

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

U.S. Patent No. 8,407,609
Filing Date: August 21, 2009
Issue Date: March 26, 2013

Case No. IPR2020-00115

PETITION FOR *INTER PARTES* REVIEW

TABLE OF CONTENTS

I.	PRELIMINARY STATEMENT	1
II.	OVERVIEW OF PRIOR ART	2
III.	THE '609 PATENT	15
	A. Overview	15
	B. Challenged Claims	20
IV.	LEVEL OF ORDINARY SKILL IN THE ART	22
V.	CLAIM CONSTRUCTION	23
VI.	STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED	24
VII.	THE CHALLENGED CLAIMS ARE UNPATENTABLE OVER THE PRIOR ART	24
	A. Ground 1: Claim 1 is anticipated by <i>Hayward</i>	24
	B. Ground 2: Claim 1 is rendered obvious by <i>Hayward</i> and <i>Middleton</i>	46
	C. Ground 3: Claims 2 and 3 are rendered obvious by <i>Hayward</i> , or <i>Hayward</i> and <i>Middleton</i> , in combination with <i>Ryan</i>	56
VIII.	GOOGLE RAISES NEW GROUNDS OF UNPATENTABILITY	60
IX.	MANDATORY NOTICES	63
	A. Real Parties-in-Interest	63
	B. Related Matters.....	63
	C. Lead and Back-Up Counsel, and Service Information	64
X.	GROUNDS FOR STANDING.....	65
XI.	CONCLUSION.....	65

LIST OF EXHIBITS

Exhibit	Description
Ex. 1001	U.S. Patent No. 8,407,609
Ex. 1002	Prosecution File History of U.S. Patent No. 8,407,609
Ex. 1003	Declaration of Dr. Jeffrey Chase
Ex. 1004	Curriculum Vitae of Dr. Jeffrey Chase
Ex. 1005	U.S. Patent App. Pub. No. 2004/0045040 to Hayward (“ <i>Hayward</i> ”)
Ex. 1006	U.S. Patent App. Pub. No. 2002/0111865 to Middleton (“ <i>Middleton</i> ”)
Ex. 1007	U.S. Patent No. 6,421,675 to Ryan (“ <i>Ryan</i> ”)
Ex. 1008	Defendant Google LLC’s Claim Term Disclosure in <i>Uniloc 2017 LLC v. Google LLC</i> , 2:18-cv-00502 (E.D. Tex., Sep. 24, 2019)
Ex. 1009	Plaintiffs’ Preliminary Claim Constructions and Identification of Extrinsic Evidence Pursuant to P.R. 4-2 in <i>Uniloc 2017 LLC v. Google LLC</i> , 2:18-cv-00502 (E.D. Tex., Sep. 24, 2019)
Ex. 1010	<i>Sling TV L.L.C. v. Uniloc 2017 LLC</i> , Petition for <i>Inter Partes</i> Review of U.S. Patent No. 8,407,609, IPR2019-01367 (July 22, 2019)
Ex. 1011	<i>Netflix, Inc. and Roku, Inc. v. Uniloc 2017 LLC</i> , Petition for <i>Inter Partes</i> Review of U.S. Patent No. 8,407,609, IPR2020-00041 (Oct. 18, 2019)
Ex. 1012	U.S. Patent Application Pub. No. 2004/0254887 to Jacoby (“ <i>Jacoby</i> ”)

I. PRELIMINARY STATEMENT

Petitioner Google LLC requests *inter partes* review and cancellation of claims 1–3 of U.S. Patent No. 8,407,609 (“the ’609 patent”) (Ex. 1001), assigned to Uniloc 2017 LLC. These claims are directed to tracking a user’s viewing of a digital media presentation, something well-known before the earliest claimed priority date of the ’609 patent.

The ’609 patent describes a content or web server and database server that allow a user, through a device, to search for digital media presentations such as videos. Ex. 1001, 4:57–61, 5:29–67. When the user selects a digital media presentation from a list of search results, the content or web server provides to the device a web page, and the selected digital media presentation is streamed to the device through a media player associated with the web page. *Id.*, 5:20–25, 11:62–64, 12:1–5. The web page includes portions that “may be used to display . . . advertisements.” *Id.*, 12:5–6.

The ’609 patent recognizes that “it may be desirable to be able to reliable [sic] identify how long the media was actually, or may typically, be played, in order to appropriately value [the] portions [] as available advertising billboard space.” *Id.*, 12:6–10. According to the ’609 patent, “[s]uch knowledge is not conventionally available.” *Id.*, 13:47–48.

But by 2008, when the provisional application leading to the '609 patent was filed, tracking a user's viewing of a digital media presentation, including how long a digital media presentation is played, was well known. For example, *Hayward* (Ex. 1005), filed in 2001, discloses tracking a user's viewing of a media file, including how long the media file is played. As another example, *Middleton* (Ex. 1006), filed in 2002, discloses tracking a user's interactions with an element displayed on a web page, including how long the element is displayed. Similarly, *Ryan* (Ex. 1007), issued in 2002, discloses measuring a user's interest in a web page by tracking how long a user looks at the web page. Ex. 1007, 12:27–31, 16:40–42. *Hayward*, *Middleton*, and *Ryan* each recognize that this knowledge is valuable to advertisers. Ex. 1005, ¶0064; Ex. 1006, ¶0010; Ex. 1007, 9:22-30, 12:22-30. And together, they anticipate and/or render obvious the claimed concepts of the '609 patent.

II. OVERVIEW OF PRIOR ART

1. *Hayward*

U.S. Patent App. Pub. No. 2004/0045040 to *Hayward* was filed October 24, 2001 and published March 4, 2004, constituting prior art under at least pre-AIA § 102(b). Ex. 1005. *Hayward* was not cited or considered during prosecution of the '609 patent.

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