

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MG FREESITES LTD,
Petitioner,

v.

SCORPCAST, LLC,
Patent Owner.

IPR2021-00512
Patent 9,703,463 B2

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

PESLAK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No 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, 5–8, 10, 11, 15–17, 20, 21, and 25–28 (the “challenged claims”) of U.S. Patent No. 9,703,463 B2 (Ex. 1001, “the ‘463 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.

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. 2091), a Declaration of Nikhil Sreenath (Ex. 2092), and a Declaration of Ricardo Valerdi, Ph.D. (Ex. 2088). 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 (“Mot.”). Patent Owner filed an opposition to the Motion to Exclude. Paper 22. 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 ‘463 patent. For the reasons discussed below, we determine Petitioner fails to establish by a preponderance of the evidence that any of the challenged claims are unpatentable. We also dismiss Petitioner’s Motion to Exclude as moot.

A. Related Matters

The parties state that the '463 patent is asserted in *Scorpcast, LLC dba HaulStars v. MG Freesites Ltd*, Case No. 6-20-cv-00877 (W.D. Tex.). Pet. xxi; Paper 3, 2. The District Judge transferred this case to the District of Delaware on June 22, 2021. Ex. 1032, 6; 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 including *Scorpcast, LLC d/b/a HaulStars v. Boutique Media PTY, Ltd.*, Case No. 2:20-cv-00193 (E.D. Tex.). Paper 3, 1–4.

B. Real Parties-in-Interest

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

C. The '463 Patent (Ex. 1001)

The '463 patent is titled “System and Methods for Providing User Generated Video Reviews.” Ex. 1001, code (54). The '463 patent issued on July 11, 2017, from an application filed on December 11, 2014. *Id.* at codes (45), (22).

The '463 patent “relates to content sharing, and more specifically, to providing user generated or produced video reviews of products and/or services.” *Id.* at 1:21–23. 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 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 2:29–32. 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 2:36–39.

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 2:48–53. “[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 2:54–58. Tags “associated with the reviewed item may be received from the users” and “may be descriptive of the reviewed item.” *Id.* at 2:65–3:1. “One or more . . . tags may be associated with the start of an item review.” *Id.* at 3:3–5.

Figure 10 from the ’463 patent is reproduced below:

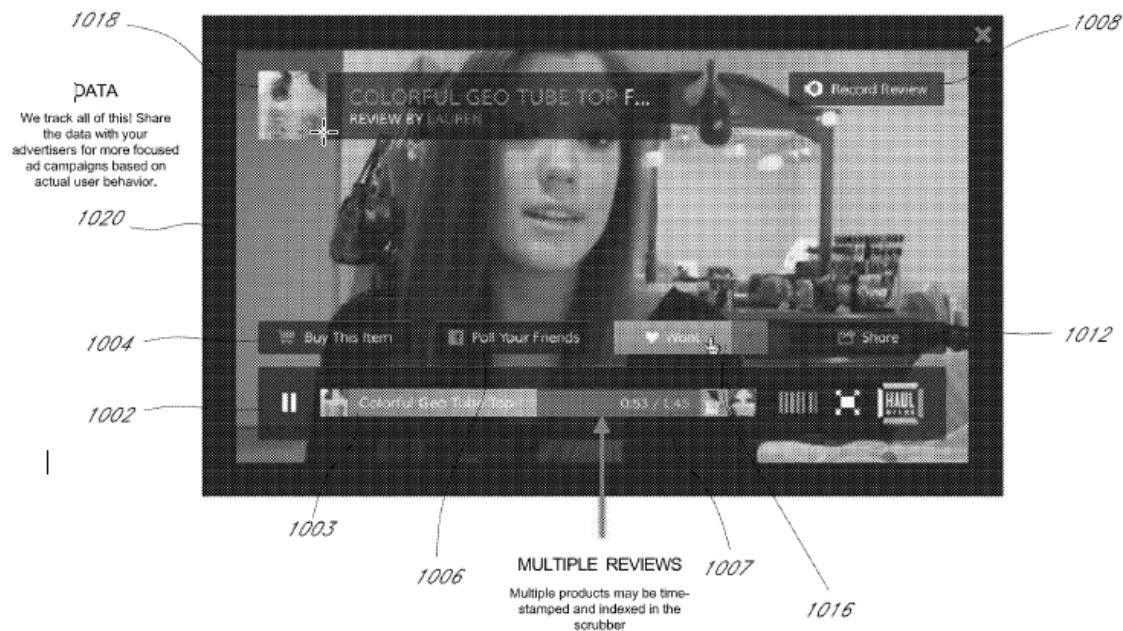


FIG. 10

Figure 10 is “an example user interface application for publishing a user generated video review. *Id.* at 13:60–61. “[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 32:31–36. 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 32:40–48. An image or a tag 1003 associated with the item being reviewed and tags 1016 of other items may be displayed in scrubber area 1002. *Id.* at 33:16–21. 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 33:21–24.

D. *Challenged Claims*

Claims 1, 11, and 21 are independent. Claim 1 is illustrative and reproduced below:

1. A non-transitory computer readable medium storing executable instructions that when executed by a system including at least one computing device cause the system to perform operations, comprising:

accessing, over a network from remote video data store, a first video file, the same first video file comprising at least a first plurality of segments;

receiving, over the network, a first plurality of images, wherein a given image in the first plurality of images is associated with a respective segment in the first plurality of segments of the same first video file and comprises an image of a product that corresponds to a product displayed in the respective segment of the same first video file, the first plurality of images comprising a first image that is not an image from the first video file;

causing the first plurality of images to be displayed at the same time in association with a playback of the first video file, for at least a portion of the time the first video file is being played back in a playback area:

causing the first plurality of images to be displayed at the same time in association with a playback of the first video file, for at least a portion of the time the first video file is being played back in a playback area;

causing the first plurality of images associated with respective segments in the same first video file to be displayed in a scrubber area displayed in association with the playback of the first video file, the scrubber area comprising a scrubber that indicates video playback progress via a scrubber timeline during a time period in which the first video file is being played, and which is manipulable to control playback of the first video file by dragging the scrubber control to a desired position;

at least partly in response to detecting that a user has selected the first image in the first plurality of images associated with respective segments in the same first video file and displayed at the same time in the scrubber area, the first image displayed on or adjacent to the scrubber that includes the draggable scrubber control that indicates video playback progress via a scrubber timeline, wherein the first image is not from the first video file, causing the playback of the first video file to jump to a segment of the first video file corresponding to the first image, the segment of the first video file corresponding to the first image and displaying the first product.

Id. at 50:38–51:14.

E. Prior Art and Asserted Grounds¹

Petitioner asserts that claims 1, 5–8, 10, 11, 15–17, 20, 21, and 25–28 are anticipated or would have been unpatentable for obviousness on the following grounds (Pet. 1–2):

Claim(s) Challenged	35 U.S.C.² §	Reference(s)/Basis
1, 5, 6, 10, 11, 15, 16, 20, 21, 25–27	103	Roberts ³ , Sterner ⁴
8	103	Roberts, Sterner, Miller ⁵
1, 5–7, 10, 11, 15–17, 20, 21, 25–28	102	Geer ⁶
8	103	Geer, Miller
7, 17, 28	103	Roberts, Sterner, Geer

II. ANALYSIS

A. Overview

A petition must show how the construed claims are unpatentable under the statutory grounds it identifies. 37 C.F.R. §42.104(b)(4).

¹ Patent Owner attempts to swear behind Roberts and Geer to disqualify each reference as prior art. PO Resp. 10–19. Because we determine that Petitioner has not met its burden to show that the challenged claims are anticipated or obvious based on the asserted grounds of unpatentability, we need not reach this issue.

² 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.

³ U.S. Publication No. 2011/0138326 A1, pub. June 9, 2011 (Ex. 1004) (“Roberts”).

⁴ U.S. Publication No. 2007/0263984 A1, pub. Nov. 15, 2007 (Ex. 1008) (“Sterner”).

⁵ Michael Miller, YouTube® For Business, 2d ed., Que, 2011 (Ex. 1010) (“Miller”).

⁶ U.S. Publication No. 2011/0112915 A1, pub. May 12, 2011 (Ex. 1005) (“Geer”).

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). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

The record contains no evidence of objective indicia of non-obviousness.

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

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. 16–17 (citing Ex. 1002 ¶¶ 1–28). Patent Owner does not dispute Petitioner’s level of ordinary skill in the art. *See* PO Resp. 9.

We apply Petitioner’s proposed level of ordinary skill in the art because it comports with the level of skill reflected in the ‘463 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 ‘463 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 submits that all claim terms should be construed using their plain and ordinary meanings. Pet. 16. Patent Owner provides a district court decision construing six claim terms. PO Resp. 110 (citing Ex. 2029). We address the district court’s construction of the claim term “scrubber area” in our discussion of Ground 1 below.

Upon review of the parties’ arguments and based on the evidentiary record, we determine that no other 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. Ground 1: Alleged Obviousness over Roberts and Sterner

Petitioner contends that claims 1, 5, 6, 10, 11, 15, 16, 20, 21 and 25–27 are unpatentable over Roberts and Sterner. Pet. 28–60. In support thereof, Petitioner identifies the disclosures in Roberts and Sterner alleged to describe the subject matter in the challenged claims. *Id.* Petitioner also provides reasons for combining the teachings of Roberts and Sterner and contends that a skilled artisan would have had a reasonable expectation of success in doing so. *Id.* at 29–31. Additionally, Petitioner offers declaration testimony from Dr. Porter in support of the Petition. Ex. 1002 ¶¶ 53–139.

Patent Owner disputes Petitioner’s contentions. PO Resp. 20–44. Patent Owner offers declaration testimony from Dr. Valerdi in support of the Patent Owner Response. Ex. 2093 ¶¶ 55–83.

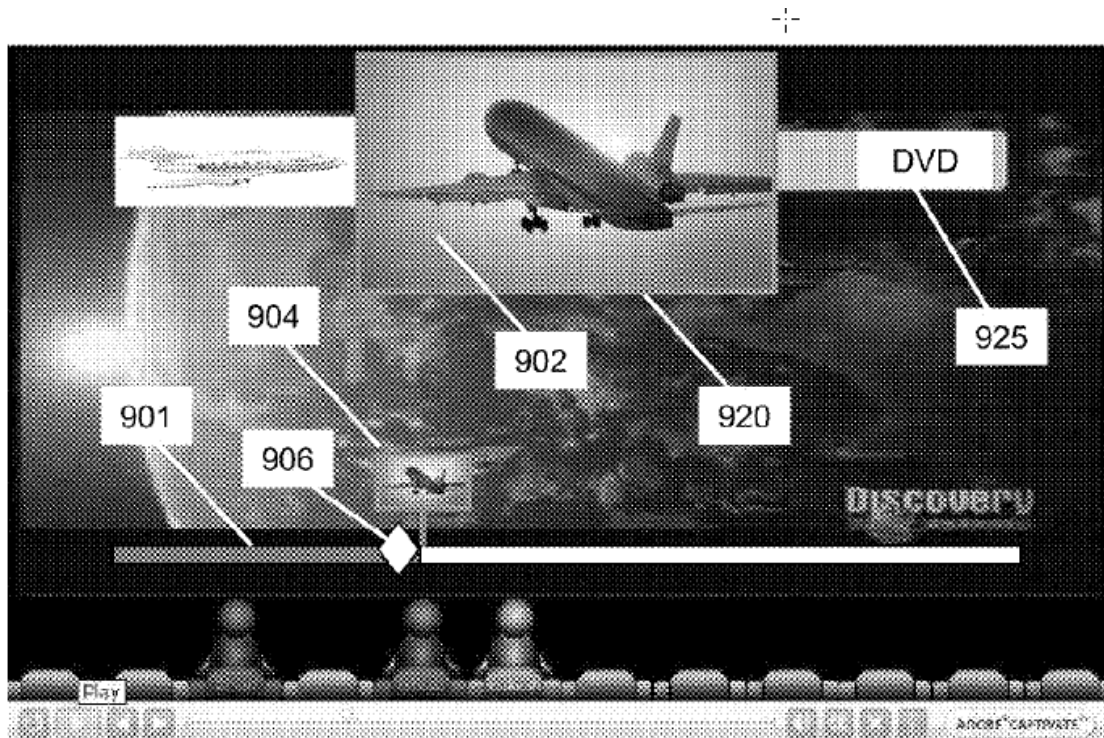
We begin our analysis with a brief overview of Roberts and Sterner. We then address the parties’ respective contentions with respect to the challenged claims.

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 on 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 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.*

Sterner – Ex. 1008

Sterner is directed “to online video; and more particularly to methods and systems for handling online video for [real] property commerce over the Internet.” Ex. 1008 ¶ 2. Sterner explains that “a consumer would like to find a house with a large kitchen,” but it would be “difficult to really experience that size and utility of the kitchen from . . . photos.” *Id.* ¶ 10. “On the other hand, video of the kitchen may provide a better representation of the space, but may be difficult to find within the footage of the entire house.” *Id.*

Sterner discloses using “cue points” that may “refer to multiple time positions within a video file” or “indexed locations or tags within a file.” *Id.* ¶¶ 61–62.

Figure 6 of Sterner is reproduced below:

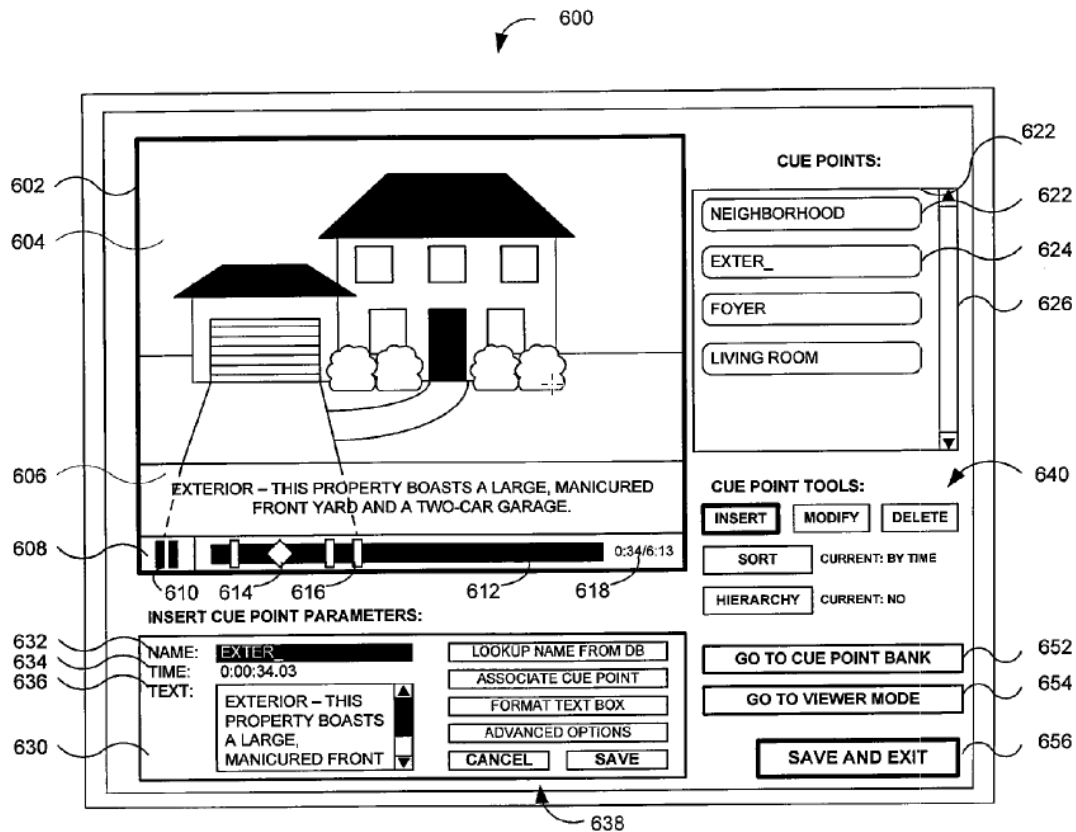


Fig. 6

Figure 6 is “an exemplary screen shot of an embodiment of” Sterner’s video editing environment. *Id.* ¶ 36. Figure 6 illustrates cue point video editor screen 600 with video frame 602. *Id.* ¶ 167. Figure 6 comprises navigation area 608 with video progress bar 612. *Id.* ¶ 170. Video progress bar 612 “may also show various cue point location indicators 616.” *Id.*

Claim 1

Preamble: A non-transitory computer-readable medium storing executable instructions that when executed by a system including at least one computing device cause the system to perform operations comprising:

Petitioner contends Roberts discloses a system with “components performing operations based on execution of instructions or programmatic code (e.g. software) stored in non-transitory memory.” Pet. 31 (citing Ex. 1004 ¶¶ 14, 29, 37–43, 80, 85, Figs. 1, 2, 4, 5, 15). Petitioner further contends Roberts’ system includes various computing devices, “e.g., media processors 106, media devices 108/135/502/512, server(s) 130/506, computing device 508, communication device 510, and remote media server(s) 550.” *Id.* at 31–32 (citing Ex. 1004 ¶¶ 43, 44, Fig. 5).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 19–38. Neither party addresses whether the preamble is limiting.

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

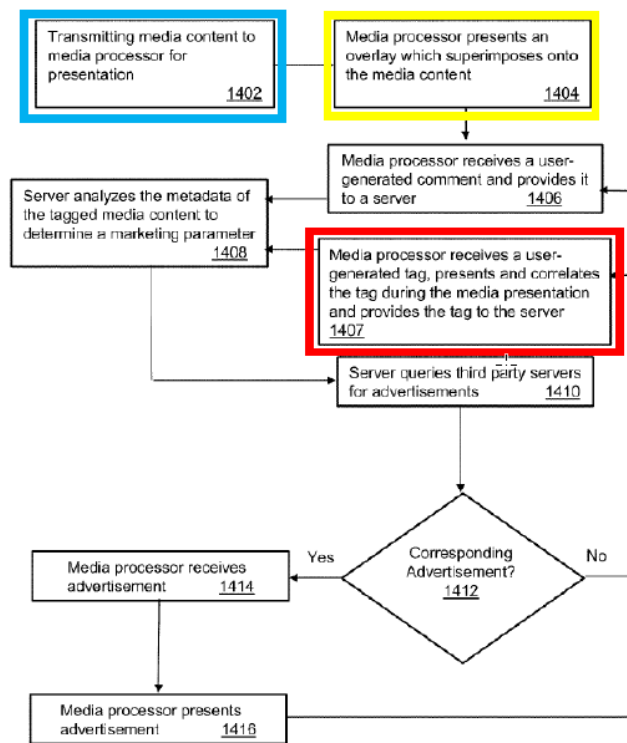
[1.1]⁷ accessing, over a network from remote video data store, a first video file, the same first video file comprising at least a first plurality of segments;

Petitioner contends that “Roberts describes the system accessing, over a network using the network interface, a video file (e.g., video-on-demand file) from a remote video data store (e.g., server).” Pet. 32 (citing Ex. 1004 ¶¶ 14, 16, 17–19, 21–22, 25, 65). Petitioner further contends that the video data store is remote because it “is connected to a recipient media device via ISP network 132.” *Id.* (citing Ex. 1004 ¶¶ 17–18, 25, 43–45, Figs. 1, 3–5).

⁷ We use Petitioner’s claim annotations for ease of reference.

Petitioner further contends that “Roberts describes the video file comprising at least a first plurality of segments, *e.g.*, based on periods of time corresponding to tags.” *Id.* at 33 (Ex. 1002 ¶¶ 62–64; Ex. 1004 ¶¶ 49, 53, 56, 57, 59, 60, Figs. 5, 9–10).

Patent Owner counters that this limitation requires “the first video file, as it is found in the video data store, must have a plurality of segments when it is accessed.” PO Resp. 20 (citing Ex. 2093 ¶ 51). Patent Owner contends that Roberts’ “tags and/or advertisement icons **are not** part of the video file but are added **after** the video file is accessed.” *Id.* According to Patent Owner, Roberts’ “tags are received from a user and are associated with the media file, **after the video file is received by the user.**” *Id.* at 21 (citing Ex. 1004 ¶ 52). To support this contention, Patent Owner provides the following annotated version of Roberts’ Figure 14:



1400
FIG. 14

Id. at 22. This image shows Roberts’ Figure 14, which is a process flow diagram of “an illustrative embodiment” of Roberts’ method with blue, yellow, and red outlines added by Patent Owner around boxes labelled as steps 1402, 1404, and 1407, respectively. Ex. 1004 ¶ 9.

Patent Owner contends that accessed media content is transmitted to a processor in step 1402 (outlined in blue) and then, in step 1404 (outlined in yellow), Roberts “superimposes an overlay onto the media content.” PO Resp. 22 (citing Ex. 1004 ¶¶ 67–68, Fig. 14). Patent Owner contends that “[i]t is only after the overlay is superimposed that tags may be added to the timeline. No such tags exist before and are not segments of the video content that is accessed.” *Id.* (citing Ex. 2093 ¶¶ 53–54). According to Patent Owner, Roberts’ “media processor receives the user-generated tags and provides them to a server—step 1407 (boxed in red above)” and, “[g]iven the tags are **user-generated**, they cannot be segments of the video content being accessed.” *Id.* at 22–23 (citing Ex. 1004 ¶¶ 68–69, Fig. 14).

Petitioner, in turn, contends “Roberts explicitly discloses ‘video-on-demand’ along with different users viewing the same video and advertisements. When the video is shown ‘on-demand,’ it includes segments, as the displayed advertisements are generated in response to existing user-generated tags.” Pet. Reply 14–15 (citing Ex. 1004 ¶¶ 16, 62, 63, 68). According to Petitioner, “when a first user adds tags to a video and advertisements are associated with these user tags, the video is segmented by the time a second user accesses the video for playback with the same advertisements.” *Id.* at 15.

In the Sur-reply, Patent Owner contends that this limitation requires “the video file, as found in the video store initially, must already contain a plurality of segments.” Sur-reply 12 (citing Ex. 2093 ¶ 51). Patent Owner

further contends because Roberts’ “‘on-demand’ videos only show segments ‘generated in response to a single user tagging the media timeline’ . . . the tags and/or advertisement icons are not part of the video file but are added after the video file is accessed by users and images become associated.” *Id.* (citing Ex. 2093 ¶ 52).

Analysis

There is no dispute that this claim limitation requires that the recited “first plurality of segments” must be present when the first video file is accessed from the remote video data store. Patent Owner directs us to Petitioner’s claim construction brief in the District Court, where Petitioner took the position that the “video that is accessed or received was already divided into segments by a user *before* the system accesses or receives it.” PO Resp. 20–21 (citing Ex. 2009, 4–5). Petitioner doesn’t dispute this reading of the claim but argues that Roberts’ video-on-demand disclosures satisfy this limitation because, after tags are added by the first user in Roberts, later users can download the video with tags added by the first user. Pet. Reply 14–15.

Patent Owner argues that subsequent downloads do not satisfy this limitation because allegedly the claim requires that the tags be present when the first user downloads the video. *See* Sur-reply 12 (arguing “the video files, as found in the video data store *initially*, must already contain a plurality of segments”) (emphasis added). The language of claim 1, however, does not require that the video files “initially” contain a plurality of segments. Ex. 1001, 50:42–44. Patent Owner relies on Dr. Valerdi’s testimony, which provides “the video file, as it is found in the video data store, must have a plurality of segments when it is accessed.” Ex. 2093 ¶ 51. This testimony does not support reading “initially” into this claim limitation.

Based on our review of the evidence cited by Petitioner and after considering Patent Owner's contentions, we find that Roberts discloses this claim limitation for downloads of videos after the first user has added tags to the video.

[1.2] receiving, over the network, a first plurality of images, wherein a given image in the first plurality of images is associated with a respective segment in the first plurality of segments of the same first video file and comprises an image of a product that corresponds to a product displayed in the respective segment of the same first video file, the first plurality of images comprising a first image that is not an image from the first video file;

Petitioner contends Roberts discloses “the system receiving a first plurality of images (*e.g.*, tags or advertisement images)” that “are received over the network using a network interface.” Pet. 33–34 (citing Ex. 1004 ¶¶ 23, 25, 52, 53, 58–60, 71, Figs. 5, 9, 10, 14). Petitioner further contends that “[a] given image (*e.g.*, particular video tag or advertisement) in the first plurality of images is associated with a respective segment (*e.g.*, particular portion or time period of the media content) in the first plurality of segments of the same first video file.” *Id.* at 34 (citing Ex. 1004 ¶¶ 49, 53, 56, 57, 60, 69, Figs. 5, 9, 10). Petitioner also contends “[t]he given image comprises an image of a product that corresponds to a product displayed in the respective segment of the same first video file.” *Id.* at 34–36 (citing Ex. 1004 ¶¶ 20, 45, 53, 55, 58–59). According to Petitioner, “[t]he tags/advertisements comprise a first image . . . that [is] not an image from the first video file, as the advertisements are separately obtained based on metadata associated with the tag.” *Id.* at 37 (citing Ex. 1002 ¶¶ 65–69; Ex. 1004 ¶¶ 58–60, 71, Figs. 5, 9, 10, 14).

Patent Owner counters that Roberts’ “tags are merely markers” not “an image or include images.” PO Resp. 24–25 (citing Ex. 1004 ¶ 24, Figs. 6–8); Sur-reply 13. According to Patent Owner, the tags shown in Roberts’ Figures 6–8 are diamonds 604, 704, and 804, and “[t]here can be no credible argument that the diamonds are ‘an image of a product.’” Pet. 26 (citing Ex. 2093 ¶ 56).

Patent Owner next contends that Roberts’ “advertisement icons” do not satisfy this limitation because “Roberts expressly states that the advertisement icon is for a generic advertisement or an advertisement from a separate advertisement GUI.” PO Resp. 26 (citing Ex. 1004 ¶ 60; Ex. 2093 ¶ 57); Sur-reply 13. Patent Owner also repeats its contention for limitation 1.1. that “because the video content of Roberts has no associated video segments, neither the tags nor the advertisement icons can be ‘associated with a respective segment in the first plurality of segments.’” *Id.* at 27.

Petitioner responds “that in Roberts, portions of media content are tagged, and ‘[d]uring media content playback, additional content corresponding to the tag is displayed based on the correlated time, superimposed onto the media content.’” Pet. Reply 16 (citing Pet. 18; Ex. 1004 ¶¶ 12, 49–66, Figs. 6–13). Petitioner contends “that ‘advertisement images [are] associated with the tags, whereby the media content playback includes displaying the advertisement images associated with the tag.’” *Id.* (citing Ex. 1004 ¶¶ 45, 46, 58–63, Figs. 9–13). Petitioner further contends that Patent Owner ignores specific examples from Roberts showing that tags constitute advertisement images. *Id.* at 17 (citing Ex. 1004 ¶¶ 20, 45, 53, 55).

Analysis

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.” Ex. 1004 ¶ 60. This disclosed correspondence satisfies the requirement that “a given image . . . is associated with a respective segment . . . of the same first video file.” Ex. 1001, 50:46–48. Although certain tags in Roberts such as item 604 in Figure 6 are not images, Roberts discloses an alternative embodiment in which tags 604 and 704 can constitute video tags. Ex. 1004 ¶ 58; *see also id.* ¶ 20 (describing video tags).

For the reasons discussed above in connection with limitation 1.1, we do not agree with Patent Owner’s contentions that Roberts does not disclose segments of the video. Further, we do not agree with Patent Owner’s argument that advertisement icons are from generic advertisements in light of the disclosure in Roberts that the tags can be “product tags” indicating the tags represent the product in the video as well as the disclosure that the icons can be based on the advertisements presented in GUI 902. Ex. 1004 ¶¶ 20, 60; *see also* Ex. 1002 ¶ 68 (Dr. Porter explaining product tags as disclosed in paragraph 20 of Roberts).

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

[1.3] causing the first plurality of images to be displayed at the same time in association with a playback of the first video file, for at least a portion of the time the first video file is being played back in a playback area, and

Petitioner contends Roberts’ “system caus[es] the first and second images to be displayed on a first user device (*e.g.*, media device 502 connected to display device 504).” Pet. 37. Petitioner further contends Roberts’ “server ‘relay[s] and/or store[s] the actual media content, tags and/or the user-generated comments associated with the media content.’” *Id.* (citing Ex. 1004 ¶ 25). Petitioner further contends Roberts’ server “can include or have access to a client program, which can be configured to present an overlay having a timeline . . . superimposed onto media content that is displayed and/or received at the devices in the system 500.” *Id.* (citing Ex. 1004 ¶ 43).

Petitioner further contends Roberts discloses two different ways by which “the first and second images” are displayed, as required by this claim limitation. Pet. 38. The first way is Roberts’ GUI Carousel (*id.* at 38–40) and the second is the Advertisement Icons Display (*id.* at 40–44).

For the GUI Carousel, Petitioner first refers to Roberts’ Figure 9, which, according to Petitioner, “displays multiple advertisements at the same time during media content playback, thereby ‘allow[ing] for rotation through the various advertisements with one of the advertisements being shown more prominently as the GUI is rotated.’” Pet. 38 (citing Ex. 1004 ¶¶ 59–60); *see also id.* at 39 (providing annotated version of Roberts’ Figure 9). Petitioner also refers to Roberts’ Figure 10, which, according to Petitioner, illustrates “multiple advertisements are displayed based on meta data associated with the tags 1006 and 1008.” *Id.* at 39 (citing Ex. 1004 ¶ 61); *see also id.* at 40 (providing annotated version of Roberts’ Figure 10).

For the Advertisement Icons Display, Petitioner contends Roberts’ Figure 9 “illustrates . . . a displayed timeline 901 and an 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 view the advertisement” and “[t]he advertisement icon 904 ‘can be based on one of the advertisements that were presented in the GUI 902.’” Pet. 41 (citing Ex. 1004 ¶¶ 19, 60); *see also id.* at 42 (providing an annotated version of Roberts’ Figure 9). Petitioner further contends “Roberts also describes various approaches to display the advertisement icons, including displaying the advertisement icon for *each* of the advertisements.” *Id.* at 42 (citing Ex. 1004 ¶ 62); *see also id.* at 43 (providing annotated version of Roberts’ Figure 13).

Patent Owner contends this limitation “requires the same ‘plurality of images’ from claim element [1.2] to be displayed at the same time” but for this limitation, “Petitioner now points to an entirely different set of images than the images Petitioner pointed to . . . for claim element [1.2].” PO Resp. 27.

For the GUI carousel, Patent Owner contends Petitioner cited to tags 906, 1006, and 1008, and alternatively advertisement icons 904 and 1004, as possible sets of images for the recited plurality of images. PO Resp. 29–30 (citing Pet. 37–38). Patent Owner further contends that for this claim element, Petitioner relies on Advertisement Images in Figure 9 and 10. *Id.* (citing Ex. 2093 ¶ 59). Based on this, Patent Owner contends Petitioner fails to show how “the first plurality of images [are] displayed at the same time.” *Id.* at 30.

For the Advertisement Icons Display, Patent Owner contends Roberts’ Figure 13 “show two advertisement icons being displayed at the same point in time on the time bar—or what Petitioner refers to as a segment of the video file.” PO Resp. 30. Patent Owner further contends this limitation requires “each image in the plurality of images must be displayed at their

respective segments at the same time. Roberts does not disclose the displaying of advertisement icons for different segments, as the Petitioner has defined segments, at the same time,” but rather Roberts Figure 13 “shows the display of two icons for the same exact segment.” *Id.* (citing Ex. 2093 ¶ 61).

Petitioner responds that the Petition “explains that the claimed plurality of images corresponds to ‘advertisement images’ that are displayed in multiple ways, including (i) with the carousel GUI and/or (ii) as advertisement icons.” Pet. Reply 19 (citing (Pet. 38–39, 18–21).

For the Advertisement Display Icons, Petitioner contends Patent Owner “seeks to limit Roberts’ Fig. 13 to its specific example where two tags are coincidentally associated to apparently the same video segment, rather than the broader teaching to be drawn from this figure.” *Id.* at 20. Petitioner further contends “Roberts’ specification does not mention that the two tags in Fig. 13 correspond to the same video segment, instead generically referring to displaying advertisement icons for each advertisement.” *Id.* (citing Ex. 1004 ¶ 62). Petitioner further contends “[a]t a minimum, Fig. 13 broadly teaches concurrently displaying all advertisement icons corresponding to tags, *even where* multiple tags are associated with the same video segment.” *Id.*

In the Sur-reply, Patent Owner contends “Roberts shows in Fig. 13 multiple advertisement images overlaying a single segment.” Sur-reply 15 (citing Ex. 1004 ¶ 73; Fig. 13). According to Patent Owner, “Roberts does not affirmatively disclose that the icons may correspond to separate segments.” *Id.* (citing Ex. 2093 ¶ 61).

Analysis

Patent Owner's contentions concerning Roberts' Figure 13 are based on its assertion that this claim limitation requires each image to be displayed at their respective segment at the same time. Claim limitation 1.2 requires that "a given image in the first plurality of images is associated with a respective segment . . . of the same first video file." Ex. 1001, 50:46–48. Limitation 1.2 does not require that each of the first plurality of images is associated with a respective segment of the first video file. Nor does the language of limitation 1.3 require that each of the images be displayed at its respective segment. *Id.* at 50:54–56. However, even if the claim requires each image to be associated with its respective segment, limitation 1.3 only requires that each image be displayed in association with a playback of the first video file. Consequently, the fact that Roberts' Figure 13 overlays multiple advertisements on a single segment of the video is of little import. Rather, because it shows multiple advertisement icons "at the same time in association with a playback of the first video," Figure 13 satisfies limitation 1.3. Because we find that the Advertisement Icon Display satisfies this claim limitation, we do not reach the question of whether the GUI Display meets also meets this limitation.

[1.4] causing the first plurality of images associated with respective segments in the same first video file to be displayed in a scrubber area displayed in association with the playback of the first video file, the scrubber area comprising a scrubber that includes a draggable scrubber control that indicates video playback progress via scrubber timeline during a time period in which the first video file is being played and which is manipulable to control playback of the first video file by dragging the scrubber control to a desired position;

Petitioner contends Roberts discloses its “system causing the first plurality of images being displayed in a scrubber area (*e.g.*, area adjacent to the displayed timeline) . . . in association with the playback of the first video file.” Pet. 45. In support of this contention, Petitioner provides the following annotated versions of Roberts’ Figures 9 and 13 (*id.* at 46–47):

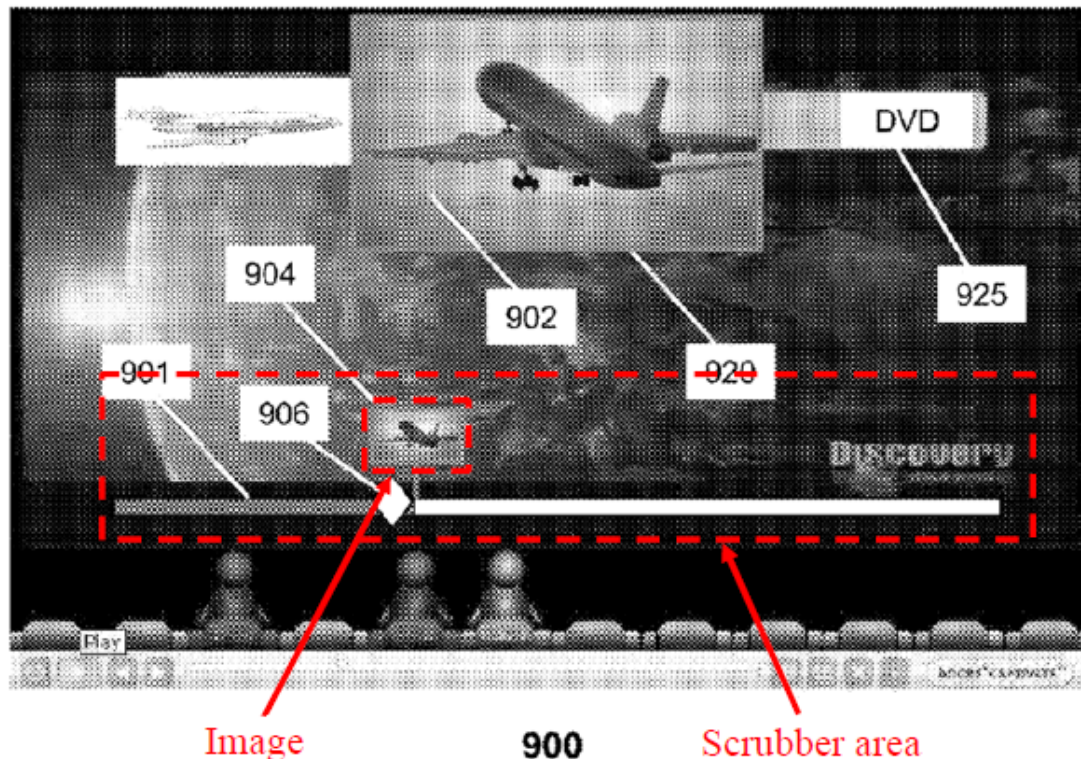
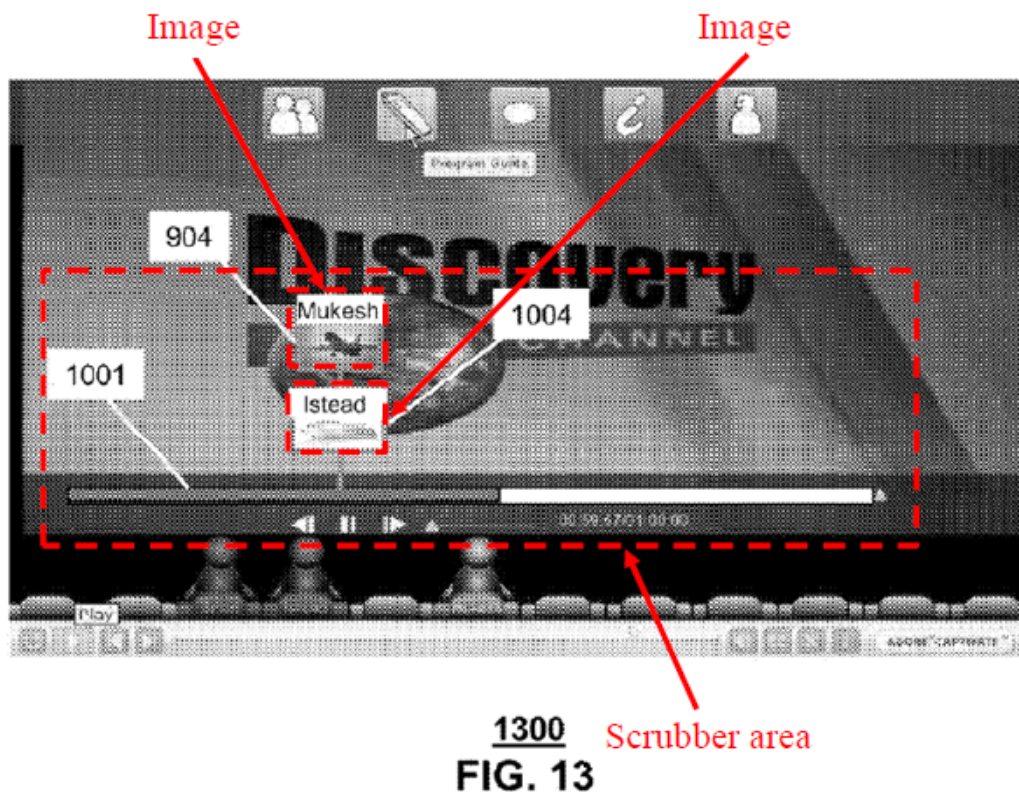


FIG. 9

Roberts Figure 9 is a screenshot showing “advertisement icon 904 . . . along timeline 901”). Ex. 1004 ¶ 60, Fig. 9. Petitioner adds a red-dotted rectangle around timeline 901 and image 904 along with an annotation that this rectangle represents a “Scrubber area” and a second annotation “Image” pointing to advertisement icon 904 within the rectangle. Pet. 46.



Roberts Figure 13 is a screenshot showing “timeline 1001” and “advertisement icon 1004.” Ex. 1004, ¶ 60, Fig. 9. Petitioner adds a red-dotted rectangle around timeline 1001 and images 904 and 1004 along with an annotation that this rectangle represents a “Scrubber Area” and two annotations “Image” pointing to advertisement icons 904 and 1004 within the rectangle. Pet. 47.

Petitioner alternately relies on Sterner for disclosing a scrubber area. Pet. 49–51. Petitioner contend Sterner discloses “a scrubber (*e.g.*, video progress bar 1112/1196) with a scrubber control (*e.g.*, playback progress indicator 1114/1194) . . . the scrubber being manipulable to control playback of a video file by dragging the scrubber control to a desired position.” *Id.* at 49 (citing Ex. 1008 ¶¶ 221, 223, 234, 235). Petitioner provides the

following annotated versions of Sterner's Figures 11A and 11C (*id.* at 50–51):

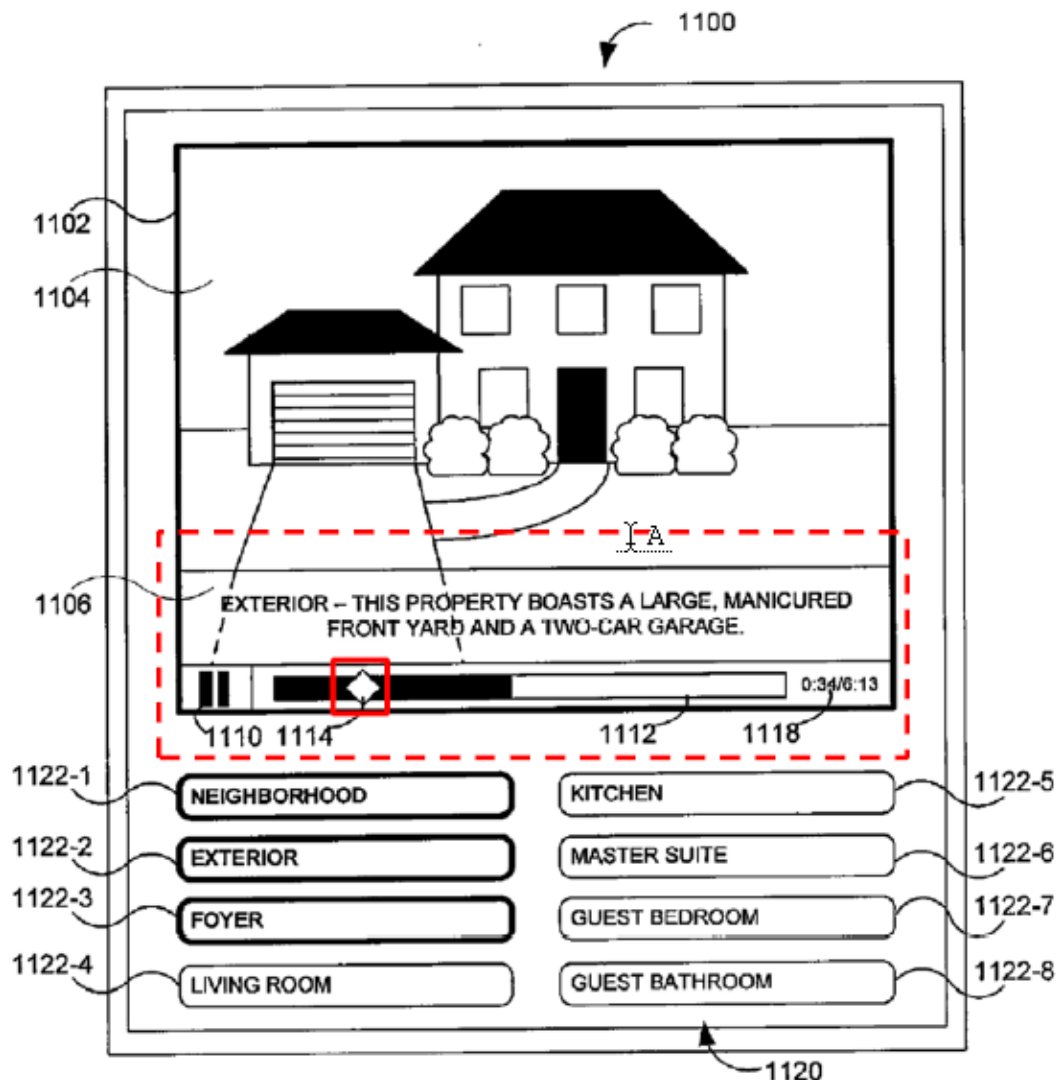


Fig. 11A

Figure 11A of Sterner is an exemplary screen shot of an embodiment. Ex. 1010 ¶ 42. Petitioner annotates Figure 11A with hatched lines representing its proposed scrubber area with a scrubber control annotated with a solid line. Pet. 50. In Petitioner's annotated Figure 11A, video progress bar 1112, which includes playback progress indicator 1114, is included in Petitioner's

proposed scrubber area along. Ex. 1010 ¶ 221. In addition, Petitioner includes comment area 1006 and a portion of video footage area 1004 within its proposed scrubber area. *Id.* ¶ 220.

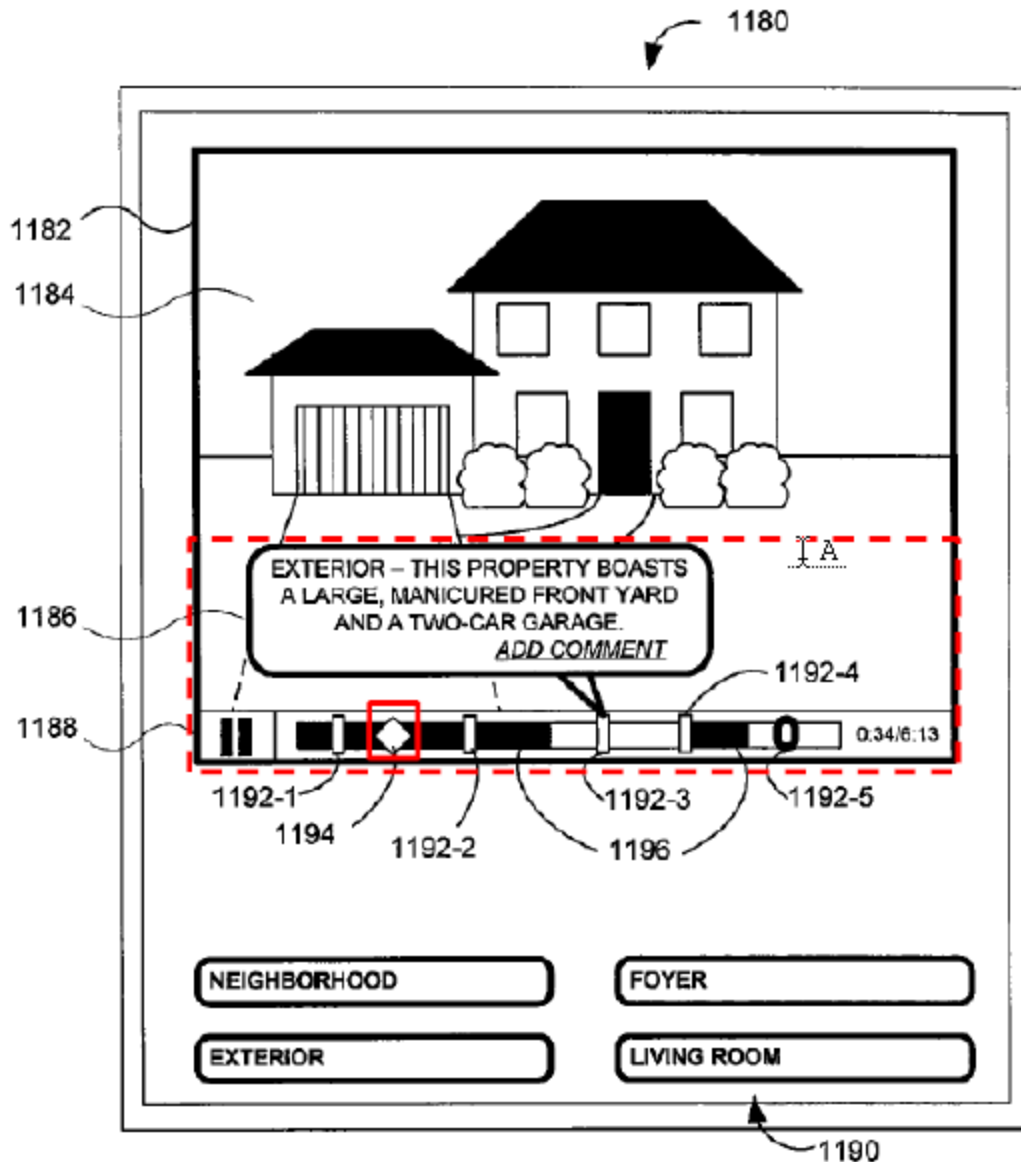


Fig. 11C

Figure 11C of Sterner is an exemplary screen shot of an embodiment. Ex. 1010 ¶ 42. Petitioner annotates Figure 11C with hatched lines representing a

scrubber area with a scrubber control annotated with a solid line. Pet. 51. In Petitioner’s annotated Figure 11C, navigation area 1188 and comment area 1186 are included in Petitioner’s proposed scrubber area. Ex. 1010 ¶ 230.

Patent Owner contends a district court⁸ in *Scorpcast, LLC d/b/a HaulStars v. Boutique Media PTY, Ltd.*, Case No. 2:20-cv-00193 (E.D. Tex.). construed “scrubber area” to “include areas adjacent to a scrubber but only if such areas enable a user to move to desired locations in a video.” PO Resp. 32–33 (citing Ex. 2090).⁹ According to Patent Owner, the EDTX construction means “that ‘a scrubber area’ is not simply a scrubber bar (or other tool) and any adjacent area” but “[r]ather that adjacent area is also a scrubbing area that enables the user to select a particular time of frame for playback that allows a user to ‘move to desired locations in the video without dragging the scrubber control.” *Id.* at 33–34 (citing Ex. 2090, 23–24).

Patent Owner next contends that Petitioner identified a “scrubber area” in its annotated figures from Roberts and Sterner that fails to satisfy this limitation. PO Resp. 34–39. For Roberts, Patent Owner contends that Petitioner’s annotated boxes in Figures 9 and 13 show different sizes for the alleged scrubber area. *Id.* at 36. Patent Owner contends Petitioner does this “in order to attempt to capture the other required claim elements.” *Id.* (citing Ex. 2093 ¶ 65). Patent Owner further contends “Petitioner’s imaginary boxes allegedly showing the ‘scrubber area’ . . . include areas that are not functional for selecting a particular point in a video.” *Id.* Patent Owner

⁸ In this case, Patent Owner sued a number of defendants for infringement of U.S. Patent 9,965,780 B2. Ex. 2090, 2. Petitioner was not a defendant in the case. *Id.* at 1.

⁹ We refer to this construction as the “EDTX construction.”

contends that the area in Figures 9 “with the background text ‘Discovery’ . . . is not functional for selecting a particular point in a video.” *Id.* Patent Owner makes a similar argument for Figure 13. *Id.*

For Sterner, Patent Owner contends the box representing the Petitioner’s proposed scrubbing area in Figure 11A “includes an area outside of the video player itself.” PO Resp. 38. For Figure 11C, Patent Owner contends Sterner teaches that comment area 1186 is actually disclosed by Sterner as being a different type of area than navigation area 1188. *Id.*

Petitioner counters that it was not a party to the district court action where “scrubber area” was construed. Pet. Reply 21. Petitioner contends that intrinsic evidence contradicts the construction upon which Patent Owner relies. *Id.* Petitioner further contends the ’463 patent “defines ‘scrubber area’ to include ‘an area adjacent to the scrubber bar’ or other scrubber control.” *Id.* at 21–22 (citing Ex. 1001, 2:48–54, 36:19–20). According to Petitioner, “the ’463 specification delineates ‘scrubber area’ as including both the scrubber bar/control and the area adjacent thereto, without attaching any functionality requirement.” *Id.* at 22. Petitioner provides the following annotated version of Figure 10 of the ’463 patent as originally filed (Pet. Reply 22):

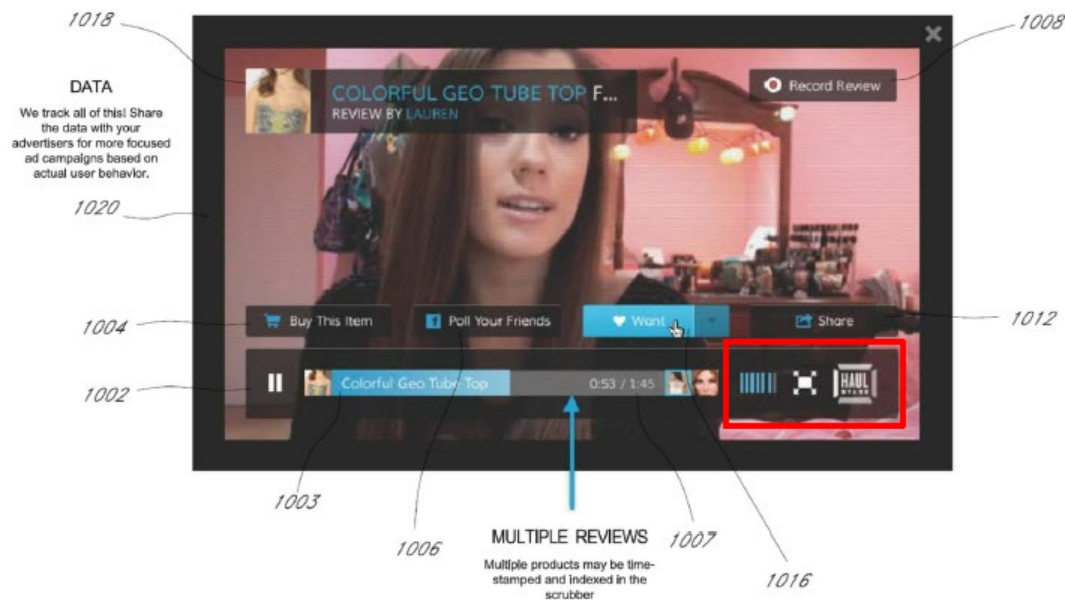


FIG. 10

Figure 10 “illustrates an example user interface application for publishing a user generated video review.” Ex. 1001, 13:60–61. Figure 10 shows a screen shot of a video with scrubber area 1002 running lengthwise near the bottom of the screen. *Id.* at 33:4–24, Fig. 10. Petitioner annotates Figure 10 with a red rectangle at the right end of scrubber area 1002 around controls for volume, maximizing the screen, and a corporate logo on the right-hand side of scrubber area 1002. Pet. Reply 22. The portion of scrubber area 1002 to the left of those controls is “a scrubber bar . . . that a user can utilize . . . by dragging a scrubber control in a scrubber timeline[] to indicate where the user wants the video playback to begin or to browse frames in the video.” Ex. 1001, 2:49–53. According to Petitioner, the controls on the right-hand side of scrubber area 1002 in the red rectangle have nothing to do with scrubbing functionality. Pet. Reply 22.

Analysis

We first address the construction of “scrubber area.” Subsequent to the briefing in this case, the Board issued its Final Written Decision in *MG Freesites LTD. v. SCORPCAST, LLC*, IPR2020-01697, Paper 38 (PTAB April 15, 2022) (“1697 FWD”). Both parties list IPR2020-01697 as a related matter in this proceeding. Paper 7, 2; Paper 8, 3.

Petitioner challenged U.S. Patent 9,965,780 B2 in IPR2020-01697. 1697 FWD, 2. In the 1697 FWD, the Board addressed the construction of “scrubber area” by considering the EDTX construction in light of the record developed by the parties in IPR2020-01697. 1697 FWD, 20–21. In particular, in light of the record, the Board did “not construe the plain and ordinary meaning of ‘scrubber area’ to require scrubbing functionality in the area adjacent to the scrubber area.” *Id.* at 19. The difference between the Board’s construction and the EDTX construction is whether the portion of the “scrubber area” adjacent to the scrubber control must provide scrubbing functionality.

We agree with the determination in IPR2020-01697 that not all areas in the recited “scrubber area” must perform scrubbing functionality for the following reasons. First, claim 1 recites “the scrubber area comprising a scrubber that includes a draggable scrubber control that indicates video playback progress via a scrubber timeline . . . and which is manipulable to control playback of the first video file by dragging the scrubber control.” Ex. 1001, 50:61–67. The use of the open-ended transition “comprising” indicates the scrubber area may include more than the draggable scrubber control. Second, the Specification of the ’463 patent describes “scrubber area” as including a “scrubber bar” and optionally “an area adjacent to the scrubber bar.” *Id.* at 2:48–54. But, the description of the optional area

adjacent to the scrubber bar in the '463 patent does not teach or suggest that the adjacent area must include scrubbing functionality. *See id.* Third, our determination that the area adjacent the scrubber control does not necessarily include scrubbing functionality is consistent with Figure 10 of the '463 patent where the right-hand side of scrubber area 1002 includes items unrelated to scrubbing functionality, *e.g.*, volume control.¹⁰ For the foregoing reasons, we do not adopt the EDTX construction of scrubber area because doing so would require us to read a limitation into “scrubber area” that, in our view, is not supported by the evidence.

Based on this determination, the dispositive issue in this case is whether the “first plurality of images” from Roberts’ Figures 9 or 13, relied on by Petitioner, are in an area “adjacent” to Roberts’ timeline. For the following reasons, Petitioner does not persuade us that Roberts satisfies this limitation.

An ordinary definition of “adjacent” is “having a common endpoint or border.”¹¹ Ex. 3003. Petitioner argues images 904 and 1004 in Figure 9 and 13 of Roberts are adjacent the timeline but does not provide an ordinary definition of the word “adjacent.” Pet. 16, 45–48; *see also* Pet. Reply 25 (arguing Patent Owner does not “dispute that these annotated areas delineate a scrubber bar . . . and an area adjacent thereto.”). As shown in Figure 10 of the '463 patent, the non-scrubbing controls on the right-hand side of scrubbing area 1002 border the scrubbing controls on the left side of

¹⁰ Neither party directs us to the any portion of the prosecution history of the '463 patent in support of its contentions on the construction of scrubber area. *See* PO Resp. 32–34; Pet. Reply 21–23. Our independent review of the prosecution history did not reveal any relevant information.

¹¹ *See Adjacent* Definition, Merriam-Webster.com, <https://www.merriam-webster.com/dictionary/adjacent> (last accessed July 8, 2022).

scrubbing area 1002. *See* Pet. Reply 22. Consequently, we apply the ordinary meaning of adjacent as “having a common endpoint or border” because it is consistent with the disclosure of the ’463 patent.

Petitioner analogizes Roberts’ “timeline 904” to a scrubber control. Pet. 46. We note, however, that Roberts does not use the terms “scrubber” or “scrubber area.” *See generally* Ex. 1004. Dr. Porter testifies that the red rectangles added to Figures 9 and 13 represent a “scrubber area” but, he cites no persuasive evidence from Roberts to support his opinion concerning the size and shape of the alleged scrubber areas in Roberts’ Figures 9 and 13, nor does he explain why images 904 and 1004 are “adjacent” the timeline. Ex. 1002 ¶¶ 78–79. Therefore, his testimony is entitled to little, if any, weight. *See* 37 C.F.R. § 42.65(a).

In order to satisfy this limitation, Petitioner creates different size scrubbing areas in Figures 9 and 13 of Roberts to fit its obviousness theory. Image 904 in Roberts’ Figure 9 is near the timeline but does not border the timeline. In addition, only one image, not the first plurality of images, is shown in the scrubber area Petitioner identifies in Figure 9. In Roberts’ Figure 13, images 904 and 1004 are shown within Petitioner’s larger proposed scrubbing area, but neither image borders the timeline. In Figure 13, image 904 is further from the timeline than image 1004 and further from the timeline than in Figure 9. Ex. 1004, Figs. 9, 13. Petitioner, however, fails to explain why image 904, which is positioned differently in Figure 9 and Figure 13, is adjacent the timeline in both. *See* Pet. 45–48.

We note that image 904 appears in Figure 9 and in Figure 13. Further, Roberts describes Figures 6–13 as depictions of “screenshots presented by a communications *device*.” Ex. 1004 ¶ 8 (emphasis added). For these reasons, we find that Roberts’ Figures 9 and 13 relate to the same

embodiment. Neither Petitioner nor Dr. Porter, however, offer any persuasive evidence or reasoned explanation why the scrubber area in Roberts' Figure 13 is larger than the scrubber area in Roberts' Figure 9. *See* Pet. 45–48; Ex. 1002 ¶¶ 78–79. Petitioner's contentions that the red rectangles on its annotated versions of Roberts' Figures 9 and 13 (Pet. 46–47) represent “scrubber areas” are, thus, attorney argument unsupported by persuasive evidence.

For these reasons, we find Petitioner has not shown that the first plurality of images it identifies from Roberts are displayed in a “scrubber area,” as required by this limitation. Petitioner relies on Sterner for disclosure of a “draggable scrubbing area” (Pet. 28) but does not rely on Sterner for display of the first plurality of images in the “scrubber area.” *See* Pet. 49–51.

Because Petitioner does not establish that Roberts alone or in combination with Sterner discloses this claim limitation, we determine Petitioner fails to establish by a preponderance of the evidence that claim 1 would have been obvious over Roberts and Sterner.¹²

Independent Claim 11

Claim 11 contains several limitations substantially similar to claim 1, including a limitation substantially similar to limitation 1.4. Ex. 1001, 52:32–45. Petitioner refers to this limitation as 11.7. Pet. xvi. For limitation 11.7, Petitioner relies on its contentions for limitation 1.4. *Id.* at 55.

Patent Owner also relies on its contentions for limitation 1.4 for limitation 11.7. PO Resp. 41.

¹² Given this determination, we need not address claim limitation 1.5.

For the same reasons discussed above for limitation 1.4, Petitioner has not established that Roberts discloses limitation 11.7. Therefore, we determine that Petitioner fails to establish by a preponderance that claim 11 would have been obvious over Roberts and Sterner.

Independent Claim 21

Claim 21 is a method claim and contains several limitations substantially similar to claim 1. Ex. 1001, 53:23–52:9. The limitations that Petitioner refers to as 21.4 and 21.5 require, *inter alia*, that “the first plurality of images associated with respective segments . . . to be displayed at the same time in association with the playback of the first video at the same time the draggable scrubber is displayed” and “the first image displayed on or adjacent to the scrubber that includes the draggable scrubber control.” Pet. xviii–xix. For limitations 21.4 and 21.5, Petitioner relies on its contentions for limitations 1.3–1.5. *Id.* at 57–58.

Patent Owner also relies on its contentions for limitations 1.3 and 1.4 for limitations 21.4 and 21.5. PO Resp. 42.

Claim 21 requires that the first image is “displayed on or adjacent to the scrubber.” Ex. 1001, 54:1–2. We do not perceive a material difference between this requirement and the requirement in claim 1 that the first plurality of images be “displayed in a scrubber area” and Petitioner does not argue that the difference is material. *See* Pet. 57–58.

For the same reasons discussed above for limitation 1.4, Petitioner has not established that Roberts discloses limitations 21.4 or 21.5. Therefore, we determine that Petitioner fails to establish by a preponderance that claim 21 would have been obvious over Roberts and Sterner.

Dependent Claims 5, 6, 10, 15, 16, 20, 25–27

Claims 5, 6, 10, 15, 16, 20, and 25–27 depend from one of claims 1, 11, or 21. Ex. 1001, 51:42–48, 51:59–62, 53:3–9, 53:20–22, 54:35–44. Petitioner directs us to various disclosures in Roberts and/or Sterner that it contends disclose the limitations of these dependent claims. Pet. 58–60.

We reviewed Petitioner’s contentions and evidence cited for these dependent claims and find this additional disclosure does not cure the deficiencies in independent claims 1, 11, and 21.

For these reasons, we determine that Petitioner fails to establish by a preponderance of the evidence that claims 5, 6, 10, 15, 16, 20, and 25–27 would have been obvious over Roberts and Sterner.

E. Ground 2: Alleged Obviousness over Roberts, Sterner and Miller

Claim 8 depends from claim 1 and requires “limiting the file size of the first video file to no greater than a first specified size.” Ex. 1001, 51:53–55. Petitioner relies on Miller for disclosure of limiting a video size. Pet. 60–61 (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 61–62 (citing Ex. 1002 ¶¶ 134–139).

We reviewed Petitioner’s contentions and evidence cited for dependent claim 8 and find this additional disclosure does not cure the deficiencies in independent claim 1 discussed above.

For these reasons, we determine that Petitioner fails to establish by a preponderance of the evidence that claim 8 would have been obvious over Roberts, Sterner, and Miller.

F. Ground 3: Alleged Anticipation by Geer

Petitioner contends that claims 1, 5–7, 10, 11, 15–17, 20, 21, 25–28 are anticipated by Geer. Pet. 62–85. In support thereof, Petitioner identifies the disclosures in Geer alleged to describe the subject matter in the challenged claims. *Id.* Additionally, Petitioner offers the Porter Declaration in support of the Petition. Ex. 1002 ¶¶ 140–211. Patent Owner disputes Petitioner’s contentions. PO Resp. 44–51.

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:

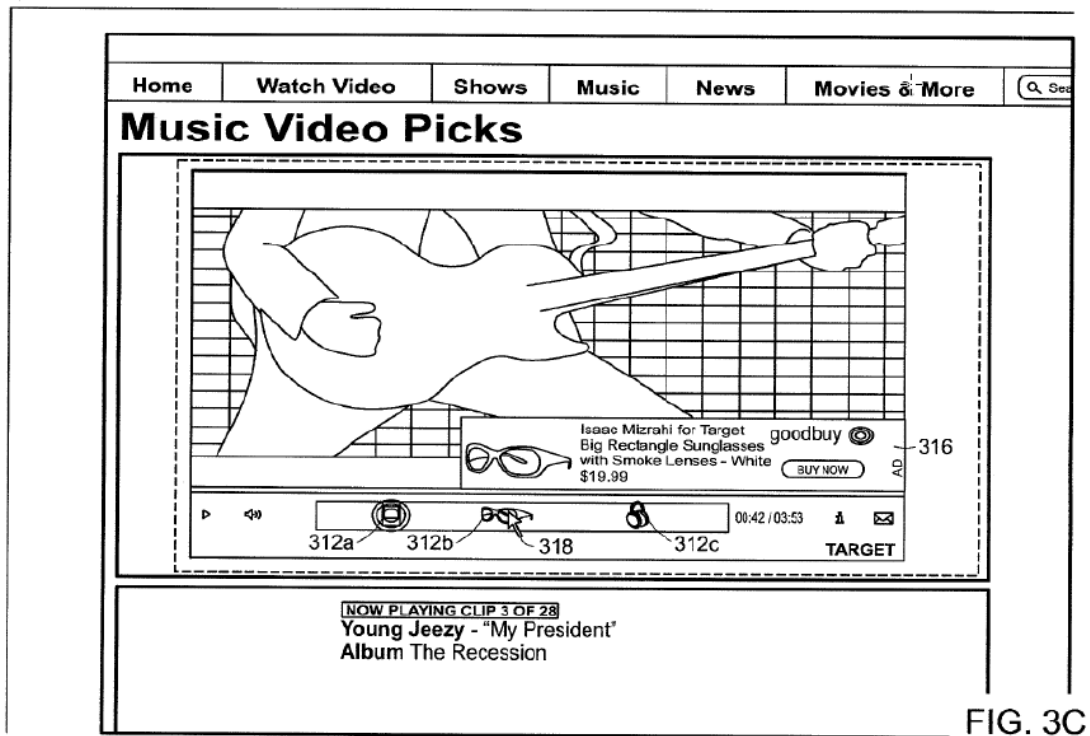


Figure 3C is “an exemplary embodiment of an interactive advertising unit provided by” Geer’s system. *Id.* ¶ 19. Figure 3C shows interactive product icons 312a–312c that are integrated with scrubber bar 306 of the media player at various intervals. *Id.* ¶ 39. Product icons 312a–312c “function within 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 1

Preamble: A non-transitory computer-readable medium storing executable instructions that when executed by a system including at least one computing device cause the system to perform operations comprising:

Petitioner contends that Geer discloses “a system 100 for dynamic integration of advertising and media content” that controls “the presentation priority of the advertising content and the digital media content.” Pet. 62

(citing Ex. 1005 ¶¶ 5–8, 22, 24, 34, Fig. 1). Petitioner further contends that “Geer describes the system components performing operations based on execution of instructions or programmatic code . . . stored in non-transitory computer-readable medium or memory.” *Id.* (citing Ex. 1005 ¶¶ 24, 59–63, 66–68). Petitioner further contends that “Geer describes the system including at least one computing/processing device, as its system includes a server computing device 106, ad server 108, and video server 110.” *Id.* at 63 (citing Ex. 1002 ¶¶ 140–143; Ex. 1005 ¶¶ 24, 59, 61–63, 65–68, Fig. 1).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 44–48. Neither party addresses whether the preamble is limiting. Pet. 62–63; PO Resp. 44–48.

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

[1.1] accessing, over a network from remote video data store, a first video file, the same first video file comprising at least a first plurality of segments;

Petitioner contends that Geer discloses accessing a first video from a video data store remote from the client computing device. Pet. 63 (citing Ex. 1005 ¶¶ 24, 27, 29, 32, Fig. 1). Petitioner further contends that “Geer describes the video, maintained as a file, comprising at least a first plurality of segments (*e.g.*, ‘intervals’ of the video).” *Id.* (citing Ex. 1002 ¶¶ 144–147; Ex. 1005 ¶¶ 19, 36, 36, 43).

Patent Owner counters that “Geer does not disclose the intervals (plurality of segments) are part of the first video file.” PO Resp. 44. Patent Owner contends that paragraphs 19, 36, 39, and 43 of Geer, cited by Petitioner, “are discussing ‘intervals’ within the scrubber bar of the video file—not the video file.” *Id.* Patent Owner supports this contention with a

discussion of the disclosure in paragraphs 19, 36, and 39 of Geer but not paragraph 43. *Id.* at 30–31.

Analysis

Patent Owner’s contentions address Geer’s disclosure in paragraphs 19, 36, and 39 but not paragraph 43. *See* PO Resp. 44–45. In paragraph 43, Geer discloses “[t]he algorithm may divide the *total running time of the video* by the number of icons 312a-c.” Ex. 1005 ¶ 43 (emphasis added). We find that dividing the total running time of the video by the number of icons corresponds to the claim requirement the “first video file comprising at least a first plurality of segments.”

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

[1.2] receiving, over the network, a first plurality of images, wherein a given image in the first plurality of images is associated with a respective segment in the first plurality of segments of the same first video file and comprises an image of a product that corresponds to a product displayed in the respective segment of the same first video file, the first plurality of images comprising a first image that is not an image from the first video file;

Petitioner contends that Geer’s system “receiv[es] over the network using a network interface, a first plurality of images (*e.g.*, images of products displayed within advertisements and as interactive product icons 312a-312c).” Pet. 64 (citing Ex. 1005 ¶¶ 12, 32, 39, 41, Figs. 3A–3C). Petitioner further contends “Geer describes that a given product image (*e.g.*, displayed as product icon 312a-312c) is associated with a respective segment (*e.g.*, video ‘interval’).” *Id.* (citing Ex. 1005 ¶¶ 12–13, 19, 36, 39, 43, 49). Petitioner further contends that the product icons comprise an image of a product and, according to Petitioner, a skilled artisan would have

understood that the images are not from the media content because the icons depict representations of respective products. *Id.* at 65 (citing Ex. 1005 ¶¶ 39, 48, 50, Figs. 3A–3C). Petitioner, referring to Geer’s Figures 3A and 3C, contends that sunglass icon 312b corresponds to the product shown in the advertisement in Figure 3C. *Id.*

Patent Owner’s first contention is that Geer “retrieves media content and separately retrieves advertising content and ‘**combines** the advertising content and the requested digital media content to provide an interactive advertising unit 202.’” PO Resp. 45–46 (citing Ex. 1005 ¶¶ 32, 41). According to Patent Owner, this means “Geer presents the images into the scrubber bar of the media player and does not receive images that are associated with respective segments of the video file as required by this element.” *Id.* at 46 (citing Ex. 1005 ¶¶ 19, 32, 39; Ex. 2093 ¶ 85).

Patent Owner’s second contention is that “product icons 312a-312c are images of different products that are being advertised such as an MP3 player or headphones” but “are not images *from* a ‘respective segment of the same first video file.’” *Id.* at 32 (citing Ex. 1005 ¶¶ 47, 48, Figs. 3A–3C) (emphasis added).

With respect to Patent Owner’s first contention, Petitioner responds that “Geer teaches an advertiser associating display of its advertisement images with specific points in time of the video.” Pet. Reply 28 (citing Ex. 1005 ¶¶ 32, 43). According to Petitioner, “[g]iven the ‘marketing association’ established between an advertiser and a media owner, its is clear the advertised products correspond to those ‘specific point[s] in time’ in the video.” *Id.* Petitioner further contends that “Dr. Valerdi agrees that the images displayed as product icons 312a-312c . . . are associated with different video segments.” *Id.* (citing Ex. 1042, 65:16–66:12).

With respect to Patent Owner's second contention, Petitioner contends that Patent Owner "completely ignores Geer's disclosure of the sunglasses advertisement." Pet. Reply 29. According to Petitioner, "Geer's Figure 3A illustrates that the advertisement for sunglasses corresponds to sunglasses depicted in the video, particularly since 'Geer's system promotes "a broad range of marketing techniques, such as product placement [and] brand association" through 'displaying advertising content in proximity to requested digital media content.'" *Id.* (citing Ex. 1005 ¶ 22, Figs. 3A, 3C).

In the Sur-reply, Patent Owner contends Figure 3A of Geer "shows a guitar being played" and does not "correspond[] to sunglasses depicted in the video." Sur-Reply 21. According to Patent Owner "[t]hat the corresponding advertisement to the icon of sunglasses (pop-out window of sunglasses) is of the same image as the icon is of no moment because the pop-out window in Geer is not the content being played and associated with the respective segment," but "is . . . simply a representation of the visual indicator in the video player." *Id.* at 21–22 (citing Pet. 22; Ex. 1005¹³ ¶¶ 47–50).

Analysis

Figure 3A of Geer shows an artist wearing sunglasses and sunglasses icon 312b but does not show a guitar being played as Patent Owner asserts. Ex. 1004, Fig. 3A. Figure 3C shows the guitar being played. *Id.* at Fig. 3C. Sunglasses icon 312b is associated with the segment of the video shown in Figure 3A because it is "an image of a product that corresponds to a product displayed in the" segment shown in Figure 3A in that the icon corresponds

¹³ The Sur-Reply refers to Exhibit 2005 which we understand to be a typographical error.

to the sunglasses worn by the artist. *Id.* at Fig. 3A; *see also id.* ¶ 43 (disclosing icons 312 a-c are positioned “according to preferences exhibited by an advertiser, such as *correlation with media content displayed at a specific point in time*”) (emphasis added). Contrary to Patent Owner’s assertion (PO Resp. 32), this claim limitation does not require the image to be “from” the respective segment of the video.

Based the evidence cited by Petitioner and after consideration of Patent Owner’s contentions, we find that Geer discloses this claim limitation.

[1.3] causing the first plurality of images to be displayed at the same time in association with a playback of the first video file, for at least a portion of the time the first video file is being played back in a playback area, and

Petitioner contends that Geer’s system “caus[es] the first plurality of images (*e.g.*, product images) to be displayed at the same time (*e.g.*, as product icons 312a-312c) in association with a playback of the first video file, as the product icons are all simultaneously displayed on the scrubber.” Pet. 67 (citing Ex. 1005 ¶¶ 32, 33, 39, 41, 43, Fig. 3C). Petitioner further contends that in Geer product icons 312a–312c are displayed at least for a portion of the time the media content is played in a playback area. *Id.* at 69 (citing Ex. 1002 ¶¶ 153–154; Ex. 1005 ¶¶ 33–43, 47–50, Figs. 3A–3B).

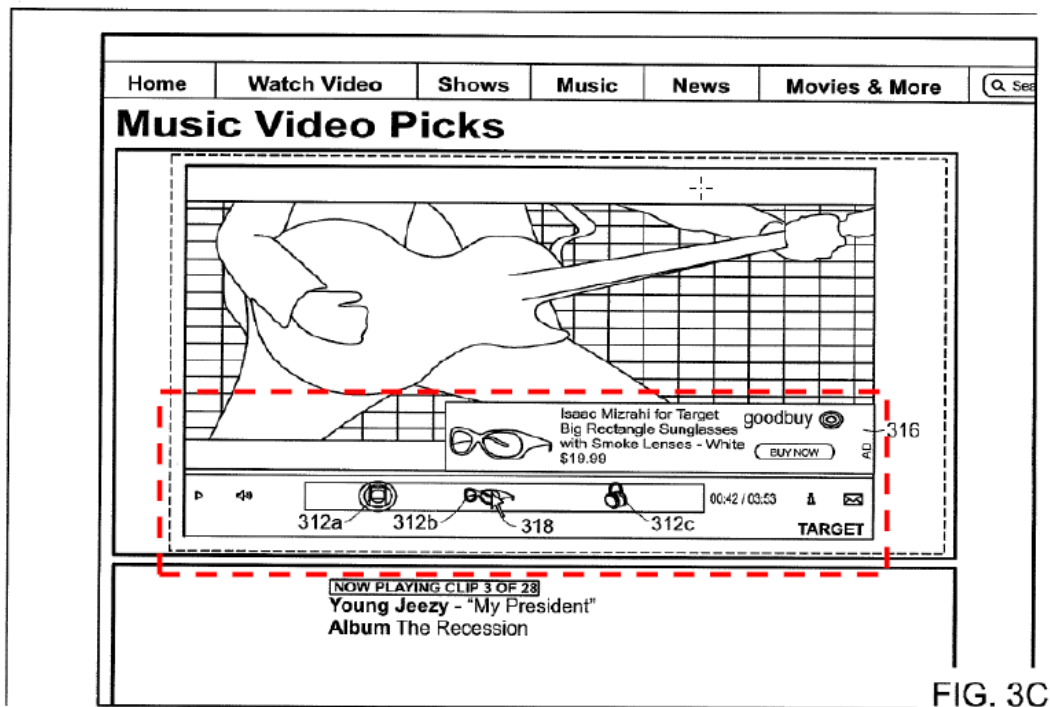
Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 44–47.

Based on the evidence cited by Petitioner, we find Geer discloses this limitation.

[1.4] causing the first plurality of images associated with respective segments in the same first video file to be displayed in a scrubber area displayed in association with the playback of the first video file, the scrubber area comprising a scrubber

that includes a draggable scrubber control that indicates video playback progress via scrubber timeline during a time period in which the first video file is being played and which is manipulable to control playback of the first video file by dragging the scrubber control to a desired position;

Petitioner contends that Geer's system "caus[es] the first plurality of images . . . to be displayed . . . in a scrubber area . . . in association with the playback of the first video file." Pet. 70 (footnote omitted). Petitioner provides the following annotated version of Geer's Figure 3C:



Id. at 71. This image is Geer's Figure 3C, which is a screenshot with a red box added by Petitioner to illustrate the portion it contends is the scrubber area. *Id.* Petitioner further contends that Geer's scrubber area comprises scrubber bar 306, including visual indicator 310 that Petitioner contends is a draggable scrubber control and indicates video playback progress when the first video file is being played. *Id.* (citing Ex. 1005 ¶¶ 40, 46, 50).

Petitioner further contends that the scrubber is “manipulable to control playback of the first video file by dragging the visual indicator 310 to a desired position.” *Id.* at 72 (citing Ex. 1002 ¶¶ 155–158; Ex. 1005 ¶ 50).

Patent Owner does not address Petitioner’s contentions. *See* PO Resp. 44–47.

Based on the evidence cited by Petitioner, we find Geer discloses this limitation.

[1.5] at least partly in response to detecting that a user has selected the first image in the first plurality of images associated with respective segments in the same first video file and displayed at the same time in the scrubber area, the first image displayed on or adjacent to the scrubber that includes the draggable scrubber control that indicates video playback progress via a scrubber timeline, wherein the first image is not from the first video file, causing the playback of the first video file to jump to a segment of the first video file corresponding to the first image, the segment of the first video file corresponding to the first image and displaying the first product,

Petitioner, referring to an annotated version of Geer’s Figure 3C, contends that Geer discloses “the first image displayed on or adjacent to the scrubber that includes the draggable scrubber control that indicates video playback progress.” Pet. 73 (citing Ex. 1005 ¶¶ 39, 42, 47, 48, Figs. 3A–3C). Petitioner further relies on the disclosure in Geer’s paragraph 50 that a “user can also slide the visual indicator” to “control[] the playback of the media content by moving forward or backward in the media content depending on the user’s action,” and, “[a]s the visual indicator 310 moves over any of the icons 312a-c, the interactive advertising unit 301 presents the corresponding pop-in window.” *Id.* at 74 (citing Ex. 1002 ¶¶ 159–162; Ex. 1005 ¶ 50) (emphasis omitted).

Patent Owner contends paragraph 50 of Geer “discusses various ways to make advertising pop-ins appear on the screen” but “[t]hat functionality is not a navigation event, as it does not cause a ‘jump to’ a segment of the video file.” PO Resp. 46–47 (citing Ex. 1004 ¶ 50). Patent Owner, further contends that Geer “merely displays a different advertisement in the pop-in overlay window 316.” *Id.* at 47. Patent Owner next contends Geer does not disclose that “selecting a product icon causes the playback of the video file to ‘jump to’ a segment of the video file corresponding to the product icon.” *Id.* (citing Ex. 2093 ¶ 88). According to Patent Owner, Geer discloses “a user must move the visual indicator over a product icon” and, as a result, “the video also moves positions such that when the visual indicator is over a product icon, the video will be in the proper position and no ‘jump to’ event needs to occur.” *Id.* at 48 (citing Ex. 1005 ¶ 50).

Petitioner counters “this claim limitation does not restrict what actions constitute a selection—for instance, it does not specifically recite ‘clicking’ the image.” Pet. Reply 30. Petitioner contends “the ’463 patent contemplates other actions beyond ‘clicking’ that nonetheless constitute a user selection.” *Id.* (citing Ex. 1001, 33:21–24). Petitioner also contends this limitation “defines a ‘draggable scrubber control,’ suggesting this limitation encompasses user selection of an image via dragging the scrubber control.” *Id.*

Petitioner next contends “the ’463 patent lacks any explanation as to the meaning of ‘jump,’ let alone what video operations constitute a ‘jump’ and what operations do not.” Pet. Reply 30. According to Petitioner, “Geer’s playback control constitutes a ‘jump’ to a corresponding video segment, since the video playback transitions from the current point in time of video playback to that video segment.” *Id.*

In the Sur-reply, Patent Owner contends Geer’s visual indicator 310 is the only tool that a user may select to cause Petitioner’s argued jump navigation to occur (dragging the visual indicator along the time bar to navigate to different points).” Sur-Reply 22 (citing Ex. 1005 ¶ 50; Ex. 2093 ¶ 87). According to Patent Owner, “[e]ven if the user drags the visual indicator to a product icon, the user does not select the product icon in order to cause the argued jump.” *Id.* Patent Owner further contends that under Petitioner’s theory, “the video has already navigated to the product icon portion of the video simultaneous with the purported ‘selection.’” *Id.* Patent Owner further contends Petitioner fails to “explain how this ‘selection’ causes anything to happen, much less a ‘jump’ to the segment.” *Id.* at 29–30.

Analysis

The language of limitation 1.5 recites that “at least partly in response to detecting that a user . . . select[s] the first image . . . causing the playback of the first video file to jump to a segment of the first video file corresponding to the first image.” Ex. 1001, 51:1–11. Both parties agree that this language imposes a temporal requirement that the user selects the first image and, then after the user selection, the playback of the first video file jumps to a segment of the first video file corresponding to the first image. Tr. 58:8–18, 109:9–10.

Petitioner relies on Geer’s description in paragraph 50 that a user can slide visual indicator 310 and, “[a]s the visual indicator 310 moves over any of the icons 312a-c, the interactive advertising unit 301 presents the corresponding pop-in window 316.” Pet. 74 (quoting Ex. 1005 ¶ 50). Dr. Porter testifies that Geer meets this limitation by relying on the same disclosure from Geer. Ex. 1002 ¶¶ 159–162. However, neither Petitioner

nor Dr. Porter persuasively explains how this disclosure in Geer satisfies the temporal requirement of limitation 1.5.

Petitioner contends the first plurality of images comprises “images of products displayed within advertisements and as interactive product icons.” Pet. 64. Geer’s “visual indicator 310 moves from left to right in the box while the elapsed time increases” and “can be an arrow, a pointer, a vertical box or the like.” Ex. 1005 ¶ 40, Fig. 3A. Petitioner does not contend that visual indicator 310 is one of the first plurality of images. Pet. 64–67. Therefore, a user manipulating visual indicator 310 does not correspond to the user selecting the first image.

Selection of one of the plurality of first images in Geer, i.e., the interactive product icons 312a–312c, occurs when the visual indicator moves over one of the icons causing advertising unit 301 to present a corresponding pop-in window 316. Dr. Valerdi’s reading of paragraph 50 is “as the user moves the visual indicator, the video also moves positions such that . . . when the visual indicator is over a product icon, the video will in the proper position and no ‘jump to’ event needs to occur.” Ex. 2093 ¶ 88. Dr. Valerdi’s testimony is consistent with the disclosure of Geer, which provides that as a result of the user sliding visual indicator 310, the media content will move forward or backward. Ex. 1005 ¶ 50. Therefore, we find Petitioner has not shown that Geer discloses this claim limitation because the video has already moved to “a segment of the first video file corresponding to the first image” when the icons 312a-c are selected and no “jump to” event occurs subsequent to the selection.

Summary of Claim 1

For all the foregoing reasons, we determine that Petitioner has not established by a preponderance of the evidence that Geer anticipates claim 1.

Independent Claim 11

Claim 11 contains several limitations substantially similar to claim 1 including a limitation similar to limitation 1.5. Ex. 1001, 52:32–45.

Petitioner refers to this limitation as 11.8. Pet. xvi. Petitioner relies on its contentions for limitation 1.5 for limitation 11.8 concerning the temporal requirement discussed above. *Id.* at 77.

Patent Owner relies on its contentions for limitation 1.5 for limitation 11.8. PO Resp. 49.

For the same reasons discussed above for limitation 1.5, Petitioner has not established that Geer discloses limitation 11.8. Therefore, we determine that Petitioner has not established by a preponderance of the evidence that Geer anticipates claim 11.

Independent Claim 21

Claim 11 contains several limitations substantially similar to claim 1 including a limitation similar to limitation 1.5. Ex. 1001, 53:53–54:9.

Petitioner refers to this limitation as 21.5. Pet. xix. Petitioner relies on its contentions for limitation 1.5 for limitation 21.5 concerning the temporal requirement discussed above. *Id.* at 79.

Patent Owner relies on its contentions for limitation 1.5 for limitation 21.5. PO Resp. 50.

For the same reasons discussed above for limitation 1.5, Petitioner has not established that Geer discloses limitation 21.5. Therefore, we determine that Petitioner has not established by a preponderance of the evidence that Geer anticipates claim 21.

Dependent Claims 5, 6, 10, 15, 16, 20, and 25–27

Claims 5, 6, 10, 15, 16, 20, and 25–27 depend from one of claims 1, 11, or 21. Ex. 1001, 51:42–48, 59–62, 53:3–9, 20–22, 54:35–44. Petitioner

directs us to various disclosures in Geer that it contends disclose the limitations of these dependent claims. Pet. 80–85.

We reviewed Petitioner’s contentions and evidence cited for these dependent claims and find this additional disclosure does not cure the deficiencies in independent claims 1, 11, and 21.

For these reasons, we determine that Petitioner has not established by a preponderance of the evidence that Geer anticipates any of claims 5, 6, 10, 15, 16, 20, and 25–27.

G. Ground 4: Alleged Obviousness over Geer and Miller

Claim 8 depends from claim 1 and requires “limiting the file size of the first video file to no greater than a first specified size.” Ex. 1001, 51:54–55. Petitioner relies on Miller for disclosure of limiting a video size. Pet. 85–86 (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 86–87 (citing Ex. 1002 ¶¶ 212–217).

We reviewed Petitioner’s contentions and evidence cited for claim 8 and find this additional disclosure does not cure the deficiencies in independent claim 1.

For these reasons, we determine that Petitioner has not established by a preponderance of the evidence that claim 8 would have been obvious over the combined teachings of Geer and Miller.

H. Ground 5: Alleged Obviousness over Roberts, Sterner, and Geer

Petitioner interposes this challenge to claims 7, 17, and 28 which depend from claims 1, 11, and 21, respectively, as an alternate challenge “[t]o the extent that Roberts does not explicitly describe displaying a name of an item being displayed during playback of the first video file . . . Geer

describes this aspect.” Pet. 87. We reviewed this challenge, which incorporates aspects of Geer from Ground 3. *Id.* at 86. The aspects of Geer relied on for this challenge do not cure the deficiencies in Roberts discussed above in connection with Ground 1 and thus, Petitioner has not shown by a preponderance of the evidence that any of claims 7, 17, or 28 are unpatentable over Roberts, Sterner, and Geer.

III. PETITIONER’S MOTION TO EXCLUDE

Petitioner filed a Motion to Exclude Patent Owner’s Exhibits 2091 and 2092 (“the Motion”). Paper 31, 1. Patent Owner opposed the Motion. Paper 32.

Exhibits 2091 and 2092 are declarations of Narbeh Avedissian and Nikhil Sreenath, the co-inventors of the ’463 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. 10–11.

Because of our disposition of this case based on the disclosures of Roberts and Geer, it is not necessary to reach the issue of conception and reduction to practice. Therefore, we do not rely on Exhibits 2091 and 2092 and dismiss Petitioner’s Motion to Exclude 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 not shown that claims 1, 5–8, 10, 11, 15–17, 20, 21, and 25–28 of the '463 patent are unpatentable.

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 5, 6, 10, 11, 15, 16, 20, 21, 25– 27	103	Roberts, Sterner		1, 5, 6, 10, 11, 15, 16, 20, 21, 25–27
8	103	Roberts, Miller		8
1, 5–7, 10, 11, 15–17, 20, 21, 25– 28	102	Geer		1, 5–7, 10, 11, 15–17, 20, 21, 25–28
8	103	Geer, Miller		8
7, 17, 28	103	Geer, Sterner, Miller		7, 17, 28
Overall Outcome				1, 5–8, 10, 11, 15–17, 20, 21, 25–28

I. ORDER

Accordingly, it is:

ORDERED that claims 1, 5–8, 10, 11, 15–17, 20, 21, and 25–28 of the '463 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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