

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MG FREESITES LTD,
Petitioner,

v.

SCORPCAST, LLC,
Patent Owner.

IPR2021-00510
Patent 9,899,063 B2

Before MEREDITH C. PETRAVICK, ERIC C. JESCHKE, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining Some Challenged Claims Unpatentable
Dismissing Petitioner's Motion to Exclude
35 U.S.C. § 318(a)

I. INTRODUCTION

Petitioner, MG Freesites Ltd, filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 9–11, 13, 18–20, 22, 24, 26, and 27 (the “challenged claims”) of U.S. Patent No. 9,899,063 B2 (Ex. 1001, “the ’063 patent”). Petitioner filed a Declaration of Dr. Adam Porter in support of the Petition. Ex. 1002. Patent Owner, Scorpcast, LLC, filed a Preliminary Response (Paper 6, “Prelim. Resp.”). On August 12, 2021, we instituted this *inter partes* review as to the challenged claims and all grounds presented in the Petition. Paper 14 (“Dec.”).

During the course of trial, Patent Owner filed a response to the Petition. Paper 16 (“PO Resp.”). In support of the Patent Owner Response, Patent Owner filed a Declaration of Narbeh Avedissian (Ex. 2089), a Declaration of Nikhil Sreenath (Ex. 2090), and a Declaration of Ricardo Valerdi, Ph.D. (Ex. 2091). Petitioner filed a Reply to the Patent Owner Response. Paper 23 (“Pet. Reply”). Patent Owner filed a Sur-reply. Paper 26 (“Sur-Reply”). Petitioner filed a Motion to Exclude Evidence. Paper 31. An oral hearing was held on May 13, 2022 and the transcript is entered into the record. Paper 37 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims of the ’063 patent. For the reasons discussed below, we determine Petitioner establishes by a preponderance of the evidence that claims 1, 9, 10, 11, 18, 19, 20, 22, 26, and 27 are unpatentable but does not establish by a preponderance of the evidence that claims 13 and 24 are unpatentable. We also dismiss Petitioner’s Motion to Exclude as moot.

A. Related Matters

The parties state that the '063 patent is asserted in *Scorpcast, LLC dba HaulStars v. MG Freesites Ltd*, Case No. 6-20-cv-00877 (W.D. Tex.). Pet. xx; Paper 3, 2. The District Judge transferred this case to the District of Delaware on June 22, 2021. Paper 10, 6; Paper 11, 1. Patent Owner also states that a decision in this proceeding would affect or be affected by numerous other *inter partes* reviews and District Court proceedings. Paper 3, 2–4.

B. Real Parties-in-Interest

Petitioner identifies itself as the only real party-in-interest. Pet. xx. Patent Owner identifies itself as the only real party-in-interest. Paper 3, 1.

C. The '063 Patent (Ex. 1001)

The '063 patent is titled “System and Methods for Providing User Generated Video Reviews.” Ex. 1001, code (54). The '063 patent issued on February 20, 2018, from an application filed on April 26, 2017. *Id.* at codes (45), (22).

The '063 patent “relates to content sharing, and more specifically, to providing user generated or produced video reviews of products and/or services.” *Id.* at 1:15–17. In an embodiment, user generated video reviews comprising audio and video data of a reviewed product or multiple products are received. *Id.* at 2:11–19. The review of a particular item “may be time stamped by the user via a user interface, the time stamp indicating at what point in time in the video review file the review of the given item begins/occurs.” *Id.* at 2:23–26. The user is provided with a control “to indicate the start of an item review and/or to add tags associated with the item review.” *Id.* at 2:30–33.

An image from a product “review may be displayed in a scrubber area . . . to indicate where the user wants the video playback to begin or to browse frames in the video.” *Id.* at 2:42–47. “[T]he scrubber area may display images of items being reviewed in the video review file, where a given item image is displayed in the scrubber timeline at a location corresponding to where the review of the respective item begins.” *Id.* at 2:48–52. Tags “associated with the reviewed item may be received from the user” and “may be descriptive of the reviewed item.” *Id.* at 2:59–62. “One or more . . . tags may be associated with the start of an item review.” *Id.* at 2:64–65.

Figure 10 from the '063 patent is reproduced below:

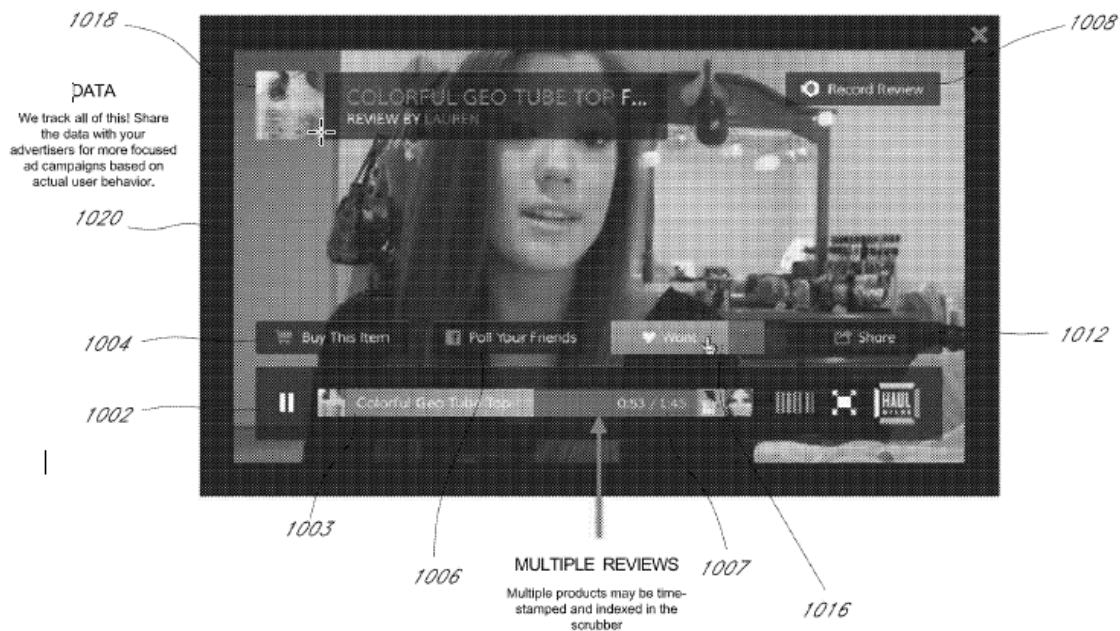


FIG. 10

Figure 10 is “an example user interface application for publishing a user generated video review.” *Id.* at 13:54–55. “[W]hile a still of the video review is being displayed and/or while the video review 1020 is being

played for a viewer, various items of information 1018 may overlay the video review . . . in one or more information areas.” *Id.* at 32:25–29. User controls 1004, 1006, 1008, and 1002 may be provided to allow the user to take various actions concerning the product being reviewed. *Id.* at 32:33–41. An image or a tag 1003 associated with the item being reviewed and tags 1016 of other items may displayed in scrubber area 1002. *Id.* at 33:8–13. Further, “a viewer may click on or otherwise select a given product image and/or tag in the scrubber area . . . , and the video player will jump to the corresponding item review.” *Id.* at 33:13–16.

D. Challenged Claims

Claims 1, 9, 20 and 26 are independent. Claim 9 is illustrative and reproduced below:

9. A system for controlling playback of video files, comprising:
 - at least one processing device;
 - a network interface configured to communicate over a network with a video data store;
 - non-transitory memory storing programmatic code that when executed by the at least one processing device, cause the system to perform operations comprising:
 - receive, over a network using the network interface, a first video;
 - store an association of a given image in a first plurality of images with a respective segment in a first plurality of segments of the first video, the first plurality of images comprising:
 - a first image associated with a first segment of the first video; and
 - a second image associated with a second segment of the first video, wherein the first image and the second image are not an image from the first video;
 - cause at least the first image and the second image to be displayed on a first user device at the same time in association

with a playback of the first video, for at least a portion of the time the first video is being played back in a playback area of a content player,

wherein the first image and the second image, associated with respective first and second segments in the first video, are displayed at the same time in the playback area, overlaying the playback of the first video, and the display of the first image and the second image are changed during playback of the second segment, relative to the display of the first image and the second image during playback of the first segment;

cause a first navigation event to occur at least partly in response to a detection that a user has selected the first image, the first image associated with the first segment and displayed at the same time as the second image in the playback area overlaying the playback of the first video;

cause a second navigation event to occur at least partly in response to a detection that a user has selected the second image, the second image associated with the second segment and displayed at the same time as the first image in the playback area overlaying playback of the first video.

Id. at 51:29–52:22.

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 1, 9–11, 13, 18–20, 22, 24, 26, and 27 are anticipated and/or would have been unpatentable on the following grounds (Pet. 1–2):

Claim(s) Challenged	35 U.S.C.¹ §	Reference(s)/Basis
9, 13, 18–20, 22, 24, 26, 27	102	Roberts ²
1, 10	103	Roberts, Kraus ³
11	103	Roberts, Miller ⁴
9,13,19, 20, 24, 26	102	Geer ⁵
1,10	103	Geer, Kraus
11	103	Geer, Miller
18, 22, 27	103	Geer, Fink ⁶
20, 22, 24	103	Roberts, Geer

II. ANALYSIS

A. Overview

Petitioner bears the burden of establishing the unpatentability of the challenged claims by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. §§ 102 and 103 that became effective after the effective filing date of the challenged claims. Therefore, we apply the pre-AIA version of 35 U.S.C. §§ 102 and 103.

² U.S. Publication No. 2011/0138326 A1, pub. June 9, 2011 (Ex. 1004) (“Roberts”).

³ U.S. Publication No. 2008/0147558 A1, pub. June 19, 2008 (Ex. 1009) (“Kraus”).

⁴ Michael Miller, *YouTube® For Business*, 2d ed., Que, 2011 (Ex. 1010) (“Miller”).

⁵ U.S. Publication No. 2011/0112915 A1, pub. May 12, 2011 (Ex. 1005) (“Geer”).

⁶ U.S. Publication No. 2009/0300475 A1, pub. Dec. 3, 2009 (Ex. 1007) (“Fink”).

A claim is anticipated under 35 U.S.C. § 102 “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). However, this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations).⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

The level of ordinary skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). The person of ordinary skill in the art is a hypothetical person presumed to have known the relevant art at the time of the invention. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). In determining the level of ordinary skill in the art, we may consider certain factors, including the “type of problems encountered in the art; prior art

⁷ The parties have not introduced any evidence of secondary considerations.

solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Id.*

Petitioner contends that a skilled artisan “would have had a Bachelor’s degree in Electrical Engineering, Computer Engineering, or Computer Science (or equivalent) plus approximately two years of work experience with technologies relating to content annotation and/or content sharing among multiple users.” Pet. 17 (citing Ex. 1002 ¶¶ 1–33). Patent Owner does not dispute Petitioner’s level of ordinary skill in the art. *See* PO Resp. 10.

We apply Petitioner’s proposed level of ordinary skill in the art because it comports with the level of skill reflected in the ’063 patent and the prior art of record.

C. Claim Construction

We apply the same claim construction standard used by Article III federal courts and the International Trade Commission, both of which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. 37 C.F.R. § 42.100(b). Accordingly, we construe each challenged claim of the ’063 patent to generally be “the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*

Petitioner contends that all claim terms should be given their plain and ordinary meanings. Pet. 16. Petitioner provides what it contends is the plain and ordinary meaning of “navigation event” that appears in a number of the challenged claims. *Id.* Petitioner contends that “navigation event” should be construed as “includ[ing] an event of jumping to a segment of a video and an event of navigating to a website.” *Id.* at 17 (citing Ex. 1002 ¶¶ 22–25).

Patent Owner does not assert that any claim terms require construction or dispute Petitioner's plain and ordinary meaning of "navigation event." PO Resp. 10. Consequently, we apply this undisputed meaning of "navigation event."

We address the plain and ordinary meaning of "dedicated mobile device" in claim 20 in our analysis of that claim.

Upon review of the parties' arguments and based on the evidentiary record, we determine that no claim terms require express construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)) (noting that "we need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy'").

D. Priority Date of the '063 Patent

The '063 patent claims priority through a series of continuation and continuation-in-part applications to application number 13/449,610 ("the '610 application") filed on April 18, 2012 and application number 13/451,478 ("the '478 application") filed on April 19, 2012. Ex. 1001, code (63).

Petitioner contends each of the challenged independent claims "recite an association of an image 'with a respective segment' of a video." Pet. 15. Petitioner further contends both the '610 application and '478 application are "devoid of any reference to associating an image with a 'segment' in a video." *Id.* Petitioner asserts "the Challenged Claims are not fully supported by the disclosures of the '610 application or the '478 application and therefore are not entitled to the benefit of either application under 35 U.S.C. § 120." *Id.* According to Petitioner, "the first description of a tag

associating an image with a ‘segment’ in a video appears in [application number 13/804,121 (‘the ’121 CIP’) filed on March 14, 2013].” *Id.*

Petitioner contends “the effective filing date of the Challenged Claims is, *at the earliest*, the March 14, 2013 filing date” of the ’121 CIP. *Id.* at 15–16.

Patent Owner disputes this contention. PO Resp. 6–9. Patent Owner directs us to disclosure in the ’610 application that it asserts provides support for the challenged claims. *See id.* (citing Ex. 1026, 239, 257, 260, 263, Figs. 4, 9).

Related to this dispute over priority is Patent Owner’s contention that it “can swear behind Roberts and Geer with evidence showing conception before June 4, 2009 (the earliest effective filing date of Roberts or Geer)[,] constructive reduction [to] practice on April 18, 2012[,]. . . and diligence during the critical period from before June 4, 2009 to April 18, 2012.” PO Resp. 10. However, Patent Owner would not be able to swear behind Roberts and Geer if the ’063 patent is only entitled to a March 14, 2013 filing date because Roberts and Geer would continue to qualify as prior art under 35 U.S.C. § 102(b). As explained below, we are not persuaded that Patent Owner provides sufficient corroborating evidence for a conception date before June 4, 2009. Consequently, we need not address whether the challenged claims are only entitled to claim priority to the March 14, 2013 filing date of the ’121 CIP because Roberts and Geer qualify as prior art based on the April 18, 2012 filing date of the ’610 application.

E. Patent Owner’s Attempt to Swear Behind Roberts and Geer

Patent Owner contends the earliest effective filing date of Roberts or Geer is June 4, 2009 based on Geer, which was filed on June 4, 2010 and claims priority to a provisional application filed on June 4, 2009. PO Resp. 10; Ex. 1005, code (60). Patent Owner submits declarations from co-

inventors Narbeh Avedissian and Nikhil Sreenath, which, according to Patent Owner, establish conception “of the inventions in the Challenged Claims before June 4, 2009.” PO Resp. 11 (citing Ex. 2089; Ex. 2090). Patent Owner also submits a series of documents referenced in the inventor declarations. *See* Ex. 2009–2086. Patent Owner provides a table listing the elements of challenged claims 1, 9–11, 13, 18, 19, 20, and 26 and citing to various paragraphs in the inventor declarations and the documents referenced by the inventors in the declarations that purportedly establish conception prior to June 4, 2009. *Id.* at 12–21.

Petitioner first contends that the inventor declarations and the referenced documents fail to establish conception. Pet. Reply 5–7. Petitioner next contends that Patent Owner fails to “corroborate conception with independent evidence,” but relies instead only on “unwitnessed documents supported by inventor testimony ‘alone.’” *Id.* at 7.

Patent Owner, in turn, contends that “[t]he Inventor Declarations (Exs. 2089, 2090) do not stand on inventor testimony alone. Those declarations cite to, for example, dated inventor notebooks with inventor[’]s names (Ex. 2009), and dated emails between the inventors (e.g. Ex. 2010).” Sur-Reply 5.

Analysis

Legal Standard for Corroborating Conception

“Conception is a question of law predicated on subsidiary factual findings, one of which is the sufficiency of corroboration.” *Apator Miitors ApS v. Kamstrup AS*, 887 F.3d 1293, 1295 (Fed. Cir. 2018). We not reach the question of whether co-inventors Mr. Sreenath and Mr. Avedissian conceived of the claimed invention prior to June 4, 2009 unless “there is sufficient corroboration.” *Kolcraft Enter., Inc. v. Graco Child.’s Prods.*,

Inc., 927 F.3d 1320, 1324 (Fed. Cir. 2019). “Inventor testimony of conception must be corroborated by other, independent information.” *Id.* (citations omitted). We examine all pertinent evidence under a rule of reason analysis “to determine whether the inventor’s testimony is credible.” *Id.* “Even under the ‘rule of reason’ analysis, however, the evidence of corroboration must not depend solely on the inventor himself.” *Aptator*, 887 F.3d at 1295.

Patent Owner’s Evidence of Conception

We reviewed the declarations of Mr. Sreenath and Mr. Avedissian (Exs. 2089, 2090) and the documents referenced therein (Exs. 2009–2086) and make the following findings of fact in connection with Patent Owner’s claim that conception occurred prior to June 4, 2009.

Most of the documents constituting Exhibits 2009 to 2086 fall into two general categories. The first category is a series of isolated handwritten pages, which Mr. Avedissian testifies are “my notebook entr[ies].” *See, e.g.*, Ex. 2089 ¶ 4 (citing Ex. 2009). The documents in this category are Exhibits 2009, 2011, 2013, 2015, 2017, 2019, 2021, 2022, 2071, and 2078 (the “notebook pages”).

The second category is a series of emails between Mr. Avedissian and Mr. Sreenath. *See, e.g., id.* ¶ 7 (citing Ex. 2012). The documents in this category are Exhibits 2010, 2012, 2014, 2016, 2018, 2020, 2023, 2024, 2025, 2026, 2027, 2028, 2029, 2030, 2031, 2032, 2033, 2034, 2035, 2036, 2037, 2038, 2039, 2040, 2041, 2042, 2043, 2044, 2045, 2046, 2047, 2048, 2049, 2050, 2051, 2052, 2053, 2054, 2055, 2056, 2057, 2058, 2059, 2060, 2061, 2062, 2064, 2065, 2066, 2067, 2068, 2069, 2073, 2074, 2075, 2079, 2080, 2081, 2082, 2083, 2084, 2085, 2086. These emails are arranged in chronological order starting from Exhibit 2010, which is an email bearing a

date of August 8, 2007. The last email dated prior to June 4, 2009 is Exhibit 2038, bearing a date of May 18, 2009.

Patent Owner cites to the emails as evidence of conception. PO Resp. 12–21. Patent Owner concedes that only documents dated prior to June 4, 2009 relate to conception of the claimed invention. *See* Tr. 67:6–68:7; PO Resp. 10–21; Sur-Reply 2–5. Patent Owner provides a chart citing to various paragraphs of the declarations and offers no further explanation as to how any of the documents, regardless of date, relate to conception prior to June 4, 2009. PO Resp. 10–21. Notwithstanding the lack of explanation, we need not reach the question of whether Patent Owner establishes conception prior to June 4, 2009 because, as explained below, we find Patent Owner fails to provide independent corroborating evidence of the inventors’ testimony.

Patent Owner does not provide the cover to the notebook or other indicia identifying the “notebook pages”⁸ as part of a notebook belonging to Mr. Avedissian. Neither Mr. Avedissian’s name nor his signature appears on any of the “notebook pages.” None of the “notebook pages” are witnessed. The only one of the “notebook pages” bearing any date at all is Exhibit 2009, with a notation “Talk to Nikhil after 7/19/07 mtg.” Ex. 2009. Therefore, the only evidence in the record that the notebook belonged to Mr. Avedissian and that he made the entries in the “notebook pages” during the time period alleged is Mr. Avedissian’s testimony. Because these alleged notebook pages are all unwitnessed, the documents “alone, cannot corroborate an inventor’s testimony of conception.” *Apator*, 887 F.3d at

⁸ Because we are analyzing conception prior to June 4, 2009, our references to “notebook pages” refers to Exhibits 2009, 2011, 2013, 2015, 2017, 2019, 2021, and 2022.

1297 (quoting *Brown v. Barbacid*, 276 F.3d 1327, 1335 (Fed. Cir. 2002)). Unwitnessed notebooks may be used “to aid in corroborating witness testimony alongside other more persuasive evidence.” *Id.* (citations omitted). In this case, as explained below, there is an absence of other more persuasive evidence.

Although some of the emails between Mr. Avedissian and his co-inventor Mr. Sreenath are dated prior to June 4, 2009, none of these emails are witnessed by a third party and the only evidence offered in connection with the emails is the testimony of co-inventors Mr. Avedissian and Mr. Sreenath. Ex. 2089; Ex. 2090. Patent Owner inserts the emails as exhibits near to various “notebook pages” in an apparent attempt to use the emails to corroborate the undated, unsigned, and/or unwitnessed “notebook pages.” None of the emails, however, reference the “notebook pages” nor do the “notebook pages” reference the emails. *See* Exs. 2009–2038.

In the Sur-Reply, Patent Owner contends that Dr. Valerdi “opined concerning the conception documents and whether they are sufficiently plain to enable those skilled in the art to understand the inventions.” Sur-Reply 3 (citing IPR2020-01697, Ex. 2089 ¶¶ 88–97)⁹. The issue of enablement of the alleged conception documents, however, is of no import to the question of whether Patent Owner provides sufficient corroborating evidence for the conception documents.

At the oral hearing, Patent Owner confirmed that the only evidence in the record of conception prior to June 4, 2009 is the declarations of Mr.

⁹ We note this exhibit is not of record in this proceeding and was first referred to by Patent Owner in the Sur-Reply, which was filed after Petitioner’s deposition of Dr. Valerdi in this proceeding. *See* Ex. 1042 (Deposition of Dr. Valerdi dated January 14, 2022).

Avedissian and Mr. Sreenath, Exhibits 2009–2038, and the deposition testimony of Mr. Avedissian and Mr. Sreenath. Tr. 67:12–68:7. After examining all the evidence and Patent Owner’s contentions under the required rule of reason, we find Patent Owner’s evidence insufficient to corroborate a conception date prior to June 4, 2009 because the only evidence presented is from the inventors themselves. *Apator*, 887 F.3d at 1295 (“[T]he evidence of corroboration must not depend solely on the inventor himself.”). We, thus, do not reach the question of whether Patent Owner has established conception prior to June 4, 2009.

Consequently, Geer and Roberts qualify as prior art under 35 U.S.C. §§ 102(a) and 102(e).

F. Ground 1: Alleged Anticipation by Roberts

Petitioner contends that claims 9, 13, 18–20, 22, 24, 26, and 27 are anticipated by Roberts. Pet. 26–52. In support thereof, Petitioner identifies the disclosures in Roberts alleged to describe the subject matter in the challenged claims. *Id.* Additionally, Petitioner offers declaration testimony from Dr. Porter in support of the Petition. Ex. 1002 ¶¶ 56–134. Patent Owner contends that Roberts does not disclose several claim limitations. PO Resp. 22–39. Patent Owner offers declaration testimony from Dr. Valerdi in support of its contentions. Ex. 2091 ¶¶ 51–86.

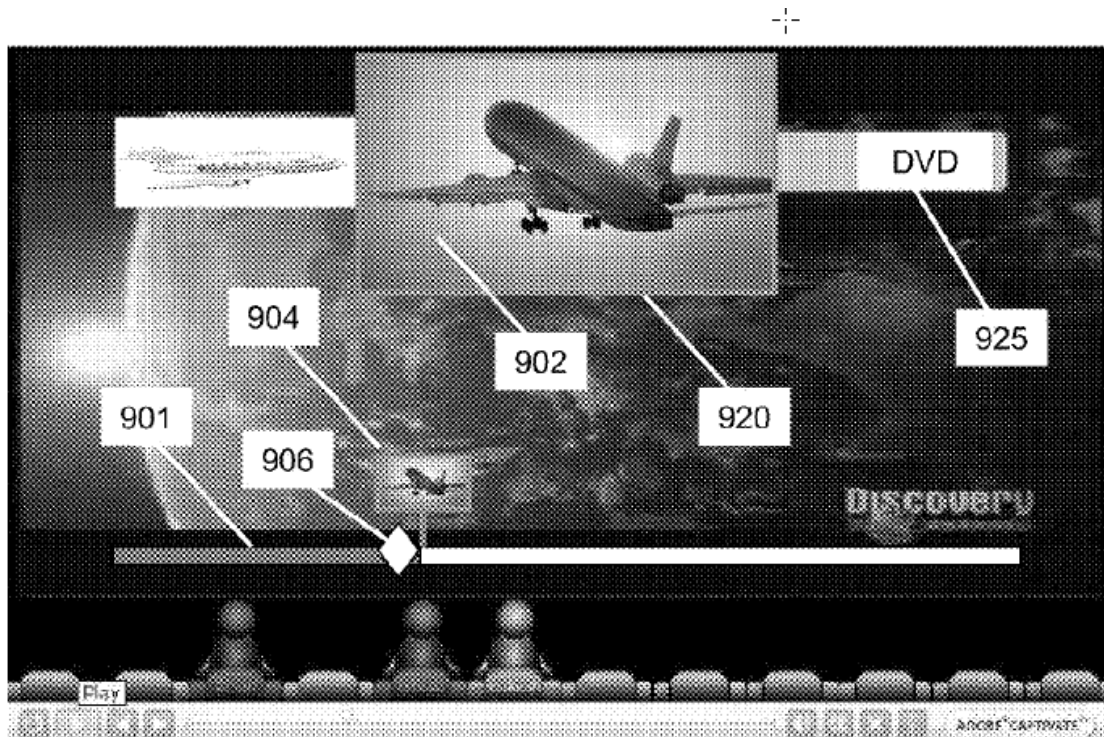
We begin our analysis with a brief overview of Roberts. We then address the parties’ respective contentions with respect to the challenged claims.

Roberts – Ex. 1004

Roberts discloses a controller for a server “to transmit media programming to a group of set top boxes for presentation with an overlay superimposed onto the media programming.” Ex. 1004 ¶ 11. Roberts’

“overlay includes a timeline corresponding to the presentation of the media programming and receive a first comment . . . during presentation of the media programming.” *Id.* Roberts’ “controller can receive a tag generated at a first set top box during presentation of the media programming and the tag can be correlated to a portion of a media presentation timeline.” *Id.*

Figure 9 of Roberts is reproduced below:



900
FIG. 9

Figure 9 is a screenshot 900 presented by Roberts’ system. *Id.* ¶¶ 8, 59.

Figure 9 shows a series of advertisements in advertising GUI 902. *Id.* ¶ 59. Screenshot 900 “shows a timeline 901 that corresponds to the presentation of the media programming and tag 906 along the timeline.” *Id.* “GUI 902 is a horizontal carousel GUI or a pop up window that allows for rotation through the various advertisements with one of the advertisements being shown more prominently as the GUI is rotated.” *Id.* Frame 920

depicts an advertisement for air travel “based on metadata associated with the tag 906.” *Id.* Frame 925 depicts a DVD advertisement “of or related to the media programming.” *Id.* Further “an advertisement icon 904 can be placed along the timeline 901 to correspond to the temporal position of the tag 906” allowing the user “to rewind the media programming to further view the advertisement.” *Id.* ¶ 60. Frame 920 may provide “an Internet link to the entity providing the particular advertisement” or alternately “the user can click on the advertisement or a portion thereof to receive further information.” *Id.*

Independent Claim 9

[9.P]¹⁰ Preamble: A system for controlling playback of video files, comprising:

Petitioner contends Roberts discloses a system that controls playback of video files. Pet. 26–27 (citing Ex. 1002 ¶¶ 55–57; Ex. 1004 ¶¶ 14, 29, 43, 45, Figs. 1, 2, 5).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 22–35. Neither party addresses whether the preamble is limiting. Pet. 26–27; PO Resp. 22–35.

We need not decide whether the preamble is limiting because Petitioner establishes that Roberts discloses the subject matter of the preamble.

[9.1] at least one processing device;

Petitioner contends Roberts discloses a “system including . . . media processors 106, media devices 108/135/502/512, server(s) 130/506, computer device 508, communications device 510, and remote media

¹⁰ We use Petitioner’s claim annotations (Pet. xi *et. seq.*) for ease of reference, but our analysis is not affected by the annotations.

server(s) 550” and that “[e]ach of these devices includes a processing device.” Pet. 27 (citing Ex. 1002 ¶¶ 58–59; Ex. 1004 ¶¶ 10, 18, 43–44, 77–84, Figs. 5, 15).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 22–35. Based on the evidence cited by Petitioner, we find Roberts discloses this claim limitation.

[9.2] a network interface configured to communicate over a network with a video data store;

Petitioner contends Roberts discloses “media device(s) 108/135/502/512, server(s) 130/506, computing device 508, communications device 510, and remote media servers 550 communicating over a network via respective network interfaces.” Pet. 27–28 (citing Ex. 1004 ¶¶ 14, 16, 17, 26, 29–33, 37, 41, 44). Petitioner further contends Roberts discloses “the media devices communicating over the network with a video data store (e.g., server) to request and obtain the media content.” *Id.* at 28 (citing Ex. 1002 ¶¶ 60–61; Ex. 1004 ¶¶ 19, 22, 25).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 22–35. Based on the evidence cited by Petitioner, we find Roberts discloses this claim limitation.

[9.3] non-transitory memory storing programmatic code that when executed by the at least one processing device, cause the system to perform operations comprising:

Petitioner contends Roberts discloses “system components performing operations based on execution of programmatic code (e.g., software) stored in non-transitory memory.” Pet. 28 (citing Ex. 1002 ¶ 62; Ex. 1004 ¶¶ 37–42, 80–85, Figs. 4, 15).

Patent Owner does not address Petitioner's contentions. *See* PO Resp. 22–35. Based on the evidence cited by Petitioner, we find Roberts discloses this claim limitation.

[9.4] receive, over a network using the network interface, a first video;

Petitioner contends that Roberts discloses that its server “receiv[es] a first video (e.g., media content) . . . over a network using the network interface.” Pet. 29 (citing Ex. 1002 ¶¶ 63–64; Ex. 1004 ¶¶ 14, 17, 21, 23, 25).

Patent Owner does not address Petitioner's contentions. *See* PO Resp. 22–35. Based on the evidence cited by Petitioner, we find Roberts discloses this claim limitation.

[9.5] store an association of a given image in a first plurality of images with a respective segment in a first plurality of segments of the first video,

Petitioner contends that “video tags” disclosed in paragraph 58 of Roberts or advertisements “associated with” tags disclosed in paragraph 59 of Roberts correspond to the first plurality of images. Pet. 29 (citing Ex. 1004 ¶¶ 58, 59, 73, Figs. 9–13). Petitioner further contends that particular video tags or advertisements are associated with a particular portion or time period of the media content which correspond to the recited “respective segment[s].” *Id.* at 29–30. In support of this contention, Petitioner relies on, *inter alia*, Roberts' disclosure in paragraph 49 of “tag[ging] a point or period in time of the program runtime.” *Id.* at 30 (alteration in original). Petitioner also contends that paragraph 25 of Roberts discloses storing the tags. *Id.*

Patent Owner counters that Petitioner “cites to no disclosure in Roberts where the tags themselves can be an image or include images.” PO Resp. 22 (citing Ex. 2091 ¶ 52). Patent Owner contends “Roberts does not

use the terms ‘tags’ and ‘advertisements’ synonymously” but “discloses that a program can allow users to add tags to media content.” *Id.* (citing Ex 1004 ¶ 23). Patent Owner further contends that Roberts discloses “[t]he tags can be correlated on the timeline presented with the media content.” *Id.* at 23 (citing Ex. 1004 ¶ 23). Patent Owner further contends that Roberts’ “tags are merely markers that indicate points in time in a video when the user would like the system to present some other content.” *Id.* (citing Ex. 1004 ¶ 24). Patent Owner points to the process steps in Roberts’ Figure 14 where the media processor receives the tags, queries third party servers for advertisements, and presents corresponding advertisements that are located. *Id.* (citing Ex. 1004 ¶¶ 69–71, Fig. 14). According to Patent Owner, “while the ‘tags’ eventually result in presentation of ‘advertisement images,’ the tags themselves are not images.” *Id.* at 23–24 (citing Ex. 2091 ¶ 54).

Patent Owner next contends that “Roberts is silent regarding storing ‘an association of a given image . . . with a respective [video] segment,’ as required by claim element [9.5].” PO Resp. 24. Patent Owner further contends because “advertisement images in Roberts are fetched and presented in real time . . . there is no need to perform the storage required by claim element [9.5].” *Id.* (citing Ex. 2091 ¶ 55). According to Patent Owner, “[i]f Petitioner is relying on inherency to show that Roberts discloses claim element [9.5], Petitioner has not met its burden.” *Id.*

Petitioner, in turn, contends although Patent Owner “appears to be arguing that the tags must themselves be the images,” this limitation “merely recites ‘store an association,’ not storing an image itself.” Pet. Reply 15 (citing Ex. 1001, 16:32–24). Petitioner further contends that both Patent Owner and Dr. Valerdi acknowledge that “Roberts’ tags are ‘markers that indicate points in time in a video when the user would like the system to

present some other content” and “such presented content includes advertisements.” *Id.* at 15–16 (citing PO Resp. 23–24; Ex. 2091 ¶¶ 53–54).

Petitioner next contends that even if limitation 9.5 requires “storing the image (*e.g.*, advertisement), Roberts still discloses such storage, given that the advertisement images are retrieved and provided to a client program for display during video playback.” Pet. Reply 16 (citing Ex. 1004 ¶¶ 59–63, 67–72, Figs. 9–14).

In response to Patent Owner’s contention that Roberts does not store advertisement images because the images are fetched and presented in real time, Petitioner contends “Roberts teaches multiple scenarios where advertisement images must be stored for later access.” Pet. Reply 16–17 (citing Ex. 1004 ¶ 16, 60, 62, 63, 67). In particular, Petitioner contends “Roberts teaches rewinding a video to view a previously-displayed advertisement, which requires storage of the advertisement” and “presenting the same tag-based advertisements to multiple users playing the same media content.” *Id.* at 17 (citing Ex. 1004 ¶¶ 60, 62). Petitioner further contends that “Dr. Valerdi testified that Roberts does not explicitly disclose ‘real time’ and this was merely his ‘own interpretation’” and “that even information provided in ‘real time’ in Roberts is still stored in the system, *e.g.*, in memory or a buffer.” *Id.* (citing Ex. 1042, 48:8–49:15).

In the Sur-Reply, Patent Owner contends that the claim language “to ‘store an association of a given image . . . with a respective segment’” requires “the system must necessarily store 1) a given image, 2) a respective segment, and 3) their association.” Sur-Reply 11. According to Patent Owner “[w]ithout storing a given image, the system would only store an association of some information with a respective segment.” *Id.* at 11–12.

Patent Owner argues this is consistent with the Specification of the '063 patent. *Id.* at 11 (citing Ex. 1001, 42:15–18).

Patent Owner further contends “none of Petitioner’s citations [in the Reply] disclose storage of an image.” Sur-Reply 12 (citing Pet. Reply 16). Patent Owner further contends Robert’s disclosure “that the system must ‘retrieve[]’ images by ‘quer[ying] third party servers for advertisements’ further demonstrates that the system does not store them.” *Id.* (citing Ex. 1004 ¶¶ 69–71). Patent Owner further contends that, in Roberts, “[e]ach instance of the advertisement being presented is due to retrieval from a third-party server . . . and does not necessitate storage.” *Id.* at 13 (citing Ex. 1004 ¶¶ 69–71, Fig. 14; Ex. 2091 ¶ 55).

Analysis

We start with the claim language, which recites “store an *association* of a given image . . . with a respective segment . . . of the first video.” The language of claim 9 does not require or suggest that the image itself is stored only that an association between the image and a segment of the video is stored.

In support of its contention that this claim language requires storage of an image, Patent Owner directs us to the portion of the Specification of the '063 patent that provides “[t]ags and other data . . . may be associated with video content from the content hosting system and stored on a system remote from the content hosting system.” Ex. 1001, 42:15–18. This part of the Specification teaches stored “tags and other data” are sufficient to associate an image with a segment of the video.

Petitioner counters by directing us to a different portion of the Specification of the '063 patent that provides “[t]he product tag may include words or phrases identifying brand, model, size, color, visual traits,

functional specifications, uses, and other descriptive texts . . . product images are optionally associated with the aforementioned tags.” Ex. 1001, 16:28–34. This portion of the Specification states that product images are optional, which supports Petitioner’s contention that this limitation does not require storing the image. Consequently, Patent Owner’s contentions that Roberts fetches and presents advertisement images in real time (PO Resp. 24) is unavailing because this limitation does not require storing images. However, even if this limitation did require storage of images, Dr. Valerdi concedes that images provided in real-time in Roberts “must be” stored in memory or a buffer “in order for it to be displayed.” Ex. 1042, 49:9–14.

Petitioner identifies disclosure in Roberts of various tags. Pet. 29–30 (citing Ex. 1004 ¶¶ 49, 53, 56–60, 69, 73, Figs. 5,9–13.) Petitioner identifies disclosure in Roberts that its system stores the tags. *Id.* at 30 (citing Ex. 1002 ¶¶ 65–67; Ex. 1004 ¶ 25). We find the cited portions of Roberts discloses storing tags. Roberts also discloses that “advertisement icon 904 can be placed along the timeline 901 to correspond to the temporal position of the tag 906 and advertisement.” Ex. 1004 ¶ 60. This disclosure in Roberts, thus, corresponds to the recited “stor[ing] an association of a given image . . . with a respective segment . . . of the first video.”

Patent Owner’s contentions largely revolve around whether Roberts discloses that the tags are images but does not dispute that Roberts’ tags satisfy the “association” limitation of claim element 9.5 nor does Patent Owner dispute that Roberts discloses storing the tags. PO Resp. 22–25; *see*

also Sur-Reply 12 (“Roberts does not disclose that tags are themselves images.”).¹¹

Based on the evidence cited by Petitioner and after considering Patent Owner’s contentions, we find Roberts discloses this claim limitation.

[9.6] the first plurality of images comprising: a first image associated with a first segment of the first video; and a second image associated with a second segment of the first video, wherein the first image and the second image are not an image from the first video;

Petitioner contends that “Roberts describes the first plurality of images comprising a first image (*e.g.*, first tag or first advertisement) associated with a first segment of the first video, and a second image (*e.g.*, second tag or second advertisement) associated with a second segment of the first video.” Pet. 30–31 (citing Ex. 1004 ¶¶ 49, 53, 56, 57, 60, 61, Figs. 5, 9, 10). Petitioner further contends that “[t]he first image and the second image (*e.g.*, overlaid advertisement images) are not from the first video, as they are separately obtained based on video metadata.” *Id.* at 31 (citing Ex. 1002 ¶¶ 68–69; Ex. 1004 ¶¶ 58–60, 71, Figs. 5, 9–10, 14).

¹¹ Patent Owner argued in the oral hearing that Roberts does not disclose segments of the video. Tr. 80:14–16. This argument does not appear in the Patent Owner Response or Sur-Reply. *See generally* PO Resp.; Sur-Reply. Generally, no new arguments or evidence should be presented at the oral hearing. Consol. Trial Practice Guide 85–86 (Nov. 2019). Nonetheless, the argument is also contrary to Dr. Valerdi’s testimony. *See* Ex. 2091 ¶ 53 (stating that “the tags are merely markers that indicate points in time in a video”); Ex. 1042, 43:21–44:2 (Dr. Valerdi confirming that tag 1008 in Roberts’ Figure 10 is associated with a different segment of the video than tag 1006).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 22–35. Based on the evidence cited by Petitioner, we find Roberts discloses this claim limitation.

[9.7] cause at least the first image and the second image to be displayed on a first user device at the same time in association with a playback of the first video, for at least a portion of the time the first video is being played back in a playback area of a content player

Petitioner contends that Roberts “describes that the first and second images are displayed on the first user device at the same time in association with playback of the first video . . . in two different manners”, i.e., a GUI Carousel Display and an Advertisement Icons display. Pet. 31–38. We focus on the Advertisement Icons Display, which, as explained below, we find discloses this claim limitation.

Advertisement Icons Display

Petitioner contends that, in Figure 9 of Roberts, “the display screen playing the video displays (i) a ‘timeline’ corresponding to the presentation of the media content . . . and (ii) an ‘advertisement icon 904’ displayed alongside the timeline.” Pet. 34–35 (citing Ex. 1004 ¶¶ 13, 59–60). Petitioner further contends that Figure 9 “illustrates such a displayed timeline 901 and advertisement icon 904 displayed alongside ‘to correspond to the temporal position of the tag 906 and advertisement, such as if the user would like to rewind the media programming to further to view the advertisement.’” *Id.* at 35 (citing Ex. 1004 ¶¶ 19, 60, Fig. 9). Petitioner alternately contends that Roberts’ Figures 11–13 illustrate “various approaches to display the advertisement icons, including displaying the advertisement icon for *each* of the advertisements.” *Id.* at 36–37 (citing Ex. 1004 ¶ 62, Fig. 13). According to Petitioner, “[i]n both approaches, such

displaying occurs for at least a portion of the time the first video is being played back in a playback area of a content player.” *Id.* at 37 (footnote omitted) (citing Ex. 1002 ¶¶ 70–77; Ex. 1004 ¶¶ 19, 20, 69, Figs. 9–13).

Patent Owner contends that the Advertisement Icons Display does not satisfy this limitation. PO Resp. 28–29. Specifically, Patent Owner contends Petitioner “fails to identify what is the first image and what is the second image, nor does the Petition assert that images associated with different segments are displayed simultaneously with regards to the Advertisement Icons Display.” *Id.* at 29 (citing Ex. 2091 ¶ 62). Patent Owner further contends the “Petition cites to advertisement 904 that corresponds to a tag 906 as disclosure of a first image; however, the Petition fails to point to a disclosure of a second image” and that “[t]imeline 901 is not an image ‘associated with a first [or second] segment of the first video,’ as required by claim 9.” *Id.* (citing Pet. 35; Ex. 1004 ¶ 59).

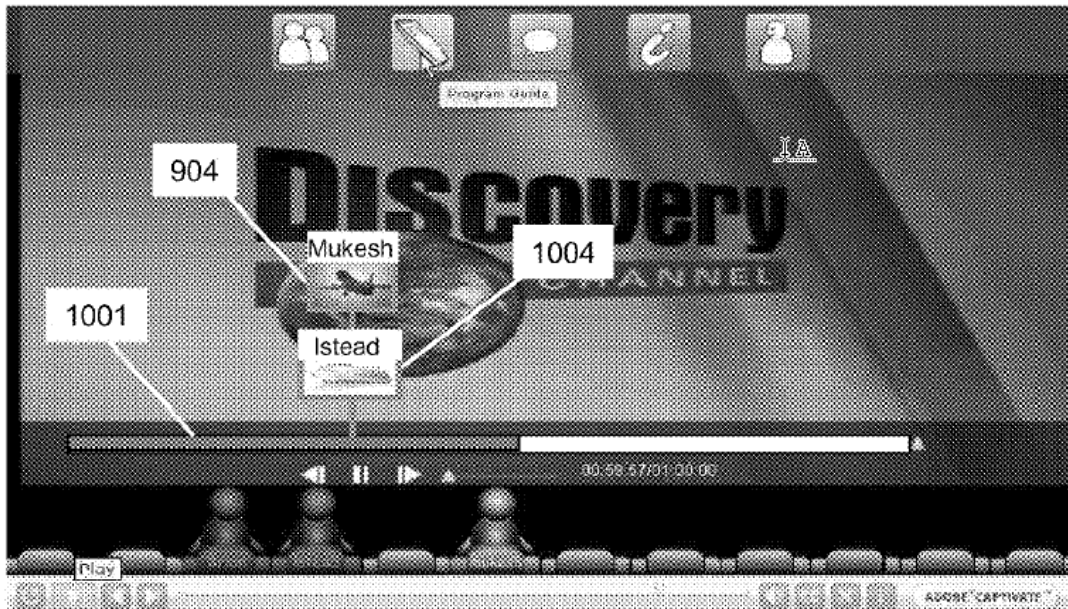
Petitioner, in turn, contends “the Petition states that the first and second images are the advertisements associated with tags.” Pet. Reply 20 (citing Pet. 34). Petitioner further contends “that Roberts describes, with respect to displaying advertisement images as advertisement icons, an option of displaying ‘icons for each of the advertisements’ simultaneously, as illustrated in Fig. 13.” *Id.* (citing Pet. 36–38; Ex. 1004 ¶ 62, Fig. 13).

In the Sur-Reply, Patent Owner contends “Roberts shows in Fig. 13 multiple advertisement images overlaying a single segment.” Sur-Reply 16 (citing Ex. 1004 ¶ 73, Fig. 13). Patent Owner further contends that “Petitioner’s mark-up of Fig. 13 demonstrates that the two identified images shown at the same time do not correspond to separate segments.” *Id.* (citing Pet. 37).

Analysis

For element 9.6, Petitioner identifies advertisement icons 904 and 1004 as the first and second images. Pet. 30 (citing Ex. 1004 ¶¶ 49, 53, 57, 59–61, Figs. 5, 9–10); Pet. Reply 20 (“Petition states that Roberts describes, with respect to displaying advertisement images as advertisement icons, an option of displaying ‘icons for each of the advertisements’ simultaneously, as illustrated in Fig. 13.”).¹² Roberts also discloses that in Figure 13, “icons for each of the advertisements presented can be shown to all of the viewers.” Ex. 1004 ¶ 62.

Roberts Figure 13 is reproduced below:



1300
FIG. 13

Figure 13 is a screenshot of Roberts system. Ex. 1004 ¶ 8.

¹² As discussed above in connection with limitation 9.6, Patent Owner does not dispute Petitioner’s contentions for element 9.6. See PO Resp. 22–35.

Element 1001 is a timeline for presenting advertisement icons. *Id.* ¶ 61. Elements 904 and 1004 are advertisement icons associated with tags 906 and 1008. *Id.* ¶¶ 61–62. Advertisement icon 904 and tag 906 appear in Roberts’ Figure 9 whereas advertisement icon 1004 and tag 1008 appear in Roberts’ Figure 10.¹³ “[A]dvertisement icons 904 and 1004 facilitate referral by the user to the advertisement and the tags 906 and 1008 are correlated to the timeline of the media programming.” *Id.* ¶ 62. Roberts’ Figure 11 shows the location of tag 906 on the timeline and Figure 12 shows the location of tag 1008 on the timeline. *Id.* Figs. 11, 12. Regardless of the display of the advertisement icons 904 and 1004 in Figure 13, the icons are associated with discrete tags on the timeline and “[t]he tags are correlated to the timeline dependent upon media program runtime at the time at which a tag request is received.” Ex. 1004 ¶ 23. Advertisement icons 904 and 1004 are, consequently, associated with respective first and second segments in the first video” as required by limitation 9.6. In Figure 13, “the first image [advertisement icon 904] and the second image [advertisement icon 1004] [are] displayed on a first user device at the same time” as required by limitation 9.7. *See* Ex. 1002 ¶¶ 77–78.

Patent Owner’s only argument against Petitioner’s contention that Figure 13 satisfies this limitation is that advertisement icons 904 and 1004 in Figure 13 overlay a single segment not separate segments of the video. Sur-Reply 16. Patent Owner cites to Dr. Valerdi’s testimony to support this

¹³ Because the tags and advertisement icons in Figure 9 and Figure 10 all appear in Figure 13, we find that Roberts’ Figures 9, 10, and 13 relate to the same embodiment. *See also* Ex. 1004 ¶ 8 (Figures 6–13 “depict screenshots presented by a *communications device* of the systems of FIGS 1-2 and 5”) (emphasis added).

argument. *Id.* (citing Ex. 2091 ¶ 62). However, Dr. Valerdi does not address Roberts’ Figures 11–13 in his testimony concerning limitation 9.7. *See* Ex. 2091 ¶¶ 56–63. Further, Patent Owner ignores Roberts’ disclosure in paragraphs 61 and 62 that the advertisement icons are associated with different tags on the timeline, that is, different segments of the video regardless of the display of the advertisement icons in Figure 13.

Based on the evidence cited by Petitioner and after considering Patent Owner’s contentions, we find Roberts’ Advertisement Icons Display in Figure 13 discloses this claim limitation.

[9.8] wherein the first image and the second image, associated with respective first and second segments in the first video, are displayed at the same time in the playback area, overlaying the playback of the first video, and the display of the first image and the second image are changed during playback of the second segment, relative to the display of the first image and the second image during playback of the first segment;

Petitioner contends that Roberts satisfies this limitation because it discloses “when displaying advertisements in the ‘GUI carousel’, that the advertisements are ‘rotated’ with ‘one of the advertisements being shown more prominently.’” Pet. 38–39 (citing Ex. 1004 ¶ 59). Petitioner further contends that a skilled artisan “would have understood that the rotation of advertisements corresponds with the media content playback, so the current advertisement is displayed more prominently.” *Id.* at 39 (citing Ex. 1004 ¶¶ 58–59); *see also id.* at 39–41 (citing Ex. 1002 ¶¶ 78–80) (providing annotated versions of Roberts’ Figs. 9, 10 illustrating different displays at different points in the timeline).

Petitioner further contends “Roberts describes changing the display of the first and second images during playback of the second segment, relative to their display during playback of the first segment.” Pet. 38–39. In

support of this contention, Petitioner points to Robert's disclosure that "when displaying advertisements in the 'GUI carousel', that the advertisements are 'rotated' with 'one of the advertisements being shown more prominently.'" *Id.* at 39 (citing Ex. 1004 ¶ 59). Petitioner contends a skilled artisan "would have understood that the rotation of advertisements corresponds with the media content playback, so the current advertisement is displayed more prominently." *Id.* at 39–40 (citing Ex. 1004 ¶¶ 58–59, Figs. 9, 10). Petitioner further contends Roberts changes the display of advertisement images based on different segments "such as displaying an advertisement image both as the advertisement and the advertisement icon on the timeline, when the particular segment corresponding to the advertisement is being played." *Id.* at 40 (citing Ex. 1004, Figs 9, 10).

Patent Owner first contends that "Roberts only 'allows for' a user to rotate through the various advertisements" but does not "disclose that changing the images in Roberts is **tied or triggered by playback of different** segments of the video, as required by" this limitation. PO Resp. 30 (citing Ex. 1004 ¶¶ 58–59, 78–80; Ex. 2091 ¶ 65). Patent Owner next contends that even if Roberts discloses changing the images, "Petitioner fails to make any citation to Roberts Specification" to support its contention that "Roberts describes changing the display of advertisement based on playback of different media content segments." *Id.* at 30–31. Patent Owner contends that Figures 9 and 10 of Roberts "simply show that there is more than one image displayed at a single point in time in the video and that a user can rotate through the advertisements at will." *Id.* at 31 (citing Ex. 1004, Figs. 9, 10; Ex. 2091 ¶ 66); *id.* at 32 ("Roberts fails to disclose that changes to these multiple advertisement icons are tied to or triggered by playback of different segments of the video.") (citing Ex. 2091 ¶ 68).

Petitioner, in turn, contends “Roberts provides no explicit disclosure of a user changing the images in the carousel GUI, and Dr. Valerdi concedes this is merely his ‘interpretation.’” Pet. Reply 21 (citing Ex. 1042, 54:4–55:3). Petitioner further contends that Dr. Valerdi’s interpretation contradicts Roberts disclosure of “the user rewinding the video to view a previously displayed advertisement.” *Id.* (citing Ex. 1004 ¶ 60). According to Petitioner, “[i]f Roberts’ carousel GUI could be rotated by a user to view a different advertisement . . . then rewinding the video to view a prior advertisement would be unnecessary.” *Id.*

Petitioner next contends that Roberts provides “ample disclosure linking advertisement images from tags to specific video segments.” Pet. Reply 22 (citing Ex. 1004 ¶¶ 58, 61–62). Petitioner further contends that Dr. Valerdi’s testimony confirms this disclosure. *Id.* at 22–23 (citing Ex. 2091 ¶¶ 53–54, 59). Petitioner further contends “Roberts’ disclosure that a user rewinds the video to view a prior advertisement, confirming that advertisement images are tied to playback of specific video segments.” *Id.* at 23 (citing Ex. 1004 ¶ 60).

Analysis

Relying on Dr. Valerdi’s testimony, Patent Owner points to paragraph 59 of Roberts for the proposition that a user can rotate through the advertisements in the GUI carousel and asks us to draw the conclusion that the changes in the display of the images during this rotation are not tied or triggered by playback of different segments of the video as required by this limitation. PO Resp. 32; Ex. 2091 ¶ 65. Regardless of whether Patent Owner is correct about a user having the ability to rotate through the advertisements in the GUI carousel, Dr. Valerdi’s testimony does not address paragraph 60 of Roberts. Ex. 2091 ¶ 65. Paragraph 60 provides

“[a]s another example, an advertisement icon 904 can be placed along the timeline 901 to correspond to the temporal position of the tag 906 and advertisement, such as if the user would like to rewind the media to further view the advertisement.” Ex. 1004 ¶ 60; *see also id.* ¶ 61 (“multiple advertisements are displayed based on metadata associated with the tags 1006 and 1008”). We find this disclosure in Roberts satisfies the claim requirement that the first image and second image are associated with different segments of the video.

To satisfy the requirement that the display of the first image and second image change from the first segment to the second segment, Petitioner points to the fact that Roberts’ Figures 9 and 10 disclose the advertisement corresponding to an advertisement icon is displayed more prominently during the segment of the video corresponding to the advertisement icon. Pet. 40–41. This argument is supported by Figures 9 and 10 of Roberts and Dr. Porter, who testifies that a skilled artisan “would have understood that the rotation of advertisements corresponds with the media content playback, so the current advertisement corresponding to current playback time is displayed more prominently.” Ex. 1002 ¶ 80. We find this evidence satisfies the requirement that “the display of the first image and the second image are changed during playback of the of the second segment relative to the display of the first image and the second image during playback of the first segment.”

Based on the evidence cited by Petitioner and after considering Patent Owner’s contentions, we find Roberts discloses this claim limitation.

[9.9] cause a navigation event to occur at least partly in response to a detection that a user has selected the first image, the first image associated with the first segment and displayed at the same

time as the second image in the playback area overlaying the playback of the first video

Petitioner contends that Roberts satisfies this limitation in two ways. Pet. 41. The first way is described by Petitioner as “Website/interactive navigation.” *Id.* Petitioner contends that Roberts discloses that an advertisement “can provide for an Internet link to the entity providing the particular advertisement” and it “can be interactive such that the user can click on the advertisement or a portion thereof to receive further information.” *Id.* at 41–42 (citing Ex. 1004 ¶ 60). The second way is described by Petitioner as “Video-jumping navigation.” *Id.* at 42. Petitioner contends Roberts discloses that an “advertisement icon 904 can be placed along the timeline 901 to correspond to the temporal position of the tag 906 and advertisement, such as if the user would like to rewind the media programming to further view the advertisement.” *Id.* (citing Ex. 1004 ¶ 60).

We focus on the Website/interactive navigation Display, which, as explained below, we find discloses this claim limitation.

Patent Owner contends that Petitioner “misrepresent[s] the cited portion of Roberts.” PO Resp. 33. Patent Owner further contends that “Roberts discloses that in one embodiment, the advertisement may ‘provide for an Internet link’” and in an alternate embodiment discloses that “frame 920 can be interactive.” *Id.* (citing Ex. 1004 ¶ 60). According to Patent Owner, in the alternate embodiment, a user is allowed “to ‘click on the advertisement or a portion thereof to receive further information (such as an email address associated with the set top box presenting the advertisement).’” *Id.* (citing Ex. 1004 ¶ 60). Patent Owner further contends “[t]he entire context of the cited portions of Roberts makes clear that the ‘link’ in the first embodiment is **not** interactive” but “is an informational text

link or website address that can be typed into a browser or the like.” *Id.* Patent Owner further contends the alternate embodiment discloses “that a user receives ‘further information’ by email, not by a navigation event.” *Id.* at 33–34 (citing Ex. 2091 ¶71).

Petitioner, in turn, contends that Roberts does not disclose that its link is merely an informational text link or website address as Patent Owner asserts. Pet. Reply 23–24. Petitioner contends that even if the link is a website address typed in to a browser, that would still satisfy this claim limitation, which requires “cause a first navigation event to occur at least partly in response to a detection that a user has selected the first image.” *Id.* at 24.

Analysis

Petitioner’s arguments are based on what it contends is the plain and ordinary meaning of “navigation event” as “includ[ing] an event of jumping to a segment of a video and an event of navigating to a website.” Pet. 17 (citing Ex. 1002 ¶¶ 22–25). Patent Owner did not dispute this plain and ordinary meaning of “navigation event.” PO Resp. 10. For purposes of our analysis of this claim limitation, we focus on “an event of navigating to a website.”

Roberts discloses “[i]n one embodiment, the frame 920 can provide for an Internet link to the entity providing the particular advertisement.” Ex. 1004 ¶ 60. Relying on Dr. Valerdi’s testimony, Patent Owner argues that we should interpret the first embodiment with reference to the succeeding sentence in Roberts’ paragraph 60 relating to “a separate alternative

embodiment.” See PO Resp. 33–34 (citing Ex. 2019 ¶ 71).¹⁴ The succeeding sentence provides that “[i]n another embodiment, the frame 920 can be interactive such that the user can click on the advertisement or a portion thereof to receive further information (such as via an email address associated with the set top box presenting the advertisement.)” Ex. 1004 ¶ 60. Roberts, however, is describing two separate embodiments where frame 920 operates in a different fashion. We decline to limit the first embodiment with disclosure of an alternate embodiment. Dr. Porter testifies that selecting the interactive Internet link of frame 920 results in a “navigation event” satisfying this claim limitation. Ex. 1002 ¶ 83. We credit the testimony of Dr. Porter over that of Dr. Valerdi because his testimony is consistent with Roberts’ description of the first embodiment of frame 920. Consequently, we find that the first embodiment where frame 920 provides “an Internet link” satisfies this limitation because “an event of navigating to a website” would occur “at least partly in response to a detection that a user has selected the first image,” which includes the Internet link.

Based on the evidence cited by Petitioner and after considering Patent Owner’s contentions, we find Roberts discloses this claim limitation.

[9.10] cause a second navigation event to occur at least partly in response to a detection that a user has selected the second image, the second image associated with the second segment and displayed at the same time as the first image in the playback area overlaying the playback of the first video.

¹⁴ Dr. Valerdi’s testimony essentially repeats Patent Owner’s contentions verbatim. Compare Ex. 2019 ¶ 31, with PO Resp. 33–34.

Petitioner and Patent Owner rely on the same contentions for this limitation as for the limitation “cause a first navigation event.” Pet. 42–43; PO Resp. 35.

Based on the evidence cited by Petitioner and after considering Patent Owner’s contentions, we find Roberts discloses this claim limitation.

Summary of Claim 9

For all the foregoing reasons, Petitioner establishes by a preponderance of the evidence that claim 9 is anticipated by Roberts.

Claim 13

Claim 13 depends from claim 9 and recites “wherein the first navigation event comprises causing the playback of the first video to jump to the first segment of the first video corresponding to the first image.” Ex. 1001, 52:33–36. The antecedent basis for “the first navigation event” in claim 13 is in limitation 9.9, which provides, in part, “cause a first navigation event to occur at least partly in response to a detection that a user has selected the first image.” *Id.* at 52:10–12.

Petitioner relies on its contentions for Video-jumping navigation for limitation 9.9 and, for claim 13 points to Roberts’ disclosure in paragraph 60 that “advertisement icon 904 . . . placed along the timeline 901 to correspond to the temporal position of the tag 906 and advertisement, such as if the user would like to rewind the media programming to further view the advertisement.” Pet. 45 (citing Ex. 1002 ¶¶ 106–110; Ex. 1004 ¶ 60); *see also id.* at 42 (arguing that Roberts’ Video-jumping navigation meets limitation 9.9).

Patent Owner contends that Roberts fails to anticipate claim 13 “for at least the same reasons Roberts fails to anticipate” claim 9. PO Resp. 38.

Patent Owner, for limitation 9.9, contends that “advertisement icon 904 merely acts as a reference point showing the user how far to rewind the video” but “is not itself the mechanism for rewinding the video.” PO Resp. 34. According to Patent Owner, Roberts “does not disclose that a user can select advertisement icon 904 for any purpose, much less select that advertisement in order to cause the video to automatically navigate to that point in the video.” *Id.* (citing Ex. 2091 ¶¶ 72–73). Patent Owner further contends Roberts “does not disclose that a user can select advertisements in Roberts’ horizontal GUI carousel display . . . or vertical GUI carousel display in order to navigate to a location in the video.” *Id.* at 34–35.

Petitioner, in turn, contends for limitation 9.9, the limitation “does not require the image itself to be some mechanism for rewinding the video, and only recites causing a navigation event to occur at least partly in response to selecting the video.” Pet. Reply 24–25. According to Petitioner, “a user selects the advertisement icon by rewinding the video until the playback reaches that point in time where the advertisement icon is located on the timeline.” *Id.* at 25.

Analysis

Claim 9 requires a temporal sequence of events. First, the system detects that a user selects the first image, and then a first navigation event occurs at least partly in response to the detection of the user selecting the first image. Ex. 1001, 52:10–12. Claim 13 recites the first navigation event is “causing the playback of the first video to jump to the first segment of the video corresponding to the first image.”

Petitioner relies on Dr. Porter’s testimony concerning Roberts’ disclosure in paragraph 60 to satisfy this claim limitation. Dr. Porter relies on the following disclosure in Roberts: “As an example, an advertisement

icon 904 can be placed along the timeline 901 to correspond to the temporal position of the tag 906 and advertisement, such as if the user would like to rewind the media programming to further view the advertisement.” Ex. 1002 ¶ 109 (quoting Ex. 1004 ¶ 60). Under Petitioner’s theory for limitation 9.9, the user selects the first image by rewinding the video to the point in time where the advertisement icon (the first image) is located on the timeline. Pet. Reply 25. At that point, however, the video has already moved to the segment in the first video and no “jump to” occurs after selection. Neither Petitioner nor Dr. Porter offers any additional argument or evidence concerning how Roberts Video-jumping navigation meets the temporal sequence requirements of claim 13. *See* Pet. 45; Ex. 1002 ¶¶ 107–11.

For these reasons, we determine that Petitioner does not establish by a preponderance of the evidence that claim 13 is anticipated by Roberts.

Claim 18

Claim 18 depends from claim 9 and recites “the operations further comprising: provide a timeline user interface for display on a second user device; and enable the timeline user interface to be utilized in associating the first plurality of images with respective segments in the first plurality of segments of the first video.” Ex. 1001, 52:64–53:4.

Petitioner contends that Roberts’ Figure 6 discloses that a first user has the option of presenting a tag along the program timeline. Pet. 48 (citing Ex. 1004 ¶ 49). Petitioner further contends that other tags can be added as shown in Figure 8 that may be visible to other users. *Id.* at 49–50 (citing Ex. 1004 ¶ 51). Petitioner further contends that Roberts discloses that each user can see advertisements generated by all other users. *Id.* at 51–52 (citing Ex. 1002 ¶¶ 130–133; Ex. 1004 ¶ 62).

Patent Owner relies on its contentions for claim 9. PO Resp. 38–39.

We reviewed Petitioner’s evidence and contentions in light of Patent Owner’s contentions for claim 9 and determine that Petitioner establishes by a preponderance of the evidence that claim 18 is anticipated by Roberts.

Claim 19

Claim 19 depends from claim 9 and recites “the operations further comprising: provide a search interface enabling a user to search for video operations by at least brand, model, or color. Ex. 1001, 53:5–8.

Petitioner contends “Roberts describes providing a search interface that enables a user to search for videos (*e.g.*, associations/comments) by keyword.” Pet. 43 (citing Ex. 1004 ¶¶ 47, 70). According to Petitioner, “Roberts places no limitations on the keywords that can be used for the search” and consequently, a skilled artisan “would have understood that Roberts’ search interface enables a user to search for videos by at least brand, model, or color based on corresponding keywords contained within comments or metadata.” *Id.* (citing Ex. 1002 ¶¶ 87–90).

Patent Owner relies on its contentions for claim 9. PO Resp. 39.

We reviewed Petitioner’s evidence and contentions in light of Patent Owner’s contentions for claim 9 and determine that Petitioner establishes by a preponderance of the evidence that claim 19 is anticipated by Roberts.

Independent Claim 20

Claim 20 contains limitations substantially similar to claim 9 but also requires “the first and second image to be displayed *via a dedicated mobile device application on a first user mobile device.*” Ex. 1001, 53:29–31 (emphasis added) (referred to by Petitioner as limitation 20.7 (Pet. xvi)). For limitation, 20.7, Petitioner directs us to Roberts’ disclosure that “the device

displaying videos include ‘cellular phones, personal digital assistants (PDA), . . .’ displaying videos using a ‘client program.’” Pet. 44 (alteration in original) (citing Ex. 1002 ¶¶ 96–99; Ex. 1003 ¶¶ 36, 43–45).¹⁵

Patent Owner counters that Roberts’ “‘client program’ is not a ‘dedicated mobile application.’ Instead the ‘client program’ is a program which server 506 may have access to but is not a ‘dedicated mobile application’ as required by claim 20.” PO Resp. 35–36 (citing Ex. [1004] ¶¶ 23, 43; Ex. 2091 ¶ 76).

Petitioner, in turn, contends Roberts “discloses that a server may ‘maintain’ the client program and may ‘enable the devices in the system . . . to access the client program and/or download the client program from the server 130.’” Pet. Reply 25 (citing Ex. 1004 ¶ 23). Petitioner further contends Roberts “describes such clients including ‘cellular phones, personal digital assistants (PDA).” *Id.* (citing Ex. 1004 ¶¶ 36, 43–45).

In the Sur-Reply, Patent Owner contends “[a] dedicated mobile application would not be downloadable to other system devices, and so the ‘client program’ identified by Petitioner is not a ‘dedicated mobile application.’” Sur-Reply 20 (citing Ex. 2091 ¶ 76).

Analysis

Patent Owner does not dispute that Roberts discloses a client program that is downloadable to a mobile device but contends Roberts’ client program is not a “dedicated” mobile application because it may also be downloaded to non-mobile devices. PO Resp. 35–36; Sur-Reply 20. Neither Petitioner nor Patent Owner, nor their respective expert witnesses,

¹⁵ For the remaining limitations of claim 20, the parties rely on their contentions for claim 9. Pet. 43–45; PO Resp. 35–37. As discussed above, we find that Roberts anticipates claim 9.

provide us with any guidance as to how “dedicated” should be construed in this limitation. *See* Pet. 44; PO Resp. 35–36; Ex. 1002 ¶¶ 97–99; Ex. 2091 ¶ 76. We turn to the Specification of the ’063 patent for guidance.

The ’063 patent describes “[u]ser interfaces . . . are optionally presented (and user instructions may be received) via a user computing device using a browser, other network resource viewer or otherwise.” Ex. 1001, 50:1–4. The ’063 patent further provides “the user interfaces may be presented . . . via an application installed on the user’s mobile phone.” *Id.* at 50:4–7. “While certain functionality may be described with respect to a mobile phone application, the same or similar functionality may be provided via other interfaces such as a browser (optionally using browser plug-in), a camera equipped kiosk, or otherwise” and “while certain functionality may be described with respect to a browser, similar or the same functionality may be provided via a *dedicated* app, a camera equipped kiosk, or otherwise.” *Id.* at 50:15–19 (emphasis added).

We first note that this portion of the Specification of the ’063 patent generally describes various user interfaces on various types of devices that all provide the same or similar functionality. This portion of the Specification also draws a distinction between user interfaces providing functionality via a browser or browser plug-in and user interfaces providing the same functionality using a mobile phone application. The ’063 patent refers to the mobile phone application as a “dedicated app.” Ex. 1001, 55:15–19.

Roberts discloses its client program can be downloaded from the server and “the client program can allow users to display comments and tags on the presented media content which can be seen amongst the users.” Ex. 1004 ¶ 23. Roberts also discloses that the display device can be a monitor,

television, cellular phones, personal digital assistants (PDA), computers or other device capable of displaying media content.” *Id.* ¶ 43. We do not locate any disclosure in Roberts that the functionality of the client program is different in a browser-enabled device as opposed to a mobile phone. *See, e.g., id.* ¶¶ 43–45.

Petitioner does not direct us to any explicit disclosure in Roberts that would support a finding of a *dedicated* mobile device application, i.e., an application downloaded to a mobile device that is not browser based, nor have we located such disclosure. Pet. 44; Pet. Reply 25–26. Dr. Porter testifies that Roberts “teaches the image display caused via a dedicated mobile device application . . . since the device displaying videos include ‘cellular phones, personal digital assistants (PDA), . . .’ displaying videos using a ‘client program.’” Ex. 1002 ¶ 99. Dr. Porter focuses on the fact that Roberts’ client program is downloadable to mobile devices but does not explain why Roberts’ client program corresponds to the recited “*dedicated* mobile device application.” Further, Petitioner does not contend that Roberts inherently discloses a *dedicated* mobile device application. *Id.*; *see also* Ex. 1002 ¶ 99 (“Roberts teaches the image display caused via a dedicated mobile device application.”).

For all of the foregoing reasons, we determine that Petitioner does not establish by a preponderance of the evidence that Roberts anticipates claim 20.

Claim 22

Claim 22 depends from claim 20 and contains limitations substantially similar to claim 18. Ex. 1001, 53:64–54:4. Petitioner relies on the same evidence and contentions discussed above for claim 18. Pet. 47–52. Patent Owner relies on its contentions for claim 20. PO Resp. 38.

We reviewed the evidence cited by Petitioner for claim 22 and find that it discloses the limitations of claim 22 but determine it does not cure the deficiencies with regard to claim 20 discussed above.

For all of the foregoing reasons, we determine that Petitioner has not established by a preponderance of the evidence that Roberts anticipates claim 22.

Claim 24

Claim 24 depends from claim 20 and contains limitations substantially similar to claim 13. Ex. 1001, 54:9–12. Petitioner relies on the same evidence and contentions discussed above for claim 13. Pet. 45. Patent Owner relies on its contentions for claim 13. PO Resp. 38.

For all of the reasons discussed above for claim 13 and claim 20, we determine that Petitioner does not establish by a preponderance of the evidence that Roberts anticipates claim 24.

Independent Claim 26

Claim 26 contains limitations substantially similar to claim 9 but also requires storing “an association of a first image not from the first video *and/or a first text.*” Ex. 1001, 54:26–27 (emphasis added). The reference to “first text” or “second text” appears in the limitations Petitioner identifies as 26.5–26.9. Pet. xvii–xviii. Petitioner relies on substantially the same contentions as for claim 9. *See* Pet. 45–47. Petitioner adds the contention that “Roberts describes the stored association being image and/or text.” *Id.* at 46 (citing Ex. 1002 ¶¶ 114–117; Ex. 1004 ¶ 58).

Patent Owner relies on substantially the same contentions as for claim 9. *See* PO Resp. 37–38.

We reviewed Petitioner’s evidence and contentions in light of Patent Owner’s contentions for claim 9 and determine that Petitioner establishes by a preponderance of the evidence that claim 26 is anticipated by Roberts.

Claims 27

Claim 27 depends from claim 26 and contains limitations substantially similar to claim 18. Ex. 1001, 54:58–65. Petitioner relies on the same evidence and contentions discussed above for claim 18. Pet. 47–52.

Patent Owner relies on the same contentions as for claim 9 and claim 26. PO Resp. 38–39.

We reviewed Petitioner’s evidence and contentions in light of Patent Owner’s contentions for claim 26 and determine that Petitioner establishes by a preponderance of the evidence that claim 27 is anticipated by Roberts.

G. Ground 2: Alleged Obviousness over Roberts and Kraus

Claim 1

Claim 1 contains limitations substantially similar to claim 9 but also requires “a first video file . . . compressed using a VP or MPEG^[16] format.” Ex. 1001, 50:37–41. Petitioner relies on Kraus for disclosure of VP and MPEG video compression formats. Pet. 52 (citing Ex. 1009 ¶ 25). Petitioner also provides reasons that a skilled artisan would have had to combine the teachings of Roberts and Kraus and contends that a skilled artisan would have had a reasonable expectation of success in modifying

¹⁶ The ’063 patent explains that a “video file may be in a raw or compressed video and audio data format.” Ex. 1001, 15:39–40. Further, “[t]he compressed video data may use the H.264, VP8, MPEG-4, MPEG-2, RealVideo, Theora, Dirac or another suitable video compression format.” *Id.* at 15:40–43.

Roberts to include VP or MPEG video compression as taught by Kraus. *Id.* at 52–53 (citing Ex. 1002 ¶¶ 134–139).

Patent Owner relies on its contentions for claim 9 in Ground 1 and asserts that Petitioner’s reliance on Kraus does not cure the alleged deficiencies in Roberts’s disclosure for claim 9. PO Resp. 39–40.

We reviewed Petitioner’s evidence and contentions in light of Patent Owner’s contentions for claim 9 and determine that Petitioner establishes by a preponderance of the evidence that claim 1 would have been obvious over the combined teachings of Roberts and Kraus.

Claim 10

Claim 10 depends from claim 9 and requires that “the first video is compressed using a VP or MPEG format.” Ex. 1001, 52:23–24. Petitioner relies on the same disclosure from Kraus as for claim 1. Pet. 58.

Patent Owner relies on the same contentions as for claim 9 and asserts that Petitioner’s reliance on Kraus does not cure the alleged deficiencies in Roberts’ disclosure. PO Resp. 40–41.

We reviewed Petitioner’s evidence and contentions in light of Patent Owner’s contentions for claim 9 and determine that Petitioner establishes by a preponderance of the evidence that claim 10 would have been obvious over the combined teachings of Roberts and Kraus.

H. Ground 3: Alleged Obviousness over Roberts and Miller

Petitioner contends that claim 11 is obvious over Roberts and Miller. Pet. 58–60. Claim 11 depends from claim 9 and requires limiting “a size of the first video to no greater than a first specified size.” Ex. 1001, 52:25–27. Petitioner relies on Miller for disclosure of limiting a video size. Pet. 58–59 (citing Ex. 1010, 154). Petitioner provides reasons why a skilled artisan would have modified Roberts to limit file size as taught by Miller and asserts

that a skilled artisan would have had a reasonable expectation of success in doing so. *Id.* at 59–60 (citing Ex. 1002 ¶¶ 163–168).

Patent Owner relies on its contentions for Ground 1 and asserts that Petitioner’s reliance on Miller does not cure the alleged deficiencies in Roberts’s disclosure. PO Resp. 41.

We reviewed Petitioner’s evidence and contentions in light of Patent Owner’s contentions for claim 9 and determine that Petitioner establishes by a preponderance of the evidence that claim 11 would have been obvious over the combined teaching of Roberts and Miller.

Based on the current record, Petitioner establishes a reasonable likelihood that claim 11 is unpatentable over Roberts and Miller.

I. Ground 4: Alleged Anticipation by Geer

Petitioner contends that claims 9, 13, 19, 20, 24, and 26 are anticipated by Geer. Pet. 60–78. In support thereof, Petitioner identifies the disclosures in Geer alleged to describe the subject matter in the challenged claims. *Id.* Additionally, Petitioner offers declaration testimony from Dr. Porter in support of the Petition. Ex. 1002 ¶¶ 170–230. Patent Owner disputes Petitioner’s contentions. PO Resp. 41–50.

We begin our analysis with a brief overview of Geer. We then address the parties’ respective contentions with respect to the challenged claims.

Geer – Ex. 1005

Geer discloses “methods and apparatuses, including computer program products, for dynamic integration and non-linear presentation of advertising content and media content.” Ex. 1005, code (57). Geer discloses displaying “advertising content (e.g., a pop-up ad) at strategic points during the presentation of digital media content to assist the user in

making a ‘connection’ between the advertised goods and the media content.”
Id. ¶ 36.

Figure 3C of Geer is reproduced below:

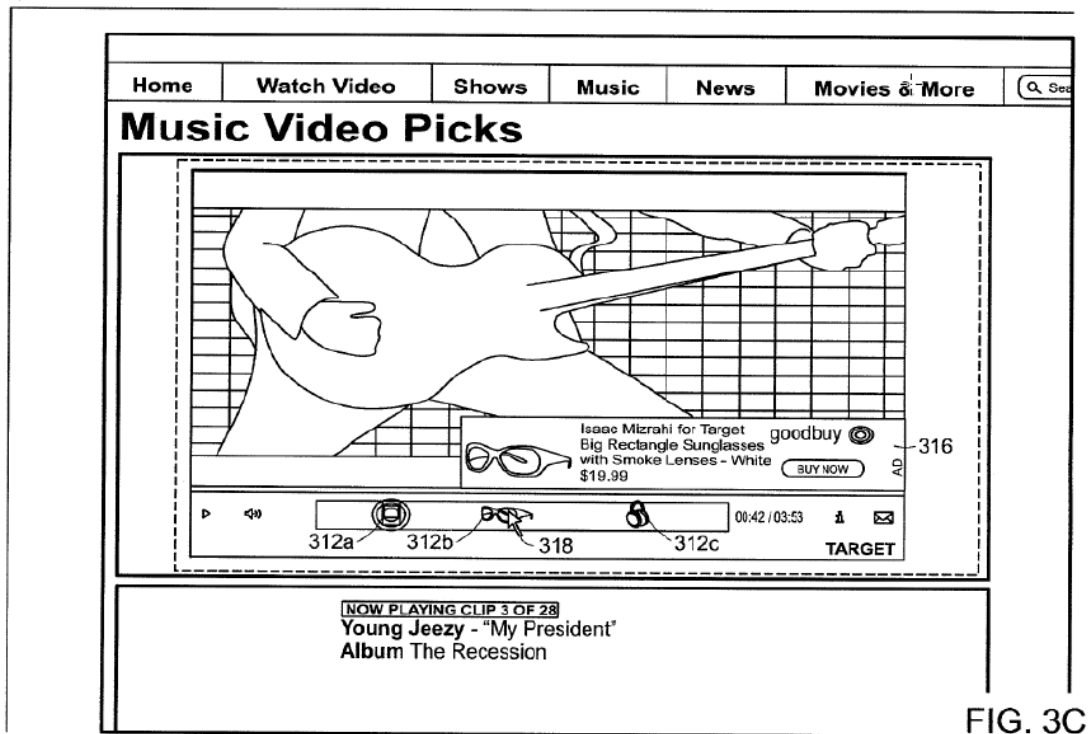


Figure 3C is “an exemplary embodiment of an interactive advertising unit provided by” Geer’s system. *Id.* ¶ 19. Figure 3C shows interactive product icons 312a–312c integrated with scrubber bar 306 of the media player at various intervals. *Id.* ¶ 39. Product icons 312a–312c “function within the context of the media player window 302b and trigger the display of advertisements associated with products represented by the icons 312a-c.” *Id.*

Independent Claim 9

[9.P] Preamble: A system for controlling playback of video files, comprising:

Petitioner contends that Geer discloses “a system 100 for dynamic integration of advertising and media content” that “controls playback of

video files by, *e.g.*, ‘coordination of content display timing between the advertising product and the media player.’” Pet. 60 (citing Ex. 1002 ¶¶ 169–170; Ex. 1005 ¶¶ 5–8, 22, 24, 34, Fig. 1).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 41–48. Neither party addresses whether the preamble is limiting. Pet. 26–27; PO Resp. 41–48.

We need not decide whether the preamble is limiting because Petitioner establishes that Geer discloses the subject matter of the preamble.

a. [9.1] at least one processing device;

Petitioner contends that Geer’s system “includ[es] a processing device, as its system includes a server computing device 106, ad server 108, and video server 110.” Pet. 61 (citing Ex. 1002 ¶ 171; Ex. 1005 ¶¶ 24, 59, 61–63, 65–68).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 41–48. Based on the evidence cited by Petitioner, we find Geer discloses this claim limitation.

[9.2] a network interface configured to communicate over a network with a video store;

Petitioner contends that Geer’s system “includ[es] a network interface (*e.g.*, on server 106) configured to communicate over a network (*e.g.*, communications network 104) with a video data store (*e.g.*, media server 110).” Pet. 61 (citing Ex. 1002 ¶ 172; Ex. 1005 ¶¶ 24, 26, 27, 29, 63, 69).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 41–48. Based on the evidence cited by Petitioner, we find Geer discloses this claim limitation.

[9.3] non-transitory memory storing programmatic code that when executed by the at least one processing device, cause the system to perform operations comprising:

Petitioner contends that Geer’s system “perform[s] operations based on execution by processor(s) of programmatic code stored in non-transitory memory.” Pet. 62 (citing Ex. 1002 ¶ 173; Ex. 1005 ¶¶ 24, 59–63, 66–68).

Patent Owner does not address Petitioner’s contentions. See PO Resp. 41–48. Based on the evidence cited by Petitioner, we find Geer discloses this claim limitation.

[9.4] receive, over a network using the network interface, a first video;

Petitioner contends that Geer’s system “receiv[es], over the network using the network interface, a first video (e.g., submitted by a user).” Pet. 62 (citing Ex. 1002 ¶ 174; Ex. 1005 ¶ 29).

Patent Owner does not address Petitioner’s contentions. See PO Resp. 41–48. Based on the evidence cited by Petitioner, we find Geer discloses this claim limitation.

[9.5] store an association of a given image in a first plurality of images with a respective segment in a first plurality of segments of the first video,

Petitioner contends that “Geer describes the video including a plurality of segments (e.g., ‘time intervals’), segmented based on, e.g., when a particular advertisement is to be displayed during playback of such segment.” Pet. 62 (citing Ex. 1005 ¶¶ 38, 43, 47–50). Petitioner further contends that “Geer describes an association of a given image (e.g., image of an advertised product, displayed as respective product icon 312a-312c and displayed within an advertisement) in a first plurality of images . . . with a respective video segment.” *Id.* (citing Ex. 1005 ¶¶ 36, 39, 42, 43, 47–50, Figs. 3A–3C). Petitioner further contends that Geer “stor[es] the association

of the image with the video time interval in the ad server 108, as the web server 106 retrieves this stored information from the ad server 108 when fulfilling a client's request to play the video and associated advertisements.” *Id.* at 63–64 (citing Ex. 1002 ¶¶ 175–178; Ex. 1005 ¶¶ 12, 32, 39).

Patent Owner contends “Geer describes a server computing device 106 combining advertising content and video” and “is specifically premised and organized around a system in which any combination between an advertisement and a video occurs at the server computing device 106, not at the client computing device 102 via the user interface as required by the limitation.” PO Resp. 41–42 (citing Ex. 1005 ¶ 32, Fig. 1; Ex. 2091 ¶ 92). According to Patent Owner, “[t]here is no association between the advertisements and the videos, either prior to the videos playing or at the time the advertisements are pushed.” *Id.* at 42 (citing Ex. 2091 ¶ 93). Patent Owner further contends “the entire goal of Geer is to **automatically** present advertisements that are stored in an ad server 108 as users browse videos that are stored in a media server 110.” *Id.* at 42–43 (citing Ex. 1005, Fig. 1; Ex. 2091 ¶ 94).

Patent Owner also contends that modifying “Geer to ‘store an association of a given image’ with ‘respective segment’ of a video . . . would render Geer inoperable for its intended purpose.” PO Resp. 42.

Petitioner, in turn, replies “Geer is not an ‘automatic’ system” and “only employs the word ‘automatic’ three times throughout its disclosure, none involving the context of associating advertisements with videos.” Pet. Reply 27 (citing Ex. 1005 ¶¶ 41, 44–45). Petitioner further contends Geer discloses that “an advertiser manually establishes an association between its advertisement and a specific time with a specific video, defining ‘preferences’ for displaying advertisement at a specific point in time during

video playback.” *Id.* (citing Ex. 1005 ¶¶ 32, 45). Petitioner further contends “Geer explicitly discloses [marketing] associations, *e.g.*, an advertiser’s ‘preferences’ associating its advertisement with a ‘specific point in time’ in a specific video” and “[t]hese manual associations are stored in the system, as they are retrieved when fulfilling a video playback request.” *Id.* at 28 (citing Ex. 1002 ¶¶ 178–179; Ex. 1005 ¶ 32).

In the Sur-Reply, Patent Owner contends “Petitioner does not refute that the Geer system discloses providing advertising content in real time—a ‘dynamic integration of advertising and media content that necessarily would be automated.” Sur-Reply 21 (citing Ex. 1005 ¶¶ 4–9, 24, 32; Ex. 2091 ¶ 92). Patent Owner contends paragraph 43 of Geer “discusses an ‘interaction module’ which ‘positions the product icons 312a-c according to preferences exhibited by advertiser’ and runs ‘algorithms that determine[] the time intervals,’ or ‘correlate[es] with content displayed at a specific point.’” *Id.* (citing Ex. 1005 ¶ 43). According to Patent Owner, this paragraph of Geer “does not teach that the marketing association/preferences necessitate any advertisement appearing at a specific time, but at most creates a correlation between an advertiser’s preference and media content.” *Id.*

Analysis

We first address Patent Owner’s contention that Geer combines the video and advertisements at server 106 as opposed to client computing device 102. PO Resp. 41–42. We perceive no requirement in limitation 9.5 that the recited actions must be performed at the client computing device as opposed to a server. Consequently, this contention is unavailing because it is not commensurate with the scope of claim 9.

Patent Owner's contention that the Petition's proposed modifications to Geer would render Geer inoperable for its intended purpose is unavailing because the Petition does not propose modifying Geer.

We also do not agree with Patent Owner's contention that because Geer is purportedly an "automatic" or "real time" system that it does not disclose storing an association of a given image with a segment of the video. Geer discloses that its interaction module runs an algorithm that "may divide the total running time of the video by the number of icons 312a-c . . . the advertiser wants to display." Ex. 1005 ¶ 43; *see also id.* at Figs. 3A–3C (illustrating placement of product icons 312a–c). Geer further discloses "interaction module 208 . . . synchronizes the temporal presentation . . . of the advertising content and the digital media content" and "coordinates the spatial, temporal, and control functionality to work in concert with each other advantageously merging the features of each presentation type." *Id.* ¶ 34. Further, Geer's "interaction module 208 displays advertising content at predetermined intervals during presentation of the digital media content." *Id.* ¶ 36. These disclosures directly contradict Patent Owner's assertion in the Sur-Reply that Geer "does not teach . . . any advertisement appearing at a specific time." *See* Sur-Reply 21.

Based on the evidence presented by Petitioner and after considering all of Patent Owner's contentions, we find that Geer discloses this limitation.

[9.6] the first plurality of images comprising: a first image associated with a first segment of the first video; and a second image associated with a second segment of the first video, wherein the first image and the second image are not an image from the first video;

Petitioner contends that Geer discloses the first plurality of images "comprising a first image (e.g., image of an advertised product, displayed as

respective product icon 312a-312c and displayed with advertisement) associated with a first segment of the first video . . . and a second image . . . associated with a second segment of the first video.” Pet. 64 (citing Ex. 1005 ¶¶ 43, 47–50). Petitioner further contends that “[t]he first and second images (*e.g.* of products) are not an image from the first video, as these images are of advertised products.” *Id.* at 65 (citing Ex. 1002 ¶¶ 179–180; Ex. 1005 ¶ 47, Figs. 3A–C).

Similar to limitation 9.5, Patent Owner contends “Geer discloses no teaching of any associations between a video and an advertisement being stored” because Geer is “premised and organized around a system in which any combination between an advertisement and a video occurs at the server computing device 106 automatically when the user views the video, not stored on a back-end server and retrieved.” PO Resp. 43 (citing Ex. 1005 ¶ 32, Fig. 1; Ex. 2091 ¶ 95).

Petitioner, in turn, responds that “Dr. Valerdi acknowledges that each product icon image in Geer is associated with a distinct video segment.” Pet. Reply 28 (citing Ex. 1042, 65:11–66:12).

In the Sur-Reply, Patent Owner contends “it is the ‘server computing device 106’ which ‘combines the advertising content and the requested digital media content to provide an interactive advertising unit 202’ at the time the video playback request is fulfilled.” Sur-Reply 22 (citing Ex. 1005 ¶ 32; Ex. 2091 ¶ 92).

Analysis

Geer’s product icons are not images from the first video, as required by this claim limitation, but are associated with product advertisements. Ex. 1002 ¶ 181; Ex. 1005, ¶ 47, Figs. 3A–3C. Patent Owner’s contentions for this limitation are substantially similar to its contentions for limitation 9.5

that Geer does not associate images with video segments and associates advertisements with video segments at a server. These contentions are unavailing for the same reasons discussed above in connection with limitation 9.5. Patent Owner's contentions are further undercut by Dr. Valerdi's testimony that Geer's icons 312a to 312c correspond to segments of the video. Ex. 1042, 65:11–66:12.

Based on the evidence presented by Petitioner and after considering all of Patent Owner's contentions, we find that Geer discloses this limitation.

[9.7] cause at least the first image and the second image to be displayed on a first user device at the same time in association with a playback of the first video, for at least a portion of the time the first video is being played back in a playback area of a content player

Petitioner contends that “Geer describes causing the first and second images to be displayed on a first user device (*e.g.*, client computing device 102) at the same time in association with a playback of the first video (*e.g.*, video in Figs. 3A-3C).” Pet. 65–66 (citing Ex. 1005 ¶¶ 32–34, 44–50, Figs. 1, 3A–3B). Petitioner further contends that Geer's “first and second images are displayed for at least a portion of the time the first video is being played back in a playback area of a content player.” *Id.* at 66–67 (footnote omitted) (citing Ex. 1002 ¶¶ 181–182; Ex. 1005 ¶¶ 33–41, ¶¶ 48–50, Fig. 3C).

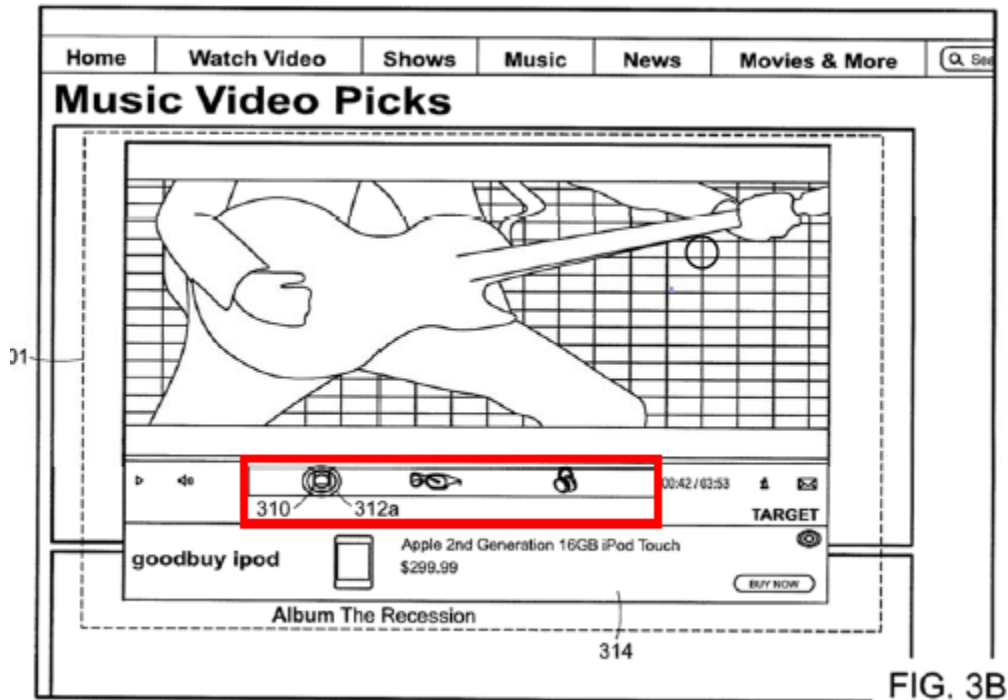
Patent Owner does not address Petitioner's contentions. *See* PO Resp. 41–48. Based on the evidence cited by Petitioner, we find Geer discloses this claim limitation.

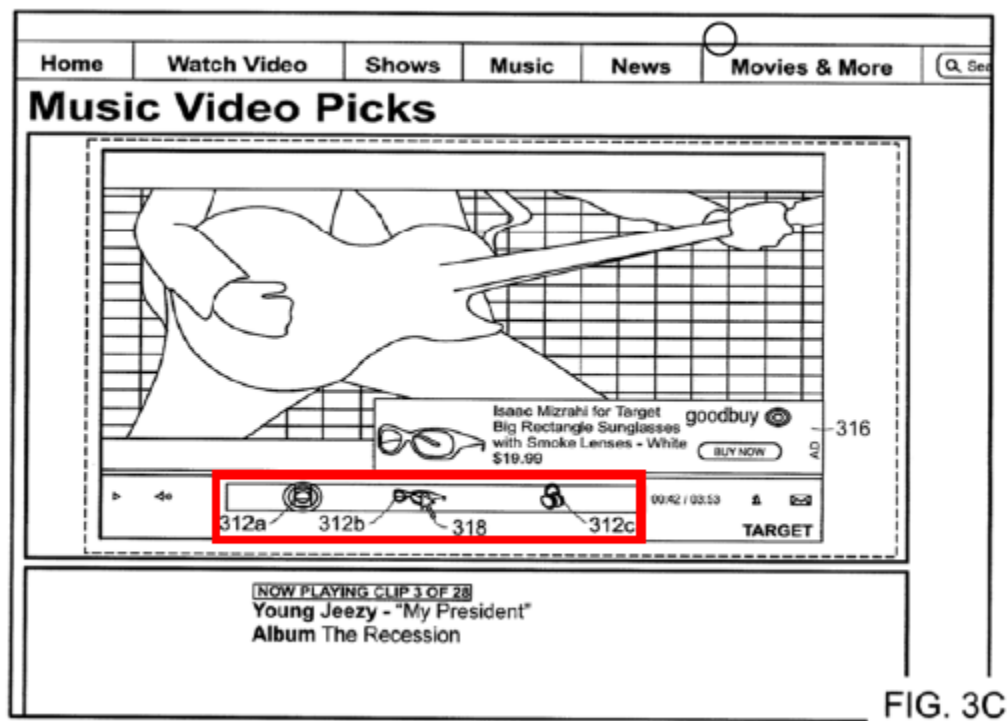
[9.8] wherein the first image and the second image, associated with respective first and second segments in the first video, are displayed at the same time in the playback area, overlaying the playback of the first video, and the display of the first image and the second image are changed during playback of the second segment, relative to the display of the first image and the second image during playback of the first segment;

Petitioner contends that Geer discloses that the first image and second image “are displayed overlaying the playback of the first video, as the video is presented on a first content player 204 and the product icons and advertisements are presented on a second content layer 206 ‘positioned on top of the first content layer 204.’” Pet. 67–69 (citing Ex. 1005 ¶¶ 33, 35, 28, 42, Fig. 2). Petitioner further contends that Geer satisfies the portion of this limitation of changing display of the first and second images by disclosing that during “video playback . . . of the first video segment (*e.g.*, corresponding to the first advertisement), the first image (*e.g.*, image of MP3 player) is displayed both as product icon 312a and within the displayed advertisement, whereas the second image (*e.g.*, image of sunglasses is displayed only as product icon 312b.” *Id.* at 69 (citing Ex. 1005 ¶ 47). Further, Petitioner contends that “[w]hen video playback is of the second video segment (*e.g.*, corresponding to the second advertisement), the first image is displayed only as product icon 312a, whereas the second image (*e.g.*, image of sunglasses) is displayed both as product icon 312b and within the displayed advertisement.” *Id.* (citing Ex. 1002 ¶¶ 183–185; Ex. 1005 ¶¶ 47–48, Figs. 3A–3C).

Patent Owner contends that Geer does not disclose “the display of the first image and the second image are changed during playback.” PO Resp. 44. Patent Owner contends that “[t]he icon images disclosed in Geer in the ‘First Content Layer’ do not change images at all” but rather “Geer discloses

that “[w]hen the visual indicator 310 is directly lined up with the product icon 312a, the interactive advertising unit 301 displays a ‘pop-out’ window 314 in the second content layer.” *Id.* (citing Ex. 1005 ¶ 47; Ex. 2091 ¶ 98). Patent Owner further contends that “[t]he ‘product icon 312a’ (first image) is static and does not change during the playback of the video.” *Id.* Patent Owner provides the following annotated versions of Geer’s Figures 3B and 3C to support this contention (PO Resp. 45–46):





Figures 3B and 3C “are screen shots of an exemplary embodiment of an interactive advertising unit provided by the system wherein interactive product icons are integrated at various intervals with the scrubber bar of the media player.” Ex. 1005 ¶ 19. Patent Owner annotates each of Figure 3B and Figure 3C with a red rectangular box around product icons 312a–312c. Pet. 45–46.

Petitioner, in turn, replies Patent Owner misconstrues the Petition. Pet. Reply 28. Petitioner contends “[t]he Petition refers to first and second images as, *e.g.*, an ‘image of an MP3 player’ and an ‘image of sunglasses’ . . . and does not limit display of these images to their display as product icons.” *Id.* at 28–29 (citing Pet. 66).

In the Sur-Reply, Patent Owner contends the advertisement “icons are the only potential images that can meet element [9.7] in Geer as they are displayed at the same time.” Sur-Reply 23.

Analysis

As discussed in connection with limitation 9.6, Petitioner identifies the recited first and second images as product icons 312a–c. *See* Ex. 1002 ¶ 180 (Dr. Porter identifying product icons as the first and second images in Geer’s Figure 3C). The claim language relevant to this dispute is “the *display* of the first image and the second image are changed during playback of the second segment, relative to the *display* of the first and second image during playback of the first segment.” Ex. 1001, 52:5–9 (emphasis added).

Patent Owner’s contention is based on construing this limitation such that the first and second image themselves must be changed during playback of the first segment relative to playback of the first segment. Patent Owner supports this contention with Dr. Valerdi’s testimony that “[t]he icon images disclosed in the ‘First Content Layer’ do not change at all.” Ex. 2091 ¶ 98.

Petitioner supports its position that the *display* of the first and second images in Geer changes from the first segment to the second segment with the testimony of Dr. Porter. Ex. 1002 ¶ 185. Dr. Porter testifies that “when video playback is of the first video segment (*e.g.*, corresponding to the first advertisement), the first image (*e.g.*, image of MP3 player) is displayed both as product icon 312a and within the displayed advertisement, whereas the second image (*e.g.*, image of sunglasses) is displayed only as product icon 312b.” *Id.* Dr. Porter further testifies that “[w]hen video playback is of the second video segment (*e.g.*, corresponding to the second advertisement), the first image is displayed only as product icon 312a, whereas the second image is displayed both as product icon 312b and within the displayed advertisement.” *Id.* ¶ 186 (citing Ex. 1005 ¶¶ 47–48, Figs. 3A–3C). Dr. Porter also points to the text of paragraph 47 of Geer that “pop-out window contains a more detailed description of the product represented by the first

product icon 312a, such as, for example, a larger picture of the product.” *Id.* ¶ 185 (quoting Ex. 1005 ¶ 47).

We find that Dr. Porter’s testimony is entitled to substantial weight because it is focused on the actual claim language concerning the “display” of the first image and second image and is supported by the disclosure of Geer. In particular, he explains how the display of the product icons changes and the fact that a larger picture of the product appears when the icon is selected is particularly probative of a change in the “display” of the first image and the second image. This testimony is confirmed by Figures 3B and 3C. In Figure 3B, the sunglasses are displayed only as a small image in scrubber bar 306. In Figure 3C, the sunglasses are displayed both as a small image in scrubber bar 306 and as a larger image in the pop-out window 316. We credit Dr. Porter’s testimony over that of Dr. Valerdi because Dr. Valerdi’s testimony focuses on the images of product icons in the scrubber area, not on the display of the images.

Based on the evidence presented by Petitioner and after considering all of Patent Owner’s contentions, we find that Geer discloses this limitation.

[9.9] cause a navigation event to occur at least partly in response to a detection that a user has selected the first image, the first image associated with the first segment and displayed at the same time as the second image in the playback area overlaying the playback of the first video

Petitioner contends that Geer discloses this limitation. Pet. 69–70 (citing Ex. 1005 ¶ 50). Petitioner first contends “Geer describes causing a first navigation event (*e.g.*, navigating to a particular point in the video).” *Id.* at 69. Petitioner next contends that the first navigation event in Geer occurs, “at least partly in response to a detection that a user has selected the first image . . . by sliding the visual indicator 310 of the scrubber bar 306 to

move it over a product icon.” *Id.* at 69–70. According to Petitioner, Geer discloses that when a user moves the icon over the product icons 312a or 312c, advertising in pop-in window 316 changes to match the icon and that when users slide visual indicator 310 in the scrubber bar, playback of the media content moves forward or backward depending on the user’s action. *Id.* at 70 (citing Ex. 1005 ¶ 50).

Patent Owner contends that Geer does not disclose this limitation. PO Resp. 46–47. Patent Owner first contends that although the user may “move the mouse pointer over a product icon on the screen in order to change the advertising pop-in window 316 . . . [t]hat functionality is not a ‘navigation event,’ as it does not cause navigation to either another portion of the video or to a different website.” *Id.* at 47 (citing Ex. 1005 ¶ 50). According to Patent Owner, “[i]t merely displays a different advertisement in the pop-in overlay window 316.” *Id.* Patent Owner further contends that Geer’s reference to sliding visual indicator 310 in the scrubber bar does not satisfy this limitation because visual indicator 310 is a navigation control but “is not a ‘first image’” as required by claim 9. *Id.* (citing Ex. 1005, Fig. 3A).

Petitioner, in turn, contends “display of the advertisement does cause navigation to a different website ‘at least partly in response to’ . . . such mouse movement, by causing the advertisement to be displayed and a ‘Buy Now’ link to be shown in the advertisement.” Pet. Reply 29.

In the Sur-Reply, Patent Owner contends, “[e]ven if moving a mouse pointer over a product icon could be construed as selecting an image, this only causes the advertisement to be displayed” and “a user would still need to further select the ‘Buy Now’ link in the advertisement to actually ‘cause a first navigation event to occur.’” Sur-Reply 24. Patent Owner further contends “Petitioner concedes that visual indicator 310 . . . is not a first

image” and “this is the only tool that a user may select to cause a navigation event to occur (dragging it along the time bar to navigate to different points).” *Id.* (citing Ex. 1005 ¶ 50; Ex. 2091 ¶ 100). According to Patent Owner, “[e]ven if the user drags the indicator to a product icon, the user does not select the product icon itself in order to cause a navigation event.” *Id.* at 24–25.

Analysis

Petitioner provides a construction of “navigation event” that includes two types of events. Pet. 17. First, a “navigation event” as “an event of jumping to a segment of a video.” *Id.* Second, a “navigation event” as “an event of navigating to a website.” *Id.*

Petitioner contends, in the Petition, Geer discloses “a first navigation event (*e.g.*, navigating to a particular point in the video) to occur at least partly in response to a detection that a user has selected the first image (*e.g.*, by sliding the visual indicator 310 of the scrubber bar 306 to move it over a product icon).” Pet. 69–70. This contention falls within the first type of navigation event.

We agree with Patent Owner that this disclosure fails to satisfy this claim limitation. Similar to claim 13 discussed above in Ground 1, Claim 9 requires a temporal sequence of events. First, the recited system detects that a user selects the first image, and then a first navigation event occurs at least partly in response to the detecting the user has selected the first image. Ex. 1001, 52:10–16. Petitioner’s theory is that selection of the first image (product icons 312a–c) occurs when the user slides visual indicator 310 over one of the product icons. But, the video has already navigated to that point in the video prior to selection of the first image so no navigation event occurs in response to detection of the selection.

In the Petitioner Reply, Petitioner changes theories and relies on the second type of navigation event, i.e., “navigating to a website.”¹⁷ Patent Owner apparently does not dispute that a user clicking on the “Buy Now” link in the pop-in advertisement causes navigation to a website. *See* Sur-Reply 24–25. Rather, the dispute between the parties revolves around whether the resulting navigation to a website is “at least partly in response to a detection that a user has selected the first image.” Ex. 1001, 52:10–12. Dr. Porter’s testimony relates to the first type of navigation event, i.e., an event of jumping to a segment of the video. Ex. 1002 ¶¶ 187–188. Dr. Porter does not offer testimony on Petitioner’s theory in the Reply that clicking on “Buy Now” is “at least partly in response to detection that a user has selected the first image.” *See id.* Dr. Valerdi testifies that the theory in the Petition does not disclose “a ‘navigation event,’ as it does not cause navigation to either another portion of the video or to a different website.” Ex. 2091 ¶ 100. Thus, neither Dr. Porter nor Dr. Valerdi offers testimony on the precise issue of whether when a user clicks the “Buy Now” link in the pop-in advertisement, the resulting navigation to a website is “at least partly in response to a detection that a user has selected the first image.” Consequently, both parties’ contentions on this point are attorney argument unsupported by persuasive evidence. Because Petitioner bears the burden of persuasion, we find that Petitioner fails to establish Geer discloses this claim limitation.

¹⁷Patent Owner does not contend that that this change in theory by Petitioner is beyond the proper scope of a reply. *See* Sur-reply 24–25.

[9.10] cause a second navigation event to occur at least partly in response to a detection that a user has selected the second image, the second image associated with the second segment an displayed at the same time as the first image in the playback area overlaying the playback of the first video.

Petitioner and Patent Owner rely on the same contentions for this limitation as for the limitation 9.9. Pet. 71; PO Resp. 35.

For the reasons discussed above for limitation 9.9, we find that Petitioner fails to establish Geer discloses this claim limitation.

b. Summary of Claim 9

For all the foregoing reasons, we determine that Petitioner fails to establish by a preponderance of the evidence that claim 9 is anticipated by Geer.

Claims 13 and 19

For claim 13, Petitioner relies on substantially the same contentions as for limitation 9.9. Pet. 74–75. For claim 19, Petitioner points to disclosure in Geer alleged to correspond to the limitations of claim 19. *Id.* at 71–72 (citing Ex. 1004 Fig. 4B.). Patent Owner does not specifically address claim 13 or claim 19. *See* PO Resp. 41–50.

We reviewed Petitioner’s evidence and contentions for claims 13 and 19 and determine it does not cure the deficiencies in claim 9 discussed above.

For these reasons, we determine that Petitioner does not establish by a preponderance of the evidence that claim 13 or claim 19 is anticipated by Geer.

Claim 20

Claim 20 contains limitations substantially similar to limitations 9.9 and 9.10. Ex. 1001, 53:44–53. Petitioner refers to these limitations as

limitations 20.9 and 20.10. Pet. xvi. For limitations 20.9 and 20.10, Petitioner relies on its contentions for limitations 9.9 and 9.10. *Id.* at 74.

For reasons discussed above for claim 9, we determine that Petitioner does not establish by a preponderance of the evidence that claim 20 is anticipated by Geer.

Claim 24

For claim 24, Petitioner relies on substantially the same contentions as for limitation 9.9. Pet. 74–75. Patent Owner does not specifically address claim 24. *See* PO Resp. 41–50.

We have reviewed Petitioner’s evidence and contentions for claim 24 and determine it does not cure the deficiencies in claim 20 discussed above.

For these reasons, we determine that Petitioner does not establish by a preponderance of the evidence that claim 24 is anticipated by Geer.

Independent Claim 26

Claim 26 contains limitations substantially similar to limitations 9.9 and 9.10. Ex. 1001, 54:46–57. Petitioner refers to these limitations as 26.9. Pet. xviii. Petitioner relies on same contentions as for limitations 9.9 and 9.10. *Id.* at 77.

For reasons discussed above for claim 9, we determine that Petitioner does not establish by a preponderance of the evidence that claim 26 is anticipated by Geer.

J. Ground 5: Alleged Obviousness over Geer and Kraus

Claim 1

Claim 1 contains limitations substantially similar to limitation 9.9. Ex. 1001, 50:64–51:2. Petitioner refers to this limitation as limitation 1.9. Pet. xii. For limitation 1.9, Petitioner relies on its contentions for limitations

9.9 and 9.10. *Id.* at 84. Petitioner does not rely on any additional disclosure from Kraus to satisfy limitation 1.9. *Id.* at 78–79.

For the reasons discussed above for claim 9, we determine that Petitioner does not establish by a preponderance of the evidence that claim 1 is unpatentable over the combined teachings of Geer and Kraus.

Claim 10

Claim 10 depends from claim 9 and requires that “the first video is compressed using a VP or MPEG format.” Ex. 1001, 52:23–24. Petitioner relies on Kraus’ disclosure of compressed video file formats such as VP or MPEG. Pet. 84 (citing Ex. 1009 ¶ 25).

We reviewed the disclosure from Kraus and determine it does not cure the deficiencies discussed above for claim 9 in Ground 4.

For these reasons, we determine that Petitioner does not establish by a preponderance of the evidence that claim 10 is unpatentable over the combined teachings of Geer and Kraus.

K. Ground 6: Alleged Obviousness over Geer and Miller

Claim 11 depends from claim 9 and requires limiting “a size of the first video to no greater than a first specified size.” Ex. 1001, 52:25–27. Petitioner relies on Miller for disclosure of limiting a video size. Pet. 84 (citing Ex. 1010, 154). Petitioner provides reasons why a skilled artisan would have modified Geer to limit file size as taught by Miller and asserts that a skilled artisan would have had a reasonable expectation of success in doing so. *Id.* at 84–85 (citing Ex. 1002 ¶¶ 260–265).

We reviewed the disclosure from Miller and determine it does not cure the deficiencies discussed above for claim 9 in Ground 4.

For these reasons, we determine that Petitioner does not establish by a preponderance of the evidence that claim 11 is unpatentable over the combined teachings of Geer and Kraus.

L. Ground 7: Alleged Obviousness over Geer and Fink

Claims 18, 22, and 27 depend from claims 9, 20, and 26, respectively. Ex. 1001, 52:64, 53:64, 54:58. Petitioner directs us to various disclosures in Geer and Fink that it contends disclose the limitations of these dependent claims. Pet. 85–88.

We reviewed Petitioner’s contentions and evidence cited for these dependent claims and determine its does not cure the deficiencies discussed above for claims 9, 20, and 26 in Ground 4.

For these reasons, we determine that Petitioner does not establish by a preponderance of the evidence that any of claims 18, 22, or 27 is unpatentable over the combined teachings of Geer and Kraus.

M. Ground 8: Alleged Obviousness over Roberts and Geer

Petitioner interposes this challenge to claims 20, 22, and 24 as an alternate challenge “to the extent that the Board disagrees that Roberts discloses a ‘dedicated’ mobile device application.” Pet. 90. Petitioner contends that Geer discloses “a ‘dedicated’ mobile application.” *Id.* Petitioner relies on Geer’s disclosure of an “iPhone® ‘app.’” *Id.* (citing Ex. 1005 ¶ 23). Petitioner contends a skilled artisan “would have recognized and appreciated by 2012-2013, mobile ‘apps’ were already commonplace and provide a more customized and tailored user interface . . . by avoiding technical limitations underlying a web browser interface.” *Id.* Petitioner further contends a skilled artisan would have also recognized that Geer’s iPhone® app “would have provided more direct access to video content, avoiding lengthier web browser navigation” and such a modification to

Roberts would “provide a more refined and interactive experience for a mobile user compared to a browser.” *Id.* at 90–91. Petitioner also contends that a skilled artisan would have had a reasonable expectation of success of incorporating a mobile app because such apps “are conventional and commonplace.” *Id.* at 91 (citing Ex. 1002 ¶¶ 277–283).

Patent Owner responds that “Roberts does not render obvious claim 20” and “Geer does not cure the deficiencies of Geer with respect to those claims.” PO Resp. 53 (citing Ex. 2091 ¶ 117). For the dedicated mobile device application” limitation of claim 20, Patent Owner contends Geer does not disclose this limitation because it “discloses the use of ‘browser software’ and the use of general ‘digital content playback plug-ins or standalone software.’” *Id.* at 48–49 (citing Ex. 1005 ¶ 25; Ex. 2091 ¶ 104).

Petitioner in turn contends Patent Owner “entirely ignores that Geer explicitly discloses ‘an interactive application downloaded and executed on a smart phone, i.e., an ‘app’ configured to run on the iphone® from Apple® Computer, Inc.’” Pet. Reply 28 (citing Pet. 73; Ex. 1005 ¶ 23).

In the Sur-Reply, Patent Owner contends “[t]hat Geer discloses ‘an interactive application’ which may be downloaded by cellular devices, does not disclose a ‘dedicated mobile application.’” Sur-Reply 25. According to Patent Owner, “Geer discloses more general ‘digital content playback plug-ins or standalone software,’” but “[t]hat content is ‘not limited to a web browser’ and could be downloaded by a phone demonstrates it is not ‘dedicated’ for that purpose.” *Id.* (citing Ex. 1005 ¶¶ 23, 25).

Analysis

Geer discloses that “[t]he display of the advertising content is not limited to a web browser or traditional embedded media player.” Ex. 1005 ¶ 23. Geer further discloses that the content “can be displayed to a user via

an interactive application downloaded and executed on a smart phone, i.e., an ‘app’ configured to run on the iPhone® from Apple® Computer, Inc.”

Id.

As discussed above in Ground 1, the Specification of the ’063 patent generally draws a distinction between user interfaces providing functionality via a browser or browser plug-in and user interfaces providing the same functionality using a mobile phone application. The disclosure of paragraph 23 of Geer draws the same distinction between a browser-based display and a mobile phone application. Dr. Porter testifies that the disclosure in Geer of the application downloaded and executed on a smart phone meets the claim requirement of “a dedicated mobile device application.” Ex. 1002 ¶¶ 201–203. Dr. Valerdi does not dispute Dr. Porter’s testimony that Geer’s disclosure of a smart phone application satisfies limitation 20.7. Ex. 2091 ¶ 104. Based on the disclosure in paragraph 20 of Geer and Dr. Porter’s testimony, we find that Geer discloses “a dedicated mobile device application” as recited in limitation 20.7.

As discussed above in Ground 1, limitation 20.7 is the only limitation in claim 20 not disclosed by Roberts. Patent Owner does not address Petitioner’s reasons for combining Roberts and Geer nor does it address Petitioner’s contentions that a skilled artisan would have had a reasonable expectation of success in combining the teachings of Roberts and Geer. PO Resp. 53; Sur-Reply 25. We find that Petitioner’s contentions in this regard are reasonable and supported by a rational underpinning.

For all the foregoing reasons, we determine that Petitioner establishes by a preponderance of the evidence that claim 20 would have been obvious over the combined teachings of Roberts and Geer.

As discussed above in Ground 1, Roberts discloses the limitations of claim 22, but we find that Roberts does not anticipate claim 22 because it does not disclose “a dedicated mobile device application,” as required by claim 20. Because we now find that Geer cures this deficiency in Roberts, we determine that Petitioner establishes by a preponderance of the evidence that claim 22 would have been obvious over the combined teachings of Roberts and Geer.

As discussed above in Ground 1, we find that Roberts does not anticipate claim 24 for the same reasons that Roberts does not anticipate claim 13. The additional evidence cited from Geer for claim 24 in this ground does not cure the deficiencies in Roberts’s disclosure discussed for claims 13 and 24 in Ground 1. For these reasons, we determine that Petitioner does not establish by a preponderance of the evidence that claim 24 would have been obvious over the combined teachings of Roberts and Geer.

III. PETITIONER’S MOTION TO EXCLUDE

Petitioner filed a Motion to Exclude Patent Owner’s Exhibits 2089 and 2090 (“the Motion”). Paper 31, 1. Patent Owner opposed the Motion. Paper 32.

Exhibits 2089 and 2090 are declarations of Narbeh Avedissian and Nikhil Sreenath, the co-inventors of the ’063 patent. Ex. 1001, code (72); Ex. 2091; Ex. 2092. Patent Owner submitted the declarations in support of its attempt to “swear behind Roberts and Geer with evidence showing conception before June 4, 2009 . . . constructive reduction of practice on April 18, 2012 . . . and diligence during the critical period from before June 4, 2009 to April 18, 2012.” PO Resp. 10.

As discussed above, even considering Exhibits 2089 and 2090 in our analysis, we determine that Patent Owner did not provide sufficient independent corroborating evidence of conception. Consequently, we dismiss Petitioner's Motion to Exclude Exhibits 2089 and 2090 as moot.

IV. CONCLUSION

Weighing the evidence of the disclosure of the references, the competing testimony, and the reasons to combine the references, we determine that Petitioner has shown that claims 1, 9, 10, 11, 18, 19, 20, 22, 26, and 27 of the '063 patent are unpatentable but has not shown that claims 13 and 24 are unpatentable.

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
9, 13, 18– 20, 22, 24, 26, 27	102	Roberts	9, 18, 19, 26, 27	13, 20, 22, 24
1, 10	103	Roberts, Kraus	1, 10	
11	103	Roberts, Miller	11	
9, 13, 19, 20, 24, 26	102	Geer		9, 13, 19, 20, 24, 26
1, 10	103	Geer, Kraus		1, 10
11	103	Geer, Miller		11
18, 22, 27	103	Geer, Fink		18, 22, 27
20, 22, 24	103	Roberts, Geer	20, 22	24
Overall Outcome			1, 9, 10, 11, 18, 19, 20, 22, 26, 27	13, 24

I. ORDER

Accordingly, it is:

ORDERED that claims 1, 9, 10, 11, 18, 19, 20, 22, 26, and 27 of the '063 patent have been shown to be unpatentable;

FURTHER ORDERED that claims 13 and 24 of the '063 patent have not been shown to be unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude (Paper 31) is dismissed as moot; and

FURTHER ORDERED that any party seeking judicial review must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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