

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLING TV L.L.C. and
VUDU, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-01367¹
Patent 8,407,609 B2

Before CHARLES J. BOUDREAU, DANIEL J. GALLIGAN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

¹ Vudu, Inc., which filed a petition in IPR2020-00677, has been joined as a petitioner in this proceeding.

I. INTRODUCTION

Sling TV L.L.C. (“Sling”) filed a Petition seeking institution of *inter partes* review of claims 1–3 of U.S. Patent No. 8,407,609 B2 (Ex. 1001, “the ’609 patent”). Paper 2 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). After reviewing those papers, we determined that Petitioner had demonstrated a reasonable likelihood that it would prevail in proving that claims 1–3 of the ’609 patent are unpatentable, and we instituted an *inter partes* review of all challenged claims on all grounds set forth in the Petition. Paper 7 (“Institution Decision” or “Inst. Dec.”).

After institution, Patent Owner filed a Response (Paper 13, “PO Resp.”), and Sling filed a Reply (Paper 15, “Pet. Reply”). Vudu, Inc. (“Vudu”) was then joined as a petitioner (Paper 16), and Sling and Vudu are now collectively referred to as “Petitioner.” Patent Owner filed a Sur-Reply (Paper 18, “PO Sur-Reply”). An oral hearing in this proceeding was held on December 3, 2020, and a transcript of the hearing is included in the record. Paper 28 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that claims 1–3 of the ’609 patent are unpatentable under 35 U.S.C. § 103(a).

A. *Related Matters*

The parties identify various civil actions involving the ’609 patent that are or were pending in district court, including *Uniloc 2017 LLC v. Sling TV, LLC*, 1:19-cv-00278 (D. Colo.); *Uniloc 2017 LLC v. Vudu, Inc.*, 1:19-cv-00183 (D. Del.); *Uniloc 2017 LLC v. Netflix, Inc.*, 8:18-cv-02055 (C.D.

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Cal.); *Uniloc 2017 LLC v. Google LLC*, 2:18-cv-00502 (E.D. Tex.). Pet. v–vi; PO Resp. 9–10; *see* Paper 19 (Petitioner’s Updated Mandatory Notices).

The ’609 patent is or was the subject of three other petitions for *inter partes* review. In IPR2020-00677, Vudu filed a petition that is substantively identical to the Petition, and the Board instituted that review and joined Vudu to this proceeding as Petitioner. Paper 16 (Joinder Order). Also, a petition filed by Netflix, Inc. and Roku, Inc. was instituted by the Board. *Netflix, Inc. v. Uniloc 2017 LLC*, IPR2020-00041 (“the 041 IPR”), Paper 10 (PTAB Mar. 25, 2020) (Institution Decision in the 041 IPR). A final written decision in the 041 IPR is being issued concurrently with this Decision. Finally, the ’609 patent was previously the subject of another petition for *inter partes* review that was discretionarily denied under 35 U.S.C. § 314(a). *Google LLC v. Uniloc 2017 LLC*, IPR2020-00115, Paper 8 (PTAB Mar. 27, 2020).

B. Real Parties in Interest

Sling states that it is owned (directly or indirectly) by Sling TV Holding L.L.C., DISH Network L.L.C., DISH Technologies L.L.C., and DISH Network Corporation. Pet. v. Vudu identifies each of the following companies as a direct or indirect owner (at some point in time): Walmart Inc., Fandango Media, LLC, NBCUniversal Media, LLC, Warner Bros. Entertainment Inc., Comcast Corporation, Warner Media, LLC, and AT&T Inc. Paper 16, 2 n.1 (citing IPR2020-00677, Papers 1, 8).

Patent Owner identifies no other real parties in interest. Paper 3, 1 (Mandatory Notice).

C. The Petition's Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 2):

Claims Challenged	35 U.S.C. §	References/Basis
1–3	103(a) ²	Jacoby, ³ Bland ⁴
1–3	103(a)	McTernan, ⁵ Robinson ⁶

Petitioner also relies on the testimony of Dr. James A. Storer to support its contentions. Ex. 1002.

D. Summary of the '609 Patent

The '609 patent is titled “System and Method for Providing and Tracking the Provision of Audio and Visual Presentations via a Computer Network.” Ex. 1001, code (54). The application that led to the '609 patent was filed on August 21, 2009, and claimed the benefit of a U.S. provisional application filed August 21, 2008. *Id.* at codes (22), (60).

The '609 patent discloses tracking a user computer's receipt of digital media presentations via a web page. Ex. 1001, code (57). An exemplary web page provided to a user's computer is shown in Figure 9, which is reproduced below:

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of § 103.

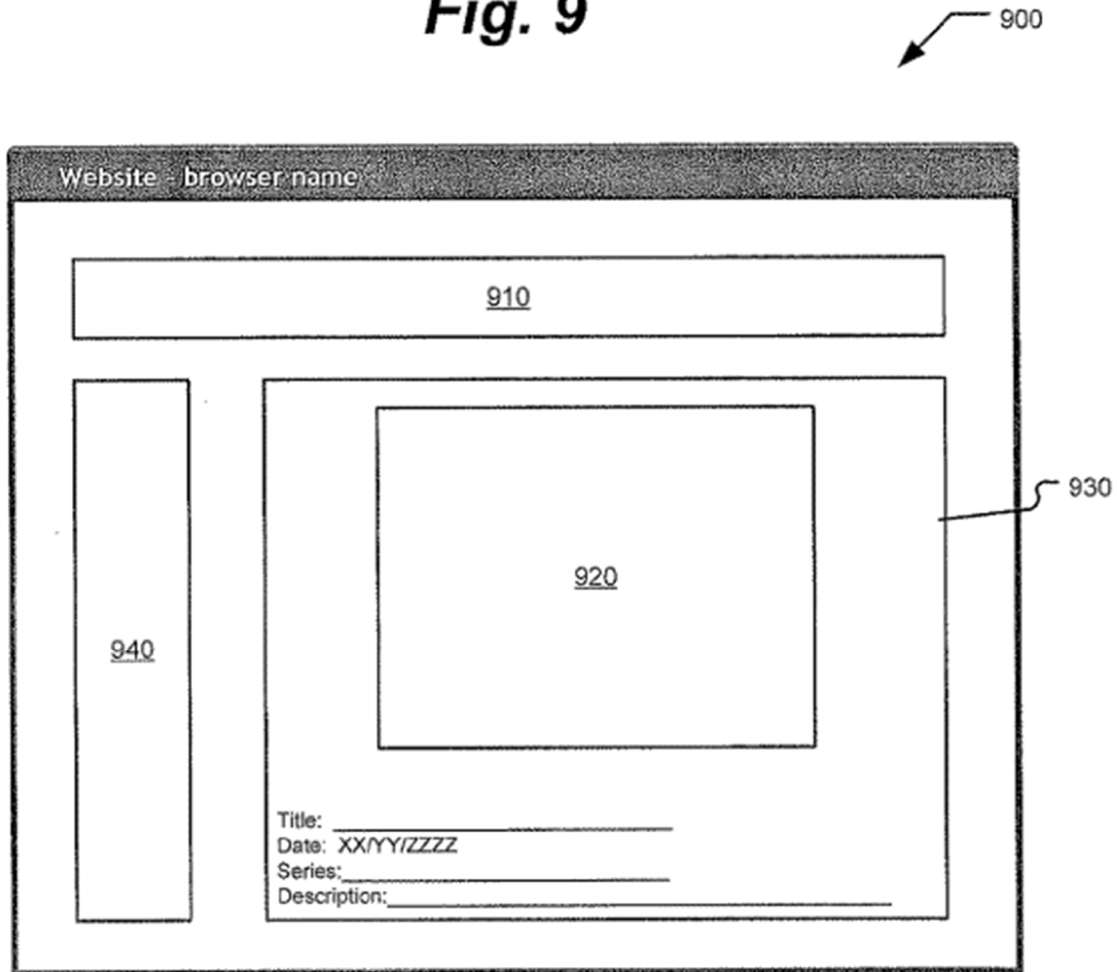
³ Jacoby, US 2004/0254887 A1, published Dec. 16, 2004 (Ex. 1006).

⁴ Bland et al., US 5,732,218, issued Mar. 24, 1998 (Ex. 1009).

⁵ McTernan et al., WO 01/89195 A2, published Nov. 22, 2001 (Ex. 1007).

⁶ Robinson et al., EP 0 939 516 A2, published Sept. 1, 1999 (Ex. 1008).

Fig. 9



Ex. 1001, Fig. 9. As shown above, Figure 9 depicts a web page (900) with portion 930 (including portion 920, where a presentation selected by the user may be displayed) and portions 910 and 940, which “may be used to display related information, such as advertisements.” *Id.* at 11:59–12:6, 12:12–14. In order to appropriately value the advertising space, the ’609 patent seeks to “identify how long the media was actually, or may typically be played.” *Id.* at 12:6–15.

The presentation, which is displayed in portion 920, may be supplied by the system or may be linked by the system (with the content stored on a third party’s computer system). Ex. 1001, 12:64–66; *see id.* at 7:25–38

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