UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEBGROUP CZECH REPUBLIC, A.S.,
NKL ASSOCIATES, S.R.O.,

PETITIONER,

V.

DISH TECHNOLOGIES L.L.C.,
PATENT OWNER.

CASE NO. IPR2025-00469

U.S. PATENT NO. 11,470,138

PATENT OWNER'S PRELIMINARY RESPONSE ON MERITS ISSUES UNDER 35 U.S.C. § 313 AND 37 C.F.R. § 42.107

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PATENT OWNER'S EXHIBIT LIST

Ex. No.	Description of Documents
2001	U.S. Patent App. Pub. No. 2004/0030547 by Leaning et al. ("Leaning US App 2004")
2002	Redline Comparison of Leaning US 2008 and Leaning US App 2004
2003	International P.C.T. Publication WO 200249343 to Leaning et al. ("Leaning PCT 2002")
2004	337-TA-1265 ITC Investigation Commission Opinion ("Comm'n Op.")
2005	337-TA-1265 ITC Investigation Final Determination and Limited Exclusion Order (EDIS Doc No. 1961623)
2006	Email Refusal to Waive Service
2007	"Peloton Will Pay Dish $75M To Avoid Import Ban" – Dani Kass, Law360 (May 5, 2023)
2008	Request for Ex Parte Reexamination of U.S. Patent No. 10,469,555
2009	Declaration of Dr. Kevin Jeffay including Curriculum Vitae ("Jeffay")
2010	Second Sub-file of Akiyo Video
2011	Akiyo Video
2012	Amendment dated April 25, 2008 to U.S. Application No. 10/433,259

I. INTRODUCTION

The Board should deny institution because Petitioner WebGroup Czech Republic, A.S. and NKL Associates, S.R.O. ("Petitioner") failed to show a reasonable likelihood that any of Claims 1-12 and 14-30 of the '138 Patent (the "Challenged Claims") are unpatentable. As demonstrated in DISH's Discretionary Denial Brief (Paper 7), Petitioner strategically delayed filing this Petition until the last possible moment in order to observe and leverage the record in nearly thirty other post-grant challenges filed by third parties against this and other related adaptive-bitrate streaming ("ABR") patents owned by Patent Owner DISH. Indeed, Petitioner derived this Petition directly from those prior challenges, blatantly copying invalidity theories presented by prior petitioner (*i.e.*, "roadmapping"). But despite the unfair advantages obtained through its tactical delay, Petitioner failed to assemble a Petition that meets the Board's institution standard. Like a truant student cribbing answers off his neighbor's exam, Petitioner's mechanical reliance on the prior petitioner's work product resulted in a Petition with clear defects that warrant institution denial.

Each ground of the Petition asserts Leaning US 2008 (EX1004)[1] as the primary reference. One defect directly attributable to Petitioner's mechanical copying of the third parties' prior petitions is that Petitioner fails to allege that Leaning US 2008 is actually prior art to the '138 Patent. *See* DISH's Discretionary Brief, 20. Leaning US 2008 is a U.S. Patent that issued in 2008—***four years after*** the priority date listed on the face of the '138 Patent.[2] It therefore cannot be prior art to the '138 Patent under "pre-AIA 35 U.S.C. § 102(b)," as Petitioner alleges. Pet., 12. And Petitioner fails to allege or support any other basis under which Leaning US 2008 would qualify as prior art. Petitioner therefore fails to carry its burden to show that the primary reference asserted across all grounds is actually "prior art" to the '138 Patent. 35 U.S.C. § 311(b).

Even if Leaning US 2008 were to qualify as prior art (it does not), that reference fails to teach or render obvious multiple claim limitations. Unlike the Challenged Claims, which are directed to ABR "video" streaming, the portions of Leaning US 2008 relied on by Petitioner are directed almost exclusively to "audio"

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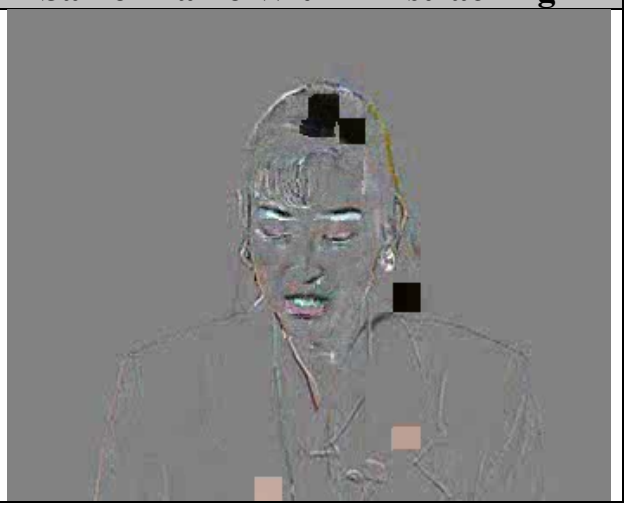
[1] DISH refers to Petitioner's primary reference as "Leaning US 2008" to maintain consistency with the naming convention used in its Discretionary Denial Brief.

[2] DISH reserves the right to establish that the challenged claims are entitled to an earlier priority date.

streaming. Petitioner resorts to "obviousness" to bridge this critical gap. But Petitioner's obviousness theory is fatally flawed.

Leaning US 2008 discloses .MP3 audio encoding and H.261 video encoding techniques. Pet., 22, 25-27. Petitioner alleges that a POSITA would understand that Leaning US 2008's .MP3 audio teachings toward rate-shifting "are equally applicable to streams that include video," and that a POSITA would be motivated to use "the H.261 video codec disclosed by Leaning" to meet elements of each Challenged Claim. *Id*. The problem for Petitioner is that Leaning US 2008 expressly states that such a modification "***is not possible***." EX1004, 13:9-11. Indeed, Leaning explains that use of "H.261," as relied on by Petitioner, results in "***serious mistracking***" after rate-shifting. EX1004, 13:9-33. The results of "mistracking" are indeed "serious," as demonstrated empirically below by DISH's expert, Dr. Jeffay. EX2009, ¶¶ 49, 51.

Properly Decoded Frame	Same Frame With "Mistracking"
	

Not only does Leaning US 2008 directly teach away, but Petitioner's proposed

modification would also result in a system that is simply inoperable for video streaming. Incredibly, Petitioner and its expert fail to acknowledge or address this critical flaw, despite the reference's express disclosure of it. Nor does Petitioner address this fatal defect with teachings from a secondary reference. Petitioner's exclusive reliance on an inoperable modification across all grounds is a bar to institution. *See Apple Inc. v. Haptic, Inc.*, IPR2024-01475, Paper 11 at 14–15 (P.T.A.B. Apr. 4, 2025) (denying institution of an IPR petition because "[the asserted prior art's] teachings undermine the very reason proffered by Petitioner") (citing *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326 (Fed. Cir. 2009) ("An inference of nonobviousness is especially strong where the prior art's teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements.")).

Petitioner also failed to meaningfully address the International Trade Commission's explicit findings that evidence of secondary considerations supported a finding of non-obviousness, despite relying solely on obviousness theories across all grounds. Petitioner dismisses the ITC's findings as "irrelevant" based solely on conclusory attorney argument. Pet., 60. This is insufficient as a matter of law. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016) (Holding one "cannot successfully rebut the presumption [of nexus] with argument alone—it must present evidence."). Moreover, Leaning US 2008 does not "disclose" a "smooth" streaming

experience, as Petitioner contends (Pet., 64), because Leaning US 2008 expressly discloses that "serious mistracking" would occur with Petitioner's proposed modification. Petitioner thus failed to address the ITC's findings in a legally meaningfully way. This too is a defect originating from Petitioner's copying of the prior petitions, which also largely neglected this critical holding.

Petitioner's other grounds fare no better. For example, the Petition does not explain how the proposed combination of Leaning US 2008 and Leighton in Ground 1 satisfies the proxy cache requirements of Claim 6, which requires a plurality of web servers to retrieve content from the same storage device(s). In a previous IPR on this patent, the Board determined that a nearly identically flawed analysis failed to meet this limitation. *See* IPR2024-00044, Paper 63 ("Ogdon FWD") at 59-60. Petitioner fails to set forth any alternate grounds for meeting Claim 6's "storage device" limitation and similar limitations in Claims 8-12, which the Board previously found patentable in the Ogdon FWD based on similar deficiencies. Thus, even if the Board determines that the Petition meets the standard for institution for some subset of the Challenged Claims, the Board's requirement to "evaluate all challenges" supports denial given the weaknesses in Petitioner's alternate grounds. *Samsung Electronics Co., Ltd., v KP Innovations 2, LLC*, IPR2025-00101, Paper 13 at 26-28 (P.T.A.B. May 12, 2025) (denying institution where only one ground was presumed to meet the institution standard) (citing Consolidated Trial Practice Guide).

Accordingly, for the reasons set forth herein and in DISH's Discretionary Denial Brief, DISH respectfully requests that the Board deny the Petition.

II. LEVEL OF ORDINARY SKILL

While DISH disputes Petitioner's definition of the level of a person of ordinary skill in the art ("POSITA"), resolution of such dispute is not necessary for the Board to determine whether to grant institution. DISH reserves the right to further address Petitioner's improper POSITA definition in subsequent filings, if necessary.

III. CLAIM CONSTRUCTION

The '138 Patent's Challenged Claims are to be construed "using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b)." 37 C.F.R. § 42.100(b) (Nov. 13, 2018). The Petition does not seek construction of any terms in the '138 Patent. For purposes of this filing, DISH does not propose that the Board construe any claims, but DISH reserves the right to do so in subsequent filings, if necessary.

IV. PETITIONER FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIM

A. Petitioner has not shown Leaning US 2008 is prior art

Petitioner bears the burden of "establishing that references relied upon qualify as prior art." *Grünenthal GMBH v. Antecip Bioventures II LLC*, PGR2017-00022, Paper 50 at 14 (P.T.A.B. Nov. 14, 2018) (citing *Dynamic Drinkware, LLC v. Nat'l*

Graphics, Inc., 800 F.3d 1375, 1378–81 (Fed. Cir. 2015)). But Petitioner has not properly alleged or shown any evidence that Leaning US 2008 qualifies as prior art to the '138 Patent.

Petitioner states that Leaning US 2008 is prior art under "pre-AIA 35 U.S.C. § 102(b)" because it "was filed Dec. 14, 2001 and published April 1, 2004." Pet., 12. This is factually incorrect. Leaning US 2008 (EX1004) was published when it issued as U.S. Patent No. 7,447,791 (the "'791 Patent") in 2008. The 2008 issuance of Leaning US 2008 does not constitute §102(b) prior art to the '138 Patent because §102(b) requires publication "more than one year prior to the date of the application for patent in the United States," and Leaning US 2008 issued ***four years after*** the priority date listed on the face of the '138 Patent. Leaning US 2008 therefore is not prior art under §102(b).

Even assuming that Petitioner had instead contended that Leaning US 2008 was prior art under pre-AIA 35 U.S.C. § 102(e) because it was filed Dec. 14, 2001 as PCT/GB01/05543 with June 2, 2003 as the filing date of the U.S. national stage application (U.S. Application No. 10/433,259 (the "'259 Application"), Petitioner would still have failed to meet its burden. The Federal Circuit in *Dynamic Drinkware* held that a petitioner in an IPR bears the burden of proving the effective priority date of a prior art patent under pre-AIA 35 U.S.C. § 102(e). *Dynamic Drinkware*, 800 F.3d at 1381-82 ("A provisional application's effectiveness as prior art depends on

its written description support for the claims of the issued patent of which it was a provisional."). There, the Federal Circuit found that the petitioner did not "demonstrate support in the [underlying] provisional application for the claims of the [reference] patent." *Id*. This same requirement exists here. For a U.S. Patent to qualify as prior art under § 102(e), it must be a "patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." Although Leaning US 2008 issued from a national stage entry of International Patent Application No. PCT/GB01/05543, which was filed on December 14, 2001, Petitioner has not met its burden to show that the "invention" set forth in the claims of Leaning US 2008 "finds a supporting disclosure in [International Patent Application No. PCT/GB01/05543] in compliance with § 112." *See In re Wertheim*, 646 F.2d 527, 537 (C.C.P.A. 1981).

Petitioner fails to meet its burden of demonstrating that at least the underlying application (the '259 Application) provides sufficient written description support for the claims of the issued patent (the '791 Patent).[3] For example, in an amendment filed on April 25, 2008, the applicant for Leaning US 2008 amended independent

[3] For the same reasons discussed herein, Petitioner has failed to show that International Patent Application No. PCT/GB01/05543 provides sufficient written description support for the claims of Leaning US 2008.

Claim 1 to recite:

> means for identifying a starting file for decoding by an iterative process of trial requests comprising generating a trial request for a first file, receiving a reply indicating whether the requested file exists, if the requested file exists generating a trial request for a later file, or if it does not exist, generating a trial request for an earlier file.

EX1004, 17:25-30; EX2012 at 2. However, the '259 Application fails to provide written description support for the above-noted amendment of Claim 1. Thus, Leaning US 2008 cannot be prior art under pre-AIA 35 U.S.C. § 102(e).

Petitioner has not alleged that Leaning US 2008 is prior art under any other basis. Nor has Petitioner sought to modify its Petition to assert a plausible basis for establishing Leaning US 2008 as prior art. Accordingly, the Petition should be rejected on its face for failing to meet this fundamental requirement of being based on prior art.

B. Petitioner's Proposed Modification of Leaning US 2008's Audio Embodiment Is Inoperable and Fails to Render the Challenged Claims Obvious

Petitioner relies on Leaning US 2008 combined with the knowledge of a POSITA as allegedly disclosing or suggesting the video streaming aspects of each Challenged Claim. But Petitioner's proposal to modify Leaning US 2008's audio embodiments to use H.261 video coding is inoperable, as confirmed by Leaning US 2008 itself, which says the technique would result in "mistracking." EX1004, 13:19-20, 13:30-33.

Every claim of the '138 Patent is directed to adaptive rate "video" streaming using video "streamlets" of varying quality. Yet, Petitioner relies on Leaning US 2008's audio embodiments when meeting the "video" limitations of the Challenged Claims, as well as a conclusory expert declaration that largely parrots the Petition.[4] *See* Pet., 18-31 (citing almost exclusively to Leaning US 2008's audio embodiment to meet elements of Claim 1), 31-59 (cross-citing Claim 1 analysis for video elements of other claims). To justify extending those audio embodiments to video, Petitioner merely states "Leaning applies the same methodology" disclosed for audio "to the delivery of video recordings." *See, e.g.,* Pet., 21 (citing EX1004, 12:48-60 ("The same principle may be applied to the delivery of video recordings")).[5] But a

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[4] The cited portions of Petitioner's expert testimony fail to provide additional analysis that might corroborate the Petitioner's conclusory assertions or explain how a POSITA would modify Leaning US 2008's audio embodiment to stream video using the H.261 video codec.

[5] Petitioner also cites to another portion of Leaning US 2008 discussing video, but that section is directed to "fast forward" and "fast rewind" functionality, which differs from rate shifting insofar as users would be more willing to accept serious visual errors and distortions when fast forwarding or rewinding, as compared to rate

POSITA would understand that Leaning's statement in that regard was, at best, aspirational, and that applying Leaning's teachings would not result in a commercially-acceptable solution. EX2009, ¶ 47. Indeed, in the very next paragraph, Leaning US 2008 explains that "further implications" arise for "delivery of video recordings." EX1004, 12:65-67. And those "further implications" are particularly problematic for the particular configuration on which Petitioner's obviousness theory is exclusively premised.

Specifically, Petitioner's obviousness theory for each Challenged Claim expressly and repeatedly relies on the "H.261" video codec to encode video for streaming and to decode it for playback. When addressing Claim 1, Petitioner alleges that a POSITA would be motivated to use "the H.261 video codec disclosed by Leaning [US 2008]" when "switching" from Leaning US 2008's audio embodiment to a video embodiment. Pet., 27. Indeed, Petitioner's reliance on H.261 could not be more clear:

> A POSITA would have been motivated to encode a video embodiment of Leaning (including the corresponding sets of sub-files) into each of a low quality, medium quality, and high quality level bitrate stream (low

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shifting during playout of a recorded or live streaming video. *See* Pet., 26 (citing EX1004, 13:42-14:64).

> at 30 kbps, medium at 300 kbps, and high at 1,920 kbps), ***using the H.261 video codec*** disclosed by Leaning, because it would enable client terminals with a wide variety of network bandwidth requirements to stream the video and would have allowed for those with user terminals with high bandwidth connections to stream at 1,920 kbps and enjoy higher resolution viewing and a better user experience. EX1003, ¶ 123. A POSITA would have had a reasonable expectation of success with such an embodiment of Leaning's disclosure because ***Leaning expressly teaches the use of the H.261 video codec***, which was known to support bitrates of up to 1,920 kbps at the presumed time of invention and because simply encoding one of the video streams at a particular bitrate, such as the 1,920 kbps of the ***H.261 video format***, ***would have been a simple and straightforward implementation of Leaning's teachings for a POSITA to make when switching from the audio to video embodiments of Leaning***.

Pet., 27. Petitioner cites this same analysis for meeting "video" elements of other claims as well.

Petitioner, however, apparently overlooks the fact that Leaning US 2008 expressly states that the modification Petitioner proposes "***is not possible***." EX1004, 13:9-11. Instead, Leaning explains that use of "H.261" results in "***serious mistracking***" after rate-shifting. EX1004, 13:9-33. Thus, not only would a POSITA have understood that Leaning US 2008 teaches away from the modification that

Petitioner proposes, it expressly states that Petitioner's proposed modification would result in a system that is inoperable for video streaming. EX2009, ¶ 49.

As Dr. Jeffay explains, the audio-based content-partitioning technique relied on by Petitioner in Leaning US 2008 involves two steps, which are expressly described in Leaning as being performed in an order that precludes the ability to achieve streaming when applied to ***video***. Specifically, the source content is encoded into multiple copies at several different bitrates and then each copy is "partitioned" into sub-files:

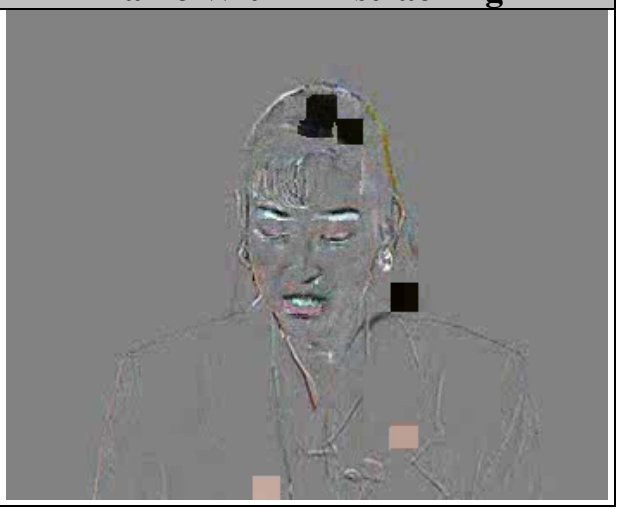
> In order to provide for rate switching, the person preparing the file for loading onto the server prepares several source files - by ***encoding*** the same PCM file several times at different rates. He ***then partitions*** each source file into sub-files ….

EX1004, 5:41-45; EX2009, ¶ 50. In other words, Leaning US 2008's disclosed approach to ***audio*** segmentation involves "encoding … then partition[ing]." And Petitioner relies exclusively on this approach to arrive at the claimed "files" or "streamlets." Pet., 22, 28, 29 (each citing figures and portions of Leaning US 2008 discussing partitioning or partitioned audio files). But Petitioner fails to address the fact that attempting to encode and partition H.261 ***video*** files in this manner would prevent the decoder from properly decoding and playing back streamlets/files once a rate switch occurred, yielding discontinuity and undesirable artifacts in playback, as confirmed by the explicit teachings of Leaning US 2008 itself. EX2009, ¶ 51.

Leaning US 2008 refers to this problem as "mistracking." EX1004, 13:19-20. "Mistracking" arises for video, but not audio, because each frame of Leaning's audio files is ***independently*** decodable without any dependencies between frames. EX2009, ¶ 52. Independently decodable frames are often referred to as "I-Frames." *Id.* In contrast, video files, including the H.261 files of Leaning US 2008, are compressed such that most frames are decodable only if the decoder has access to the preceding frame, from which the encoded frame depends (*i.e.*, ***dependently*** decodable). EX2009, ¶ 52; EX1004, 13:9-20. The dependently decodable frames of H.261 are referred to as "P-Frames." *Id.* In view of this dependency, Leaning US 2008 expressly states that "mistracking" will occur if the system were to attempt to perform rate switching between videos compressed with the H.261 "inter-frame" coding techniques because "of course the terminal does not have at its disposal" the preceding frames required to decode the P-Frames of the new stream. EX2009, ¶ 52; EX1004, 13:18-20.

The results of "mistracking" are dramatic, as demonstrated by the images below created by Dr. Jeffay. As Dr. Jeffay explains, the images below show the same frame of a video file that was compressed using H.261 and then divided into subfiles as disclosed by Leaning US 2008. The difference between frames is that the frame on the left was decoded when the decoder had access to the I-Frame at the beginning of the original video file, while the right frame was decoded when the decoder did

not have access to the I-Frame at the beginning of the original video file, simulating a "rate switch" operation in Leaning US 2008. EX2009, ¶ 53. The result is that the right image was decoded without the benefit of the preceding I-Frame needed to decode it, which results in a significant loss in image data. EX2009, ¶ 53.

Properly Decoded Frame	Frame With "Mistracking"
	

Leaning expressly states that this "mistracking" phenomenon occurs with H.261-encoded video because that standard "do[es] not provide for the frequent, regular inclusion of intra-frames [or I-Frames]." EX2009, ¶ 52; EX1004, 13:9-20. Thus, video encoded in H.261 necessarily results in Leaning US 2008's sub-files comprising P-Frames without the prerequisite I-Frames required for decoding.

Critically, Petitioner failed to address this "serious mistracking" problem for video as expressly disclosed by Leaning US 2008, failed to show any disclosure of video rate switching in Leaning US 2008 that would resolve "mistracking," and failed to explain how or why a POSITA would modify Leaning US 2008's teaching

to resolve "mistracking." Again, Petitioner's exclusive reliance on an inoperable modification across all grounds is a bar to institution. *See Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01100, Paper 11 at 14–15 (P.T.A.B. Apr. 4, 2025) (denying institution of an IPR petition because "the proposed combination, on this record, raises a concern over the operability of the proposed combination") (citing *In re Urbanski*, 809 F.3d 1237, 1243 (Fed. Cir. 2016) ("[I]f references taken in combination would produce a seemingly inoperative device, such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.") (internal quotations omitted); *Plas-Pak Industries, Inc. v. Sulzer Mixpac AG*, 600 F. App'x. 755, 758 (Fed. Cir. 2015) ("[C]ombinations that … render the prior art inoperable for its intended purpose, may fail to support a conclusion of obviousness.")).

The failure of Petitioner's Ground 1 obviousness theory cuts across all other grounds. Grounds 2 and 3 are presented to meet only dependent claims 9-12 and 18-20. Pet., 55, 57. Accordingly, Grounds 2 and 3 fail to cure the failure of Petitioner's Ground 1 obviousness theory.

Without any cognizable theory to overcome Leaning US 2008's disclosure of "mistracking" when streaming video subfiles, Petitioner has failed to meet its burden to show unpatentability.

C. Petitioner Largely Ignores the Strong Evidence of Secondary Considerations

The Board has repeatedly "cautioned petitioners … that petitions may be denied if they do not address known evidence of secondary considerations." *Stryker Corp. v. KFX Med., LLC,* IPR2019-00817, Paper 10 at 28-29 (P.T.A.B. Sep. 16, 2019)[6]. In *Stryker*, the Board denied institution, faulting Petitioner for failing to address evidence of secondary considerations which had been successfully relied upon to establish non-obviousness during a prior litigation. IPR2019-00817 (Paper 10) at 23, 27-29. The facts here are strikingly similar. Just like *Stryker*, Petitioner was aware of a prior litigation where objective indicia of non-obviousness were presented, yet Petitioner has failed to adequately address them. *Id.* at 28.

Specifically, Petitioner acknowledges its awareness of a prior International Trade Commission ("ITC") proceeding where evidence of objective indicia of non-obviousness was relied upon to find non-obviousness of the claims similar to those challenged here. *See, e.g.*, Pet., 59-61. The Final Initial Determination in the ITC Investigation (as adopted in relevant part by the ITC in its written opinion) made the following findings:

> [Technology expert] Dr. Jeffay demonstrated through corroborating evidence that [initial patent-owner] Move's success is

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[6] *Accord Robert Bosch Tool Corp. v. SD3 LLC*, IPR2016-01751 (P.T.A.B. Mar. 22, 2017) (Paper 15) (denying institution for failure to address objective indicia presented during an ITC proceeding).

> tied to the "unique characteristics of the claimed invention." As Dr. Jeffay testified, the Move system was described as early as 2008 as offering "a smooth end user experience as the Move Media Player up-shifts and down-shifts in response to network and client CPU availability." Moreover, the Move Media Player's encoding technique allowed streaming via HTTP, and the use of "[s]imple HTTP protocol transfer of media files from standard Web servers rather than deployment of expensive media servers' reduces cost and complexity." DISH further adduced evidence demonstrating that the Move Media Player was recognized as superior in streaming performance relative to its competitors, rebutting respondents' argument that "advancements in compression and encoding technologies," etc. account for the Move Media Player's success.
>
> In view of this record evidence, I [Chief ALJ] find DISH is entitled to a presumption that there is a nexus between the objective evidence of non-obvious DISH proffers and the claimed invention. I find respondents have not rebutted that presumption.
>
> … [analyzing evidence of objective indicia of nonobviousness]
>
> Having considered the claimed invention, the prior art, the objective indicia of non-obviousness, and the record as a whole, **I find that the objective indicia support a determination of non-obviousness. Thus, even if a hindsight combination of the prior art references identified by respondents would comprise every element of the claimed invention, I find that the objective evidence indicates a person of skill in the art at the time of the invention would not have found the invention to be obvious in view of those referenc**es.

EX1009 (Final ID) at 213-17 (internal citations omitted, emphasis added). Chief ITC ALJ Cheney found that DISH's objective indicia evidence had "demonstrated long-felt but unresolved need and failure of others," and that DISH had "adduced evidence demonstrating surprising results," "commercial success," and "praise by others." *Id.*; *see also* EX2004 (Comm'n Op.) at 2 (adopting same).

Critically, in addition to finding that DISH's predecessor's commercial product, the Move Media Player, actually "embodies the claimed invention" such

that "DISH is entitled to a presumption that there is a nexus between the objective evidence … and the claimed invention," the ITC also found a "nexus in fact" tying the objective evidence of non-obviousness to the "unique characteristics of the claimed invention." EX1009, 213.

Petitioner attempts to dismiss Chief ALJ Cheney's well-supported findings as "irrelevant" because the "purportedly unique and successful aspects of the Move system were already in existence in the prior art and thus cannot form the basis of any nexus to the claimed invention." Pet., 60-61. But Petitioner's threadbare assertions — that "Leaning [US 2008] discloses" the "supposedly unique features of the claimed invention, namely offering a smooth end user experience as the Move Media Player up-shifts and down-shifts in response to network and client CPU availability" — lack any supporting explanation or analysis supporting that contention. Pet., 60. This is insufficient as a matter of law. One "cannot successfully rebut the presumption with argument alone—it must present evidence." *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016) (citing *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)). Because Petitioner has failed to offer any evidence in support of its argument, it fails to rebut the ITC finding of nexus.

Moreover, Petitioner's contention that "Leaning discloses" a "smooth" experience when upshifting and downshifting (Pet., 60) is false and is contradicted

by Leaning US 2008's very teachings. As demonstrated above (*supra* § IV.B), Leaning US 2008 expressly discloses that "serious mistracking" would occur when modifying its audio embodiment to stream video based on Petitioner's proposed modification. As Dr. Jeffay explains, there is nothing "smooth" about mistracked video. EX2009, ¶ 51. Leaning does not "disclose" the features Petitioner attributes to it.

Finally, even if Leaning were to disclose certain "unique features," the fact that "an isolated feature may be present in the prior art may not render irrelevant objective evidence of non-obviousness of that feature in the claimed combination." *WBIP*, 829 F.3d at 1330–31. Where, as here, it is the claimed combination as a whole that serves as a nexus for the objective evidence, proof of nexus is not limited to when objective evidence is tied to the supposedly "new" features. *Id.* Petitioner's conclusory argument fails to recognize that it is the combination of claim features that provides the nexus here.

Because Petitioner has failed to address adequately the objective indicia of non-obviousness, the Board should deny this Petition. *See Stryker* at 27-29 (denying petition "further view of the secondary considerations evidence").

D. The Weak Merits of Petitioner's Additional Grounds Confirm That Denial is Appropriate

The Trial Practice Guide states that "[i]f a panel determines that a petition meets the standards for institution in relation to fewer than all the challenges

presented, … the panel will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied. See 37 C.F.R. §§ 316(b), 326(b); Consolidated Trial Practice Guide, 64 (November 2019) ("CTPG"). Thus, even if the Board determines that the Petition meets the standard for institution for some subset of the Challenged Claims, the requirement to "evaluate all challenges" favors denial here given the weaknesses in Petitioner's alternate grounds. *Samsung Electronics Co., Ltd., v KP Innovations 2, LLC*, IPR2025-00101, Paper 13 at 26-28 (P.T.A.B. May 12, 2025) (denying institution where one ground was presumed to meet the institution standard) (citing CTPG).

Ground 1 of the Petition—the only ground in the Petition that challenges Claim 6—relies on Leighton (EX1007) as allegedly disclosing the "plurality of webservers" recited in element 6[A]. But Petitioner completely overlooks the proxy cache requirement of element 6[C], and therefore fails to meet its burden with respect to that claim, as well as other related claims of the '138 Patent. Pet., 39-40.

Claim 1 of the '138 Patent recites "[a] system for adaptive-rate content streaming of a video … comprising: at least one storage device storing the video." Claim 6 depends from Claim 1 and recites "a plurality of web servers located at different locations across the internet" that are each configured to "retrieve" streamlets from "the storage device" recited in Claim 1 in response to client requests.

In other words, Claim 6 requires different webservers that, in response to client requests, each ***retrieve the same content*** from ***the same*** central storage device. The '138 Patent refers to the configuration recited in Claim 6 as a "proxy cache." EX1001, 7:1-3. The '138 Patent explains that a plurality of "proxy cache servers" replicate content from a central content server by "asking for content ***on behalf of*** the client module." *Id.,* 7:3-6. Accordingly, the '138 Patent discloses a process where content is cached at a plurality of remote proxy cache servers after first retrieving that content from a central storage device responsive to client requests. EX1001, 7:1-6.

Petitioner simply asserts that "Leaning [US 2008] discloses" element 6[C], while cross-citing back to its analysis of for element 6[B]. Pet., 39. But Leaning US 2008 merely discloses a single server, where "data files are stored on the server" (EX1004, 2:50-51) and accessed directly by clients (EX1004, 4;58). Leaning US 2008's single server that directly serves content from itself does not disclose a plurality of servers retrieving content from the same storage device(s) as required by Claim 6. Petitioner failed to meet its burden on Claim 6.

The Board already determined in the Ogdon FWD that a nearly identically flawed analysis failed to meet this limitation. Ogdon FWD at 59-60. There, the Board determined that an argument in which "webservers [were] retrieving the streamlet from itself" was not "coherent" and failed to render Claim 6 obvious. *Id.*,

60. The Board's analysis is directly applicable to Petitioner's Claim 6 theory, where Petitioner relies on the server of Leaning US 2008 serving content from itself.

Critically, the Board cited the very same deficiencies with respect to the prior art asserted in the previous IPR in affirming the validity of Claims 8-12. Ogdon FWD, 62-63. Because Petitioner fails to address the deficiencies in its Claim 6 analysis with respect to Claims 8-12, Petitioner also failed to meet its burden with respect to those claims as well. Thus, by simply applying the Board's prior reasoning to the analogously deficient grounds here, the Petition fails to meet its burden with respect to no fewer than 6 claims.

Evaluation of "all challenges" therefore reveals serious defects that support denial. The "entire petition" should be denied in the interest of "efficient administration of the Office and integrity of the patent system." CTPG, 64; *Samsung*, 26-28.

V. CONCLUSION

For the foregoing reasons, DISH respectfully requests that the Board deny Petitioner's request for IPR of U.S. Patent No. 11,470,138.

Respectfully Submitted,

June 17, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), we certify that an electronic copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107(a) along with any accompanying exhibits was served on Petitioner's counsel of record at the following address:

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count under §42.24(b)(1) for the foregoing Patent Owner Preliminary Response to the Petition for *Inter Partes* Review totals 5,192 words, within the 14,000 word limit allowed under § 42.24(a)(1)(i).

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