UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

AFFINITY LABS OF TEXAS, LLC,
Patent Owner.

Case IPR2017-00122
Patent 9,444,868 B2

PETITIONER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. § 42.8, Petitioner Netflix, Inc. ("Petitioner") hereby submits the following Updated Mandatory Notices information to update the mailing address for Petitioner's counsel.

I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(A)(1)

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

The real party in interest is Netflix, Inc.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

The '868 patent is the subject of a patent infringement lawsuit brought by Affinity in the Western District of Texas, Case No. 1:15-cv-00849. U.S. Patent No. 9,094,802 ("'802 patent") is also the subject of the same suit. Netflix has petitioned for IPR of the '802 patent in IPR2016-01701.

Other sibling patents to the '868 patent have been the subject of adverse decisions in District Courts and at the Board. These sibling patents are all continuations of the same parent '812 application, share the same specification, and have substantively similar claims. In two District Court cases, recently affirmed by the Federal Circuit,[1] Judges Manske and Smith found every claim of two of these sibling patents, U.S. Patent Nos. 7,970,379 and 8,688,085, to be ineligible for patenting under 35 U.S.C. § 101 and, in doing so, found the claims

[1] Affinity v. Amazon.com Inc., --- F.3d ---- 2016 WL 5335502 (Sep. 23, 2016); Affinity v. DirecTV, LLC, --- F.3d ---- 2016 WL 5335501 (Sep. 23, 2016).

provided no inventive concept. Ex. 1009, p. 6; Ex. 1010, pp. 14, 19. As stated by Judge Smith, "[t]he '085 patent solves no problems, includes no implementation software, designs no system." Ex. 1009, p. 6. The claims of the '085 patent are substantively similar to those of the '868 patent, allegedly including the "bitrate-switching" feature. In fact, invalidated claim 16 of the '085 patent is similar to the independent claims of the '868 patent. Compare Ex. 1001, 18:56-19:24, 19:48-20:10, 19:49-21:6 with Ex. 1008 ('085 patent), 20:6-20:24, 20:30-36.

Three other siblings to the '868 patent have had claims rendered unpatentable by the Board. First, in IPR2014-00209 and -00212, the Board held claims 16, 19 and 20 of U.S. Patent No. 7,953,390 unpatentable. This decision too was recently affirmed by the Federal Circuit. Ex. 1013. Second, in IPR2014-01181, -01182 and -01184, the Board held claims 1-3 and 5-14 of U.S. Patent No. 8,532,641 unpatentable in light various combinations of art. Third—and most relevant here—in the '407 IPR, the Board held claims 1, 2, 5-8, and 10 of the '007 patent unpatentable in light of Treyz and Fuller. The claims of the '007 patent are strikingly similar to Challenged Claims, which add more words but not substance. See Ex. 1007, ¶¶79-81.

Affinity cannot escape these prior invalidity rulings on similar claims by simply rearranging claim limitations. Given the extensive overlap in claim language between the unpatentable claims of the '007 patent and the claims of the

'868 patent at issue here, to promote judicial economy and to the extent feasible, Netflix respectfully requests that this proceeding be assigned to the same panel that presided over IPR2014-00209, -00212, and IPR2014-00407, -00408 (Judges Turner, Pettigrew, and Tornquist).

C. Lead and Back-Up Counsel and Service Information Under 37 C.F.R. § 42.8(b)(3) and (4)

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Petitioner consents to electronic service by delivering the documents to the email addresses of primary and backup counsel.

Respectfully submitted,

Date: March 31, 2017

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CERTIFICATE OF SERVICE

As authorized by Patent Owner's Mandatory Notice, I hereby certify that on March 31, 2017, a copy of this document has been served in its entirety by electronic mail on Patent Owner's lead and backup counsel.

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