

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY COMPUTER ENTERTAINMENT AMERICA LLC,
Petitioner,

v.

ROTHSCHILD DIGITAL MEDIA INNOVATIONS, LLC,
Patent Owner.

Case IPR2015-01364
Patent 6,101,534

Before MICHAEL W. KIM, MICHAEL J. FITZPATRICK, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Sony Entertainment America LLC, filed a Petition to institute an *inter partes* review of claims 1, 6–9, and 21–24 of U.S. Patent No. 6,101,534, as amended by U.S. Patent Reexamination Certificate 6,101,534 C1, (Ex. 1001, “the ’534 patent”) pursuant to 35 U.S.C. § 311(a). Paper 3 (“Pet.”). Patent Owner, Rothschild Digital Media Innovations, LLC, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Upon consideration of the Petition, and for the reasons explained below, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to all challenged claims. *See* 35 U.S.C. § 314(a). Accordingly, we grant the Petition to institute an *inter partes* review.

A. Related Matters

The Director requires a petitioner to include certain mandatory notices with its petition. 37 C.F.R. § 42.8(a)(1). The mandatory notices include a requirement to “[i]dentify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding.” 37 C.F.R. § 42.8(b)(2) (titled “Related matters”). “Judicial matters include actions involving the patent in federal court. Administrative matters include every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party’s involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent.”

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Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

Pursuant to 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related matter only: *Rothschild Digital Media Innovations, LLC v. Sony Computer Entertainment America LLC*, Case No. 5:14-cv-03928 (N.D. Cal.) (the “California lawsuit”). Pet. 59; *see also* Paper 6, 2 (Patent Owner’s mandatory notice identifying the same lawsuit).

Petitioner does not identify as related matters the following: (1) *Rothschild Trust Holdings, LLC v. Citrix*, Case No. 06-21359-CIV (S.D. Fla.), a lawsuit in which Patent Owner asserted the ’534 patent (the “Florida lawsuit”); and (2) Reexamination Control No. 90/008,591, a third party-requested *ex parte* reexamination of the ’534 patent (the “reexamination”). Pet. 59; *see also* Paper 6, 2 (Patent Owner’s mandatory notice also failing to identify these matters as related matters).

Although the Florida lawsuit and the reexamination are discussed in the body of the Petition, those matters should have been specifically identified as related matters in Petitioner’s section expressly dedicated to “MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(A)(1).” *See* Pet. 59.¹

¹ Both parties should file updated mandatory notices to identify all related matters.

B. The '534 Patent

The '534 patent relates to an interactive remote computer interface system. Ex. 1001, 1:6–7. In general, it describes a system in which local data and remote data are combined for local use. *Id.* at Abstract. The use of local data on, for example, a CD-ROM reduces the amount of data required to be downloaded in order to render desired data on a display, while the use of remote data allows for providing updated data from a centralized source. *Id.* at 6:41–46, 7:4–8.

The system includes a remote server, a local processor, and a data storage assembly associated with the local processor. Ex. 1001, 5:20–42. The remote sever includes primary site data and at least one primary site address that includes at least a portion of the primary site data. *Id.* at 5:20–25. The data storage assembly may be a hard drive but is preferably a compact, portable, and interchangeable computer readable medium such as a CD-ROM. *Id.* at 5:40–45. The data storage assembly includes auxiliary site data associated with the primary site data and is encoded with a plurality of remotely accessible auxiliary site addresses, each of which includes select portions of auxiliary site data. *Id.* at 5:46–53.

Petitioner fairly describes operation of an embodiment of the '534 patent as follows:

a user at a local computer, having access to a CD-ROM or the like that has been previously distributed and stored at a local computer, is able to go online to access primary site information (e.g., through a website). *See, e.g.*, [Ex. 1001] at Col. 13:43-14:32. When the interaction calls for interactive video, downloading is not necessary

because the system accesses the CD-ROM, and initiates utilization of auxiliary data stored thereon. *See id.* The auxiliary data is stored at specific auxiliary site addresses on the CD-ROM so that the data is readily accessible. *See id.*

Pet. 4. Lastly, it is clear from the specification that a focus of the '534 patent is on application of the invention to a real estate context. *See, e.g., id.* at 7:30–35 (“the present invention is directed towards a system for the display of a three dimensional space, generally 10, and preferably, a real state display system 10 structured to provide for the remote exhibition of real estate space.”). But, the challenged claims, which are discussed below, are not limited to such an application.

C. The Challenged Claims

Petitioner challenges claims 1, 6–9, and 21–24. Pet. 2–3. Claims 1, 23, and 24 are independent, and the remaining challenged claims—claims 6–9, 21, and 22—ultimately depend from claim 1. Claim 1 is illustrative and reproduced below.

1. An interactive, remote, computer interface system comprising:

a remote server assembly, said remote server assembly including a quantity of primary site data;

said remote server assembly including at least one primary site address, said primary site address including at least a portion of said primary site data and being distinct so as to identify a location thereof on a computer network;

a local processor assembly;

said local processor assembly being coupled in data transmitting and receiving communication with said remote server assembly;

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