

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLING TV L.L.C.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-01367
Patent 8,407,609 B2

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

DIRBA, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

On July 22, 2019, Sling TV L.L.C. (“Petitioner”) 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 Patent Owner Preliminary Response on November 6, 2019. Paper 6 (“Prelim. Resp.”).

To institute an *inter partes* review, we must determine that the information presented in the Petition, viewed in light of the Preliminary Response, “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Having considered the parties’ submissions, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1–3 on one of the grounds asserted in the Petition. Accordingly, we institute an *inter partes* review of the challenged claims.

A. *Related Matters*

The parties identify the following related proceedings currently or previously pending in district courts: *Uniloc 2017, LLC v. Sling TV, LLC*, 1:19-cv-00278 (D. Colo.); *Uniloc 2017 LLC v. Netflix, Inc.*, 8:18-cv-01899 (C.D. Cal.); *Uniloc 2017 LLC v. American Broadcasting Companies, Inc.*, 8:18-cv-01930 (C.D. Cal.); *Uniloc 2017 LLC v. Google LLC*, 2:18-cv-00456 (E.D. Tex.); *Uniloc 2017 LLC v. Google LLC*, 2:18-cv-00502 (E.D. Tex.); *Uniloc 2017 LLC v. Netflix, Inc.*, 8:18-cv-02055 (C.D. Cal.); *Uniloc 2017 LLC v. American Broadcasting Companies, Inc.*, 8:18-cv-02056 (C.D. Cal.); *Uniloc 2017 LLC v. Roku, Inc.*, 1:18-cv-01126 (W.D. Tex.); *Uniloc 2017*

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LLC v. Vudu, Inc., 1:19-cv-00183 (D. Del.); *Uniloc 2017 LLC v. Roku, Inc.*, 8:19-cv-00295 (C.D. Cal.). Pet. v–vi; Prelim. Resp. 2–3.

The '609 patent is also the subject of two other petitions for *inter partes* review: IPR2020-00041 (filed by Netflix, Inc. and Roku, Inc. on October 18, 2019) and IPR2020-00115 (filed by Google LLC on October 31, 2019). Prelim. Resp. 3. A decision whether to institute has not been entered in either proceeding.

B. Real Parties in Interest

Petitioner 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. 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:

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

¹ 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.

² Jacoby, US 2004/0254887 A1, published Dec. 16, 2004 (Ex. 1006).

³ Bland et al., US 5,732,218, issued Mar. 24, 1998 (Ex. 1009).

⁴ McTernan et al., WO 01/89195 A2, published Nov. 22, 2001 (Ex. 1007).

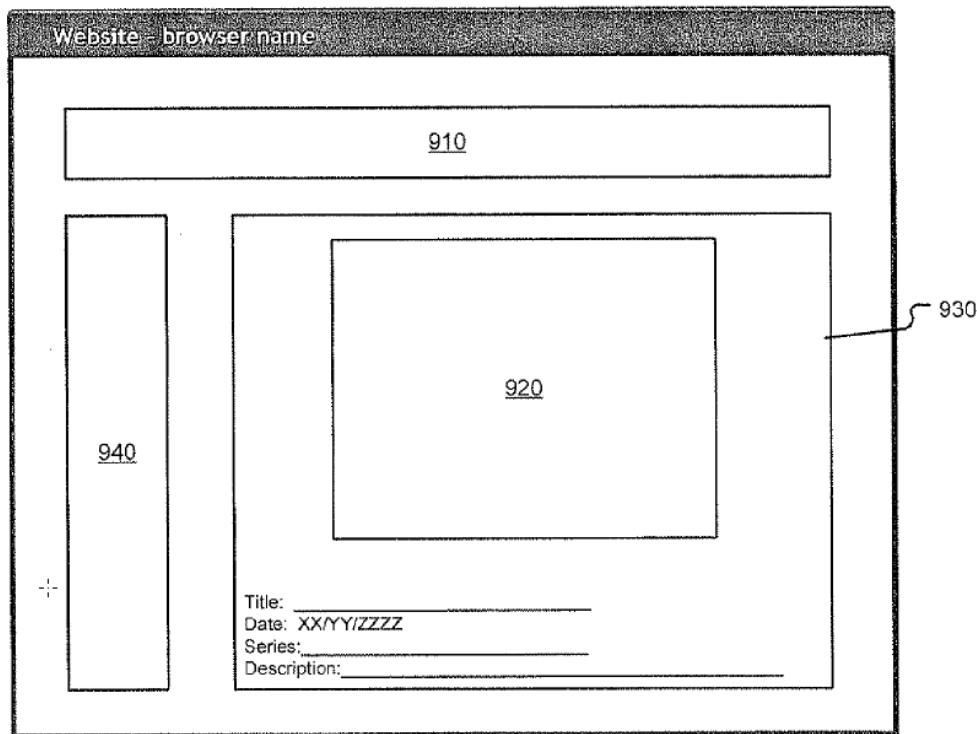
⁵ Robinson et al., EP 0 939 516 A2, published Sept. 1, 1999. (Ex. 1008).

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, Abstract. An exemplary web page provided to a user's computer is shown in Figure 9, which is reproduced below:



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 (identifying challenge of tracking presentation “[w]here content is housed elsewhere and linked to by computers 30”). “Regardless, page 900 may include a timer applet,”⁶ which is “used to indicate when a pre-determined temporal period has elapsed.” *Id.* at 12:66–67, 13:5–6. For example, the temporal period may be 10, 15, or 30 seconds. *Id.* at 13:6–8. “[W]hen the applet determines the predetermined temporal period has elapsed, it signals its continued execution to system 20.” *Id.* at 13:10–12. In addition, “the applet may cause [a] cookie [received with web page 900], or associated data, to be transmitted from the user’s computer 20 to system 30.” *Id.* at 13:14–21; *see id.* at Fig. 1 (illustrating user computers 20 and server computers 30). The system logs receipt of the applet’s signal and the client’s cookie data (or data associated with it). *Id.* at 13:12–13, 13:21–23. For example, “a table entry” may be made identifying the user, the page, and total time on that page. *Id.* at 13:24–30.

According to the ’609 patent, this “provide[s] the capability to know that a viewer began viewing a particular show at a certain time, and to know

⁶ “‘Applet,’ as used herein, generally refers to a software component that runs in the context of another program” Ex. 1001, 12:67–13:3.

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