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Paper No. 7
Filed: March 3, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2016-01762
Patent 8,893,212 B2

Before JAMESON LEE, KEN B. BARRETT, and JOHN F. HORVATH, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Roku, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") to institute *inter partes* review of claims 1–23 of U.S. Patent No. 8,893,212 B2 (Ex. 1002, "the '212 patent"). Convergent Media Solutions, LLC, ("Patent Owner") did not file a Preliminary Response.

Upon consideration of the Petition, we are persuaded, under 35 U.S.C. § 314(a), that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of claims 1–22 of the '212 patent. However, we are not persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of claim 23 of the '212 patent. Accordingly, we institute an *inter partes* review of claims 1–22 of the '212 patent.

B. Related Matters

Petitioner identifies the following as matters that could affect, or be affected by, a decision in this proceeding: *Convergent Media Solutions, LLC v. Roku, Inc.*, No. 3:15-cv-02163 (N.D. Tex); *Convergent Media Solutions LLC v. AT&T Inc.*, Case No. 3:15-cv-02156 (N.D. Tex.), the latter being a lead case consolidating individual cases brought by Convergent Media Solutions LLC against AT&T Inc., Hulu, Inc., and Netflix Inc. Pet. 2. Patent Owner identifies the same matters. Paper 4.

C. Evidence Relied Upon

Reference		Effective Date	Exhibit
Zintel	US 6,910,068 B2	Mar. 16, 2001 (filing)	Ex. 1003

Reference		Effective Date	Exhibit
Elabbady	US 7,483,958 B1	Mar. 26, 2002 (filing)	Ex. 1004
Palm	US 2001/0042107 A1	Jan. 8, 2001 (filing)	Ex. 1006
Janik	US 7,130,616 B2	Aug. 7, 2001 (filing)	Ex. 1007
Vallone	US 6,847,778 B1	Mar. 30, 2000 (filing)	Ex. 1008

Petitioner also relies upon the Declaration of Andrew Wolfe, Ph.D. Ex. 1009.

D. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

References	Basis	Claims Challenged
Elabbady, Palm, and Zintel	§ 103(a)	1–18, 20, 22, and 23
Elabbady, Palm, Zintel, and Vallone	§ 103(a)	19
Elabbady, Palm, Zintel, and Janik	§ 103(a)	21

II. ANALYSIS

A. The '212 Patent

The '212 patent relates to systems and methods for navigating hypermedia using multiple coordinated input/output device sets. Ex. 1002, 3:4–6. The method allows "a user and/or an author to control what resources are presented on which device sets." *Id.* at 3:6–8. The device sets may include laptops, desktops, tablets, personal digital assistants (PDAs), televisions (TVs), set-top boxes (STBs), video cassette recorders (VCRs) and digital video recorders (DVRs). *Id.* at 16:29–36, 18:38–19:40. The term hypermedia refers to "any kind of media that may have the effect of a

non-linear structure of associated elements," and includes "graphics, video, and sound." *Id.* at 7:5–14. The '212 patent characterizes video and sound as examples of "continuous media," or a "representation of 'content' elements that have an intrinsic duration, that continue (or extend) and may change over time." *Id*. at 19:65–20:2.

The multiple input/output device sets described in the '212 patent may be coordinated using "a device set management process that performs basic setup and update functions . . . to pre-identify and dynamically discover device sets." Ex. 1002, 37:28–35. This management process can "be based on and compatible with related lower-level processes and standards defined for linking such existing devices and systems . . . based on UPnP, HAVi, OSGi, Rendezvous and/or the like." *Id.* at 37:38–42. The process enables basic communications among the devices in the device set, and "provide[s] discovery, presence, registration, and naming services to recognize and identify devices as they become available to participate in a network, and to characterize their capabilities." *Id.* at 37:42–47.

Independent claim 1 of the '212 patent, reproduced below, is illustrative of the claims of the '212 patent. Each of the other challenged claims depends from claim 1.

> 1. A method for use in a second computerized device set which is configured for wireless communication using a wireless communications protocol that enables communication with a first computerized device set, wherein the first and second computerized device sets include respective first and second continuous media players, the method comprising:

> receiving discovery information that is obtained in accordance with a device management discovery protocol that is implemented at a communication layer above an internet protocol layer wherein the discovery information allows a determination to be made at the second computerized device set that the first computerized device set is capable of supporting selected functions;
>
> making available to a user a first user interface that allows the user to enable communications with the first computerized device set;
>
> making available to the user a second user interface that allows the user to browse internet content including a listing of continuous media content, the continuous media content being available to be accessed and presented on demand, wherein the listing is accessible via the internet using an internet protocol, the listing allowing the user to identify a particular content item of the continuous media content;
>
> responsive to the user identifying the particular content item of the continuous media content, causing to be wirelessly transmitted, in accordance with a wireless local area network protocol, an identification of the particular content item from the second computerized device set for subsequent use by the first computerized device set to facilitate accessing and presenting the particular content item on the first computerized device set;
>
> wherein the supported selected functions include at least receiving of the identification of the particular content item, the accessing of the particular content item and the presenting of the particular content item.

Ex. 1002, 163:62–165:33.

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