

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREE STREAM MEDIA CORP.
D/B/A SAMBA TV,
Petitioner,

v.

GRACENOTE, INC.,
Patent Owner.

IPR2020-00216 (Patent 9,066,114 B2)
IPR2020-00217 (Patent 9,407,962 B2)
IPR2020-00218 (Patent 9,479,831 B2)¹

Before MICHELLE N. ANKENBRAND, GARTH D. BAER, and
AARON W. MOORE, *Administrative Patent Judges*.

ANKENBRAND, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Supplemental Briefing on 35 U.S.C. § 325(d)
37 C.F.R. § 42.5(a)

¹ We issue a single order for entry in all three proceedings. The parties are not authorized to use this style heading for subsequent papers without Board preapproval.

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I. INTRODUCTION

Petitioner, Free Stream Media Corp. d/b/a Samba TV (“Petitioner”), filed Petitions on December 6, 2019, challenging claims of U.S. Patent Nos. 9,066,114, 9,479,831, and 8,806,957 B2 (collectively, the “challenged patents”). IPR2020-00216, Paper 1; IPR2020-0217, Paper 1; IPR2010-00218, Paper 1. Patent Owner filed a Preliminary Response in each proceeding on March 10, 2020. IPR2020-00216, Paper 12; IPR2020-00217, Paper 12; IPR2020-00218, Paper 12. In its Preliminary Responses, Patent Owner argues that the Board should apply its discretion under 35 U.S.C. § 325(d) to deny institution of the requested proceeding because the Examiner considered three of Petitioner’s primary references during prosecution of the ’957 patent. *See, e.g.*, IPR2020-00216, Paper 12, 41–47 (arguing that certain asserted references are cumulative to references previously presented to the Office during prosecution and pointing to *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph)).

On review of the parties’ submissions, we determine that it would be helpful for the parties to provide additional briefing on the applicability of § 325(d) to this case. In particular, we request that the parties address the recent Board decision in *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential). The decision explains that the Board uses a two-part framework under § 325(d), specifically,

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and

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(2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, Paper 6 at 8. Under the first part of the framework, previously presented art includes “art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at 7–8. Under the second part of the framework, a demonstration of Examiner material error “may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Id.* at 8–9 n.9. And “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* at 9.

Advanced Bionics also acknowledges that the *Becton, Dickinson* factors “provide useful insight into how to apply the framework under . . . § 325(d).” *Id.* at 9 & n.10 (detailing the *Becton, Dickinson* factors). So we also encourage the parties to discuss any *Becton, Dickinson* factors relevant to the facts of this case. The parties may submit additional evidence from the prosecution history of the challenged patents to support any facts asserted in the supplemental briefing.

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II. ORDER

Accordingly, it is

ORDERED that Petitioner is authorized to file a reply to the Preliminary Response, no more than five (5) pages and limited to addressing the issue of discretionary denial under 35 U.S.C. § 325(d), by May 4, 2020; and it is

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply to Petitioner's reply, no more than five (5) pages and limited to the issue of discretionary denial under 35 U.S.C. § 325(d), by May 11, 2020.

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For PETITIONER:

Donald Daybell
Alyssa Caridis
ORRICK, HERRINGTON & SUTCLIFFE, LLP
D2dtabdocket@orrick.com
A8cptabdocket@orrick.com

For PATENT OWNER:

Jennifer Bailey
Robin Snader
Jason Mudd
ERISE IP, P.A.
Jennifer.bailey@eriseip.com
Robin.snader@eriseip.com
Jason.mudd@eriseip.com