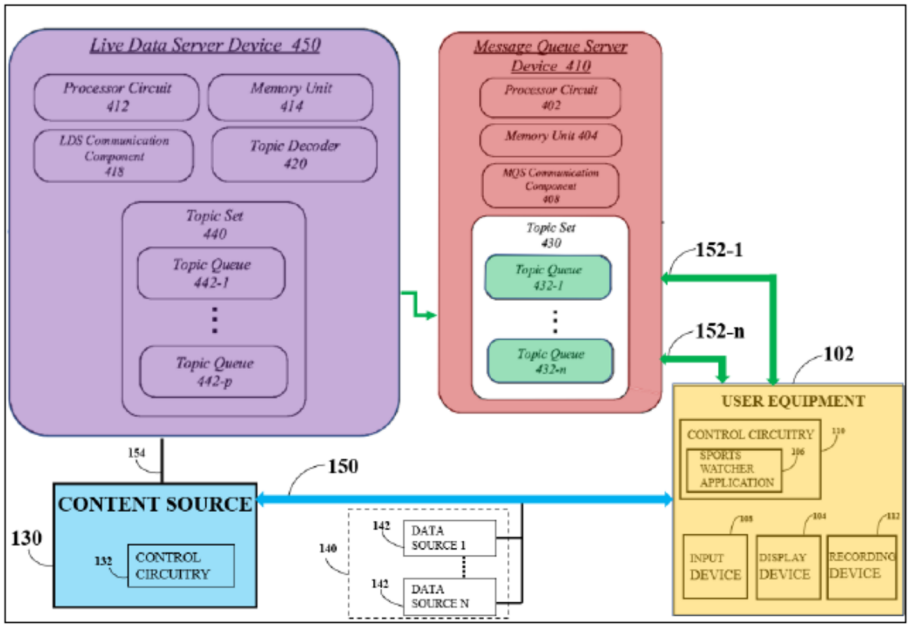
### G. Additional Factor 1: The Petition And The Genius IPR Relied Heavily On Petitioner's Expert Testimony

In accordance with the Stewart Memo, the Board should also consider "[t]he extent of the Petition's reliance on expert testimony" as a factor for discretionary denial. (EX-2004, 2.) In instituting the Genius IPR, the Board relied heavily on Petitioner's expert testimony, stating "[w]e, therefore, give [Patent Owner's expert]'s testimony less weight than [Petitioner expert]'s testimony at this preliminary stage." (IPR2024-01307, Paper 8 at 38.)

For example, the Board "agree[d] with Petitioner (Pet. 40 n.7) that Spivey

suggests the intermediary live data access server is optional" based solely on a footnote citing Petitioner's expert declaration. (IPR2024-01307, Paper 8 at 36.) The Board also concluded that "Spivey at least suggests a direct connection between the message queue server device and client devices" again based on a footnote stating, "these passages better support Petitioner's and Dr. Wicker's assertions at this stage." (IPR2024-01307, Paper 8 at 36.) Furthermore, the Board "also credit[ed] preliminarily Petitioner's reason to omit the live data access server" based on expert testimony, rather than relying on specific disclosures from the prior art itself. (IPR2024-01307, Paper 8 at 37.)

Another example of Petitioner's dependence on extrinsic testimony is its reliance on an entirely expert-created figure. This figure depicts an amalgamation of disparate prior art systems and fabricated components, purporting to represent a make-believe combined system that allegedly invalidates the claimed invention:




(Petition, 12.) The Board adopted this "illustration of [Petitioner's] conception of the combined system" in deciding the Genius IPR. (IPR2024-01307, Paper 8 at 18.) As illustrated in the figure, however, the "151-1" and "151-2" connections are entirely fictional creations by Petitioner's expert and do not originate from intrinsic evidence (Petition, 12.)

Therefore, Petitioner's heavy reliance on expert testimony weighs in favor of discretionary denial. (EX-2004, 2.)

### H. Additional Factor 2: Compelling Economic Interests Favor Discretionary Denial Because Of Petitioner's Anti-Competitive Conduct

The Stewart Memo states that "[c]ompelling economic [interests]" should be considered as a factor for discretionary denial. (EX-2004, 2.)

On February 25, 2025, Patent Owner filed an amended complaint, with

evidence that Petitioner not only copied Patent Owner's patented technology but also coerced Patent Owner's potential customers into using Petitioner's infringing products through anticompetitive tying arrangements. (EX-2036, ¶1.) Petitioner's coercion involved, among other things, conditioning access to essential data—controlled by Petitioner via exclusive contracts—on the use of its sports betting app technology, which includes its infringing products, in violation of antitrust laws. (EX-2036, ¶¶1, 18-31, 361-382.)

Patent Owner developed technology for delivering broadcasts enriched with synchronized, contextually matched, and actionable live data and content, using technology claimed in the '697 patent. The '697 patent is embodied in Patent Owner's "SocketVision technology," which is incorporated in Patent Owner's consumer-focused "patented streaming platform" SportsCastr, as well as in the B2B "sports betting platform" PANDA Studio. (EX-2011-2014.) Petitioner learned of Patent Owner's products under the guise of exploring partnerships, but in reality, Petitioner was developing its own products by copying Patent Owner's patented technology. (EX-2015.)

On Feb 24, 2018, 3:10 PM -0500, Ben Turner <ben.turner@geniussports.com>, wrote:

> Hey Kevin,
>
> Thanks for your time yesterday. It is great to see what you guys are doing with SportsCastr. Let's organise a follow up call for when I am back in Australia and I will have a think about some potential intro's that might be of interest.

(EX-2015 (annotated).)

On Mon, 7 May 2018 at 7:15 am, Ben Turner <ben.turner@geniussports.com> wrote:

> Hi Kevin, Andrew and Luke,
>
> I wanted to introduce you all to each other. As I travel around I find many great companies working in the sports digital/tech space and like to make introductions where synergies may exist. So...
>
> Kevin April (CEO) and Andrew Schupak (CFO) founded Sportscastr - https://sportscastr.com/ - they are based in NY and doing amazing work around sports broadcast with social commentators, graphics and real time chat.

(EX-2015 (annotated).)

## III. INSTITUTION SHOULD BE DENIED UNDER *GENERAL PLASTIC*

The Trial Practice Guide specifies that "one petition should be sufficient to challenge the claims of a patent in most situations." CTPG, 59. But this Petition is one of ***six*** petitions filed against the '697 patent relying on the same prior art and identical grounds—two of which are copycats of the Genius IPRs that were filed four months before the four Sportradar petitions.[4]

Petitioner's tactic presents the same "potential for abuse" with which the precedential *General Plastic* decision was concerned. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (P.T.A.B., Sept. 6,

[4] *See* footnote 1, *supra*. The Genius IPRs were filed on August 22, 2024.

2017) (precedential). Institution of this Petition would reward the exact "opportunity to strategically stage their prior art and arguments in multiple petitions" at issue in *General Plastic* by allowing Petitioner to use Patent Owner's submissions in related IPRs[5] challenging patents in the same family on identical prior art grounds (as well as future submissions from Patent Owner in the earlier cases) "as a roadmap." *Id*., 17-18. Institution of this serial Petition would thus be "unfair to patent owner[]" and "an inefficient use of the inter partes review process." *Id*.

The only difference between this Petition and the three other Sportradar petitions is that it challenges claims 10-18. (Paper 2 at 1-2.) However, these dependent claims depend from independent claim 1 that was challenged in the Petitioner's copycat petition—the -265 IPR—and the Genius IPR petition—the -1308 IPR—that was filed four months prior to this Petition. This Board has specifically denied institution under *General Plastic* even though the prior "IPR did not specifically challenge [the dependent claims, because] these claims depend from and incorporate all of the subject matter of independent claim 1 and dependent claim 4, which were challenged in the [prior] IPR." *Masimo Corp. v. Apple Inc.*, IPR2024-00071, Paper 7 at 16 (P.T.A.B. Apr. 25, 2024). The Board reasoned in *Masimo Corp.*

---

[5] Patent Owner filed Patent Owner Preliminary Responses in IPR2024-01309, Paper 8, and IPR2024-01308, Paper 8, for the related patent, U.S. Patent 10,425,697, on December 10, 2024 (four days before this Petition was filed).

*v. Apple Inc.* that "because the Petition is directed to some of the same claims (*i.e.*, [the independent claims]) and much of the same subject matter (*i.e.*, from independent claim 1) that were previously challenged in the [prior] IPR" discretionary denial under *General Plastics* is appropriate. *Id*. at 17.

The Board has identified seven factors relevant to determining whether to discretionarily deny "follow on" petitions under 35 U.S.C. § 314(a) (the "*General Plastic* factors"):

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

*General Plastic* at 16. Here, all seven *General Plastic* factors weigh against institution or are neutral.

**1. Petitioner previously filed a petition directed to the same claims of the same patent.**

Sportradar is "the same petitioner" that filed three other petitions directed to various claims of the '697 patent. All four petitions challenge the various claims of the '697 patent on nearly identical grounds. (*Compare* IPR2025-00268 Paper 2 at 7 *with* IPR2025-00315, Paper 3 at 5; *compare* IPR2025-00269, Paper 3 at 7 *with* IPR2025-00316, Paper 3 at 6.)

Petitioner's assertion that "each petition challenges different claims" (Paper 2 at 2) is inaccurate. As the Board has previously found, "the *General Plastic* framework is applicable to this situation" where "a second petition challeng[es] different claims of the same patent." *Bytedance LTD. et al. v. Triller, Inc*., IPR2021-00774, Paper 6 at 9 (P.T.A.B. Oct. 12, 2021). This is particularly true when the additional "Petition is directed to some of the same claims (*i.e.*, [the independent claims]) and much of the same subject matter (*i.e.*, from independent claim 1) that were previously challenged in the [prior] IPR." *Masimo Corp. v. Apple Inc.*, IPR2024-00071, Paper 7 at 16 (P.T.A.B. Apr. 25, 2024).

Claims 10-18, the only additional challenged claims in this Petition, depend from independent claim 1, which was challenged in the prior copycat petition. (*Compare* Petition at 4 *with* IPR2025-00265 Paper 3 at 6.) Furthermore, this Petition presents arguments based on the same prior art combinations of Ellis-Spivey and

Herzog-Spivey-Ellis with respect claims 23 and 24 as relied upon in the prior copycat petition. (*Compare* Petition at 5-6 *with* IPR2025-00265 Paper 3 at 7.)

This Petition and the copycat petition therefore address the exact same claimed subject matter with respect to both claims 23 and 24. As previously recognized by the Board, "although different claims are involved, many of the issues addressed in the [prior] IPR would be present in the instant proceeding, most particularly claim construction issues." *Fujifilm Corp. v. Sony Corp.*, IPR2018-00060, Paper 8 at 8-9 (P.T.A.B. Apr. 19, 2018). In addition, in *Masimo Corp. v. Apple Inc.*, the Board held that when "both [petitions] are directed to [the same claims] … the petitions in both proceedings are directed to most of the same subject matter." IPR2024-00071, Paper 7 at 16. Accordingly, if this Petition were instituted, there would be substantial overlap in the issues and arguments in the two proceedings even though, as addressed below with respect to Factors 6 and 7, the two proceedings would be conducted on significantly different schedules.

In assessing Factor 1, the Board has previously found that overlap of only a single claim challenged in two serial petitions "[weighs] in favor of invoking our discretion to deny institution of a second petition." *Club Champion LLC v. True Spec Golf LLC*, IPR2019-01569, Paper 9 at 9, 6 (P.T.A.B. Mar. 17, 2020); *see also Metall Zug Ag et al. v. Carl Zeiss Meditec AG*; IPR2020-01074, Paper 8 at 5-6 (P.T.A.B. Jan. 5, 2021) (applying discretionary denial to serial petitions with only a "relatively

minimal degree of overlap"). Here, Petitioner not only challenges the same claims (*i.e.*, claims 23 and 24) as the previous copycat petition but the additional challenged dependent claim (*i.e.*, claim 26) is dependent from those same claims 23 and 24. This overlap, along with Petitioner's reliance on the same Ellis-Spivey and Herzog-Spivey-Ellis combinations, presents the same scenario that *General Plastic* was concerned with. Further, the reasoning in *Club Champion* that even one overlapping claim causes Factor 1 to favor discretionary denial is instructive here due to the overlap in the issues presented in the two petitions regarding claims 23 and 24.

For at least these reasons, Factor 1 weighs against institution.

**2. When Petitioner filed the prior copycat petition, Petitioner knew of the prior art asserted in this additional Petition.**

In this follow-up Petition, Petitioner reasserts the same three references—Ellis, Spivey, and Herzog—that were relied upon in its prior copycat petition, with Ellis and Herzog as the only primary references in both petitions. The Petitioner was fully aware of the prior art cited in this follow-up Petition, as it had already asserted three of the same references in the prior copycat petition (IPR2025-00265, Paper 3) and in its Preliminary Invalidity Contentions filed on May 6, 2024 in the district court. (EX-2044.)

Under *General Plastic*, the relevant issue for Factor 2 "is whether the prior art references relied on in the follow-on petitions…could have been found with

reasonable diligence." *General Plastic* at 20. The *General Plastic* decision further noted when weighing Factor 2 against institution that the petitioner left the record "devoid of any explanation why Petitioner could not have found the newly asserted prior art in any earlier search(es) through the exercise of reasonable diligence." *Id.*

The record here is similarly devoid of any explanation by Petitioner of why it could not have found either Kellicker or Phillips with reasonably diligent searching. Indeed, both Kellicker and Phillips are patent application publications available through the USPTO's own searchable archive. *See* (EX-1049; EX-1050.) As the Southern District of California has observed, patent publications "do[] not merit consideration as 'new evidence'" because they are "public record[s], available on a searchable database maintained by the USPTO and accessible on the internet." *Cimcore Corp. v. Faro Techs., Inc.*, 2007 U.S. Dist. LEXIS 17936, *4-5 (S.D. Cal. 2007); *see also VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065-66 (Fed. Cir. 2020) ("When there is an established publisher there is a presumption of public accessibility as of the publication date."). Petitioner has provided no argument or evidence to rebut this presumption that Kellicker and Phillips were readily identifiable through reasonable searching.

When, as here, "[s]everal of the references asserted in the present Petition are also asserted in the [earlier filed] IPR," and the additional references were readily available through well-known resources such as the USPTO's searchable patent

archive or were "published in a well-known journal," Factor 2 weighs "in favor of invoking [the Board's] discretion to deny institution." *Green Energy Tech. Co. et. al. v. Hanwha Solutions Corp.*, IPR2020-0047, Paper 18 at 9-10 (P.T.A.B. Apr. 27, 2020).

Because Ellis, Spivey, and Herzog were known at the time of filing of the Preliminary Invalidity Contentions and Petitioner provides no justification for why the additional references could not have been identified at that time, Factor 2 weighs strongly against institution.

**3. When Petitioner filed this additional Petition, Petitioner had already received Patent Owner's preliminary response to related petitions.**

By the time Petitioner filed this additional Petition, Patent Owner had already filed its preliminary responses to related IPRs challenging patents in the same family on identical prior art grounds. On December 10, 2024, Patent Owner filed its preliminary responses in IPR2024-01308 and IPR2024-01309 for U.S. Patent 10,425,697, both of which Petitioner later filed copycats on in IPR2025-00265, Paper 3, and IPR2025-00266, Paper 3. The primary prior art grounds that the Petitioner used to challenge the '697 patent are identical to the those in this Petition.

| Ground | Basis | Claim(s) | References |
|---|---|---|---|
| 1 | §103 | 23, 24 | Ellis in view of Spivey |
| 2 | §103 | 26 | Ellis in view of Spivey, Kellicker and Phillips |
| 3 | §103 | 23, 24 | Herzog in view of Spivey and Ellis |
| 4 | §103 | 26 | Herzog in view of Spivey, Ellis, Kellicker and Phillips |

(Petition, 6.)

| Ground | Basis | Claims | References |
|---|---|---|---|
| 1 | §103 | 19-25, 27-30 | Ellis in view of Spivey |
| 2 | §103 | 19-25, 27-30 | Herzog in view of Spivey and Ellis |

(IPR2025-00266 Paper 3 at 7.)

| Ground | Basis | Claims | References |
|---|---|---|---|
| 1A | §103 | 1, 7-9 | Ellis in view of Spivey |
| 1B | §103 | 2-6 | Ellis in view of Spivey and Herzog |
| 2 | §103 | 1-9 | Herzog in view of Spivey and Ellis |

(IPR2025-00265 Paper 3, 7.)

In other words, by the time Petitioner filed this Petition it had access to Patent Owner's Preliminary Responses to the prior petitions against the '697 patent, which contained the same prior art arguments raised in this Petition. This is the precise fact pattern *General Plastic* cautions will waste the Board's resources: Petitioner used Patent Owner's Preliminary Response to develop a roadmap for future petitions. *See General Plastic*, IPR2016-01357, Paper 19 at 17.

Accordingly, this Factor weighs in favor of denying institution.

**4. Petitioner waited more than seven months after learning of the asserted prior art before filing this additional Petition.**

Petitioner served its district court Preliminary Invalidity Contentions citing Ellis, Herzog, and Spivey on May 6, 2024, (EX-2003). Yet, Petitioner waited more than seven months—until December 14, 2024—to file this additional Petition. Petitioner offers no explanation for this delay. This Factor therefore weighs in favor of denying institution.

**5. Petitioner provides no explanation for the time elapsed between the filing of the Genius IPR and this Petition.**

Factor 5 examines why Petitioner delayed "between the filings of multiple petitions directed to the same claims of the same patent." *General Plastic,* IPR2016-01357, Paper 19 at 9–10. The prior Genius petition (the -1307 IPR) that Petitioner filed a copycat on—which relied on the same primary references as this Petition—

was filed in August 2024. Petitioner then waited nearly five months to file this additional Petition, yet Petitioner failed to provide any explanation for the time elapsed between these two filings or for why it could not have filed the evidence added in the instant petition in its copycat. Accordingly, this Factor weighs in favor of denying institution.

**6. The finite resources of the Board favor denial.**

The Board has explained that "[i]n general, having multiple petitions challenging the same patent, especially when not filed at or around the same time … is inefficient and tends to waste resources." *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 15 (P.T.A.B. Apr. 2, 2019) (precedential). Petitioner had its chance to file a petition using the best evidence it had available to it in May 2024. The Board should not expend its finite resources on this follow-on Petition that was filed without justifiable reasons. As in *Valve*, Petitioner has filed serial and repetitive attacks against the same patent relying on the same prior art. "These serial and repetitive attacks implicate the efficiency concerns underpinning *General Plastic* and, thus, favor denying institution." *Valve*, IPR2019-00062, Paper 11 at 15.

Additionally, Factor 6 favors denial in view of the Stewart Memo, which states, "[t]o ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings,

the Director will exercise her discretion on institution of AIA proceedings under 35 U.S.C. §§ 314(a) and 324(a) … The processes described herein are temporary in nature due, in part, to the current workload needs of the PTAB." (EX-2004, 1, 3.)

Accordingly Factor 6 weighs in favor of denying institution.

**7. The one-year final determination deadline does not support institution.**

Like the sixth *General Plastic* Factor, the seventh Factor—"the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after the date on which the Director notices institution of review"—implicates efficiency. This Factor is at best neutral because it is an inefficient use of the Board's time to review multiple petitions based on the same claims and the same prior art and to draft decisions on the same issues multiple times within a year.

## IV. CONCLUSION

For the reasons set forth above, Patent Owner respectfully requests that the Director exercise discretion and deny institution under Section 314(a).

Dated: May 19, 2025

*/Brian Eutermoser/*

Brian Eutermoser
Reg. No. 64,058
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80206
Telephone: (720) 535-2312

*Counsel for Patent Owner SportsCastr Inc. (d/b/a PANDA Interactive)*

## CERTIFICATE OF SERVICE

I certify that I caused to be served a true and correct copy of the foregoing: **PATENT OWNER DISCRETIONARY DENIAL BRIEF** and **EXHIBITS** were served by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as via electronic mail on May 19, 2025, in its entirety on the following:

Scott W. Cummings
Alexander Walden
BRYAN CAVE LEIGHTON PAISNER LLP
1155 F St. N.W.
Washington, D.C. 20004
(202) 508-6000
Scott.cummings@bclplaw.com
Alexander.walden@bclplaw.com

Frank Fabiani
BRYAN CAVE LEIGHTON PAISNER LLP
1290 Avenue of the Americas
New York, NY 11004
(212) 541-2000
Frank.fabiani@bclplaw.com

*/Brian Eutermoser/*
Brian Eutermoser
Reg. No. 64,058
KING & SPALDING LLP

*Attorney for Patent Owner SportsCastr Inc. (d/b/a PANDA Interactive)*

Date: May 19, 2025
1401 Lawrence Street, Suite 1900
Denver, CO 80202
Telephone: (720) 535-2312