IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NETFLIX, INC.,
Petitioner,

v.

AVAGO TECHNOLOGIES INTERNATIONAL SALES PTE. LIMITED,
Patent Owner.

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IPR2021-01582

U.S. Patent No. 8,572,138 B2

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STATEMENT REGARDING MULTIPLE PETITIONS

Petitioner Netflix, Inc. respectfully submits this paper pursuant to the November 2019 Update to the AIA Trial Practice Guide. Petitioner has filed two petitions against U.S. Patent No. 8,572,138 (the '138 patent) and ranks them as follows:

(1) IPR2020-01582, challenging claims 1, 3, 4, 9-10, 17, 19, 21, and 26. (the "First Petition"); and

(2) IPR2021-00542, challenging claims 11, 12, 14, 22, and 24 (the "Second Petition").

As described below, Netflix was required to file the Second Petition because Patent Owner delayed its assertion of the claims challenged therein. In particular, the Second Petition addresses claims first identified on January 5, 2021 in a co-pending district court case when Patent Owner served its Infringement Contentions. *See* Exs. 1021 and 1022. Even if Patent Owner had identified all asserted claims prior to the filing of the First Petition, the Second Petition would have been necessary to challenge the asserted claims given the overall number of claims at issue and the word count limits applicable to IPR petitions. Institution of both petitions will be an efficient use of the Board's resources given (i) the materiality of the challenged claims to the parties' dispute; (ii) the common limitations across the challenged claims; and (iii) the common prior art underlying the Petitions.

I. TWO PETITIONS ARE NEEDED TO PREVENT PREJUDICE

In this case, two petitions were necessary to allow Netflix to challenge the full set of claims Broadcom has asserted in parallel district court litigation. In particular,

Netflix filed the First Petition on October 20, 2020 challenging claims 1, 3, 4, 9-10, 17, 19, 21, and 26 of the '138 patent. At that time, those appeared to be the claims potentially at issue in the district court litigation. Subsequently, Broadcom served Infringement Contentions on January 5, 2021 identifying for the first time additional asserted claims—including claims 11, 12, 14, 22, and 24. A second petition was thus required to address those newly asserted claims.

In addition to the above timing considerations, two petitions are necessary in this case given the number of claims and the length of the claims being challenged across the two petitions. *See Intel Corp. v. VLSI Technology LLC*, IPR2019-01199, Paper 19 at 10-11 (Feb. 6, 2020) (filing of three petitions reasonable where, among other factors, the three petitions addressed different independent claims).

There is no prejudice to the Patent Owner here from the Second Petition. The two Petitions challenge different sets of claims. This is not a situation where multiple petitions attack the same claims, leveraging the extra space to assert additional prior art references or permutations of references. While technically some claims are addressed in both petitions, this was necessary given the dependence of the claims being challenged in the second petition. For example, while Petitioner is challenging claims 11, 12, 14, 22, and 24, those claims rely on claims 1, 9, and 19—claims that Petitioner challenged in the First Petition. Accordingly, in this Second Petition, Petitioner is including the same arguments and prior art for claims 1, 9, and

19 as it submitted in the First Petition (in addition to its arguments and prior art for claims 11, 12, 14, 22, and 24). Petitioner's arguments and prior art for the newly asserted claims are directed toward new elements and additional functionality present only in this set of claims (e.g. undeployment and the generating and use of an application matrix). No institution decision has been issued in the first proceeding. Although Patent Owner has already filed a Patent Owner Preliminary Response, there can be no allegation that Petitioner engaged in any "road mapping" in preparing the Second Petition because the Second Petition was filed based on the same underlying prior art and arguments as the First Petition for the overlapping claims.

The Board has recognized that a second petition filed under these circumstances does not truly qualify as a "follow-on petition" as that term is used in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (designated precedential in relevant part). *See Volkswagen Grp. of Am., Inc., v. Carucel Invs., L.P.*, IPR2019-01573, Paper 7 at 7 (PTAB Jan. 22, 2020) (finding petitioner's second petition not a "follow-on petition" because the second petition covered different claims than first petition); *Cirrus Design Corp., v. Hoyt Augustus Fleming*, IPR2020-00762, Paper 19 at 9 (PTAB Oct. 1, 2020). To the contrary, the Board has found that the filing of a second petition challenging different claims of the same patent "is warranted" where the patent

owner waited until after the filing of a first petition to assert those additional claims. *See Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, Case IPR2019-01644, Paper 9, at 9-15.

II. THE *GENERAL PLASTIC* FACTORS FAVOR INSTITUTION OF THE SECOND PETITION

To the extent applicable, the *General Plastic* factors also favor institution of the Second Petition. Under Factor 1, Petitioner has not previously challenged the same claims of the '138 patent because the Second Petition only challenges claims that were not addressed in the First Petition. *See Volkswagen*, IPR2019-01573, Paper 7 at 7. Although the Second Petition is based on the same prior art as the First Petition, Factors 2 and 4 "do not favor denial" because Petitioner "is challenging newly-asserted claims" with that art. *Id.*, at 8. Under Factor 3, no institution decision has been issued with respect to the First Petition. Under Factor 5, less than two months have elapsed since Patent Owner first asserted the claims challenged in the Second Petition. A two month period between the identification of newly asserted claims and the filing of a petition is well within the reasonable amount of time to prepare an IPR petition. *See Dish Network LLC v. Broadband iTV, Inc.*, IPR2020-01267, Paper 15 at 20-21 (citing an earlier case for the proposition that a petitioner was diligent in filing a petition within two months of related district court proceedings and concluding that Petitioner exercised sufficient diligence in filing

within three months of learning the full set of claims Patent Owner was initially asserting and receiving PO's preliminary infringement contentions for those claims).

Under *General Plastics* Factor 6, instituting review on the Second Petition will be an efficient use of the Board's finite resources. The limitations of the claims challenged in the First and Second Petitions are largely overlapping. Also, as noted above, Petitioner is relying on overlapping art to challenge the newly asserted dependent claims, utilizing a single additional piece of art to address the dependent claim limitations. Moreover, the newly asserted claims are material to the parties' overall dispute given that those claims are now asserted in a co-pending district court litigation. Netflix also does not oppose any effort to align the schedules of the two IPR proceedings. Finally, under Factor 7, no issues are presented that would inhibit the issuance of a final determination within one year of institution.

III. CONCLUSION

Institution of both Petitions would be an efficient use of the Board's resources and result in no prejudice to Patent Owner. By contrast, denial of the Petitions would prejudice Netflix by depriving it of a fair opportunity to challenge the '138 patent.

Respectfully submitted,

SHEPPARD, MULLIN,
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/Harper Batts/
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UPDATED EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 8,572,138 ("the '138 patent")
1002	Prosecution File History for the '138 patent
1003	Declaration of Prashant Shenoy
1004	U.S. Patent No. 7,577,722 to Khandekar *et al*. ("Khandekar")
1005	U.S. Patent No. 8,209,680 to Le *et al*. ("Le")
1006	U.S. Patent No. 7,962,633 to Sidebottom *et al*. ("Sidebottom")
1007	U.S. Patent Application Publication No. 2003/0036886 to Stone ("Stone")
1008	Khanna *et al*., *Application Performance Management in Virtualized Server Environments*, NOMS 2006 ("Khanna")
1009	Urgaonkar *et al*., *Dynamic Provisioning of Multi-tier Internet Applications*, ICAC'05 ("Urgaonkar")
1010	Excerpt of S. Russell, P. Norvig, *Artificial Intelligence - A Modern Approach* (2d. ed. Prentice-Hall 2003) ("Russell")
1011	Barham *et al.*, *Xen and the Art of Virtualization*, SOSP '03: ACM Symposium on Operating Systems Principles, 164-177 (Oct., 2003)
1012	U.S. Patent No. 6,496,847 to Bugnion *et al*. ("Bugnion")
1013	U.S. Patent Application Publication No. 2004/0019672 to Das *et al*. ("Das")
1014	U.S. Patent Application Publication No. 2007/0220246 to Powell *et al*. ("Powell")
1015	JP Patent Application Publication No. 2001-318797 to French
1016	English translation of JP Patent Application Publication No. 2001-318797 to French ("French")
1017	Declaration of Sylvia D. Hall-Ellis
1018	Reserved
1019	Reserved
1020	Reserved

Exhibit No.	Description
1021	Broadcom PR 3-1 and 3-2 Disclosures from *Broadcom Corp. et al. v. Netflix, Inc.,* Case No. 3:20-cv-04677-JD
1022	Preliminary Infringement Contentions for Sundar 138 *Broadcom Corp. et al. v. Netflix, Inc.,* Case No. 3:20-cv-04677-JD

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on February 22, 2021 true and complete copies of the Multiple Petition Statement, Updated Exhibit List, and Exhibits 1021-1022 were served via email to all parties to this proceeding at the addresses indicated:

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