

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAMELOFT, S.A.,
Petitioner,

v.

ROTHSCHILD DIGITAL MEDIA INNOVATIONS, LLC,
Patent Owner.

Case IPR2016-00472
Patent 6,101,534

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

FITZPATRICK, *Administrative Patent Judge*.

DECISION

Granting Joinder; Denying *Inter Partes* Review
37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Gameloft, S.A., (“Petitioner” or “Gameloft”) 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.”). Petitioner also filed a Motion for Joinder (“Motion”) with *Sony Entertainment America LLC*, (“Sony”) v. *Rothschild Digital Media Innovations, LLC*, IPR2015-01364 (the “Sony IPR”). Paper 4 (“Mot.”).

Patent Owner, Rothschild Digital Media Innovations, LLC, filed a paper, stating that it waives filing a preliminary response and does not oppose joinder. Paper 8, 2.

For reasons explained below, we grant joinder, dismiss the Motion as moot, and deny the Petition.

A. Related Matters

The parties identify the following cases as related matters: *Rothschild Digital Media Innovations, LLC v. Sony Computer Entertainment America LLC*, Case No. 5:14-cv-03928 (N.D. Cal.) (pending); *Rothschild Digital Media Innovations, LLC v. G5 Entertainment, AB*, Case No. 1:15-cv-23301 (S.D. Fla.) (pending); *Rothschild Digital Media Innovations, LLC v. Gameloft, S.A.*, Case No. 1:15-cv-23302 (S.D. Fla.) (pending); *Supercell Oy v. Rothschild Digital Media Innovations, LLC*, Case No. 2:15-cv-1119 (W.D. Wash.) (pending); *ORB Networks v. Rothschild Trust Holdings, LLC*, Case No. 3:07-cv-400 (N.D. Cal.) (terminated); *Rothschild Trust Holdings, LLC v. ORB Networks, Inc.*, Case No. 1:06-cv-22921 (S.D. Fla.)

IPR2016-00472
Patent 6,101,534

(terminated); *Rothschild Trust Holdings, LLC v. Citrix Systems, Inc.*, Case No. 1:06-cv-21359 (S.D. Fla.) (terminated). Pet. 40–41; Paper 7, 2–3.

Petitioner alone identifies the following additional cases as related matters: *Trust Licensing, LLC v. Interactual Technologies, Inc.*, Case No. 1:03-cv-20672 (S.D. Fla.) (terminated); *Trust Licensing, LLC v. Disc Publishing, Inc.*, Case No. 1:02-cv-21192 (S.D. Fla.) (terminated); *In re Intracorp Entertainment, Inc.*, Case No. 96-16276 (S.D. Fla.) (terminated). Pet. 41. Likewise, Petitioner alone identifies the Sony IPR as a related matter. *Id.*

Patent Owner alone identifies Reexamination Control No. 90/008,591, which was a third party-requested *ex parte* reexamination of the '534 patent (the “reexamination”) resulting in U.S. Patent Reexamination Certificate 6,101,534 C1, as a related matter. Paper 7, 3.

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 server 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. 3–4. 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 estate 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, which are the same claims involved in the Sony IPR. Pet. 1; Mot. 2; IPR2015-01364, Paper 8. 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;

said local processor assembly being structured to access said primary site address so as to achieve said data transmitting and receiving communication with said remote server assembly;

at least one data storage assembly associated with said local processor assembly and structured to contain a quantity of auxiliary site data thereon, said auxiliary site data being associated with said primary site data;

said data storage assembly including a compact, portable and interchangeable computer readable medium;

said compact, portable and interchangeable computer readable medium including a plurality of remotely accessible, auxiliary site addresses encoded therein, each of said remotely accessible, auxiliary site addresses including select portions of

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.