

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NETFLIX, INC. and ROKU, INC.,  
Petitioner,

v.

UNILOC 2017 LLC,  
Patent Owner.

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IPR2020-00041  
Patent 8,407,609 B2

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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 October 18, 2019, Netflix, Inc. and Roku, Inc. (collectively “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 1 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response on January 24, 2020. Paper 9 (“Prelim. Resp.”).<sup>1</sup>

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 the grounds asserted in the Petition. Accordingly, we institute an *inter partes* review of the challenged claims.

### A. Related Matters

The parties identify several district court proceedings involving the ’609 patent, including *Uniloc 2017 LLC v. Netflix, Inc.*, 8:18-cv-02055 (C.D. Cal.); *Uniloc 2017 LLC v. Roku, Inc.*, 8:19-cv-00295 (C.D. Cal.); *Uniloc 2017 LLC v. Google LLC*, 2:18-cv-00502 (E.D. Tex.); *Uniloc 2017 LLC v. American Broadcasting Companies, Inc.*, 8:18-cv-02056 (C.D. Cal.); *Uniloc*

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<sup>1</sup> In the Preliminary Response, some page numbers are repeated, causing different pages to have identical page numbers. This Decision cites to this Paper using the number appearing at the bottom of a page and, unless otherwise indicated, refers to pages occurring after the first set of pages 1–9.

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*2017 LLC v. Vudu, Inc.*, 1:19-cv-00183 (D. Del.); and *Uniloc 2017, LLC v. Sling TV, LLC*, 1:19-cv-00278 (D. Colo.). Pet. 2–3; Prelim. Resp. 1.

The '609 patent is also the subject of two other petitions for *inter partes* review: IPR2019-01367 (filed by Sling TV, L.L.C. on July 22, 2019) and IPR2020-00115 (filed by Google LLC on October 31, 2019). Pet. 3; Prelim. Resp. 1. The Board instituted an *inter partes* review in IPR2019-01367. *Sling TV, L.L.C. v. Uniloc 2017 LLC*, IPR2019-01367, Paper 7 (PTAB Feb. 4, 2020) (Institution Decision). A decision whether to institute has not yet been entered in IPR2020-00115.

*B. The Petition's Asserted Grounds*

Petitioner asserts the following grounds of unpatentability (Pet. 5):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3	103(a) <sup>2</sup>	Davis <sup>3</sup> and Choi <sup>4</sup>
1–3	103(a)	Siler <sup>5</sup> and Davis

Petitioner also relies on the testimony of Dr. Michael Franz to support its contentions. Ex. 1002.

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<sup>2</sup> 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.

<sup>3</sup> US 5,796,952, issued Aug. 18, 1998 (Ex. 1003).

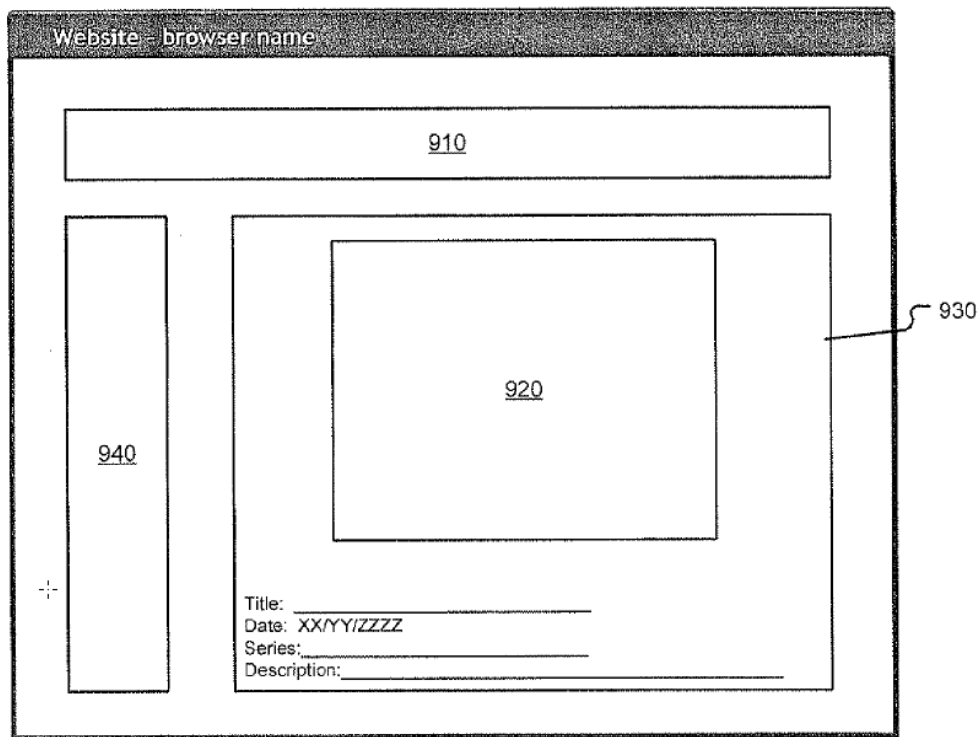
<sup>4</sup> US 2003/0236905 A1, published Dec. 25, 2003 (Ex. 1004).

<sup>5</sup> US 2004/0133467 A1, published Jul. 8, 2004 (Ex. 1005).

C. *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 code (22), (60).

The '609 patent discloses tracking a user computer's receipt of digital media presentations via a web page. Ex. 1001, Abstr. 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,”<sup>6</sup> 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 ten, fifteen, or thirty 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 when a user began viewing a different page, or show, thereby providing knowledge of how long a particular viewer spent on a particular page.” *Id.*

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<sup>6</sup> “‘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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