

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUODECAD IT SERVICES LUXEMBOURG S.À R.L.,
ACCRETIVE TECHNOLOGY GROUP, INC., ICF TECHNOLOGY, INC.,
RISER APPS LLC, and STREAMME, INC. (f/k/a VUBEOLOGY, INC.),
Petitioners,

v.

WAG ACQUISITION, LLC,
Patent Owner.

Case IPR2017-00820
Patent 8,122,141 B2

Before TREVOR M. JEFFERSON, BRIAN J. McNAMARA, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION

Petition for *Inter Partes* Review and Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

On January 31, 2017, Duodecad IT Services Luxembourg S.à r.l.,
Accretive Technology Group, Inc., ICF Technology, Inc., Riser Apps LLC,
and StreamMe, Inc. (“Petitioners”) filed a Petition (Paper 2, “Pet.”) to

institute an *inter partes* review of claims 1–28 of U.S. Patent No. 8,122,141 B2 (“the ’141 patent”); and (2) a Motion for Joinder (Paper 3, “Mot.”) with IPR2016-01238 (“the related IPR”), which was instituted on January 4, 2017. On February 21, 2017, WAG Acquisition, LLC (“Patent Owner”) filed an Opposition to the Motion for Joinder (Paper 8, “Opp.”), to which Petitioners replied on February 27, 2017 (Paper 9, “Reply”). On March 20, 2017, Patent Owner waived filing of a Preliminary Response to the Petition. Paper 14.

We grant the Motion for Joinder, joining Petitioners as parties to the related IPR, and dismiss the Petition.

I. BACKGROUND

A. *The ’141 Patent*

The ’141 patent discloses a system for streaming media, such as audio or video, via the Internet with reduced playback interruptions. Ex. 1001, col. 4, ll. 39–44. Data interruptions can be recovered while a media player continues to play the audio or video material. *Id.* at col. 4, ll. 48–50. Figure 1 of the ’141 patent is reproduced below.

Fig. 1

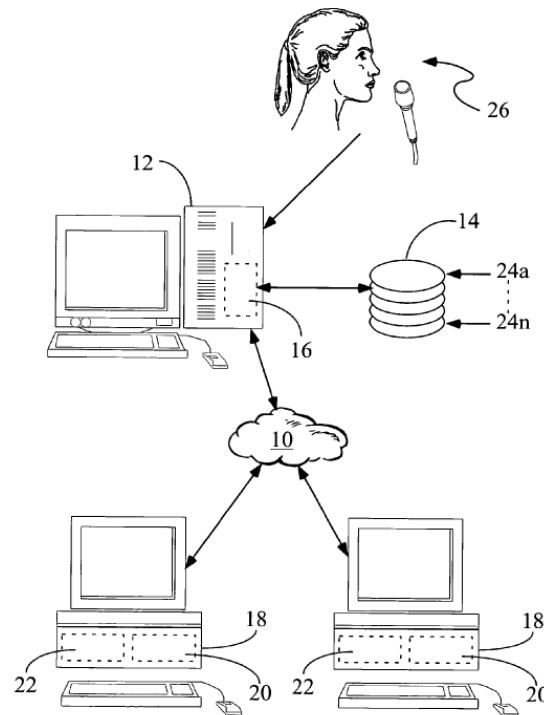


Figure 1 is a schematic diagram that illustrates elements of a streaming media buffering system. *Id.* at col. 10, ll. 7–9. Server 12 is connected to the Internet for transmitting sequenced streaming-media data elements. *Id.* at col. 10, ll. 22–25. Associated with server 12 are buffer manager 16 and first-in-first-out (“FIFO”) buffer 14, which stores at least one of the data elements for transmission. *Id.* at col. 10, ll. 25–27. Buffer manager 16 receives the media data, supplies the media data in order to FIFO buffer 14, and maintains pointers 24a–24n into the buffer for user computers, indicating the last media data element that has been sent to respective users and thus indicating the next element or elements to be sent. *Id.* at col. 10, ll. 30–38. Once FIFO buffer 14 is full, the oldest data elements in the buffer are deleted as new elements are received. *Id.* at col. 10, ll. 38–40. A

predetermined number of data elements are kept in FIFO buffer 14. *Id.* at col. 10, ll. 40–41.

At least one user computer 18 is connected to server 12 via the Internet. *Id.* at col. 10, ll. 45–46. User buffer 20 is associated with user computer 18 and stores a predetermined number of the media data elements. *Id.* at col. 10, ll. 47–49. Buffer manager 22, associated with user computer 18, receives and stores a predetermined number of media data elements received by the media player, plays the data out sequentially as audio and/or video, and deletes media data elements from buffer 20 as they are played out to maintain approximately the predetermined number of data elements in the user's buffer. *Id.* at col. 10, ll. 53–59, col. 8, ll. 31–34.

B. Illustrative Claims

Independent claims 10 and 19 are illustrative of the claims at issue:

10. A server for distributing streaming media via a data communications medium such as the Internet to at least one user system of at least one user, the streaming media comprising a plurality of sequential media data elements for a digitally encoded audio or video program, said user system being assumed to have a media player for receiving and playing the streaming media on said user system, which is operable to obtain media data elements from said server by transmitting requests to said server to send one or more specified media data elements, said server comprising

at least one data storage device, memory for storing machine-readable executable routines and for providing a working memory area for routines executing on the server, a central processing unit for executing the machine-readable

executable routines, an operating system, at least one connection to the communications medium, and a communications system providing a set of communications protocols for communicating through said at least one connection;

a machine-readable, executable routine containing instructions to cause the server to assign serial identifiers to the sequential media data elements comprising the program;

a machine-readable, executable routine containing instructions to cause the server to receive requests from the user system for one or more media data elements specifying the identifiers of the requested data elements; and

a machine-readable, executable routine containing instructions to cause the server to send media data elements to the user system responsive to said requests, at a rate more rapid than the rate at which said streaming media is played back by a user.

Ex. 1001, col. 13, l. 63–col. 14, l. 28.

19. A non-transitory machine-readable medium on which there has been recorded a computer program for use in operating a computer to prepare streaming media content for transmission by a server wherein said server responds to user requests for media data elements identified by a serial identifier, said program recorded on said non-transitory machine readable medium comprising a routine to store and serially identify sequential data elements comprising said streaming media content, in a format capable of being served to users by said server.

Id. at col. 14, ll. 49–58.

C. References

Petitioners rely on the following references. Pet. 7–10.

Chen	US 5,822,524	Oct. 13, 1998	Ex. 1002
Carmel	US 6,389,473 B1	May 14, 2002	Ex. 1003

M. H. Willebeek-LeMair, K. G. Kumar, and E. C. Snible,
Bamba—Audio and video streaming over the Internet, 42 IBM
J. RES. DEVELOP. 269 (March, 1998) (Ex. 1004) (“Willebeek”)

International Standard ISO/IEC 11172-1, *Information
Technology—Coding of moving pictures and associated audio
for digital storage media at up to about 1,5 Mbit/s—Part 1:
Systems* (ISO/IEC, August 1993) (Ex. 1018) (“ISO-11172-1”)

International Standard ISO/IEC 11172-2, *Information
Technology—Coding of moving pictures and associated audio
for digital storage media at up to about 1,5 Mbit/s—Part 2:
Video* (ISO/IEC, August 1993) (Ex. 1019) (“ISO-11172-2”)

International Standard ISO/IEC 11172-3, *Information
Technology—Coding of moving pictures and associated audio
for digital storage media at up to about 1,5 Mbit/s—Part 3:
Audio* (ISO/IEC, August 1993) (Ex. 1020) (“ISO-11172-3”)¹

D. Asserted Grounds of Unpatentability

Petitioners challenge claims 1–28 of the ’141 patent on the following grounds. Pet. 4–5.

¹ In their challenges, Petitioners refer collectively to ISO-11172-1, ISO-11172-2, and ISO-11172-3 as “ISO-11172.” Because the challenges involving these references are all under 35 U.S.C. § 103(a), and because there is a self-evident reason to combine their teachings, we do not address whether they are properly considered as a single reference or as three separate references.

Reference(s)	Basis(es)	Claims Challenged
Chen	§ 102(b)	1, 2, 4–7, 9–11, 13–16, 18–20, 23, 24, and 26–28
Chen and Willebeek	§ 103(a)	8, 17, and 21
Chen and ISO-11172	§ 103(a)	3, 12, 22, and 25
Carmel	§ 102(a) § 102(e) ²	10, 11, 13–21, and 23
Carmel and Willebeek	§ 103(a)	1, 2, 4–9, 24, and 26–28
Carmel, Willebeek, and ISO-11172	§ 103(a)	3 and 25
Carmel and ISO-11172	§ 103(a)	12 and 22

E. Related Proceedings

The parties identify the following matters as involving the '141 patent: (1) *WAG Acquisition, LLC v. Sobonito Investments, Ltd.*, No. 2A14-cv-1661-ES-MAH (D.N.J.); (2) *WAG Acquisition, LLC v. Multi Media, LLC*, No. 2:14-cv-2340-ES-MAH (D.N.J.); (3) *WAG Acquisition, LLC v. Data Conversions, Inc.*, No. 2:14-cv-2345-ES-MAH (D.N.J.); (4) *WAG Acquisition, LLC v. Flying Crocodile, Inc.*, No. 2:14-cv-2674-ES-MAH (D.N.J.); (5) *WAG Acquisition, LLC v. Gattyàn Group S.à r.l.*, No. 2:14-cv-2832-ES-MAH (D.N.J.); (6) *WAG Acquisition, LLC v. FriendFinder Networks Inc.*, No. 2:14-cv-3456-ES-MAH (D.N.J.); (7) *WAG Acquisition, LLC v. Vubeology, Inc.*, No. 2:14-cv-4531-ES-MAH (D.N.J.); (8) *WAG Acquisition, LLC v. Gamelink Int'l Ltd.* No. 2:15-cv-3416-ES-MAH

² Page 4 of the Petition asserts that claims 10, 11, 13–21, and 23 are challenged “under 35 U.S.C. § 102(b) as anticipated by Carmel,” but page 8 of the Petition alleges that Carmel “is prior art under at least 35 U.S.C. § 102(a) and (e).”

(D.N.J.); (9) *WAG Acquisition LLC v. WebPower, Inc.*, No. 2:15-cv-3581-ES-MAH (D.N.J.); and (10) *WAG Acquisition, LLC v. MFCXY, Inc.*, No. 2:14-cv-3196-ES-MAH (D.N.J.). Pet. 2, Paper 7, 2–3.

In addition, the parties identify the following *inter partes* reviews as involving the '141 patent: IPR2015-01037, IPR2016-01238, IPR2016-01656, and IPR2017-00786. Of these, review has been instituted in IPR2016-01238 and IPR2016-01656, but denied in IPR2015-01037. Like this proceeding, a motion for joinder with IPR2016-01238 was filed in IPR2017-00786. We have concurrently issued a decision in IPR2017-00786 granting joinder with IPR2016-01238.

A continuation of the '141 patent, U.S. Patent No. 8,327,011 B2, is the subject of IPR2015-01033, IPR2016-01161, and IPR2016-01655; institution was denied in each of those proceedings. Two other related patents are the subject of further *inter partes* review proceedings: U.S. Patent No. 8,185,611 is the subject of IPR2015-01035, IPR2016-01162, and IPR2016-01657, with institution denied in each of those proceedings; and U.S. Patent No. 8,364,839 is the subject of IPR2015-01036, IPR2016-01239, IPR2016-01658, IPR2017-00784, IPR2017-00785, and IPR2017-01179.

II. ANALYSIS

In the related IPR, we instituted an *inter partes* review of claims 10–23 on the following bases:

Reference(s)	Basis(es)	Claim(s) Challenged
Chen	§ 102(b)	19, 20, and 23
Chen and Willebeek	§ 103(a)	21

Reference(s)	Basis(es)	Claim(s) Challenged
Chen and ISO-11172	§ 103(a)	22
Carmel	§ 102(a) § 102(e)	10, 11, 13–21, and 23
Carmel and ISO-11172	§ 103(a)	12 and 22

WebPower, Inc. v. WAG Acquisition, LLC, Case IPR2016-01238, slip op. at 22–23 (PTAB Jan. 4, 2017) (Paper 7).

The Petition in this proceeding challenges the same claims challenged in the related IPR on the same grounds of unpatentability, and relies on the same evidence and arguments. Pet. 4–5, Mot. 1. In addition to representing that the Petition is substantively identical to the petition in the related IPR, Petitioners “request that the institution of the accompanying Petition be limited to the grounds instituted” in the related IPR. Mot. 2. Petitioners agree to “adhere to all applicable deadlines” in the related IPR, to “coordinate all filings with” the petitioner in the related IPR, not to seek additional depositions or deposition time, and to “coordinate deposition questioning and hearing presentations with” the petitioner in the related IPR. *Id.* at 1–2.

In light of these representations and agreements, and in light of Patent Owner’s waiver of filing a Preliminary Response, we determine that Petitioners have demonstrated sufficiently that the arguments in the Petition warrant institution of an *inter partes* review under 35 U.S.C. § 314 with respect to the grounds instituted in the related proceeding. A party may be joined to an instituted *inter partes* review in accordance with the following statutory provision:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c); see 37 C.F.R. § 42.122. As the moving party, Petitioners bear the burden of proving that they are entitled to the requested relief. 37 C.F.R. § 42.20(c).

Patent Owner opposes joinder because “the instant Petition and motion are second bites at the apple for Petitioners, and Petitioners have failed to explain why the instant grounds and arguments were not raised in prior (and timely) petition.” Opp. 1. Patent Owner observes that, but for the exception provided by 35 U.S.C. § 315(b) for a request for joinder, the Petition would be time barred, arguing that “Petitioners had their chance,” with one of the Petitioners having “filed an IPR petition against the ’141 Patent in 2015, within a year of having been served with a complaint alleging infringement of the ’141 Patent.” *Id.* Petitioners reply that joinder will promote efficiency by consolidating issues and that Patent Owner does not refute the “*Dell*” factors outlined by Petitioner in its Motion for Joinder. Reply 1–4.

Based on the facts and circumstances discussed above, we determine that Petitioners have met their burden of demonstrating that their joinder to the related proceeding is warranted. We have considered Patent Owner’s argument that at least one of the Petitioners could have raised the arguments

and evidence in its 2015 petition. Although the fact that a petition includes arguments and evidence that reasonably could have been raised in an earlier petition may weigh against joinder, the decision to grant or deny joinder is made “on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” See *Unified Patents, Inc. v. PersonalWeb Techs., LLC*, Case IPR2014-00702, slip op. at 3 (PTAB July 24, 2014) (Paper 12); *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, Case IPR2013-00385, slip op. at 3 (PTAB July 29, 2013) (Paper 17). Because Patent Owner is already defending the related IPR, and because there will be no schedule change or separate filings by Petitioners in the related IPR, Patent Owner will not be prejudiced. Accordingly, we conclude that the Motion for Joinder should be granted, and the Petition dismissed so that all further filings are made in the related proceeding to which Petitioners are joined.

III. ORDER

It is

ORDERED that Petitioners’ Motion for Joinder is *granted* and that Petitioners are hereby joined as parties to IPR2016-01238;

FURTHER ORDERED that the grounds of unpatentability on which trial was instituted in IPR2016-01238 are unchanged and remain the only grounds on which trial has been instituted;

FURTHER ORDERED that the Scheduling Order and any modifications thereto entered in IPR2016-01238 shall govern the schedule of the joined proceeding;

FURTHER ORDERED that the joined parties in IPR2016-01238 shall file all papers jointly in the joined proceeding as consolidated filings, and will identify each such paper as “Consolidated,” except for papers that involve fewer than all of the parties;

FURTHER ORDERED that the Petition is *dismissed*;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2016-01238; and

FURTHER ORDERED that the case caption in IPR2016-01238 shall be modified in accordance with the attached example to reflect joinder of Petitioners, as well as joinder of the petitioners of IPR2017-00786, who are concurrently joined to IPR2016-01238 by a Decision in IPR2017-00786.

IPR2017-00820
Patent 8,122,141 B2

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Example Case Caption for Joined Proceeding

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEBPOWER, INC.,

FRIENDFINDER NETWORKS INC., STEAMRAY INC., WMM, LLC,
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DUODECAD IT SERVICES LUXEMBOURG S.À R.L.,
ACCRETIVE TECHNOLOGY GROUP, INC., ICF TECHNOLOGY, INC.,
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