

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

TECHNO VIEW IP, INC.,
Exclusive Licensee of the Patent Owner.¹

Case IPR2018-01044 (Patent 7,666,096)
Case IPR2018-01045 (Patent 8,206,218)

Before WILLIAM V. SAINDON and NORMAN H. BEAMER,
Administrative Patent Judges.

SAINDON, *Administrative Patent Judge.*

DECISION
Authorizing Reply to Patent Owner Preliminary Response
37 C.F.R. § 42.108(c)

¹ TD Vision Corporation S.A. de C.V is the Patent Owner. Paper 4; *see also infra* note 3.

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Sony Interactive Entertainment LLC (“Petitioner”) filed petitions requesting *inter partes* reviews of claims 1–14 and 16–19 of U.S. Patent No. 7,666,096 B2 (Ex. 1001, “the ’096 patent”) and claims 1–11, 13, and 14 of U.S. Patent No. 8,206,218 B2 (IPR2018-01045, Ex. 1001, “the ’218 patent”). Paper 2 (“1044 Pet.”)²; IPR2018-01045, Paper 2 (“1045 Pet.”). Techno View IP, Inc. (“Patent Owner”)³ filed a Preliminary Response in both proceedings. Paper 6 (“1044 Prelim. Resp.”); IPR2018-01045, Paper 7 (“1045 Prelim. Resp.”).

Petitioner requested a conference call to seek authorization under 37 C.F.R. § 42.108(c) to file a Reply to the Preliminary Response based on two pieces of evidence cited in the Preliminary Response. The first is that, in the Preliminary Response, Patent Owner offered, as evidence in support of an argument against Petitioner’s rationale to combine, an “End User License Agreement” (“EULA”), purported to be required of users of Petitioner’s “PS4 videogame console.” 1044 Prelim. Resp. 22–23 (citing Ex. 2002);

² Unless otherwise noted, citations in this Decision are to papers and exhibits in IPR2018-01044.

³ To follow the convention used by the parties and avoid confusion, for the purposes of this proceeding we will identify Techno View IP, Inc., the exclusive licensee of the ’096 patent, as the “Patent Owner.” See *Motorola Mobility LLC v. Patent of Michael Arnouse*, No. IPR2013-00010 (Paper 27), 2013 WL 5970127 at *3 (PTAB April 5, 2013) (applying Federal Circuit standing analysis to determine who “has the right to participate in proceedings at the Office”); *Sicom Sys. Ltd. v. Agilent Techs., Inc.*, 427 F.3d 971, 976 (Fed. Cir. 2005) (“[A]n exclusive license may be treated like an assignment for purposes of creating standing if it conveys to the licensee all substantial rights.”); *Prima Tek II, L.L.C. v. A-Roo Co.*, 222 F.3d 1372, 1377 (Fed. Cir. 2000) (holding that, with a transfer of “all substantial rights under the patent, the assignee may be deemed the effective ‘patentee’ under 35 U.S.C. § 281”).

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1045 Prelim. Resp. 26–28 (citing IPR2018-01045, Ex. 2001). During the call, Petitioner argued that it would not have reasonably foreseen that its EULA would be offered as evidence against obviousness and that good cause exists for Petitioner to respond to this evidence. Patent Owner argued that good cause did not exist because Petitioner should have foreseen the use of this evidence. We agree with Petitioner that citation of this particular evidence was not reasonably foreseeable and that good cause exists to allow Petitioner a brief reply to address this evidence. In particular, we find sufficiently novel and unexpected the argument that an end user of a “PS4 videogame console” is representative of the level of ordinary skill in the art (the perspective from which obviousness is determined), or that legal constraints on the end user’s actions affect that perspective. In our opinion, a brief answer by Petitioner is warranted in order to provide us with better information to make a well-informed decision on institution.

The second piece of evidence cited by Patent Owner in its Preliminary Response is Huether (Ex. 2001). In its Petition, Petitioner relies on Johnson (Ex. 1008) as a primary reference for several grounds, and in particular for the limitation of several claims regarding a determination if a signal is in a two- or three-dimensional format. *See, e.g.*, Pet. 47; Prelim. Resp. 33. Patent Owner introduces Huether, cited and incorporated by reference in Johnson as a command signal protocol, to distinguish Johnson’s teachings relative to the claims.

This presents a closer case, as Johnson’s incorporation by reference of Huether is the only cross-reference in Johnson (*see* Ex. 1008, 1:8–12) and appears relevant to the communication protocol relied at least in part upon by Petitioner to teach a limitation (*see* Pet. 47, citing Ex. 1008, 6:61–7:3,

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4:35–43). The Huether protocol appears relevant to one of the portions of Johnson cited by Petitioner. Ex. 1008, 4:40–46 (discussing how a stereoscopic mode may be set and citing indirectly to Huether as a protocol for doing so). On the other hand, a reference teaches all it suggests to a person of ordinary skill in the art, and Johnson alone may be relied upon to suggest a limitation, if a person of ordinary skill in the art would understand it to make such a suggestion (even if it turns out Johnson in fact uses some other protocol). *See, e.g., EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985) (“A reference must be considered for everything it *teaches* by way of technology and is not limited to the particular *invention* it is describing and attempting to protect.”); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”). We point this out merely to highlight that Petitioner’s position is not *per se* reliant on Huether and thus analysis of Huether is perhaps not necessarily foreseeable.

In any event, Petitioner has already established good cause for a limited number of pages. We see little harm in allowing Petitioner to spend some of a fixed number of pages on this topic because it will provide us with better information to make a well-informed decision on institution. Ultimately, Petitioner is constrained to the grounds set forth in the Petition and the Reply cannot change the grounds, only argue their merits.

Accordingly, we grant Petitioner’s request to file a Reply to the Preliminary Response, due October 5, 2018. The Reply is limited to responding to Patent Owner’s arguments in the Preliminary Response regarding EULA and Huether; no new evidence may be submitted. The

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Reply will be no more than 5 pages and the exact same Reply will be filed in both cases.

Our Decision herein is based on a very limited review of the record, constrained to understanding whether Petitioner has established good cause for a reply; nothing should be construed as a finding of fact or holding of law regarding the merits of either party's arguments in the Petition or Preliminary Response.

ORDER

In view of the foregoing, it is hereby:

ORDERED that Petitioner's request for a Reply is granted, and that the Reply is limited according to the parameters set forth above.

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