Trials@uspto.gov
571-272-7822

Paper 15
Date: July 21, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner,

v.

EQUIL IP HOLDINGS LLC,
Patent Owner.

IPR2023-00332
Patent 9,158,745 B2

Before RICHARD M. LEBOVITZ, ROBERT J. WEINSCHENK, and SHARON FENICK, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

Akamai Technologies, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1–7 ("the challenged claims") of U.S. Patent No. 9,158,745 B2 (Ex. 1001, "the '745 patent"). Equil IP Holdings LLC ("Patent Owner") filed a Preliminary Response (Paper 8, "Prelim. Resp.") to the Petition.

Subsequent to the filing of the Petition and Preliminary Response, we authorized Petitioner (Ex. 1040 (PTAB email dated May 18, 2023)) to file a Preliminary Reply Brief (Paper 12, "Prelim. Reply Br.") limited to addressing (1) Patent Owner's arguments under 35 U.S.C. § 325(d); and (2) Patent Owner's arguments relating to the correction of inventorship in U.S. Patent No. 6,964,009 ("the '009 patent") and its effect on the prior art status of a piece of art included in several of the asserted grounds. We also authorized Patent Owner to file a responsive Preliminary Sur-reply (Paper 13, "Prelim. Sur-reply").

An *inter partes* review may not be instituted unless "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

After considering the Petition, the Preliminary Response, the Preliminary Reply Brief, the Preliminary Sur-reply, and the evidence of record, for the reasons explained below, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of at least one claim challenged in the Petition. Hence, we deny the Petition and do not institute an *inter partes* review.

B. Real Parties in Interest

The parties identify themselves as the only real parties in interest. Pet. 3; Paper 4, 1.

C. Related Matters

Petitioner and Patent Owner identify the following proceeding as a related matter involving the '745 patent: *Equil IP Holdings LLC v. Akamai Technologies, Inc.*, No. 1:22-cv-00677 (D. Del.). Pet. 3; Paper 4, 1.

D. The '745 Patent (Exhibit 1001)

The '745 patent, titled "Optimization of Media Content Using Generated Intermediate Content," issued on October 13, 2015, from Application No. 13/752,110 ("the '110 application") filed January 28, 2013. Ex. 1001, codes (45), (21), (22).

The '745 patent claims priority to a chain of ancestor patent applications, including Application No. 09/929,904 ("the '904 application"), filed on August 14, 2001, which issued as the '009 patent. Ex. 1001, code (60). The published version of the '904 application, US Pub. No. 2002/0078093 A1 (Ex. 1007 ("Samaniego")), is cited by Petitioner as prior art in three of the patentability challenges to the '745 patent claims. Pet. 6. We address the status of Samaniego as a printed publication in more detail below.

The '745 patent discloses an "automatic graphics delivery system that operates in parallel with an existing Web site infrastructure." Ex. 1001, 7:6–7. The system is described as "streamlin[ing] the post-production process by automating the production of media," requested by a user from a browser,

"through content generation procedures controlled by proprietary tags placed within URLs embedded within Web documents." Ex. 1001, 7:8–11. The disclosed system "automatically processes the URL encoded tags and automatically produces derivative media for the web site from the original media" which is available for viewing by a user. Ex. 1001, 7:13–16.

The '745 patent explains that the proprietary tags are used "to generate optimized media" by automated processing of the tags upon request of the media by a client. Ex. 1001, 5:65–6:1. This process, according to the '745 patent, reduces the "need for the Web author to create different versions of a Web site" for clients. Ex. 1001, 6:1–6:3. The '745 patent also discloses that "generated media is cached such that further requests for the same media require little overhead." Ex. 1001, 6:3–5.

An embodiment of the process described in the '745 patent is illustrated in Figure 21, reproduced below:

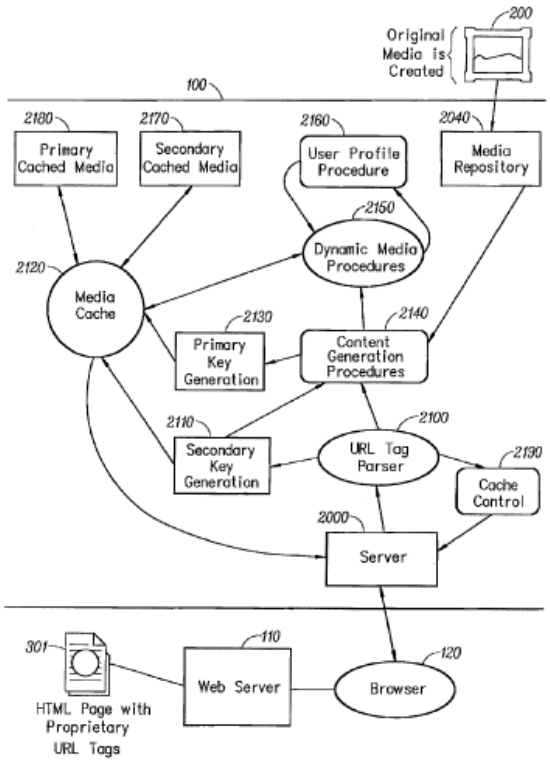

Figure 21, reproduced above, shows a flow chart of a process including delivery of an HTML web page with proprietary tags to browser 120, followed by the transfer of the delivered HTML web page from browser 120 to server 2000. Server 2000 is shown as being part of system 100. System 100 comprises URL tag parser 2100 for processing the proprietary tags. System 100 also comprises content generation procedures 2140 and dynamic media procedures 2150 that are performed on the media. Media cache 2120 is also part of system 100.

More specifically, with reference to Figure 21, a user through browser 120 makes a request to web server 110 for web page 301. Ex. 1001, 19:12–14. Web page 301 is labeled in Figure 21 as an "HTML Page with Proprietary URL Tags." The proprietary URL tags contain the information that direct browser 120 "to request the specified content generation procedure 2140 from the system 100 using input parameters specified with proprietary tags encoded within the URL." Ex. 1001, 19:9–12. The content generation procedures are performed on the media. Ex. 1001, 19:5–7. Browser 120 receives web page 301 with the proprietary tags and provides them to server 2000; the server is part of system 100. Ex. 1001, 19:14–15; Fig. 21. Thus, system 100 receives the proprietary tags specifying content generation procedure 2140 from a user.

System 100 comprises URL tag parser 2100 which parses the proprietary URL tags embedded in web page 301 that are sent to server 2000 "to determine the content generation procedure 2140 to execute, any corresponding input parameters to be used by such procedure, [and] any dynamic content processing 2150 to be performed by dynamic media procedures" on the media. Ex. 1001, 19:15–20. The '745 patent discloses

examples of the proprietary tags and commands used in these procedures, e.g., tags listed in Tables A and D (Ex. 1001, 10:27–46; 20:52–21:15), media processing script commands in Table B (*id.* at 10:51–15:20), and content creation commands in Table E (*id.* at 21:15–22:38).

The '745 patent further discloses that system 100 generates lookup key 2110 for the requested media. Ex. 1001, 19:23–24. When "intermediate content" is found in media cache 2120, "such media is passed directly to the dynamic media content system 2150 having dynamic media procedures, wherein appropriate action is taken to generate the required derivative from the intermediate media data." Ex. 1001, 19:30–35. However, when the intermediate content is not found, the '745 patent discloses that "such intermediate image is generated according to instructions specified by the content generation procedure, . . . and passed to the dynamic media system 2150," where "appropriate action is taken to generate the required derivative from the intermediate image data." Ex. 1001, 19:36–43.

The resulting media, after the dynamic processing is completed, is passed to a user profile system, appropriate modifications are made, and the media is cached and returned to the browser 120 for viewing by the user. Ex. 1001, 19:44–20:2.

E. Illustrative Claim

Claim 1 is only the only independent challenged claim. Claims 2–7 depend from claim 1. Claim 1 is reproduced below (bracketed numbering added from the Petition (Pet. vii–viii) and additional numbering added herein for clarity and reference to the specific limitations in the claim):

[1.pre] A method in a host computer for developing transformation processing operations to optimize media content playback to a plurality of playback devices connected with the host computer in a network, the method comprising:

[1.a] receiving a first request from a first playback device for media content;

[1.b] wherein the first request contains information, the information indicating a [1.b.i] first original media content, [1.b.ii] first content generation operations, and [1.b.iii] first transformation operations;

[1.c] determining whether a previously-generated first intermediate media content is available for reuse, the previously-generated first intermediate media content having been created using the first original media content and the first set of content generation operations; and

[1.d] responsive to determining that a previously-generated first intermediate media content is available, creating a first optimized media content for the first playback device by performing the first set of transformation operations on the previously-generated first intermediate media content; and

[1.e] responsive to determining that a previously-generated first intermediate media content is not available, creating a first optimized media content for the first playback device by creating a first intermediate content using the first original media content and the first set of content generation operations, and performing the first set of transformation operations on the first intermediate media content; and

[1.f] sending the first optimized media content to the first playback device.

F. Evidence

The following evidence of unpatentability submitted by Petitioner is relied on in this decision:

Evidence	Exhibit No.
Barger et al., US 9,158,745 B2, issued Oct. 13, 2015 ("the '745 patent")	1001
Declaration of Vijay K. Madisetti ("Madisetti Declaration")	1003
Tso et al., US 6,421,733 B1, issued July 16, 2002 ("Tso")	1004
Huang et al., US 6,438,576 B1, issued Aug. 20, 2002 ("Huang")	1005
Lawler, US 5,905,522, issued May 18, 1999 ("Lawler")	1006
Samaniego et al., US 2002/0078093 A1, published Jun. 20, 2002 ("Samaniego")	1007

G. Asserted Grounds

Petitioner asserts that the challenged claims are unpatentable based on the following grounds (Pet. 6):

Claim(s) Challenged	35 U.S.C. §[1]	Reference(s)/Basis
1–5	103	Tso in view of Huang
6, 7	103	Tso in view of Huang, Lawler
1–7	102/103	Samaniego
2–4	103	Samaniego in view of Tso
6, 7	103	Samaniego in view of Lawler

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102 and 103. Because the '745 patent has an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA version of § 103.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Citing the testimony of Petitioner's declarant, Dr. Vijay Madisetti, Petitioner argues that a person of ordinary skill in the art ("POSITA") would have had "a bachelor's degree in computer systems, computer science, or the equivalent thereof, and at least two years of experience with networked media delivery or related technologies." Pet. 10 (citing Ex. 1003 ¶¶ 45–46, 48–49). Patent Owner does not dispute Petitioner's statement of the level of ordinary skill in the art. Prelim. Resp. 8.

Petitioner's definition of a POSITA is consistent with the level of skill disclosed in the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). We therefore adopt Petitioner's definition for the purpose of this Decision.

B. Claim Construction

In an *inter partes* review proceeding, a patent claim is construed using the same standard applied in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of the claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b).

Petitioner requests that we construe the "content generation operations" recited in limitations [1.b], [1.c], and [1.e] of claim 1 to encompass the "content creation commands" disclosed in the '745 patent, e.g., "converting media to a specified type/bit-depth, scaling to a specified size, and saving to a specified file." Pet. 11 (citing Ex. 1001, 21:16–22:39).

Petitioner also requests we construe the "transformation operations" recited in claim limitations [1.b], [1.d], and [1.e] to encompass the disclosed "media processing script commands," for example, "SetResolution" and "Colorize." Pet. 11–12 (citing Ex. 1001, 10:27–15:20). Petitioner cites the Madisetti Declaration to support its claim construction. Ex. 1003 ¶¶ 55–59.

Petitioner's construction of "content generation operations" and "transformation operations" are not disputed by Patent Owner. Prelim. Resp. 9.

As held in *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999), only those terms that are "in controversy, and only to the extent necessary to resolve the controversy," need to be construed. *See also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (applying *Vivid* to *inter partes* reviews). Here, a construction of "content generation operations" and "transformation operations" is not necessary to resolve the unpatentability issues before us. Consequently, we do not address Petitioner's proffered claim constructions.

C. Ground 1 based on Tso and Huang; Ground 2 based on Tso, Huang, and Lawler

Petitioner argues that claims 1–5 would have been obvious to one of ordinary skill in the art based on Tso and Huang (Ground 1) and claims 6 and 7 would have been obvious based on Tso, Huang, and Lawler (Ground 2). Pet. 6. Patent Owner disputes Petitioner's arguments. Prelim. Resp. 32–40.

1. Tso (Ex. 1004)

We begin the analysis with a discussion of Tso.

A network client in Tso makes a request for a hypertext object. Ex. 1004, 9:56–58. Tso describes a network client comprising a browser that communicates with a transcoding server comprising transcoding software. This configuration is illustrated in Figure 3 of Tso, reproduced below:

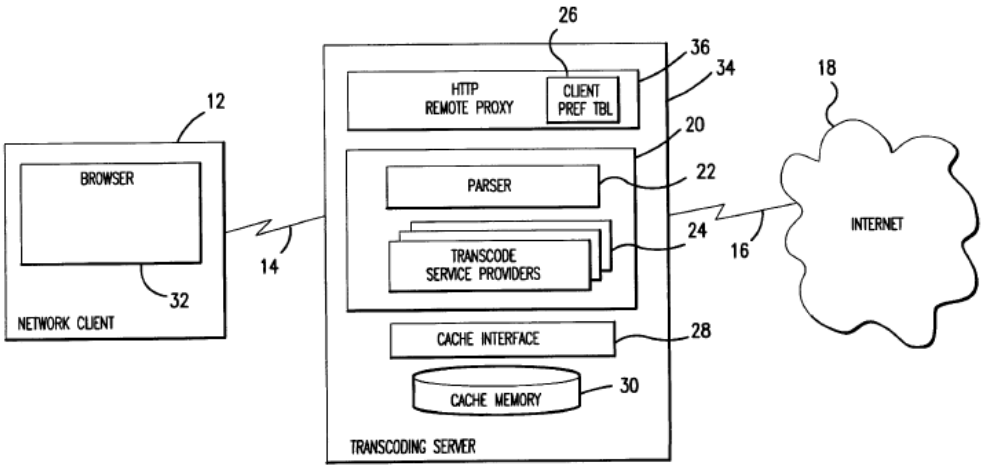

Figure 3 of Tso is reproduced above. Figure 3 is a block diagram showing the network client, transcoding server, and internet. Each element is labeled with a number, 12 is the network client, 34 is the transcoding server, 20 is the transcoder, 22 is the parser, 24 is the transcode server providers, and 16 is the server/network communications link from transcoding server 34 to internet 18. Figure 3 shows network client 12 communicating with transcoding server 34, and transcoding server 34 communicating with internet 18. The discussion below references Figure 3.

The transcoding software in Tso's system comprises transcoder 20 which includes parser 22 and transcode service providers 24. Ex. 1004, 3:7–11.

Parser 22 of transcoder 20 "is configured to act upon data received by transcoder 20, such as a request for a network object generated by a client device [12] or a reply to such a request provided by a content server device."

Ex. 1004, 3:11–14. Parser 22 "is responsible for selectively invoking one or more of transcode service providers 24 based upon a predetermined selection criterion."[2] Ex. 1004, 3:14–16. The transcode service provider 24 "selectively transcode[s] content based on a predetermined selection criterion." Ex. 1004, 3:48–51. Transcode service provider 24 can compress and scale different types of content, and "provide a wide variety of transcoding functions." Ex. 1004, 3:51–65.

The system further comprises HTTP proxy server 36 which accesses the internet through communication link 16. Ex. 1004, 3:31–33. When network client 12 requests a hypertext object, HTTP proxy server 36 first attempts to retrieve the object from parser 22. Ex. 1004, 6:24–28. If the object is not found by parser 22, parser 22 creates an entry which is returned to HTTP proxy server 36. Ex. 1004, 6:28–31. HTTP proxy server 36 requests the object from internet 18. Ex. 1004, 6:31–33. "As a data stream for the hypertext object is returned, HTTP remote proxy 36 calls parser 22" and passes the data stream to the parser. Ex. 1004, 6:33–37. "Parser 22 selects an appropriate transcode service provider 24 based, for example, on the content type of the data stream." Ex. 1004, 6:37–39. Transcode service provider 24 subsequently provides the transcoding functions to the incoming data stream. Ex. 1004, 3:42–44, 63–65.

"The parser [22] is configured to selectively invoke the transcode service provider in response to a predetermined selection criterion." Ex.

[2] Tso uses the singular form "criterion" throughout its disclosure, despite grammatically treating it in some instances as the plural form of the word. We use the term "criterion" as the singular form and "criteria" as the plural form.

1004, 2:16–18; *see also* Ex. 1004, 3:14–16, 6:64–66 ("parser 22 may selectively invoke one of transcode service providers 24 based upon satisfaction of a predetermined selection criterion."). The selection criteria may comprise information "contained in a header portion of a data packet received by transcoding server 34." Ex. 1004, 6:67–7:2. The "predetermined selection criterion" may alternatively "comprise information contained in a data portion of such a data packet." Ex. 1004, 7:4–6. The "predetermined selection criterion may comprise a condition of the device on which transcoding server 34 is installed." Ex. 1004, 7:8–9. Tso lists nine examples of predetermined selection criteria. Ex. 1004, 7:20–8:9.

2. Petitioner's proposed ground

We now turn to Petitioner's proposed ground of unpatentability based on Tso and Huang.

The first step [1.a] of claim 1 recites "receiving a first request from a first playback device for media content." Petitioner asserts that the "Network client" 12 of Tso teaches the claimed "playback device." Pet. 24 (emphases omitted) (Petitioner-annotated version of Fig. 3 of Ex. 1004). Petitioner identifies the disclosure in Tso of a "Network client 12, via browser 32" that "transmits an HTTP request for the hypertext object to transcoding server 34 over client/server communications link 14" (Ex. 1004, 9:45–65) as teaching the claim limitation. Pet. 23–24; *see also id.* at 24 (citing Ex. 1004, 3:12–13 ("request for a network object generated by a client device"), Fig. 5 (showing "Network Client" 12 comprising "Browser" which sends HTTP requests to the internet via a transcoding server)).

Step [1.b] of the claim recites "wherein the first request contains information, the information indicating a [1.bi] first original media content, [1.bii] first content generation operations, and [1.biii] first transformation operations." Thus, the information in the request from the playback device must indicate these three different items. Petitioner contends that a request "packet" from the network client in Tso contains information indicating all three pieces of information. Pet. 24 (citing Ex. 1004, 6:64–7:14).

Petitioner identifies the following disclosures from Tso as meeting the claimed "information" requirements of the claim (Pet. 24–25):

[1.b.i] the "media content," which is Tso's "requested hypertext object" (Ex. 1004, 10:25–27);

[1.b.ii] the "first content generation operations," which are Tso's "content characteristics," specifying "data type, type of encoding/compression" or "size" (Ex. 1004, 7:31–33); and

[1.b.iii] the "first transformation operations," which are Tso's "network client" properties, "content characteristics" specifying "number of colors," "resolution," and "content provider preferences" including "degree of alteration desired for its content" (Ex. 1004, 7:21–22, 60–62).

The Madisetti Declaration is cited by Petitioner to support the correspondence between Tso's disclosure of predetermined selection criteria and content generation operations. *See* Ex. 1003 ¶¶ 90–94. Dr. Madisetti testified that a person of ordinary skill in the art "would have understood" Tso's "content characteristics" to include "for example, 'data type, type of encoding/compression,' and 'size.'" Ex. 1003 ¶ 93 (citing Ex. 1004, 7:15–8:9). Dr. Madisetti testified "that these types of characteristics specify content generation operations that are consistent with, for example, the

'save' and 'scale' content generation operations described in Table E of the '745 patent" and that the operations "allow saving media to a 'specified file' and scaling media to a 'specified size.'" Ex. 1003 ¶ 93 (citing Ex. 1001, 21:20–22:38.

Dr. Madisetti testified that a person of ordinary skill in the art would have understood Tso's "'client' characteristics such as a 'number of colors,' additional 'content characteristics' such as 'encoding/compression' or 'resolution,' and 'content provider preferences' including, for example, 'the degree of alteration desired for its content'" to serve as the claimed transformation operations, such as the media processing script commands disclosed in the '745 patent. Ex. 1003 ¶ 94 (citing Ex. 1004, 7:20–8:4; Ex. 1001, 7:20–8.4); *see also* Pet. 25 n.5.

To address the requirement in the claim that the "information" in [1.b] is received from the playback device, Petitioner relies on the disclosure in Tso that the predetermined selection criteria are stored in a "request packet." Pet. 24–25 (citing Ex. 1004, 6:64–7:14; 7:15–8:9). Dr. Madisetti specifically testified, also citing Ex. 1004, 6:64–8:9, that "[t]he 'request packet' *sent by the client* carries 'information' in both its 'header' and 'data portion[s]' that includes 'selection criterion,' which is used to specify what transcoding should be applied to the content." Ex. 1003 ¶ 66 (emphasis added); *see also* Ex. 1003 ¶ 36.

Step [1.c] of claim 1 recites "determining whether a previously-generated first intermediate media content is available for reuse, the previously-generated first intermediate media content having been created using the first original media content and the first set of content generation operations." For this limitation, Petitioner cites Tso's disclosure of a

"GetScaledObject()" call by a server to determine "if the requested version of the content is cached. Tso, 14:25-30."[3] Pet. 15. "If so," Petitioner explains, Tso teaches that "the content is retrieved and returned to the client. Tso 14:30-32." Pet. 15. "The GetScaledObject () call is . . . used to request an object from server-side cache memory 30." Ex. 1004, 6:9–13. Petitioner cites Tso's teaching that the server-side cache stores "both original and transcoded versions of content for later transmission to network client 12 without the need to re-retrieve the content from Internet 18 or to re-transcode the content." Ex. 1004, 4:1–5 (as cited in Pet. 27). Thus, Petitioner asserts that the availability of media for "reuse" in step [1.c] corresponds to the use of media cached in the server-side cache of Tso.

To meet limitation [1.c] of claim 1 that "the previously-generated first intermediate media content having been created using the first original media content and the first set of content generation operations," Petitioner argues that Tso teaches "each server creates and receives partially-transcoded content, and caches transcoded versions of content." Pet. 27 (citing Ex. 1004, 4:1–5, 5:36–41, 14:47–15:6, 15:66–16:14). Petitioner contends that "a POSITA would have understood that a server responsible for performing only a partial transcoding caches that partially-transcoded version of content." Pet. 27 (citing Ex. 1003 ¶ 99). Petitioner also contends that Tso is "agnostic" about the order in which transcoding steps are performed, making it obvious to perform content generation operations

[3] Ex. 1004, 14:26–30: "GetScaledObject [[00bf] [00a8] call to server-side cache interface 28 to determine whether a non-transcoded version of the requested hypertext object already exists in the server-side cache memory 30 (Step 170)."

before additional transcoding operations are performed on the media content. Pet. 27 (citing Ex. 1003 ¶ 100).

Petitioner further cites disclosure in Huang for [1.c] of "determining whether a previously-generated first intermediate media content is available for reuse." Pet. 29–30 (emphasis omitted). Specifically, Petitioner argues that after a request for an object is made, the proxy server in Huang searches for a sufficiently "detailed" cached version of the content for the request. Pet. 17 (citing Ex. 1005, 7:23–36). If one is found, Petitioner argues that Huang discloses that the server performs any additional needed rendering, and then caches and returns the rendered content. Pet. 17 (citing Ex. 1005, 7:53–8:11; Ex. 1003 ¶ 76). Again, Petitioner analogizes the "reuse" in the claim with searching for cache versions of the media content.

Petitioner also asserts that Huang discloses the second part of [1.c] that "the previously-generated first intermediate media content having been created using the first original media content and the first set of content generation operations." Pet. 29–30 (emphasis omitted). Petitioner relies on Huang's disclosure of a "partially-rendered" object in cache (Ex. 1005, 6:63–67) which Huang teaches can be further processed by completing "the entire rendering process" based on "RHI" (receiver hint information) (Ex. 1005, 6:12) stored with the content. Pet. 17, 29–30 (further citing Ex. 1005, 7:42–8:11). Petitioner's position is apparently that the partial-rendering of an object using only one of two sets of rendering operations indicates that the partial rendered copy was made using only the first set of content generation operations as required by [1.c] of the claim.

Petitioner asserts that it would have been obvious to apply Huang's teaching about caching partially-coded content to Tso "to advantageously

avoid re-retrieval and re-transcoding as previously performed on partially-transcoded content, and perform transcoding steps in an order that improves the efficiency of the system, advantageously streamlining content generation." Pet. 30. Petitioner argues that it would have been obvious "to use Tso's GetScaledObject() and GetProperties() calls to retrieve and check the transcoding status of a cached copy of content, including determining previously-performed transcoding/rendering steps, before further transcoding content using that partially-transcoded version instead of re-retrieving and re-transcoding original content" as described in Huang. Pet. 30.

In step [1.d] of claim 1, "responsive to determining that a previously-generated first intermediate media content is available," "a first optimized media content for the first playback device" is created "by performing the first set of transformation operations on the previously-generated first intermediate media content." Huang is argued by Petitioner to describe this limitation of the claim. Pet. 32–33 (citing Ex. 1005, 6:9–23).

Petitioner asserts that Huang's teaching of completing rendering on a partially rendered object makes limitation [1.d] obvious to one of ordinary skill in the art when applied to Tso's disclosure of performing transformation operations. Pet. 33 (citing Ex. 1003 ¶¶ 104–107).

Claim 1 additionally recites [1.e] "creating a first optimized media content for the first playback device by creating a first intermediate content using the first original media content and the first set of content generation operations" "responsive to determining that a previously-generated first intermediate media content is *not* available." (Emphasis added.)

Petitioner identifies Figure 8 of Tso as disclosing "responsive to determining that a previously-generated first intermediate media content is *not* available." Pet. 34 (emphasis added) (reproducing Figure 8 of Tso showing "OBJECT IN CACHE" with a choice of "Y" or "NO," i.e., "not available."). Petitioner asserts that Tso, after finding that the intermediate content is not available, creates "a first intermediate content using the first original media content and the first set of content generation operations." Pet. 34 (citing Ex. 1004, 10:24–49).

Petitioner also argues that Huang describes limitation [1.e]. Pet. 35. Petitioner points to the disclosure in Huang that "[i]f the requested object cannot be found in the cache, . . . the proxy server . . . modifies the associated RHI to indicate its ability for providing rendering services and then sends the request and the modified RHI to another proxy server or to the content server." Pet. 35–36 (citing Ex. 1005, 7:36–41; Ex. 1003 ¶¶ 110–112) (emphases omitted). Petitioner asserts it would have been obvious to modify Tso with Huang's teaching "to advantageously cache the 'partial' transcoding output from each of the transcode service providers . . . in order to 'avoid repeating' transcoding steps." Pet. 35 (citing Ex, 1005, 6:63–67).

The last step of claim 1 is "[1.f] sending the first optimized media content to the first playback device." Petitioner cites Tso as disclosing this limitation ("HTTP remote proxy 36 transmits a data stream for the transcoded hypertext object to network client 12 (Step 260)." Pet. 36 (citing Ex. 1004, 6:55–57).

3. Patent Owner's arguments

Patent Owner asserts that Petitioner fails to demonstrate a reasonable

likelihood that Tso discloses limitation [1.b] of independent claim 1 of "wherein the first request," which is [1.a] received from "a first playback device," "contains information, the information indicating . . . [1.bii] first content generation operations." Prelim. Resp. 35. Generally, Patent Owner does not dispute Petitioner's mapping of the claim limitations to Tso and Huang nor the reason to combine the references. However, while Patent Owner does not disagree with Petitioner's mapping of the claimed [1.b.ii] "content generation operations" to certain of Tso's "content characteristics," Patent Owner argues that Petitioner "fails to show that Tso's transcoding server 34 receives Tso's content characteristics from Tso's network client 12," where network client 12 serves as the claimed playback device. Prelim. Resp. 36 (emphasis omitted).

Patent Owner argues that "neither Petitioner nor Dr. Madisetti provides any explanation or support for their position that Tso's transcoding server 34" receives a "request packet" from the network client 12. Prelim. Resp. 39 (citing Pet. 24–25; Ex. 1003 ¶¶ 91–92). Patent Owner asserts that neither Petitioner nor Dr. Madisetti explain "why a POSITA would have understood that the content characteristics are received from the network client 12 despite Tso's express and contrary teachings that such information is received from the internet 18." Prelim. Resp. 39 (citing Ex. 1004, 10:32–44). Because Petitioner contends that the network server 12 corresponds to the claimed playback device and the playback device is required by the claim to originate the first request and the information [1.b] in it ("a first request from a first playback device"), Patent Owner asserts that because network server 12 in Tso does not originate the content characteristics (the claimed "content generation operations"), Petitioner has not established a

reasonable likelihood that it will prevail in the challenge based on Grounds 1 and 2.

4. Discussion

Patent Owner argues, as indicated above, that the patentability challenge should be denied because Tso does not describe the "information" [1.b.ii] contained in the "first request" as being from the "first playback device" as required by claim 1, but instead discloses that the information [1.b.ii] is received from the "Internet 18." Prelim. Resp. 36–37. Petitioner maps the "information" in [1.b] of claim 1 to the "predetermined selection criterion" disclosed by Tso. Pet. 24–25. Consequently, we must turn to the discussion of the "predetermined selection criterion" by Tso.

It is correct, as testified by Dr. Madisetti (Ex. 1003 ¶¶ 66, 91, 92), that Tso discloses predetermined "selection criterion may comprise, for example information contained in . . . a data packet received by transcoding server 34." Ex. 1004, 6:66–7:2. However, contrary to Dr. Madisetti's testimony,[4] the cited disclosure in Tso does not identify the sender of the packet as the network client 12 nor does Tso state that any of the nine disclosed predetermined selection criteria are contained in a data packet. Dr. Madisetti's statement is conclusory, omitting any reasoning as to why one of ordinary skill in the art would have concluded that the "content characteristics" are received in a data packet from the network client 12, when such information is not explicitly stated in the portion of Tso

[4] "The 'request packet' *sent by the client* carries 'information' in both its 'header' and 'data portion[s]' that includes 'selection criterion,' which is used to specify what transcoding should be applied to the content. Tso, 6:64-8:9." Ex. 1003 ¶ 66 (emphasis added) (footnote omitted).

referenced by Dr. Madisetti. We do not accord weight to conclusory expert testimony. *See TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359 n.5, 1360 (Fed. Cir. 2019).

The "predetermined selection criterion" (the asserted "information" of step [1.b]) is described by Tso as being used by the parser 22 to "selectively invoke the transcode service provider." Ex. 1004, 2:16–18. Tso lists nine examples of the criteria. Ex. 1004, 7:20–8:9. Tso discloses that a selection criterion can comprise information in the header of a *data packet* received by transcoding server 34. Ex. 1004, 6:66–7:3. But in this section Tso does not disclose the source of the data packet. Petitioner asserts it comes from the network client 12. Patent Owner's argument is that it comes from the internet. Prelim. Resp. 36–37 (citing Ex. 1004, 9:49–10:49). To address this issue, we revisit the architecture of Tso's system.

Tso discloses a transcoding server 34 which includes HTTP proxy server 36, parser 22, and transcode service providers 24. Tso, Fig. 3 (reproduced above). Tso teaches "[n]etwork client 12, via browser 32, transmits an HTTP request for the hypertext object to transcoding server 34 over client/server communications link 14." Ex. 1004, 9:54–56. The request is passed to the internet 18 by HTTP remote proxy 36. Ex. 1004, 3:31–34; 9:56–60. When a requested hypertext object is found on internet 18, "HTTP remote proxy 36 begins receiving an HTTP data stream [from internet 18] representing the hypertext object. HTTP remote proxy 36 passes the handle for this incoming data stream to parser 22." Ex. 1004, 10:32–36. Parser 22, which is part of the transcoding server 34, "dynamically determines whether the data stream satisfies any applicable *predetermined selection criteria.*" Ex. 1004, 10:37–38 (emphasis added). Parser 22 makes this determination

"by interrogating a MIME type in the content-type header record that appears at the beginning of the incoming HTTP data stream." Ex. 1004, 10:40–44. "If parser 22 detects a match for a predetermined selection criterion, the HTTP stream handle is given to the appropriate transcode service provider 24." Ex. 1004, 10:44–47. The transcode service provider 24 "then transcodes the data stream appropriately, and HTTP remote proxy 26 transmits the transcoded data stream to network client 12." Ex. 1004, 10:47–49.

Thus, Tso discloses that parser 22 determines whether the HTTP data stream from internet 18 satisfies a predetermined selection criterion, consistent with Patent Owner's contention that the criterion comes from the internet. When parser 22 interrogates the header of a data packet from the HTTP object (i.e., the "media" of claim 1) obtained from the internet, the parser determines whether the "content characteristics" in the packet header match any of the predetermined criteria. *See* Ex. 1004, 10:40–44. But none of this disclosure, as argued by Patent Owner, teaches that the predetermined selection criteria are received in a media request from the playback device as required by claim 1.

We return to the disclosure in Tso at column 6, line 64 to column 7, line 2, cited by Petitioner as teaching the claimed "[1.a] receiving a first request from a first playback device for media content; [1.b] wherein the first request contains information, the information indicating . . . [1.b.ii] first content generation operations." *See* Pet. 13, 24.[5]

[5] "Tso also discloses that request packets 'selection criteri[a]' specifying the 'particular content' requested and transcoding parameters used by a server's 'parser" to "selectively invoke' one or more 'transcode service providers.'

The pertinent disclosure from Tso is copied below:

> As noted above, parser 22 may selectively invoke one of transcode service providers 24 based upon satisfaction of a predetermined selection criterion. Such selection criterion may comprise, for example, information contained in a header portion of a *data packet* received by transcoding server 34, such as a MIME type, a URL (Uniform Resource Locator), a last modified time indicator and so on.

Ex. 1004, 6:64–7:3 (emphasis added).

Patent Owner's argument appears to be that the "data packet" described by Tso at column 6, line 64 to column 7, line 3, is a reference to the process described at column 10, lines 40–44, in which parser 22 interrogates the HTTP data stream packets for the predetermined selection criteria. Prelim. Resp. 38–39. Patent Owner's contention that the "predetermined selection criterion" are received by parser 22 from internet 18 in Tso's example at column 10, lines 27–38, is supported by the evidence. Petitioner does not identify disclosure in Tso of where the parser, or any other component of Tso's system, receives the selection criteria in a request for media by a user browser. In particular, Petitioner does not identify a specific teaching in Tso of where the parser receives the media's "(3) content characteristics, such as its data type, type of encoding/compression, size, and dimension" (Ex. 1004, 7:31–33) which Petitioner asserts corresponds to the claimed "first content generation operations" contained in the first request sent by the recited playback device. Pet. 24–25.

Tso, 6:64-7:14."

Petitioner contends that [1.b.ii] "first content generation operations," such as the "content characteristics," are received from a first playback device, but as asserted by Patent Owner, Tso identifies these characteristics as coming from data packet stream from the internet and received by the parser. Because Petitioner did not identify receiving a first request from a playback device comprising limitation [1.b.ii] "first content generation operations," the evidence before us does not support a reasonable likelihood that Petitioner will prevail in their challenge to claims 1–5 based on Tso and Huang.

The additionally cited Lawler (Ex. 1006), as making claims 6 and 7 obvious in combination with Tso and Huang, is not asserted by Petitioner to describe a first request from a playback device comprising limitation [1.b.ii] "first content generation operations" as recited in claim 1. Pet. 40–41. Consequently, the evidence also does not support a reasonable likelihood that Petitioner will prevail in their challenge to claims 6 and 7 based on Tso, Huang, and Lawler.

D. Grounds 3 and 4 based on Samaniego; Ground 4 based on Samaniego and Tso; Ground 5 based on Samaniego and Tso; Ground 6 based on Samaniego and Lawler

The '745 patent claims priority to a chain of continuation and divisional applications, including the '904 application, filed on August 14, 2001. Ex. 1001, code (60). The '904 application subsequently issued as the '009 patent. The '904 application was published on June 20, 2002 as U.S. Pub. No. 2002/0078093 A1 ("Samaniego"). Ex. 1007, code (10), (43). In Grounds 3 and 4, Samaniego is cited by Petitioner as section 102(b) prior art to the '745 patent. Pet. 49–68.

In the Petition, Petitioner argues that claim 1 of the '745 patent is not entitled to the priority date of the '904 application or its ancestor because none of the '745 patent's named inventors are "name[d] . . . in the previously filed application[s]," a requirement of 35 U.S.C. § 120 to claim the benefit of the filing date of an earlier filed application. Pet. 5–6. Based on this reasoning, Petitioner asserts that the earliest filing date that the '745 patent can be accorded is November 7, 2005 when Application No. 11/269,916,[6] which shares common inventors with the '745 patent, was filed. Pet. 2. Samaniego was published June 20, 2002, more than two years before that November 7, 2005 filing date and, therefore, according to Petitioner, is 35 U.S.C. § 102(b) prior art to the '745 patent. Pet. 2. Consequently, Petitioner challenges the patentability of claims 1–7 as anticipated or obvious in view of Samaniego, claims 2–4 as obvious in view of Samaniego and Tso, and claims 6 and 7 as obvious in view of Samaniego and Lawler. Pet. 49–68.

Petitioner asserts that Patent Owner cannot dispute that Samaniego discloses the subject matter of challenged claims 1–7 because the specifications of the '745 patent and Samaniego "are substantively identical." Pet. 49 (citing Ex. 1013 (Petitioner's redline comparison between the specifications of the '745 patent and Samaniego, showing substantial identity). Petitioner also asserts that Patent Owner is estopped from disputing that Samaniego discloses the claimed subject matter because the Examiner found support for it in Samaniego. Pet. 49 (citing Ex. 1002, 165; Ex. 1003 ¶ 178). Patent Owner acknowledges that the specifications of the '745 patent and Samaniego are substantively identical and admits there is

[6] Application No. 11/269,916 is listed as a "continuation-in-part" of the '904 application. Ex. 1001, code (60).

written description support in Samaniego for the '745 patent claims. Prelim. Resp. 10.

Patent Owner responds in the Preliminary Response that Petitioner's argument that Samaniego is prior art is moot because a petition was filed under 37 C.F.R. § 1.324 to correct the inventorship of the '009 patent by adding Sean Barger as a co-inventor. Prelim. Resp. 10–11 (citing Ex. 2003). Mr. Barger is also listed as a co-inventor of the '745 patent and, therefore, Patent Owner asserts all the requirements under 35 U.S.C. § 120 for getting the benefit of an earlier filing date are met. Prelim. Resp. 9. Patent Owner thus asserts that the inventorship correction to the '009 patent cures the 35 U.S.C. § 120 defect in the '745 patent's priority claim. Petitioner, however, disputes the propriety and effect on the '745 patent of the inventorship correction. Prelim. Reply Br. 1. We thus first turn to 35 U.S.C. § 256, which authorizes correction of the named inventor(s) of an issued patent.

Under section 256(a), "[w]henever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may . . . issue a certificate correcting such error." The requirements to correct inventorship under 35 U.S.C. § 256(a) are listed in 37 C.F.R. § 1.324. Patent Owner filed a petition pursuant to section 1.324(b) to correct the inventorship of the '009 patent by adding Sean Barger as a named inventor. The petition was filed on April 3, 2023, approximately three months after the filing date of this Petition. Ex. 2003, 3. The section 1.324(b) petition was granted (Ex. 2012). A Certificate of Correction correcting inventorship was approved (Ex. 2013) and subsequently entered in the '009 patent on June 13, 2023, adding the name of Sean Barger as a co-inventor of the '009 patent. Ex. 2014.

Petitioner argues in the Preliminary Reply Brief that section 256 "limits its effects to only inventorship errors in the patent being corrected." Prelim. Reply Br. 1. Petitioner, in support of this argument, asserts that Section 256 is "a savings provision" to avoid invalidity under section 102(f)[7] of the patent in which correction is sought. Prelim. Reply Br. 2 (citing *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998)). Petitioner further asserts that any retroactive effect of a Certificate of Correction under section 256 must be authorized by Congress. Prelim. Reply Br. 2. Petitioner contends that a Certification of Correction, as expressly stated in sections 254 and 255, has only a prospective effect on "the trial of actions for causes thereafter arising" after the Certificate of Correction has issued. Prelim. Reply Br. 2–3. In addition, Petitioner argues that section 256(b) expressly refers to correcting an inventorship in the patent "in which such error occurred" and therefore restricts the correction to "errors of inventorship implicating §102(f)" in the patent in which the inventorship error occurred. Prelim. Reply Br. 3. Thus, Petitioner's principal argument is that the inventorship correction to the '009 patent cannot be applied retroactively in this proceeding to cure the section 120 defect in the '745 patent's priority claim to the filing date of the '009 patent. *Id.* at 1.

Patent Owner argues that "[n]othing in the statute indicates that the effect of [inventorship] corrections are limited solely to the patent being corrected." Prelim. Sur-reply 1–2. Patent Owner asserts that Petitioner is reading a "prospective" requirement into section 256 which is not there.

[7] 35 U.S.C. § 102(f) (pre-AIA) states that "A person shall be entitled to a patent unless – . . . [the person] did not . . . invent the subject matter sought to be patented."

Prelim. Sur-reply 2. To support this position, Patent Owner cites *Viskase Corp. v. Am. Nat'l Can Co.*, 261 F.3d 1316, 1329 (Fed. Cir. 2001) which held "[a]bsent fraud or deceptive intent, the correction of inventorship does not affect the validity or enforceability of the patent for the period before the correction." Prelim. Sur-reply 3. Thus, Patent Owner argues retroactive effect is given to a Certificate of Correction correcting inventorship under section 256. Prelim. Sur-reply 3.

To begin, the language of section 256 indicates that a certificate of correction issued pursuant to the statute is applied retroactively to the patent in which the correction is made. *See Roche Palo Alto LLC v. Ranbaxy Labs. Ltd.*, 551 F. Supp. 2d 349, 358 (D.N.J. 2008).[8] Section 256(b) expressly states that "[t]he error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section." This statutory language has been interpreted to mean that, despite an initial error being made in the naming of the inventor(s), once this error has been corrected, it is as if the patent was valid from the beginning and the defect in inventorship had never happened. *See Viskase*, 261 F.3d at 1329; *see also Emerson Electronic Co. v. Sipco LLC*, IPR2016-00984, Paper 52 at 11–21 (PTAB January 24, 2020) (Decision on Remand) (distinguishing the retroactive effect of section 256 from sections 254 and 255 which are prospective).

Next, we must consider whether the correction to the inventorship of the '009 patent can retroactively correct the '745 patent's priority claim to

[8] "[T]here are many federal cases that have given retrospective effect to a Certificate of Correction when it regards correction of inventorship, albeit all of these cases involve petitions under Section 256."

the '009 patent under 35 U.S.C. § 120. If so, Samaniego would no longer be available as prior art because the '745 patent would then have an inventor in common with the '009 patent and the '904 application from which it issued and upon which Samaniego is based.

We begin with 35 U.S.C. § 256. According to *Merry Mfg. Co. v. Burns Tool Co.*, 206 F. Supp. 53, 58 (N.D. Ga 1962), *aff'd.*, 335 F.2d 239 (5th Cir. 1964), "Section 256 of Title 35 of the United States Code is a codification of the law as it was established by the Court of Appeals for the District of Columbia [in] *In re Roberts*, 49 App.D.C. 250, 263 F. 646." (Emphasis added).

In re Roberts, 263 F. 646 (D.C. Cir. 1920) was an appeal from a decision of the Patent Office "refusing to treat" an application by sole inventor Roberts "as a continuation of a joint application embracing the same subject-matter, theretofore filed by appellant [Roberts] and another [Roberts' son] under a mistake of fact." *Roberts*, 263 F. at 646.[9] In an interference between the application of Bruckman and the joint application of Roberts and his son, it was discovered that Roberts' son was not an inventor of the joint application and priority was awarded to Bruckman. *Roberts*, 263 F. at 646–647. "[T]he Patent Office declined to consider the present application [by Roberts alone] as a continuation of the former joint application, the result being that the Bruckman patent, having issued more than two years prior to the filing of the present application, became a statutory bar to its allowance." *Roberts*, 263 F. at 647. The question framed by the D.C. Court of Appeals was "whether, in a case like the present, where

[9] We recognize that the statutes in place when *Roberts* was decided are not the same as they were when the '009 and '745 patents were filed.

it appears that a joint application has been filed through mistake or inadvertence and without fraudulent intent, the sole inventor, one of the joint applicants, is estopped from taking any advantage of that application." *Roberts*, 263 F. at 647. On this question, the court held:

> All that was sought in the new application [by Roberts alone] was the elimination of one of the joint applicants, to whom credit mistakenly had been given for the particular invention involved. There was identity of subject-matter, and it is difficult to perceive any reason for not permitting the rectification of such a mistake by an amendment eliminating the superfluous applicant.

Roberts, 263 F. at 648.

The court therefore concluded that the "second application" by Roberts as sole inventor was "filed merely to correct a formal error" in the first application, and thus properly could be given benefit of the first application. *Roberts*, 263 F. at 648–49. The court further explained:

> To prevent a possible failure of justice, the present application should have been considered as a continuation of the abortive application. As already suggested, we perceive no reason why the mistake could not have been rectified by a simple amendment, but in any event the sole inventor should not be deprived of his day in court by the raising of artificial barriers against him. He claimed his invention, and, through mistake, gave his son credit where no credit was due. The elimination of the son ought not to deprive the father, the sole inventor, of the benefit of his original application; and we so rule.

Roberts, 263 F. at 649.

In re Schmidt, 293 F.2d 274 (CCPA 1961) involved the impact that an inventorship correction in an earlier-filed application, pursuant to 35 U.S.C. § 116, had on a later-filed continuation application that sought to claim

benefit under 35 U.S.C. § 120[10] to the filing date of the earlier, corrected application. *Schmidt* considered sections 116 and 256 parallel for inventorship correction purposes and held that "the same inventor" as used in section 120 "embraces the possibility permitted by sections 116 and 256 that the earlier application may be corrected thereunder by changes in the name or names of the applicants under the conditions stated in section 116." *Schmidt*, 293 F.2d at 279. A patent was removed as prior art when *Schmidt* held "that appellant was entitled under section 116 to correct the errors in the intermediate application filed in the names of joint inventors and under section 120 was entitled as 'the same inventor' to the benefits of the filing dates of the earlier co-pending applications." *Schmidt*, 293 F.2d at 279. *Schmidt* cited *Roberts* as approving this practice. *Schmidt*, 293 F.2d at 279; *see also Weil v. Fritz*, 572 F.2d 856, 863 (CCPA 1978) (stating that *Schmidt* was correctly decided).

While the statutes at the time *Schmidt* and *Roberts* were decided are different from those in place when the '745 and '009 patents were filed, the legal principles reflected in these cases suggest that the inventorship correction to the '009 patent can be applied retroactively to cure the defect in the '745 patent's section 120 priority claim. Specifically, in *Roberts*, the subsequently-filed patent application by Roberts alone was given benefit of the previously-filed first patent application to Roberts and son, despite the error in naming the son as a co-inventor in the first application. Similarly,

[10] *Schmidt* involved an interpretation of the statutory language of 35 U.S.C. § 120 requiring that the continuing application for which benefit of the earlier application is sought must be filed by "the same inventor." *Schmidt*, 293 F.2d at 277. Section 120 has since been amended and no longer contains this language.

the Patent Owner of the '745 patent seeks the benefit of the earlier-filed '009 patent, despite the initial error in naming the inventors of the '009 patent. This error otherwise forecloses the inventors of the '745 patent from claiming priority to the '009 patent. As explained in *Roberts*, to deny the second application the benefit of priority of the first application would deprive an inventor of their invention because of a mistake which could be corrected. *Schmidt* further approved the practice of curing a defect in a claim to priority under section 120 by making an inventorship correction in an earlier-filed application. *See also Winbond Elecs. Corp. v. Int'l Trade Comm'n*, 262 F.3d 1363, 1371 (Fed. Cir. 2001) ("'Incorrect inventorship is a technical defect in a patent that may be easily curable.' . . . Rule 324 permits such an easy cure." (quoting *Canon Comput. Sys., Inc. v. Nu–Kote Int'l, Inc.*, 134 F.3d 1085, 1089 (Fed. Cir. 1998))) (opinion corrected, 275 F.3d 1344 (Fed. Cir. 2001)); *see also Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1554 (Fed. Cir. 1997) (discussing "the availability of section 256 to the policy of rewarding the actual inventor").

We are not persuaded by Petitioner's argument that inventorship correction under section 256 limits a Certificate of Correction to the patent "in which such error occurred" and "has only a confined effect that does not retroactively impact the '745 [patent]." Prelim. Reply Br. 3 (quoting from section 256(b)). Section 256(b) states: "The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section." This statement indicates that a defect in naming the inventors does not invalidate the patent—the purpose for which section 256 was enacted. Petitioner argues that because the statute refers to correcting an inventorship

error in the patent, it cannot be used to correct an error in any other patent, such as a descendant of the corrected patent. However, the only patent expressly mentioned in section 256 is the patent in which the error occurred. Unlike sections 254 and 255 which expressly state that the change "shall have the same effect and operation in law" for "causes . . . arising" after a certificate of correction has been issued, no such constraint appears in section 256.

Our reviewing court has "interpreted § 256 broadly as a 'savings provision' to prevent patent rights from being extinguished simply because the inventors are not correctly listed." *Chou v. University of Chicago*, 254 F.3d 1347, 1358 (Fed. Cir. 2001) (citing *Pannu*, 155 F.3d at 1349). Petitioner has not a supplied an adequate reason to limit the effect of the certificate of correction to the ancestor patent of the '745 patent. *In re Schmidt*, in particular, appears to be consistent with the result that an inventorship correction to an intermediate or ancestor patent can be used to correct a defect in a section 120 priority claim in a later filed patent.

Petitioner contends that Patent Owner failed to raise the inventorship defect timely. Prelim. Reply Br. 3. Citing *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1296 (Fed. Cir. 2000), Petitioner argues "requiring a patentee to 'check a patent when it is issued' is not 'asking too much.'" Prelim. Reply Br. 3. Petitioner asserts that Patent Owner knew of the inventorship issue "since at least 2008—before the '745 was filed—when it filed a related application removing Samaniego's inventors and replacing them with an entirely new set of inventors. *See* Ex. 1026, 79–87." Prelim. Reply Br. 3. Despite this alleged knowledge, Petitioner contends that Patent Owner did nothing to correct the inventorship during the life of the

'745 patent. Prelim. Reply Br. 3. Petitioner argues that "the public has been on notice that the '745 was invalid over Samaniego given the discontinuity in inventorship." *Id*. Petitioner asserts that it "relied on this discontinuity and filed a petition seeking to invalidate these claims based on this deficiency." *Id.*

In response, Patent Owner argues "there is no concern that the public was not aware of the priority claim" because the '745 patent "claims priority to the '009 patent on its face." Prelim. Sur-reply 3; *see* Ex. 1001, code (60). Patent Owner contends that the requirements of Section 120 are met for the claim of priority to the '009 patent. Prelim. Sur-reply 4. Patent Owner asserts that the inventorship correction under section 256 is an administrative correction and formality to list the proper inventors on the '009 patent.

We agree with Patent Owner. Despite Petitioner's arguments about untimeliness[11] and lack of notice, the USPTO granted Patent Owner's request under 37 C.F.R. § 1.324 to correct inventorship of the '009 patent.

[11] Petitioner has not established that the asserted "delay" in filing the certification of correction is a factor that should have been considered in determining whether to enter a certificate of correction of inventorship should be entered. Petitioner has not identified any statutory language in Section 256 which makes "timeliness" a factor to consider when correcting inventorship of a patent. In this regard, we point out that "diligence is not a requirement to correct inventorship under section 256." *Stark v. Advanced Magnetics, Inc*., 119 F.3d 1551, 1554 (Fed. Cir. 1997); *see also Advanced Cardiovascular Sys., Inc. v. SciMed Life Sys., Inc.*, 988 F.2d 1157, 1162 (Fed. Cir. 1993) ("Since the defense of patent invalidity based on incorrect inventorship can be raised at any time, correction of inventorship should be similarly available at any time.").

Ex. 2012 (Decision Granting Inventorship Petition). A Certificate of Correction, signed by the Director of the USPTO, was subsequently entered in the '009 patent. Ex. 2013 (Decision Approving Request for Certificate of Correction), Ex. 2014 (Certificate of Correction correcting inventorship).

Regarding Petitioner's allegations that, due to the conduct of Patent Owner, "[t]he Board . . . should not permit [Patent Owner] to change the inventorship of Samaniego" (Pet. 43–44), Petitioner has not described under what principle or caselaw the Board should act. *See* Prelim. Reply 1 n.1.

For the foregoing reasons, we decide Samaniego is not prior art to the '745 patent. Following correction of the inventorship of the '009 patent, and with no dispute by Petitioner that all other requirements under section 120 necessary for the '745 patent to claim the benefit of the filing date of the '009 patent are met (*see* Prelim. Resp. 9–11), Samaniego is excluded as prior art. Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail in proving the unpatentability of claims 1–7 based on Samaniego alone, or Samaniego in combination with Tso or Lawler.

III. §§ 325(D) & 314(A) DISCRETION

The institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding").

Patent Owner argues that institution should be denied under 35 U.S.C. § 325(d) because Tso (Ex. 1004) was previously considered by the Examiner and under 35 U.S.C. § 314(a) because four of Petitioner's six grounds are "facially deficient." Prelim. Resp. 1–2.

Because we have considered the grounds of unpatentability on the merits, and decide not to institute, we do not address the sections 325(d) and 314(a) issues raised in this proceeding.

IV. CONCLUSION

After considering the Petition, the Preliminary Response, the Preliminary Reply Brief, the Preliminary Sur-reply, and the evidence of record, and for the reasons discussed above, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of at least one claim challenged in the Petition. Hence, we deny the Petition and do not institute an *inter partes* review.

V. ORDER

Accordingly, it is

ORDERED that the Petition is denied and no trial is instituted.

PETITIONER:

Scott McKeown
James L. Davis, Jr.
Daniel W. Richards
ROPES & GRAY LLP
scott.mckeown@ropesgray.com
james.l.davis@ropesgray.com
daniel.richards@ropesgray.com

PATENT OWNER:

Christopher T. Bovenkamp
Ararat Kapouytian
CHARHON CALLAHAN ROBSON & GARZA, PLLC
cbovenkamp@ccrglaw.com
akapouytian@mkwllp.com

Jason A. Fitzsimmons
Richard M. Bemben
Michael D. Specht
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
jfitzsimmons-ptab@sternekessler.com
rbemben-ptab@sternekessler.com
mspecht-ptab@sternekessler.com