

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner,

v.

EQUIL IP HOLDINGS LLC,
Patent Owner.

IPR2023-00332
Patent 9,158,745 B2

Before RICHARD M. LEBOVITZ, ROBERT J. WEINSCHENK, and
SHARON FENICK, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

Akamai Technologies, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–7 (“the challenged claims”) of U.S. Patent No. 9,158,745 B2 (Ex. 1001, “the ’745 patent”). Equil IP Holdings LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”) to the Petition.

Subsequent to the filing of the Petition and Preliminary Response, we authorized Petitioner (Ex. 1040 (PTAB email dated May 18, 2023)) to file a Preliminary Reply Brief (Paper 12, “Prelim. Reply Br.”) limited to addressing (1) Patent Owner’s arguments under 35 U.S.C. § 325(d); and (2) Patent Owner’s arguments relating to the correction of inventorship in U.S. Patent No. 6,964,009 (“the ’009 patent”) and its effect on the prior art status of a piece of art included in several of the asserted grounds. We also authorized Patent Owner to file a responsive Preliminary Sur-reply (Paper 13, “Prelim. Sur-reply”).

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any 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).

After considering the Petition, the Preliminary Response, the Preliminary Reply Brief, the Preliminary Sur-reply, and the evidence of record, for the reasons explained below, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of at least one claim challenged in the Petition. Hence, we deny the Petition and do not institute an *inter partes* review.

B. Real Parties in Interest

The parties identify themselves as the only real parties in interest. Pet. 3; Paper 4, 1.

C. Related Matters

Petitioner and Patent Owner identify the following proceeding as a related matter involving the '745 patent: *Equil IP Holdings LLC v. Akamai Technologies, Inc.*, No. 1:22-cv-00677 (D. Del.). Pet. 3; Paper 4, 1.

D. The '745 Patent (Exhibit 1001)

The '745 patent, titled “Optimization of Media Content Using Generated Intermediate Content,” issued on October 13, 2015, from Application No. 13/752,110 (“the '110 application”) filed January 28, 2013. Ex. 1001, codes (45), (21), (22).

The '745 patent claims priority to a chain of ancestor patent applications, including Application No. 09/929,904 (“the '904 application”), filed on August 14, 2001, which issued as the '009 patent. Ex. 1001, code (60). The published version of the '904 application, US Pub. No. 2002/0078093 A1 (Ex. 1007 (“Samaniego”)), is cited by Petitioner as prior art in three of the patentability challenges to the '745 patent claims. Pet. 6. We address the status of Samaniego as a printed publication in more detail below.

The '745 patent discloses an “automatic graphics delivery system that operates in parallel with an existing Web site infrastructure.” Ex. 1001, 7:6–7. The system is described as “streamlin[ing] the post-production process by automating the production of media,” requested by a user from a browser,

“through content generation procedures controlled by proprietary tags placed within URLs embedded within Web documents.” Ex. 1001, 7:8–11. The disclosed system “automatically processes the URL encoded tags and automatically produces derivative media for the web site from the original media” which is available for viewing by a user. Ex. 1001, 7:13–16.

The '745 patent explains that the proprietary tags are used “to generate optimized media” by automated processing of the tags upon request of the media by a client. Ex. 1001, 5:65–6:1. This process, according to the '745 patent, reduces the “need for the Web author to create different versions of a Web site” for clients. Ex. 1001, 6:1–6:3. The '745 patent also discloses that “generated media is cached such that further requests for the same media require little overhead.” Ex. 1001, 6:3–5.

An embodiment of the process described in the '745 patent is illustrated in Figure 21, reproduced below:

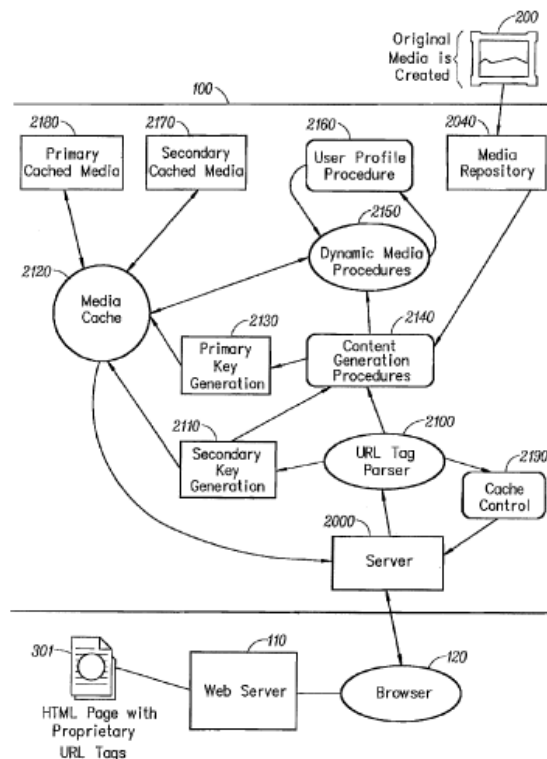


Figure 21, reproduced above, shows a flow chart of a process including delivery of an HTML web page with proprietary tags to browser 120, followed by the transfer of the delivered HTML web page from browser 120 to server 2000. Server 2000 is shown as being part of system 100. System 100 comprises URL tag parser 2100 for processing the proprietary tags. System 100 also comprises content generation procedures 2140 and dynamic media procedures 2150 that are performed on the media. Media cache 2120 is also part of system 100.

More specifically, with reference to Figure 21, a user through browser 120 makes a request to web server 110 for web page 301. Ex. 1001, 19:12–14. Web page 301 is labeled in Figure 21 as an “HTML Page with Proprietary URL Tags.” The proprietary URL tags contain the information that direct browser 120 “to request the specified content generation procedure 2140 from the system 100 using input parameters specified with proprietary tags encoded within the URL.” Ex. 1001, 19:9–12. The content generation procedures are performed on the media. Ex. 1001, 19:5–7. Browser 120 receives web page 301 with the proprietary tags and provides them to server 2000; the server is part of system 100. Ex. 1001, 19:14–15; Fig. 21. Thus, system 100 receives the proprietary tags specifying content generation procedure 2140 from a user.

System 100 comprises URL tag parser 2100 which parses the proprietary URL tags embedded in web page 301 that are sent to server 2000 “to determine the content generation procedure 2140 to execute, any corresponding input parameters to be used by such procedure, [and] any dynamic content processing 2150 to be performed by dynamic media procedures” on the media. Ex. 1001, 19:15–20. The ’745 patent discloses

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