

IPR2025-00775  
U.S. Patent No. 10,771,849 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Google LLC,  
Petitioner

v.

Withrow Networks Inc.  
Patent Owner

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IPR2025-00775

U.S. Patent No. 10,771,849 B2  
Issue Date: September 8, 2020

Title: MULTIMEDIA SYSTEM FOR MOBILE CLIENT PLATFORMS

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

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<b>Exhibit No.</b>	<b>Description of Document</b>
<b>1001</b>	U.S. Patent No. 10,771,849 B2 to Mark Sinclair Krebs (filed Nov. 5, 2018, issued Sept. 8, 2020) (“’849 patent”)
<b>1002</b>	Declaration of Dr. Nathaniel Polish (“Polish”)
<b>1003</b>	U.S. Patent No. 6,389,473 to Sharon Carmel et al. (filed Mar. 24, 1999, issued May 14, 2002) (“Carmel”)
<b>1004</b>	Marco Mattavelli, Sylvain Brunetton, <i>Computational Graceful Degradation for Video Decoding</i> , Signal Processing IX Theories and Applications, Proceedings of Eusipco-98 Ninth European Signal Processing Conference (1998) (“Mattavelli”)
<b>1005</b>	Excerpts from John Watkinson, <i>The MPEG Handbook</i> , MPEG-1, MPEG-2, MPEG-4 (2001) (“Watkinson”)
<b>1006</b>	Excerpts from David Gourley et al., <i>HTTP: The Definitive Guide</i> (2002) (“Gourley et al.”)
<b>1007</b>	Shih-Hao Wang et al., <i>A Platform-Based MPEG-4 Advanced Video Coding (AVC) Decoder with Block Level Pipelining</i> , Proc. of the 2003 Joint Conference of the Fourth International Conference on Information, Communications & Signal Processing and Fourth Pacific-Rim Conference on Multimedia Vol. 1, (ICICS-PCM 2003) (“Wang”)
<b>1008</b>	Prosecution History for U.S. Patent No. 10,771,849
<b>1009</b>	U.S. Patent No. 5,841,432 to Sharon Carmel et al. (filed Feb. 9, 1996, issued Nov. 24, 1998) (“Carmel ’432”)
<b>1010</b>	U.S. Patent No. 6,397,230 to Sharon Carmel et al. (filed Aug. 27, 1997, issued May 28, 2002) (“Carmel ’230”)
<b>1011</b>	Microsoft Computer Dictionary (5th Ed. 2002) (excerpted)

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<b>1013</b>	U.S. Patent Application Publication No. US 2002/0131768 to Robert S. Gammenthaler (filed Mar. 19, 2001, published Sept. 19, 2002) (“Gammenthaler”)
<b>1014</b>	A Guide to MPEG Fundamentals and Protocol Analysis (Including DVB and ATSC), Tektronix (2000)
<b>1015</b>	Archived Webpage (Internet Archive Wayback Machine) of A Guide to MPEG Fundamentals and Protocol Analysis (Including DVB and ATSC), Tektronix (June 16, 2002)
<b>1016</b>	U.S. Patent No. 7,096,481 to John Forecast et al. (filed Mar. 31, 2000, issued Aug. 22, 2006) (“Forecast”)
<b>1017</b>	U.S. Patent No. 6,631,163 to Shaomin Peng (filed Nov. 14, 2000, issued Oct. 7, 2003) (“Peng”)
<b>1018</b>	Stephan Mietens et al., <i>New Complexity Scalable MPEG Encoding Techniques for Mobile Applications</i> , EURASIP Journal on Applied Signal Processing 2004(2):236-252 (2004) (“Mietens”)
<b>1019</b>	Joseph Y. Hui et al., <i>Client-Server Synchronization and Buffering for Variable Rate Multimedia Retrievals</i> , 14 IEEE Journal on Selected Areas in Communications 226 (Jan. 1996) (“Hui et al.”)
<b>1020</b>	Excerpts from Peter Symes, <i>Digital Video Compression</i> (2004) (“Symes”)
<b>1021</b>	Excerpts from Fernando Pereira, Touradj Ebrahimi, <i>The MPEG-4 book</i> (2002) (“Pereira et al.”)

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<b>1027</b>	Thomas Stockhammer et al., <i>H.264/AVC in Wireless Environments</i> , 13 IEEE Transactions on Circuits and Systems for Video Technology 657 (July 2003) (“Stockhammer”)
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<b>1029</b>	Arnaud Bourge and Joel Jung, <i>Low-power H.264 video decoder with graceful degradation</i> , Visual Communications and Image Processing 2004, 5308 Proceedings of SPIE-IS&T Electronic Imaging 372 (2004) (“Bourge”)
<b>1030</b>	U.S. Patent No. 5,867,230 to Feng Chi Wang et al. (filed June 30, 1997, issued Feb. 2, 1999) (“Wang et al.”)
<b>1031</b>	U.S. Patent No. 6,637,031 to Philip A. Chou (filed Dec. 4, 1998, issued Oct. 21, 2003) (“Chou”)

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<b>1033</b>	Jian Lu, <i>Signal Processing for Internet Video Streaming: A Review</i> , Proc. SPIE Image and Video Communications and Processing (Jan. 2000) (“Lu”)
<b>1034</b>	H. Schulzrinne et al., Real Time Streaming Protocol (RTSP), Internet Engineering Task Force, Internet Society (April 1998)
<b>1035</b>	U.S. Patent No. 7,529,806 to Yevgeniy Eugene Shteyn (filed Nov. 4, 1999, issued May 5, 2009) (“Shteyn”)
<b>1036</b>	U.S. Patent No. 5,721,878 to Hal Hjalmar Ottesen et al. (filed June 7, 1995, issued Feb. 24, 1998) (“Ottesen et al.”)
<b>1037</b>	<i>DV Format, Digital Video</i> , Canon U.S.A., Inc. (Oct. 13, 1999) <a href="https://web.archive.org/web/19991013131445/http://canondv.com:80/shared/dvinfo/dvinfo2.html">https://web.archive.org/web/19991013131445/http://canondv.com:80/shared/dvinfo/dvinfo2.html</a>
<b>1038</b>	Alan T. Wetzel, Michael R. Schell, <i>Consumer Applications of the IEEE 1394 Serial Bus, and a 1394/DV Video Editing System</i> , IEEE (1996) (“Wetzel et al.”)
<b>1039</b>	Won-Kyu Paik and Sun-Young Hwang, <i>Design of a novel synthesis filter for real-time MPEG-2 audio decoder implementation on a DSP chip</i> , 45 IEEE Transactions on Consumer Electronics 1119 (1999) (“Paik”)
<b>1040</b>	Keun-Sup Lee et al., <i>Software Optimization of the MPEG-Audio Decoder Using a 32-Bit MCU RISC Processor</i> , 48 IEEE Transactions on Consumer Electronics 671 (Aug. 2002) (“Lee”)

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<b>1042</b>	Patrick De Smet et al., <i>Do Not Zero-Pute: An Efficient Homespun MPEG-Audio Layer II Decoding and Optimization Strategy</i> , Proc. of ACM Multimedia 2004 conference, pp. 376-379 (2004) (“De Smet”)
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<b>1044</b>	MPEG-4 Overview – (V.21 – Jeju Version), International Organisation for Standardisation Organisation International De Normalisation ISO/IEC JTC1/SC29/WG11 Coding of Moving Pictures and Audio (Mar. 2002)
<b>1045</b>	U.S. Patent No. 5,754,241 to Shigeyuki Okada et al. (filed Nov. 14, 1995, issued May 19, 1998) (“Okada”)
<b>1046</b>	U.S. Patent No. 7,006,755 to Takeo Morinaga (filed Feb. 8, 2001, issued Feb. 28, 2006) (“Morinaga”)
<b>1047</b>	Vladimir Z. Mesarovic et al., <i>Optimized Huffman Decoding for AAC</i> , Silicon for Audio – AES 16th UK Conference, pp. 117-122 (2001) (“Mesarovic”)
<b>1048</b>	U.S. Patent No. 6,963,972 to Yuan-Chi Chang et al. (filed Sept. 26, 2000, issued Nov. 8, 2005) (“Chang”)
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<b>1051</b>	U.S. Patent No. 7,398,312 to Katherine H. Guo et al. (filed Mar. 29, 2000, issued July 8, 2008) (“Guo”)
<b>1052</b>	U.S. Patent No. 8,868,772 to R. Drew Major and Mark B. Hurst (filed Apr. 28, 2005, issued Oct. 21, 2014) (“Major”)
<b>1053</b>	U.S. Patent Provisional Application No. 60/566,831 to Robert D. Major and Mark B. Hurst (filed Apr. 30, 2004)
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<b>1055</b>	Complaint filed in <i>Withrow Networks, Inc. v. Google, LLC</i> , No. 5:24-CV-3203 (N.D. Cal. May 28, 2024), ECF No. 1
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<b>1059</b>	U.S. Patent No. 7,502,514 to Yaakov Gringeler et al. (filed Jan. 4, 2005, issued Mar. 10, 2009) (“Gringeler”)
<b>1060</b>	U.S. Patent No. 6,766,373 to Bruce A. Beadle et al. (filed May 31, 2000, issued July 20, 2004) (“Beadle”)
<b>1061</b>	U.S. Patent No. 7,099,389 to Guoyao Yu et al. (filed Dec. 10, 2002, issued Aug. 29, 2006) (“Yu”)

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<b>1063</b>	Expert Declaration of Dr. Ingrid Hsieh-Yee
<b>1064</b>	<i>Curriculum Vitae</i> of Dr. Nathaniel Polish
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<b>1067</b> [New]	DocketNavigator Statistics for Motion Success for Stay Pending IPR (Post-Institution) for Northern District of California (June 12, 2025)
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<b>1072</b> [New]	Notice of Abandonment for Application No. 11/106,952 (Jan. 26, 2017)
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<b>1074</b> [New]	Plaintiff Withrow Networks, Inc.'s Opposition to Defendants' Motion to Strike Plaintiff's Infringement Contentions filed in <i>Withrow Networks, Inc. v. Google, LLC</i> , No. 5:24-CV-3203 (N.D. Cal. May 27, 2025), ECF No. 85
<b>1075</b> [New]	Time Between Trial Setting Conference Date and Scheduled Trial Start Date in Identified Civil Cases before Judge P. Casey Pitts
<b>1076</b> [New]	Notice of Sotera Stipulation of Defendants Google LLC and YouTube, LLC filed in <i>Withrow Networks, Inc. v. Google, LLC</i> , No. 5:24-CV-3203 (N.D. Cal. Jul. 16, 2025), ECF No. 93

## I. INTRODUCTION

The Director should deny Patent Owner's ("PO's") Request for Discretionary Denial ("DD Req.") under 35 U.S.C. §§ 314(a) and 325(d).

Discretionary denial under § 314(a) is not appropriate in this case for several reasons. First, the co-pending litigation in the Northern District of California is still in its early stages. No trial date has been set, and median time-to-trial statistics and other evidence shows that any possible future trial would likely occur well after the October 2026 statutory deadline for a final written decision in this IPR. Second, if IPR is instituted, the evidence also shows that the district court is likely to grant a stay in parallel litigation, alleviating concerns about inefficiency and duplication of efforts between the district court and the Board. Third, to further avoid any potential overlap between the district court and PTAB proceedings, Petitioner Google LLC ("Google") has provided a *Sotera* stipulation. Finally, other considerations, including the strength of the Petition, the absence of "settled expectations," and the aim of correcting a material error made by the Office in improvidently issuing the challenged claims, also support institution and weigh against discretionary denial under § 314(a). Indeed, the Director has recently denied requests for discretionary denial in cases having very similar facts and circumstances.

Discretionary denial under § 325(d) is likewise not appropriate in this case because neither prong of the *Advanced Bionics* framework is satisfied. First, neither

the combinations of prior art in the asserted grounds nor the arguments raised in the Petition were previously presented to the Office. And second, as explained in more detail below, the Examiner materially erred by overlooking (or misapprehending) the teachings of the Carmel reference (which had been included in an IDS with 45 other references but was not used as a basis for rejection or otherwise discussed or acknowledged during prosecution) and by not rejecting the claims as obvious over Carmel in view of the other references asserted in the Petition.

For these reasons and those provided below, Google respectfully requests that the Director reject PO's request for discretionary denial and allow this IPR to proceed to an institution determination on the merits.

## **II. THE DIRECTOR SHOULD NOT EXERCISE HER DISCRETION TO DENY INSTITUTION OF THE PETITION**

### **A. Discretionary Denial Under 35 U.S.C. § 314(a) Is Not Appropriate Here**

Discretionary denial is not appropriate in this case because each of the *Fintiv* factors either favors institution or is, at minimum, neutral. As the Board observed in *Fintiv*, “there is some overlap among [the] factors” and “[s]ome facts may be relevant to more than one factor.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”) (precedential). Taken as a whole, the facts and factors summarized below (and discussed in detail in the subsections that

follow) demonstrate that the “efficiency and integrity of the system are best served by” instituting review and denying PO’s request for discretionary denial. *See id.*

- Factor 1 – post-institution motion to stay pending IPR statistics from the Northern District of California plus other evidence of record in the district court litigation indicate there is a high likelihood a post-institution stay will be granted;
- Factor 2 – there is no trial date set in the litigation, and the evidence indicates that (even absent a stay) any trial would take place well after the expected October 2026 date for a final written decision;
- Factor 3 – the district court is still in its early stages with no fixed deadlines currently set for the close of fact discovery, expert discovery, or *Daubert* and dispositive motions; instead all of those deadlines are tied to the issuance of a claim construction order. The claim construction hearing is scheduled to occur on October 25, 2025, *after* the expected date of the institution decision, with a claim construction order to follow some unspecified time after that, showing that the bulk of the investment in the parallel litigation still lies ahead;
- Factor 4 – Google (and real party-in-interest YouTube, LLC (*see* Pet. at 1)) submitted a *Sotera* stipulation that will eliminate any overlap of issues addressed in the district court litigation and this IPR;
- Factor 5 – Google and PO are the same parties in the district court litigation;

- Factor 6 – other considerations, including the strength of the Petition, the absence of settled expectations, and the ability to correct a material error made by the Office in improvidently issuing the challenged claims, also support institution and weigh against discretionary denial.

Indeed, the Director has recently denied requests for discretionary denial applying the March 26, 2025 Interim Processes for PTAB Workload Management in cases having closely analogous—and in certain key respects, materially identical—factual circumstances to the ones here. *See Twitch Interactive, Inc. v. RazDog Holdings LLC*, IPR2025-00307, Paper 18 at 2-3 (P.T.A.B. May 16, 2025) (“*Twitch*”) (denying request for discretionary denial where there was no currently scheduled trial date and there was good reason to believe, in view of the district’s post-institution motion to stay pending IPR statistics, that a stay will be granted in the parallel district court proceeding in the Northern District of California); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (P.T.A.B. June 12, 2025) (“*Imperative*”) (same).

Google respectfully submits that when the rationales articulated in *Twitch* and *Imperative* are applied to the facts of this case, the Director should reach the same outcome. The similar factual circumstances here favor institution and weigh against discretionary denial.

**1. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted**

Factor 1 weighs in favor of institution and against discretionary denial.

Shortly after filing the Petition, Google moved for a stay of the parallel litigation in the Northern District of California pending a decision on the IPR. During the hearing on the stay motion, the court indicated that it was primarily focused on the potential for simplification of the issues in the district court proceedings. (EX1066 at 3 (“[T]he most important factor ... is, at this state, the likelihood of this to simplify these proceedings.”), 19.) The court decided that, *pre-institution*, it was unclear whether the IPR would simplify matters at the district court, and it denied the motion on that basis. (*Id.* at 19.) The court made clear, however, that the denial was without prejudice, and it “welcome[d]” Google to bring another motion (or a stipulation, possibly) to stay if the IPR is instituted. The court stated:

But I remain, you know, just -- I remain concerned that at this stage we really -- it's speculative that IPR proceedings will simplify the matters before us. And so I am going to deny without prejudice the motion for a stay at this time. And, you know, certainly once there's a decision on IPR review, and **if [the Board] does in fact decide to institute review, you know, this denial is without prejudice and you're welcome to come back** either to agree if you think -- if both parties think that makes sense **or to come back on a motion for a stay given that the institution has in fact been granted.**

(*Id.* (emphasis added).) In *Fintiv*, the Board stated that “such guidance from the district court”—*i.e.*, denying a motion for stay without prejudice and indicating that it will consider a renewed motion to stay if a PTAB trial is instituted—“if made of record, suggests that the district court may be willing to avoid duplicative efforts and await the PTAB’s final resolution of the patentability issues raised in the petition before proceeding with the parallel litigation” and weighs against exercising discretion to deny institution. *Fintiv*, IPR2020-00019, Paper 11 at 7.

If IPR is instituted, Google intends to take the court up on its invitation and renew/bring a motion to stay the district court proceedings.<sup>1</sup> And, there is good reason to believe that such a post-institution motion to stay would be granted. Once instituted, the IPR will simplify matters in the district court one way or another. The challenged claims of the ’849 patent potentially will be (and indeed should be, for the reasons provided in the Petition) found unpatentable by the Board, thereby eliminating all<sup>2</sup> of the claims asserted in the district court proceeding. And, even if one or more asserted claims were to survive review (assumed *arguendo*), once

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<sup>1</sup> Google further expects that if IPR is instituted (with a decision expected by October 17, 2025), it would promptly move for a stay.

<sup>2</sup> The ’849 patent is the only patent asserted in the district court proceeding, with Patent Owner currently alleging infringement of claims 1-4 and 6-8.

instituted and in view of the *Sotera* stipulation filed by Google, the estoppel provisions of § 315(e) will apply and simplify the invalidity issues raised in the district court. Also, PO is not a competitor of Google (or YouTube), making a stay more likely to be granted.

Further, judges in the Northern District of California routinely grant stays after IPR institution—granting or partially granting 76% of all post-institution motions to stay pending *inter partes* review in the past twelve years. (See EX1067.) Indeed, in the Director’s recent decision in *Twitch*, the Director found these post-institution motion to stay statistics to be “persuasive evidence that “[t]here is good reason to believe that a stay will be granted”” in a parallel litigation in the Northern District of California following IPR institution. *Twitch*, IPR2025-00307, Paper 18 at 2; see also *Imperative*, IPR2025-00289, Paper 9 at 2 (Director’s finding “Petitioner also provides evidence that the district court [in the Northern District of California] is likely to grant a stay if this proceeding is instituted” in decision denying request for discretionary denial). The same evidence, statistics, and reasoning in *Twitch* and *Imperative* apply here, and the Director should reach the same conclusion.

Accordingly, the likelihood that the district court will stay the litigation following institution of this IPR weighs against discretionary denial.

**2. Factor 2: proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision**

*Fintiv* Factor 2 weighs strongly against denial.

No trial date in the parallel district court litigation has been set. (*See* Ex. 1068 at 1-3.) Under the operative scheduling order in the district court, the latest event that is provided with an actual, concrete deadline is the Claim Construction Hearing scheduled for October 28, 2025. (*Id.* at 2.) Subsequent deadlines in the case schedule (*e.g.*, close of fact discovery, close of expert discovery, dispositive motion briefing) are conditional and contingent upon triggering events that have no currently set deadline for completion. (*Id.* at 2-3.) Indeed, the ultimate date for trial is unknown and presently unknowable because it is contingent upon the completion of *multiple* independent, open-ended events/milestones for which there is no currently fixed deadline, including: (i) the district court’s ruling on claim construction; (ii) the scheduling of a hearing on *Daubert* and dispositive motions, and (iii) the scheduling of the trial itself at a trial setting conference. (*Id.*)

Even applying the most aggressive (likely unrealistic) assumptions possible to the waterfall of contingent deadlines provided in the scheduling order (*i.e.*, that the court issues a claim construction order the same day as the *Markman* hearing and that the hearing on *Daubert* and dispositive motions is held as soon as it possibly could be under the order—21 days after filing of replies), the earliest that the *trial*

*setting conference* could possibly be held—to say nothing of the actual trial—is November 3, 2026. (See EX1068.) Thus, the *earliest possible* trial setting conference date is *after* the October 17, 2026 statutory deadline for a final written decision in this IPR.

A trial, of course, would occur sometime after this earliest possible November 2026 conference date. In the other civil cases before Judge Pitts (the presiding judge in the district court litigation) that Google was able to identify as making it to a trial setting conference, the gap between the trial setting conference and the scheduled trial has been nearly six months on average, with a low of 97 days and a high of 286 days. (See EX1075.) This means that a trial would not be expected in the district court litigation until well into 2027, again even under the most aggressive (likely unrealistic) assumptions possible. And, when more realistic assumptions are used (*e.g.*, an approximate 5-month average time between a claim construction hearing and a claim construction order in patent cases before Judge Pitts), the expected trial date would be even further into the future and further from the October 2026 deadline for a final written decision.

This conclusion is in accord with the median time-to-trial statistics. They show that, based on the May 28, 2024 filing date of the complaint, a trial is unlikely

to occur before January 2027, again well after the expected date for a final written decision. (*See* EX1055; EX1069 at 2.)

And, in addition to the scheduling order-based analysis above, there are good reasons to believe that a trial in this case would not occur until even further into 2027. As PO pointed out in its brief, Judge Pitts has a standing order that provides a goal or expectation of having no more than 24 months between the initial case management conference and the trial. (DD Req. at 7 (citing EX2011 at 2).) But, PO used the wrong starting date for its trial date calculation in its brief. It used the date when the initial case management conference was originally scheduled (August 29, 2024) rather than the date when the initial case management conference was actually held (February 21, 2025). (*See id.* at 7 & n.5.) At a hearing in this litigation, Judge Pitts clarified the meaning of his standing order, stating: “I would say it [*i.e.*, the 24-month period] would run from the actual conduct of the actual case management conference because that’s really when we’re moving forward with the case.” (EX1066 at 20.) When the correct date is used as the starting point, the anticipated trial date based on the standing order timeframe would be at the end of February 2027.

Moreover, Judge Pitts indicated that even a late February 2027 trial date could be too ambitious for this case, noting that this 24-month period is “guidance for

every case that comes before me, some of which are far less complicated than some of these patent cases that we handle.” (EX1066 at 20.) He also undermined PO’s unrealistic and unsupported assertion in its Request that “the parties would finish their *Daubert* and dispositive motion briefing in that matter by July 2026 and be ready to proceed to trial shortly thereafter.” (See DD Req. at 7.) To the contrary, Judge Pitts stated: “I need time to decide to issue a ruling on the dispositive motions. The parties need time to take account of that ruling and formulating their trial strategies and all of their pretrial motions so I realize that I do think trying to get to trial within a few months of -- even of the hearing on dispositive motions is challenging.” (EX1066 at 21; *see also id.* at 21-22.)

Thus, PO’s assertion that trial in the parallel litigation will likely occur before the Board’s final written decision is based on speculation unsupported by any evidence (*e.g.*, “assuming a claim construction ruling within two months ...”) and other demonstrably faulty assumptions (*e.g.*, using the incorrect date for the initial CMC as its starting point for estimating a trial date). (See DD Req. at 7.)

In sum, there is no trial date currently set in the co-pending district court litigation and the scheduling order, the presiding judge’s standing order, and other statements on the record all indicate that trial would not be expected to begin until

February 2027 at the very earliest, which would be many months after the Board’s statutory deadline for issuing a final written decision.

The Director identified similar circumstances as supporting her decision to deny requests for discretionary denial in *Twitch* and *Imperative*. See *Twitch*, IPR2025-00307, Paper 18 at 2 (“However, there is no currently scheduled trial date in the co-pending district court litigation [in the Northern District of California]. ... [E]ven if a trial were to be scheduled, the median time-to-trial statistics suggest trial will begin in February 2027, which would be significantly after the projected final written decision (July 30, 2026).”); *Imperative*, IPR2025-00289, Paper 9 at 2 (“In particular, there is no trial date scheduled in the district court [in the Northern District of California].”). These same circumstances are present here and support the same outcome.

The proximity of the trial date in the district court (which is not currently set) to the Board’s statutory deadline for providing a final written decision (October 2026) thus weighs strongly against discretionary denial here.

**3. Factor 3: investment in the parallel proceeding by the court and the parties**

Factor 3 likewise weighs against discretionary denial.

PO overstates and exaggerates the investment in the district court proceeding by the court and the parties. While some work has been done, the bulk of the work

and investment in the district court litigation (particularly as it relates to the validity of the '849 patent) lies ahead. For example, the district court has not issued a claim construction order, and the claim construction hearing itself is not scheduled to occur in the district court until October 28, 2025—*i.e.*, *after* the October 17, 2025 expected date for an institution decision.<sup>3</sup> (EX1068 at 2.) Further, much of fact discovery remains left to complete—*e.g.*, no depositions have been noticed, much less taken (party or third-party, individual or 30(b)(6)); document production is not complete; PO still has 23 of its 25 interrogatories left, while Google has 24 of its 25 interrogatories left (with YouTube having 16 interrogatories left); no requests for admission have been propounded by any party—and there is no fixed deadline for the close of fact discovery. (*Id.*) Expert discovery, where much of the effort by the parties in addressing the validity of the '849 patent will lie, has not commenced and currently has no set start (or end) date. Briefing and the hearing on *Daubert* and dispositive motions lie even further in the future and have no currently set deadlines.

Because there is much work left to be done in the district court litigation, there is no claim construction order and no fixed deadlines for other key milestones, the current investment in the parallel proceeding thus is not likely to reduce the chances

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<sup>3</sup> As noted above, if instituted, Google anticipates that it will promptly move to stay the district court litigation pending resolution of the IPR.

of a stay being granted or result in the duplication of efforts and costs.<sup>4</sup> *See Fintiv*, Paper 11 at 10 (“This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceedings tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.”). Indeed, notwithstanding the efforts made in the case thus far, as discussed above, the district court went on the record welcoming Google to renew or submit another motion to stay pending IPR, if instituted. (EX1066 at 19; *see also* Sections II.A.1 and II.A.2 (*Fintiv* Factors 1 & 2 analysis), *supra*.)

The events in the parallel litigation that PO identifies in its brief, including a motion to dismiss, the exchange of initial infringement, invalidity and damages contentions, serving initial interrogatories and requests for production, and negotiating an ESI order and a protective order (*see* DD Req. at 10-11), only serve to demonstrate the early stage of the litigation. These are typical events and discovery that occur early in the lifecycle of any patent litigation, much of which is required by the Northern District of California’s local patent rules.

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<sup>4</sup> This is particularly true in view of Google’s *Sotera* stipulation. *See* Section II.A.4, *infra*.

The early stage of the litigation is further exemplified by PO's stated intention to amend its infringement contentions (and possibly its pleadings) to add a new accused instrumentality, depending on what discovery reveals. (*See* EX1066 at 11-12 ("Once we receive those Google TV documents, we'll move to amend to add Google TV, at which point, Google TV will be part of the case.")) Moreover, Google has moved to strike PO's infringement contentions, which is set to be heard on July 29, 2025. In its opposition, PO requested leave to amend its contentions. (*See* EX1073; EX1074 at 21.) Google does not concede that any amendment to PO's contentions (whether as to Google TV or any other issue) would be proper; regardless, PO's contentions are in flux, and PO apparently believes the litigation has not advanced to a point where it was required to finalize them.

PO also points out that claim construction briefing will take place before the expected institution date. (*See* DD Req. at 11.) PO does not dispute, however, that the claim construction hearing (and claim construction order to follow) is not scheduled to occur until after the expected institution date.

The claim construction briefing and unremarkable early fact discovery that PO identifies does not add up to "significant investment in parallel litigation" that

supports discretionary denial.<sup>5</sup> Indeed, the Board has found previously that this factor does not weigh in favor of discretionary denial in cases where the parallel proceedings were similarly advanced—or even further along—than the district court proceeding here. *See, e.g., Samsung Elecs. Co. v. Headwater Rsch. LLC*, IPR2024-01396, Paper 13 at 6-7 (P.T.A.B. Apr. 1, 2025) (finding factor 3 weighed against denial where parties “have likely done some work” including exchanging preliminary contentions and with fact discovery being just over a month from completion but where claim construction proceedings had not yet completed).

Again, this case is similar to the *Twitch* and *Imperative* cases, which were at similar stages and where similar investments in the respective parallel proceedings in the Northern District of California had been made. *See Twitch Interactive, Inc. v. RazDog Holdings LLC*, IPR2025-00307, Paper 13 at 16-20 (Apr. 30, 2025)

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<sup>5</sup> PO also points out that Google has raised “validity challenges in the district court based not only on prior art patents and printed publications, but also failure of written description, lack of enablement, and claim indefiniteness.” (DD Req. at 11.) PO fails to explain how, if at all, this purportedly relates to *Fintiv* factor 3, and it does not cite any authority for the proposition that a petitioner pursuing different defenses in a parallel litigation that are statutorily unavailable in IPR somehow weighs in favor of discretionary denial, particularly where (as here) the petitioner has offered a *Sotera* stipulation.

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(petitioner’s opposition noting that while initial contentions had been served, some fact discovery had been produced, and claim construction process/exchanges had begun, fact discovery had not closed, no party deposition had been noticed, no depositions taken, no claim construction order had issued, and expert discovery was still a long way off); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 8 at 16-19 (May 28, 2025) (petitioner’s opposition noting that the parties had only recently begun document production, no party depositions had been scheduled or completed, the parties had exchanged initial disclosures and preliminary contentions, and “outside of limited discovery related to PO’s preliminary injunction motion and claim construction, the parties have not engaged in any expert discovery or filed dispositive motions (nor has the Court set any deadlines for expert discovery or dispositive motions).”) And, the Director did not identify the relatively limited investment in these parallel proceedings—where, as here, the bulk of the efforts still remained ahead—as supporting discretionary denial. *See Twitch*, IPR2025-00307, Paper 18 at 2-3; *Imperative*, IPR2025-00289, Paper 9 at 2. The Director should reach a similar conclusion here.

PO also suggests that Google was less than diligent in filing the Petition and that the timing of the filing supports its Request. (*See* DD Req. at 10-11.) PO is mistaken. Google diligently and expeditiously filed its well-supported Petition on

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March 24, 2025—more than two months before the statutory deadline, less than three weeks after PO served its infringement contentions, and several weeks before Google served its invalidity contentions and even further in advance of when the parties commenced claim construction exchanges. (*See* Pet.; EX1055; EX1068 at 2.) PO’s statement that Google served its invalidity contentions in the district court litigation before filing the Petition (*see* DD Req. at 1-2) is incorrect. Google served its invalidity contentions on PO on April 21, 2025, several weeks *after* it filed the Petition. (*See* EX1068 at 2.)

This evidence further weighs against discretionary denial. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 11 (“If the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution under *NHK*.”); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 17 (P.T.A.B. Dec. 1, 2020) (“*Sotera*”) (finding the timing of the petition was reasonable where “Petitioner filed its Petition approximately two months after serving its initial invalidity contentions, and approximately two weeks before the statutory deadline.”); *Cellco P’ship v. Huawei Device Co.*, IPR2020-01117, Paper 10 at 22 (P.T.A.B. Feb. 3, 2021) (“We also credit Petitioner’s diligence in filing the Petition in this case within a relatively short time (less than three months) after being

served infringement contentions in the parallel case, thus also mitigating somewhat the investments made in the district court.”).

**4. Factor 4: overlap between issues raised in the petition and in the parallel proceeding**

The Director should likewise find that *Fintiv* factor 4 weighs against discretionary denial.

Google appreciates the Board’s aim “to minimize the duplication of work by two tribunals to resolve the same issue.” *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 11 (P.T.A.B. Jan. 9, 2020). Thus, to eliminate any potential overlap between the issues raised (or that could have been raised) in the Petition and in the parallel district court litigation, Google (and identified real party-in-interest YouTube) provided a *Sotera* stipulation,<sup>6</sup> which stipulates that:

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<sup>6</sup> To the extent PO asserts that Google should have submitted a stipulation at some earlier point in time, Google notes that it filed its Petition before the March 26, 2025 Interim Process for PTAB Workload Management Memorandum issued and the then-operative precedent provided that the “appropriate time for a petitioner to offer a stipulation related to the *Fintiv* factor 4 analysis is prior to the Board’s decision of whether to institute review.” *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 at 4 (P.T.A.B. Sept. 7, 2022) (de-designated as precedential Apr. 25, 2025); *see also Nike, Inc. v. Adidas AG*, 955 F.3d 45, 52 (Fed. Cir. 2020) (“In interpreting the APA’s notice provisions in the context of IPR proceedings, we have cautioned that an agency may not change theories in midstream without giving respondents

If the PTAB institutes IPR (and does not subsequently vacate institution) in response to Defendants' petition against Plaintiff's U.S. Patent No. 10,771,849 (IPR2025-00775), Defendants will not pursue in this litigation as to the claims challenged in IPR2025-00775: (i) the specific grounds raised in IPR2025-00775 or (ii) any other grounds that reasonably could have been raised before the PTAB in that instituted proceeding.

(See EX1076.)

Google's broad stipulation eliminates any potential overlap between issues raised in the Petition and in the parallel district court litigation, nullifies PO's potential overlap arguments,<sup>7</sup> and ensures that the IPR is a "true alternative" to the

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reasonable notice of the change and the opportunity to present argument under the new theory.") (citation and quotation marks omitted). Google further notes that the PO submitted its request for discretionary denial on the same day that the Office published its FAQs for Interim Processes for PTAB Workload Management, which included guidance on stipulation timing.

<sup>7</sup> Although it is mooted by the stipulation, PO's statement that there is "complete" overlap between the two proceedings with the same claims (1-9) "at issue in both the NDCA Litigation and this matter" is incorrect. (See DD Req. at 12.) While the Petition challenges all claims (1-9) of the '849 patent, PO has only alleged infringement of seven of the claims (1-4, 6-8) in the district court litigation. This fact also weighs against discretionary denial. See, e.g., *Hanwha Solutions Corp. v. Maxeon Solar PTE. Ltd.*, IPR2024-01203, Paper 17 at 18-19 (P.T.A.B. Feb. 26,

district court proceeding. *See Sotera*, IPR2020-01019, Paper 12 at 19 (“Petitioner’s stipulation here mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.”). The Board, not the district court, will be the forum where the invalidity issues raised in the Petition are decided following institution.

**5. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party**

Factor 5 weighs against discretionary denial.

The parties in the IPR are the same as in the parallel district court litigation. The Board has previously “found that factor 5 generally follows factor 2, such that ‘this factor favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true.’” *Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01372, Paper 17 at 23-24 (P.T.A.B. Apr. 23, 2025) (quoting *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (P.T.A.B. June 14, 2021) (collecting cases).)

Because the district court has not set a trial date and other evidence discussed in Section II.A.2 (Factor 2) above indicates that any trial in the district court

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2025) (finding *Fintiv* factor 4 weighed against discretionary denial where “some overlap of issues may exist, [but] complete overlap does not exist and resolution of the companion trial will not address the non-overlapping claims”).

litigation will occur after the expected deadline for a final written decision in this case, Factor 5 also weighs against discretionary denial or is, at minimum, neutral.

**6. Factor 6: other circumstances that impact the Director's exercise of discretion, including the merits**

Other relevant considerations in this case weigh against discretionary denial. These additional considerations include: the strength of the merits of the Petition, the absence of settled expectations in the validity and continued enforceability of the relatively recently-issued, but now-expired, '849 patent, and the material error the Office made in improvidently granting the challenged claims.

PO makes several arguments that there are additional considerations that favor discretionary denial, but these arguments are mistaken for the reasons discussed below.

**a. The merits of the Petition are strong**

First, the merits of the Petition are strong, presenting a compelling case of unpatentability. The Petition presents a straightforward combination of the teachings of Carmel [EX1003] and Mattavelli [EX1004] or Wang [1007] that render obvious the challenged claims. (*See* Pet. at 3 (listing asserted grounds).)

Carmel discloses techniques for dividing a stream of multimedia data into a sequence of slices (including instances where slices have multiple, different quality levels) for real-time broadcasting over a computer network, as well as a client

multimedia player that makes dynamic adjustments to the selection of what slices are downloaded in response to changes in the available network bandwidth so as to maintain fluidity and the highest quality playback. (*See, e.g.*, Pet. at 13-25 (citing, *e.g.*, Carmel at Abstract, 8:42-9:9, Figs. 3A, 3D (data structure of a broadcast sequence for a multi-level streaming embodiment for a sequence of multimedia slices)), 35-45 (citing, *e.g.*, Carmel at 2:1-21, 7:18-49, 8:42-9:9, 10:27-11:22, Figs. 3A, 3D, 6B (flow chart illustrating technique for selecting, receiving, and playing multimedia data slices encoded at multiple quality levels))).)

Mattavelli and Wang teach optimized decoding processes that allow computationally-constrained clients (such as mobile devices) to efficiently and effectively decode received compressed multimedia data to likewise produce and maintain fluidity and quality playback. (*See* Pet. at 45-55 (citing, *e.g.*, Mattavelli at 2309, 2310-11, 2312 (CGD technique is used as a “tool able to guarantee real-time performance in [the] presence of peaks of decoding complexity[.]”)), 70-78 (citing, *e.g.*, Wang at 51-52 (teaching “an optimized AVC decoder” designed to decode efficient AVC-encoded multimedia data on resource-constrained mobile devices), 53-55).)

As detailed in the Petition, these teachings satisfy and render obvious the challenged claims, including the limitations that the Examiner mistakenly concluded were not present in the prior art (as discussed further below in Section II.B.2).

PO is wrong when it asserts “the merits of the Petition are weak.” (*See* DD Req. at 14.) Indeed, PO’s primary argument in support of this assertion—that “[e]ach of Petitioner’s invalidity grounds are based on obviousness” (*id.*)—merely shows the flimsiness of its critique. Obviousness has (obviously) long been recognized as a basis for unpatentability, and the Board has instituted countless IPRs on obviousness grounds. PO fails to identify even a single instance in which the Board found reliance on obviousness grounds alone somehow undermined the merits of a petition under *Fintiv* factor 6.

Moreover, PO’s brief identification of a handful of specific alleged issues with the Petition (*id.* at 15) simply shows that PO has misunderstood and mischaracterized the teachings of the asserted references and Google’s invalidity arguments.

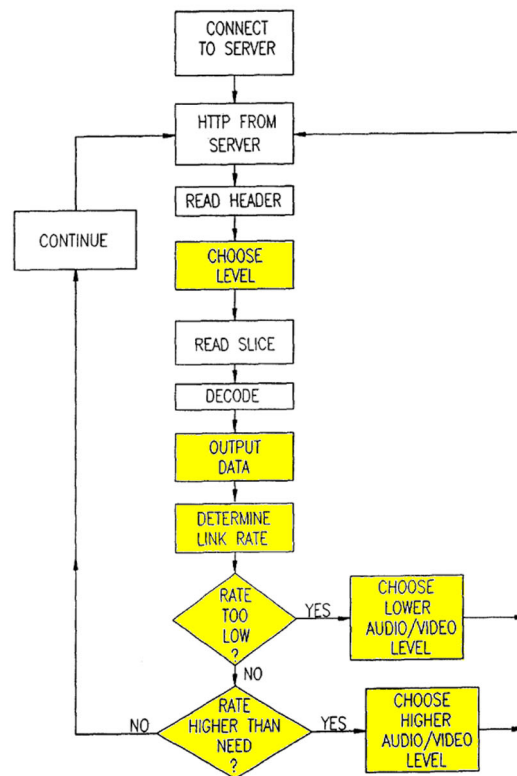
For example, PO asserts that the Petition “improperly equates” “fluidity” with “continuity” but fails to explain what, if anything, distinguishes these concepts in the context of multimedia playback. (*Id.*) The fine or false distinction that PO seeks to draw appears to be misdirection—an attempt to confuse or distract the Board from

how the Petition demonstrates that the asserted art teaches techniques for maintaining smooth, continuous, *fluid* playback, avoiding abrupt interruptions of streamed multimedia segments, and thus satisfies this claim element. (*See, e.g.*, Pet. at 35-45 (citing, *e.g.*, Carmel at Abstract, 2:1-21 (disclosed techniques “allow[] the broadcast to go on substantially in real time”), 7:18-49 (time codes are monitored to make sure reception is “keeping up”), 8:42-9:9 (techniques for “maintaining the required slice timing”), 10:27-11:22 (quality level selection is adjusted depending on whether fluid playback, indicated by timestamps, can be maintained), Figs. 3A, 3D, 6B)), 45-55 (citing, *e.g.*, Mattavelli at 2309-10 (abrupt interruptions “are perceptually very annoying”), 2311-12 (teaching techniques “able to guarantee real-time performance”)), 70-78 (citing, *e.g.*, Wang at 51 (teaching optimized AVC-decoding processes that improved throughput 6 to 7 times), 52-55).)

PO uses a similar tactic when it alleges that the Petition conflates the element of “autonomously adjusting” “playback” with the elements of “selecting” and “autonomously adjusting” the “selection.” (DD Req. at 15.) Not so. The Petition addresses each and every element of the challenged claims, including these elements identified by PO in its Request. The Petition demonstrates how Carmel teaches and renders obvious methods and systems where an initial selection of a quality level for downloaded multimedia slices/objects is made by a multimedia player and where

that selection is subsequently autonomously adjusted in view of the currently available network bandwidth. (See, e.g., Pet. at 35-45 (citing, e.g., Carmel at Abstract, 2:1-21, 7:18-49, 8:42-9:9, 10:27-11:22 (initial quality level selection is adjusted depending on whether fluid playback, as indicated by timestamps, can be maintained), Figs. 3A, 3D, 6B).)

FIG. 6B



(Pet. at 44 (Carmel Fig. 6B (annotated) showing an example flow chart of multimedia player functions on client when performing multi-quality level streaming technique).) The Petition further explains how Carmel and Mattavelli also

teach autonomously adjusting the playback of the received multimedia slices/objects in view of the available network bandwidth and available decoding resources to the multimedia player respectively. (*See* Pet. at 44-45, 45-55.)

Finally, PO also incorrectly suggests that the combination of Carmel with Mattavelli teaches a reduction in quality in the playback of multimedia data rather than “maintaining” this quality by using, among other things, optimized decoding processes.<sup>8</sup> (*See* DD Req. at 15.) The Petition explains in detail, however, how Carmel and Mattavelli teach techniques for ***maintaining*** the highest quality possible when streaming multimedia data to a client multimedia player—including, *e.g.*, avoiding “abrupt interruptions” (which Mattavelli teaches are particularly detrimental to the perceived playback quality)—in the face of system constraints, including the available network bandwidth and available decoding resources. (*See, e.g.*, Pet. at 36-40 (“Carmel generally teaches and repeatedly emphasizes seeking to match the bitrate/data rate of the multimedia slices with the available network bandwidth for download (and upload) **so as to avoid lag and maintain fluidity of the multimedia playback and the best possible/practicable quality.**” (emphasis

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<sup>8</sup> In addition to being wrong, this critique does not address or apply to the combination of Carmel and Wang that is asserted in Ground 2 of the petition. (*See* Pet. at 70-78.)

added; citations omitted)), 40-45, 45-55 (“A POSA would have been motivated to combine the complementary methods and techniques taught by Carmel and Mattavelli to form a streaming system that is more robust and that addresses both bandwidth-based and client processing-based constraints together to provide an improved or best possible/practicable playback experience.” (citing EX1002 at ¶¶212-215).) Indeed, as shown in Carmel Figure 6B above (and discussed in the Petition), Carmel discloses instances where the selected quality level is *improved* or *increased*, if/when allowed by the available network bandwidth. (See, e.g., Pet. at 41 (citing Carmel at 10:64-11:22, Fig. 6B).)

As discussed above, the Petition further details how Mattavelli teaches optimized decoding processes (e.g., computational graceful degradation for video decoding techniques) to maintain fluidity and quality playback. (Pet. at 45-55.)

Further, to the extent that PO is suggesting here that “maintain[ing]” quality and fluidity, as recited in the challenged claims, cannot include or encompass *any* reduction in any quality—regardless of for how long, for what reason (such as fluctuations in available network bandwidth or decoding resources), or for what purpose (such as preserving fluidity of the playback at the expense of other aspect(s) of playback quality)—such a position is inconsistent with the ordinary meaning of this term in view of the specification. The ’849 specification provides, for example:

In a third aspect, the invention provides novel optimizations for digital video decoding. Some of these optimizations can then be used by an expert assessment process, whereby, the decoder maintains a state information list of short-cuts, related to perceived frame rate in a sorted list starting with those that will decrease output quality the least, **to those that will *decrease* output quality the most but have the most impact on decoding speed. The *client player-decoder dynamically adjusts* how many shortcuts must be taken. These short-cuts are specifically designed to drastically reduce the number of computations necessary at certain critical steps in the video decoding process *at the cost video output quality*.** This allows the video decoder to scale in complexity based on the processing power of the device being used. It also allows users to experience multimedia playback despite the limitations of the device they may be using.

(EX1001, 4:7-23 (emphasis added).) Indeed, PO identified this passage from the specification as supporting its plain and ordinary meaning proposed construction of the “*maintain* quality playback” term in the district court litigation. (EX1070 at 10 (emphasis added).) PO’s (mistaken) critique of the Petition in its Request is thus inconsistent with the ’849 specification and PO’s claim construction position in the district court.

**b. The Petition’s reliance on focused expert testimony is reasonable, appropriate, and necessary**

The Petition’s reliance on the expert testimony of Dr. Nathaniel Polish is not undue or unreasonable. Rather, Dr. Polish’s declaration is appropriate and, indeed, necessary to provide proper evidentiary support for the obviousness grounds set forth in the Petition, including explanations for how a person of ordinary skill in the art would have understood and applied the teachings of the prior art. It is consistent with the Board’s repeated warnings regarding the inadequacy of unsupported attorney argument. *See, e.g., Dyson Tech. Ltd. v. Omachron Intell. Prop. Inc.*, IPR2024-00938, Paper 7 at 17 (P.T.A.B. Nov. 19, 2024) (“At this stage of the proceeding, these assertions are mere attorney argument, unsupported by declaration testimony or other evidence of the understanding of one of ordinary skill in the art on the relevant issues.”). Further, Dr. Polish’s declaration is thorough and complete in order to satisfy the legal and regulatory requirements for providing credible, adequately supported expert testimony. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306, 1311 (Fed. Cir. 2000) (“Lack of factual support for expert opinion going to factual determinations, however, may render the testimony of little probative value in a validity determination.” (quoting *Ashland Oil, Inc. v. Delta Resins & Refractories*,

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*Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985))). Dr. Polish’s declaration is supported by numerous cites to objective evidence supporting his opinions. (*See, e.g.*, EX1002, ¶¶40-59, 116-128, 136, 142-145, 162, 177-178, 206, 209-222.)

Contrary to PO’s unsupported suggestion otherwise, the Petition presents prior art disclosure corresponding to each and every element of the nine challenged claims, and there is no element for which Google relies exclusively on expert testimony to show invalidity. *See, e.g., Advanced Micro Devices Inc. v. Realtek Semiconductor Corp.*, IPR2023-00789, Paper 9 at 34-35 (P.T.A.B. Oct. 26, 2023) (finding that “Petitioner ha[d] provided sufficient argument and evidence” supported by citation to the prior art and rejecting patent owner’s argument that petitioner had improperly relied on expert testimony to fill in gaps in the art).

Like the patent owner in *Twitch*, PO here broadly criticizes Google for purportedly “cit[ing] its expert’s 262-page declaration over 100 times in the Petition, often relying on large swaths of expert testimony to backfill and plug holes in its arguments.” (DD Req. at 15.) Also like the patent owner in *Twitch*, PO does *not* identify any specific examples of such alleged improper reliance or backfilling nor point to any authority suggesting that the number of citations to a supporting declaration (which totaled over 260 in *Twitch*) weighs in favor of discretionary denial. Indeed, the Director rejected such arguments “alleg[ing] improper or undue

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reliance on expert opinion” in *Twitch*, finding they were not “sufficiently explained.” *Twitch*, IPR2025-00307, Paper 18 at 3. Again, the Director should reach the same conclusion here. *See also GD Energy Prods., LLC v. Kerr Mach. Co.*, PGR2025-00031, Paper 11 at 2 (P.T.A.B. June 25, 2025) (finding that expert testimony was complying with regulations requiring the disclosure of “underlying facts or data” and that this circumstance did not favor discretionary denial).

That Dr. Polish’s declaration is thorough and well-supported does not weigh in favor of discretionary denial.

**c. Any settled expectations here weigh in favor of institution and against discretionary denial**

There are no settled expectations that the ’849 patent would not be subject to IPR challenge. The ’849 patent issued on September 8, 2020 (EX1001), which is only a little over three-and-a-half years before PO sued Google in the Northern District of California and about four-and-a-half years before the Petition was filed. This early challenge to the ’849 patent favors institution. *See Zhuhai Cosmx Battery Co. v. Ningde Amperex Tech. Ltd.*, IPR2025-00385, Paper 9 at 2-3 (P.T.A.B. July 2, 2025) (“[T]he early challenges to the patents tip the balance against discretionary denial.”).

For comparison, in the *Twitch* case, the challenged patent (U.S. Patent No. 9,729,658) issued on August 8, 2017—making it over three years older than the ’849

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patent challenged here. *See also Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (P.T.A.B. July 2, 2025) (“[T]he challenged patents issued in 2019 and 2020, such that Patent Owner has not developed strong settled expectations that favor discretionary denial.”).

And, like the patent owner in the *Twitch* case, PO here does not identify what the alleged “settled expectations of the parties” purportedly are, but rather merely notes the age of the challenged patent without any explanation as to why this was allegedly relevant. When rejecting patent owner’s request for discretionary denial in *Twitch*, the Director also rejected this argument “alleg[ing] settled expectations of the parties” as not “sufficiently explained.” *Twitch*, IPR2025-00307, Paper 18 at 3. The same is true here.

Further, although it was only issued relatively recently, the ’849 patent has already expired. (*See* EX1001; EX1066 at 12 (counsel for PO in the district court litigation acknowledging that the challenged patent expired on April 26, 2025).) So, the claims of the ’849 patent (if valid) would have been in force only for just over four-and-a-half years. PO plainly has no expectation that the claims of the ’849 patent would remain enforceable past April 26, 2025, and it should not have had any settled expectations that the past validity of its short-lived, already expired patent would not be challenged. Indeed, in the recent *Globus Medical v. Spinelogik*

decision, the Director rejected the patent owner’s settled expectations argument and found that discretionary denial was not appropriate in circumstances where the challenged patent had already expired and had been in force for only around four years. *See Globus Med., Inc., v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 at 2 (P.T.A.B. June 12, 2025).

The circumstances here are similar, and likewise any alleged “settled expectations of the parties” do not support discretionary denial. In fact, given the relative youth of the ’849 patent, the settled expectations and early challenge to the ’849 patent here favor institution.

**d. Institution would be an appropriate use of the Board’s resources**

Finally, instituting review would be an efficient and appropriate use of the Board’s resources, particularly to correct the material error the Office made in improvidently granting the challenged claims.

The Director recently declined to discretionarily deny a petition based on a showing of material error during patent examination, despite the fact that (unlike here) the scheduled district court trial was set to precede the expected final written decision date. *See Microsoft Corp. v. Partec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 at 2-4 (P.T.A.B. June 12, 2025). The Director stated: “Ordinarily, a scheduled district court trial date that precedes the date projected for

a Board final written decision weighs in favor of exercising discretion to deny the Petition. Here, however, the Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error.” *Id.* at 3. As discussed in Section II.B below, Google also shows that the Office made a material error when it overlooked (or misapprehended) the teachings of Carmel and issued the challenged claims. It would likewise be an appropriate use of the Board’s resources to review and correct this error. This too favors institution and weighs against denial.

The PTAB or another forum has not already adjudicated the validity of the challenged claims of the ’849 patent, which also weighs against discretionary denial. Moreover, the Board previously considered and rejected the claims of a parent application to the ’849 patent that shared many common or similar elements to the challenged claims. (See EX1071 (Board decision in *Ex parte Krebs*, Appeal No. 2016-002538, affirming the final rejection of the claims of application no. 11/107,952 as unpatentable over Vetro, Jayant, and Lin); *compare id.* at 2-3 (independent claim 5 of 11/107,952 application), *with* EX1001 at 19:19-39 (independent claim 1 of ’849 patent) (common or similar claim elements include, *e.g.*: multimedia objects; segments/split intervals of multimedia data, wireless connections/clients, supplied host path identification/distinctive Internet addresses,

maintaining visual fluidity).) Following this decision by the Board, the '952 parent application to the '849 patent was abandoned. (*See* EX1072.)

In another recent decision denying a request for discretionary denial, the Director found that “[t]he fact that the Board previously determined related claims to be unpatentable—prior to the issuance of the challenged claims in this proceeding” weighs against discretionary denial. *POSCO Co. v. Arcelormittal*, IPR2025-00370, Paper 10 at 3 (P.T.A.B. June 25, 2025). Here, in view of the similar facts in this case, it is likewise “an appropriate use of Office resources to provide consistency and predictability to the public, and to ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding.” *Id.* (citing 37 C.F.R. § 42.73(d)(3)).

For these reasons, the Director should decline to exercise her discretion to deny institution under § 314(a).

**B. Discretionary Denial Under 35 U.S.C. § 325(d) Is Not Appropriate Here**

Because neither prong of the analytical framework set forth in *Advanced Bionics* supports it, the Director should not exercise her discretion to deny institution under 35 U.S.C. § 325(d).

The Board addresses § 325(d) by applying a “two-part framework.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469,

Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (“*Advanced Bionics*”) (precedential). First, the Board considers whether the same or substantially the same art or arguments were previously presented to the Office, and, if so, second, the Board considers “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of [the] challenged claims.” *Id.*

The *Becton, Dickinson* factors are typically used when applying this framework under § 325(d). *Id.* at 9-11. These factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which [p]etitioner relies on the prior art or [p]atent [o]wner distinguishes the prior art;
- (e) whether [p]etitioner has pointed out sufficiently how the [e]xaminer erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the [p]etition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (P.T.A.B. Dec. 15, 2017) (“*Becton, Dickinson*”). Factors (a), (b), and (d) are used to evaluate the first prong of the *Advanced Bionics* framework, and factors (c), (e), and (f) are used to evaluate the second prong. *Advanced Bionics*, IPR2019-01469, Paper 6 at 10-11.

Patent Owner does not discuss or apply the *Advanced Bionics* framework or the *Becton, Dickinson* factors in its argument for discretionary denial under § 325(d). (See DD Req. at 17-18.) Rather, it merely points out that the Carmel reference—which is combined in each of the asserted grounds with other references that were *not* before the Examiner—was previously presented to the Office as part of an IDS. (*Id.*) Patent Owner fails to show that these circumstances support the exercise of discretion under § 325(d). Indeed, neither part of the *Advanced Bionics* framework supports discretionary denial here.

**1. Neither the combinations of prior art in the asserted grounds nor the arguments raised in the Petition were previously presented to the Office**

The first prong of the *Advanced Bionics* framework is not satisfied here, as neither the combinations of prior art in the asserted grounds nor the obviousness arguments raised in the Petition were previously presented to the Office.

The Petition raises five grounds, each asserting obviousness based on a combination of prior art references. (See Pet. at 3.) As shown below, Carmel's [EX1003] teachings are combined with those of Mattavelli [EX1004] in Grounds 1 and 5, and Carmel's teachings are combined with those of Wang [EX1007] in Grounds 2-4. (*Id.*) In addition to Carmel and Mattavelli or Wang, Grounds 3-5 also include the teachings of Wolters [EX1041], Guo [EX1051], Yu [EX1061], and/or Forecast [EX1016]. (*Id.*)

Ground	Claims	Basis for Challenge under §103(a)
1	1-9	Carmel in view of Mattavelli
2	1-9	Carmel in view of Wang
3	1-9	Carmel in view of Wang and Wolters
4	1-9	Carmel in view of Wang, Wolters, Guo, Yu, and Forecast
5	1-9	Carmel in view of Mattavelli, Guo, Yu, and Forecast

Carmel was included (along with about 45 other references) in an IDS submitted by the applicant, which was later initialed by the Examiner. (*See* EX1008, 140-146, 523-528.) Carmel was not used as a basis for rejection, discussed, or otherwise acknowledged by the Examiner during prosecution. (*See, e.g., id.* at 545-558.)

The other prior art references relied upon in the asserted grounds (*i.e.*, Mattavelli, Wang, Wolters, Guo, Yu, and Forecast) were not before the Examiner during prosecution, however, and they are not cited on the face of the '849 patent. (*See* EX1001 at Cover; *see generally* EX1008 (no mention of these additional references in the prosecution history).) Thus, there are material<sup>9</sup> differences between

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<sup>9</sup> As discussed further in the following section, the Petition shows how the asserted combinations of prior art in the asserted grounds do not suffer from the purported deficiencies that PO argued were present in the art used as a basis for rejection, and

the asserted art—*i.e.*, the asserted *combinations* of references that form the asserted grounds—and the prior art involved during examination under *Becton, Dickinson* factor (a). (*See* Pet. at 3 (asserted grounds); EX1008 at 523-528, 545-558.)

Further, PO does not allege (nor offer any support for any such allegations): (i) that any of these other asserted prior art references (*e.g.*, Mattavelli, Wang) are cumulative of those that were before the Examiner or (ii) that the unpatentability arguments raised in the Petition are the same or substantially the same as the prior art arguments made by the Examiner during prosecution.<sup>10</sup> (*See* DD Req. at 17-18.) In other words, PO does not allege nor offer any evidence to show that *Becton, Dickinson* factors (b) or (d) support a finding that the same or substantially the same art or arguments were previously presented to the Office.

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are thus materially different from this art. (*See* EX1008 at 549-556, 580-583 (Patent Owner's arguments purporting to distinguish the Vetro, Chang, and Hemy references); Pet. at 35-45, 45-50, 72-73 (describing how the asserted combinations of Carmel and Mattavelli and Carmel and Wang satisfy and render obvious the same claim limitations PO argued were not satisfied by the art used as a basis for rejection).)

<sup>10</sup> Nor could PO have (properly) raised such allegations, as the asserted combinations are not cumulative of what was before the Examiner, and the arguments presented in the Petition are different from those made by the Examiner. *See* footnote 9, *supra* and Section II.B.2, *infra*.

So, while Carmel was previously presented to the Office, none of the asserted obviousness combinations raised in the Petition were. The asserted combinations include and are based on new evidence, and they raise new art and arguments that were not previously considered. Accordingly, the first prong of the *Advanced Bionics* analysis is not met. *See ETN Cap., LLC v. FBA Operating Co.*, IPR2024-01445, Paper 14 at 14-16 (P.T.A.B. Feb. 28, 2025) (agreeing that “each of the references [petitioner] combine[d] with [a reference before the Office during prosecution] were not considered by the [e]xaminer” and finding that the same or substantially the same art or arguments were not previously presented to the Office); *Samsung Elecs. Co. v. Maxell, Ltd.*, IPR2024-00906, Paper 11 at 11, 14-18 (P.T.A.B. Dec. 11, 2024) (finding first prong of *Advanced Bionics* was not satisfied where certain references in the asserted obviousness grounds (*e.g.*, Dua) had been listed in an IDS but other references used in combination (*e.g.*, N93, Herle, Rooyen, Desai) were not previously before the Examiner, stating the Board was unpersuaded that “art substantially the same as ***Petitioner’s grounds*** were previously presented to the Office” (emphasis added)); *Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01373, Paper 17 at 28 (P.T.A.B. Apr. 23, 2025) (finding first prong of *Advanced Bionics* not satisfied where same primary reference (Niikawa) had been raised but not considered in a prior IPR but other references in the currently asserted

obviousness combinations had not been previously presented).

**2. The Examiner materially erred by not rejecting the claims as obvious over Carmel in view of Mattavelli or Wang**

Although the Director need not reach the second prong of the *Advanced Bionics* framework, it too does not support discretionary denial under § 325(d).<sup>11</sup> The Examiner materially erred by overlooking (or misapprehending) the teachings of Carmel and by not rejecting the claims as obvious over Carmel in view of Mattavelli or Wang. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 8 n.9 (“An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.”), 10 (“[I]f the record of the Office’s previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive[.]”).

As discussed above, Carmel was the only prior art reference from the asserted obviousness grounds that was before the Examiner during prosecution, by virtue of its inclusion in an IDS. Carmel was not used as the basis for any rejection, and there is no analysis or discussion of Carmel’s teachings in the prosecution history. (*See*,

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<sup>11</sup> Moreover, as discussed above in Section II.A.6 (Factor 6), the material error by the Office weighs against discretionary denial under § 314(a) as well. *See Microsoft*, IPR2025-00318, Paper 9 at 3.

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e.g., EX1008, 140-146, 523-528, 545-558.) Carmel’s teachings were overlooked, and *Becton, Dickinson* factor (c) thus weighs against the exercise of discretion under § 325(d). See *Ascend Elements, Inc. v. Duesenfeld GmbH*, IPR2024-00948, 2024 WL 4869116, at \*16 (P.T.A.B. Nov. 22, 2024) (finding that petitioner has demonstrated that the Office had materially erred where “the Office did not rely on any of the references asserted [] to reject any of the claims challenged here[,]” “so it appears [the asserted obviousness arguments] were overlooked”); *CODE200, UAB v. Bright Data Ltd.*, IPR2022-00353, Paper 8 at 10 (P.T.A.B. July 1, 2022) (fact that reference was not the basis of rejection in the prosecution of challenged patent “weighs strongly against exercising our discretion to deny institution under 35 U.S.C. § 325(d)”); *Aylo Freesites Ltd. v. Dish Techs. L.L.C.*, IPR2024-00940, Paper 12 at 33-34 (P.T.A.B. Nov. 21, 2024) (“Neither the applicants nor the Examiner discussed these references and petitions, and the Examiner did not use any of them as a basis of any rejection. Rather, the Examiner’s only interaction with these items appears to be within the context of receiving and responding to Information Disclosure Statements.”).

As detailed in the Petition, Carmel (in combination with Mattavelli or Wang) teaches and renders obvious all of the limitations of the challenged claims, including the limitations mistakenly identified by the Examiner as not present in the prior art

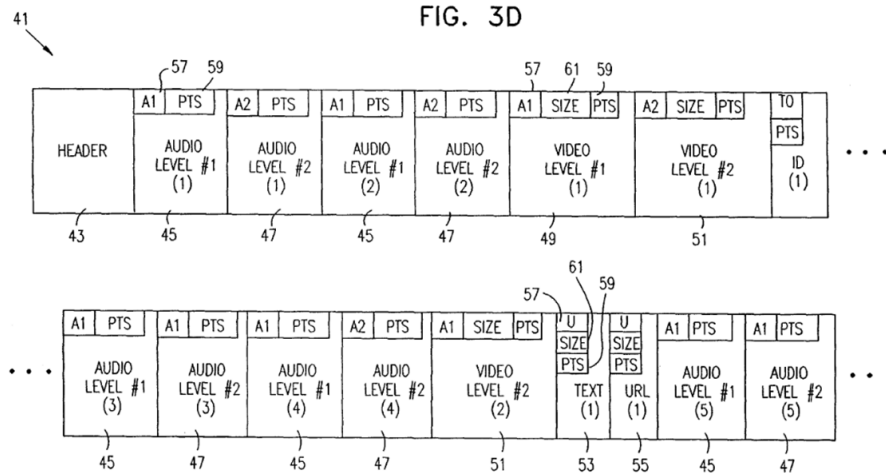
in the Notice of Allowance. (*See* EX1008 at 589.) There, the Examiner indicated the limitation reciting “wherein the multimedia player is configured to play multimedia objects in a sequence such that fluidity, video quality and audio quality are maintained by selecting a plurality of said multimedia objects that reflect available network bandwidth, autonomously adjusting said selection and playback according to the multimedia object parameters and supplied host path identification” was “the reason for allowance.” (*Id.*)

The Petition identifies and analyzes the overlooked teachings from Carmel that disclose and render obvious this “wherein the multimedia player is configured ...” limitation (in combination with the other limitations). In particular, the Petition identifies and discusses Carmel’s teachings regarding a multi-level streaming technique where the multimedia player on the client automatically selects and adjusts the selection of the quality level of the requested multimedia objects in a manner that reflects the available network bandwidth according to the object parameters (*e.g.*, playback time stamps, size/quality level parameters, etc.) and host path identification to maintain fluidity and quality playback of the multimedia sequence “for the appreciation of a user.”<sup>12</sup> (*See, e.g.*, Pet. at 35-40 (citing, *e.g.*,

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<sup>12</sup> The Petition also identifies teachings from Mattavelli [EX1004] (which, again, was not before the Examiner) that also teach and render obvious a media player

Carmel at 2:1-21, 7:18-41, 8:42-9:9, 10:48-54, 10:64-11:9, Figs. 3A, 3D, 6B), 40-45 (citing, *e.g.*, Carmel at 7:28-49, 10:27-31, 10:64-11:22, Fig. 6B).)

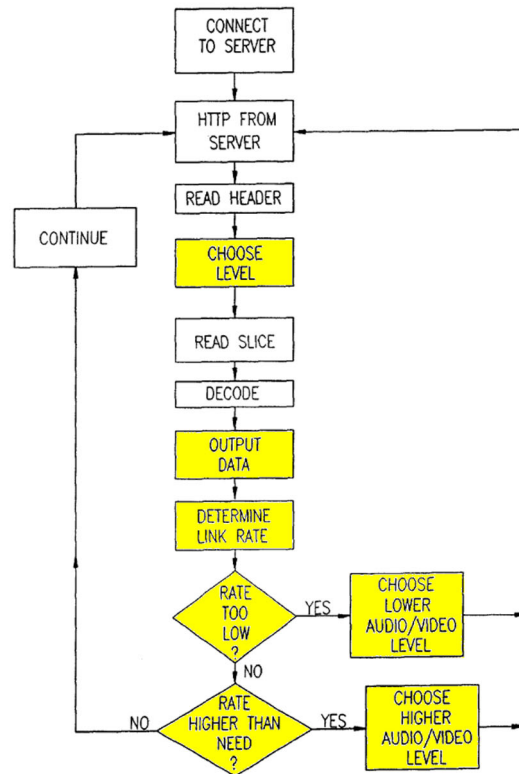


(Pet. at 38 (Carmel Fig. 3D showing example of multi-level multimedia segments/slices/objects having different quality levels with associated parameters/metadata).)

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autonomously adjusting playback of multimedia objects according to object parameters (*e.g.*, predicted decoding complexity information). (See Pet. at 44-45 (citing Mattavelli at 2309, 2311-12), 47-48.)

FIG. 6B



(Pet. at 44 (Carmel Fig. 6B (annotated) showing an example flow chart of multimedia player functions on client when performing multi-quality level streaming technique).)

The Petition further shows how Carmel (alone and in combination with Mattavelli and Wang) does not suffer from the purported deficiencies that Patent Owner argued were present in the art used as a basis for rejection. For example, in its April 16, 2020 Arguments and Remarks Made in an Amendment, PO “clarified that adjusting selection and playback is done autonomously (ie. [sic] without server-

side intervention)” and argued that the cited Vetro reference disclosed server-side—not client- or player-side—adjustment and control. (See EX1008 at 580-583.) As discussed in the Petition, Carmel teaches that the adjustment to the selection and playback of multimedia slices is performed “autonomously,” without server-side intervention, by the player on the client device. (See Pet. at 43-45 (citing, e.g., Carmel at 11:1-8, 11:9-15, 10:27-31, 10:64-67, Fig. 6B).) The Petition further details how Carmel and Mattavelli and Wang teach and render obvious a media player that makes dynamic multimedia quality selection adjustments in response to changes in the available network bandwidth and provides optimized decoding of multimedia objects/segments/slices, unlike (as PO argued and the Examiner acquiesced) the prior art used as the basis for rejection. (See Pet. at 35-45, 45-50, 72-73; EX1008 at 580-583.)

Under *Becton, Dickinson* factor (e), the teachings from Carmel identified above (and analyzed in greater detail in the identified patentability contentions from the Petition) demonstrate that the Examiner materially erred in the evaluation of the prior art. The Examiner overlooked (or misapprehended) these teachings from Carmel (and never considered the identified teachings of Mattavelli or Wang) when mistakenly concluding that the “wherein the multimedia player is configured ...” limitation called out in the Notice of Allowance (EX1008 at 589) was not found in

the prior art. *See Aylo Freesites*, IPR2024-00940, Paper 12 at 34-35 (“It is difficult to characterize error in a nearly silent record, and we find that Petitioner has sufficiently demonstrated error based in part on its unpatentability contentions.”).

Finally, the Petition includes additional evidence and facts that were not before the Examiner during prosecution, including, *e.g.*: (i) the prior art references that are combined with Carmel in the asserted obviousness grounds (*i.e.*, Mattavelli, Wang, Wolters, Guo, Yu, and Forecast) and (ii) the expert declaration of Dr. Nathaniel Polish explaining the teachings of Carmel and these additional references that were not before the Examiner and why a person of ordinary skill would have been motivated and found it obvious to combine them. (*See* EX1002 (Polish Declaration).) *Becton, Dickinson* factor (f) thus further shows material error and weighs against the exercise of discretion under 325(d). *See, e.g., Ascend Elements*, 2024 WL 4869116, at \*16 (Petitioner offered additional evidence including additional references in the asserted obviousness combinations, as well as expert declaration, “that was not before the Office during examination”); *Taro Pharms. U.S.A., Inc. v. Apotex Techs., Inc.*, IPR2017-01446, Paper 7 at 18 (P.T.A.B. Nov. 28, 2017) (new expert declaration evidence that was not previously presented to the Office).

For these reasons, the Director should decline to exercise her discretion to

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deny institution under § 325(d).

### III. CONCLUSION

For the reasons provided above and in the Petition, the Director should not exercise her discretion to deny institution. Petitioner respectfully requests the Director allow this IPR to proceed to an institution determination on the merits, institution of review on claims 1-9 of the '849 patent, and a finding they are unpatentable.<sup>13</sup>

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<sup>13</sup> Petitioner reserves the right to challenge the March 26, 2025 Interim Process for PTAB Workload Management at least because it is legally invalid as (1) exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

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Dated: July 17, 2025

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE WITH WORD COUNT**

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** contains 10,654 words, according to the word-processing system used to prepare this paper, excluding the parts of this paper that are exempted by 37 C.F.R. § 42.24(a) (including the table of contents, a table of authorities, a certificate of service or this certificate word count, and appendix of exhibits). The foregoing word count complies with the 14,000-word type-volume limit specified by the Interim Processes for PTAB Workload Management and 37 C.F.R. § 42.24.

DATED: July 17, 2025

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**CERTIFICATE OF SERVICE**

I hereby certify, pursuant to 37 C.F.R. § 42.6 that a true and correct copy of **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**, and **Exhibit Nos. 1066-1076**, are being served electronically on July 17, 2025 to the e-mail addresses shown below:

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