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Paper 16
Entered: August 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VUDU, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00677
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
Granting Petitioner's Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

On March 3, 2020, Vudu, Inc. ("Vudu" or "Petitioner")[1] 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 1 ("Pet."). Concurrently with the filing of the Petition, Petitioner filed a Motion for Joinder, seeking to join itself as a petitioner in *Sling TV L.L.C. v. Uniloc 2017 LLC*, IPR2019-01367 ("the 1367 IPR"). Paper 3 ("Joinder Motion" or "Mot."). Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response in this proceeding (Paper 7 ("Prelim. Resp.")), but did not oppose the Joinder Motion.

Upon considering the information presented in each of these papers, for reasons discussed below, we institute trial in this *inter partes* review, and we join Petitioner as a party to the 1367 IPR.

II. DISCUSSION

A. Institution of Trial

1. Summary of 1367 IPR

In the 1367 IPR, Sling TV L.L.C. ("Sling") challenges the patentability of claims 1–3 of the '609 patent on the following grounds:

[1] Pursuant to 37 C.F.R. § 42.8(b)(1), which requires identification of real parties in interest, Petitioner identifies each of the following companies as a direct or indirect owner of Petitioner (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. Pet. vi; Paper 8 (Petitioner's Updated Mandatory Notice).

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

IPR2019-01367, Paper 2 at 2. After considering the petition and Patent Owner's preliminary response in the 1367 IPR, we determined that Sling had demonstrated a reasonable likelihood of showing that the challenged claims would have been obvious over the combined teachings of McTernan and Robinson, and we instituted trial. *See* IPR2019-01367, Paper 7 (PTAB Feb. 4, 2020) ("1367 Institution Decision").

2. Analysis of this Proceeding

To determine whether Petitioner has met the threshold for institution in this proceeding, we consider Petitioner's obviousness challenge to claim 1 based on the combination of McTernan and Robinson. Claim 1 is reproduced below, with bracketed lettering:

> 1. A method for tracking digital media presentations delivered from a first computer system to a user's computer via a network comprising:

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[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).

> [a] providing a corresponding web page to the user's computer for each digital media presentation to be delivered using the first computer system;
>
> [b] providing identifier data to the user's computer using the first computer system;
>
> [c] providing an applet to the user's computer for each digital media presentation to be delivered using the first computer system, wherein the applet is operative by the user's computer as a timer;
>
> [d] receiving at least a portion of the identifier data from the user's computer responsively to the timer applet each time a predetermined temporal period elapses using the first computer system; and
>
> [e] storing data indicative of the received at least portion of the identifier data using the first computer system;
>
> [f] wherein each provided webpage causes corresponding digital media presentation data to be streamed from a second computer system distinct from the first computer system directly to the user's computer independent of the first computer system;
>
> [g] wherein the stored data is indicative of an amount of time the digital media presentation data is streamed from the second computer system to the user's computer; and
>
> [h] wherein each stored data is together indicative of a cumulative time the corresponding web page was displayed by the user's computer.

Ex. 1001, 14:17–45.

Petitioner here (Vudu) represents that the present Petition is substantively identical to the petition in the 1367 IPR, challenges the same claims based on the same grounds, and relies on the same expert declaration. Pet. 1 (citing Ex. 1013); Mot. 1, 6. We have considered the relevant petitions and we agree with Petitioner's representation that this Petition is substantially identical to the petition in the 1367 IPR. *Compare* Pet., *with*

IPR2019-01367, Paper 2; *see* Ex. 1013 (redline showing differences between petitions).

Patent Owner does not respond to Petitioner's contentions for the preamble of claim 1 and for limitations [a], [b], [c], [d], [e], and [g]. *See generally* Prelim. Resp. 31–43. We are persuaded that Petitioner has shown sufficiently that the combination of McTernan and Robinson teaches the subject matter recited in the preamble and in these limitations for the reasons set forth in the 1367 Institution Decision, which we incorporate herein. *See* IPR2019-01367, Paper 7 at 13–19, 23.

For limitations [f] and [h], Patent Owner's instant Preliminary Response contains the same arguments as its preliminary response filed in the 1367 IPR, but it also further elaborates on those previously presented arguments. In particular, the Preliminary Response further seeks to explain Patent Owner's contentions that the Petition fails to show, for limitation [f], "a second computer system distinct from the first computer system" (*compare* Prelim. Resp. 31–34, *with* IPR2019-01367, Paper 6 at 16–17) and, for limitation [h], a motivation to combine the heartbeats of Robinson with the system of McTernan (*compare* Prelim. Resp. 34–43, *with* IPR2019-01367, Paper 6 at 17–20).

For limitation [f], expanding on the arguments it made in its preliminary response in IPR2019-01367, Patent Owner argues that the 1367 "Institution Decision does not refute Patent Owner's argument that the Petition does not show the alleged 'first computer system' and 'second computer system' are not under common operation or control," and, according to Patent Owner, the Petition is premised on Petitioner's argument that the computer systems "are distinct because they are not under common

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