

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MG FREESITES LTD.,
Petitioner,

v.

SCORPCAST, LLC,
Patent Owner.

IPR2021-00513
Patent 9,832,519 B2

Before MEREDITH C. PETRAVICK, HYUN J. JUNG, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PETRAVICK, *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 *inter partes* review of claims 1–5, 9–11, and 16–18 of U.S. Patent No. 9,832,519 B2 (Ex. 1001, “the ’519 patent”). In support of the Petition, Petitioner filed a Declaration of Dr. Adam Porter. Ex. 1002. Patent Owner, Scorpcast, LLC, filed a Preliminary Response (Paper 6). On September 9, 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. 2090), a Declaration of Nikhil Sreenath (Ex. 2091), and a Declaration of Ricardo Valerdi, Ph.D. (Ex. 2092). Petitioner filed a Reply to the Patent Owner Response. Paper 24 (“Pet. Reply”). Patent Owner filed a Sur-reply. Paper 25 (“Sur-Reply”).

Petitioner filed a Motion to Exclude Evidence. Paper 29. An oral hearing was held on June 6, 2022, and the transcript is entered into the record. Paper 35 (“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 ’519 patent. For the reasons discussed below, we determine Petitioner does not establish by a preponderance of the evidence that the challenged claims are unpatentable. We also dismiss Petitioner’s Motion to Exclude as moot.

A. Related Matters

The parties state that the '519 patent was asserted in *Scorpcast, LLC dba HaulStars v. MG Freesites Ltd.*, Case No. 6-20-cv-00877 (W.D. Tex.). Pet. xxv; Paper 3, 2. On June 21, 2021, the District Judge transferred this case to the District of Delaware, *Scorpcast, LLC dba HaulStars v. MG Freesites Ltd.*, Case No. 1:21-cv-00887. Paper 12, 1–2; Paper 13, 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 '519 Patent

The '519 patent is titled “Interactive Video Distribution System and Video Player Utilizing a Client Server Architecture.” Ex. 1001, code (54). The '519 patent issued on November 28, 2017, from an application filed on January 7, 2016. *Id.* at codes (45), (22). The '519 patent claims priority to applications filed as early as April 19, 2012. *Id.* at code (63). Petitioner, however, argues that the challenged claims are not entitled to the benefit of early applications but “at the earliest” a date of March 14, 2013. Pet. 14.

The '519 patent describes, in one embodiment, receiving user generated video reviews comprising audio and video data of a reviewed product or multiple products. Ex. 1001, 8:14–19. 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 8:26–29. 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 8:33–36

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 8:45–50. “[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 8:51–55. Tags “associated with the reviewed item may be received from the user” and “may be descriptive of the reviewed item.” *Id.* at 8:62–65. “One or more . . . tags may be associated with the start of an item review.” *Id.* at 8:67–9:1.

Figure 10 from the '519 patent is reproduced below:



FIG. 10

Figure 10 is “an example user interface application for publishing a user generated video review.” *Id.* at 4:12–13. “[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 37:34–38. 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 37:42–50. 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 38:17–22. 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 38:22–26.

D. Challenged Claims

Petitioner challenges claims 1–5, 9–11, and 16–18. Claims 1, 9, and 16 are independent claims. Claims 2–5 depend from claim 1. Claims 10 and 11 depend from claim 9. Claims 17 and 18 depend from claim 16.

Claim 1 is illustrative and reproduced below:¹

[1.P] 1. A video system, comprising:

[1.1] at least one processing device;

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

[1.3] receive over a network, from a first user terminal of a first user, an upload of a first video or a link thereto;

[1.4] provide over the network to the first user terminal a user interface that enables the first user to define a plurality of

¹ Claim 1 is reproduced with Petitioner’s labels. Pet. xiii–xv.

segments within the first video and associate a given navigation image from a source other than the first video with a respective segment in the first video, wherein the user interface enables the user to provide a link to a given image from a source other than the first video or to upload a given image from a source other than the first video to the video system;

[1.5] receive, over the network video from the first user terminal via the user interface that enables the first user to define a plurality of segments within the first video and associate a given navigation image from a source other than the first video with a respective segment in the first video, an association of a given navigation image from a source other than the first video with a respective segment in the first video;

[1.6] receive an association of a link, comprising a Uniform Resource Locator (URL) to a destination associated with an item depicted in a respective segment, to a networked destination with a respective navigation image from a source other than the first video;

[1.7] provide a video player for display on a second user terminal of a second user;

[1.8] enable the video player to play the first video, including multiple segments of the first video, and automatically display:

- a first navigation image associated with a corresponding first segment of the first video, and

- a second navigation image associated with a corresponding second segment of the first video, the second segment later in time than the first segment,

while the first segment of the first video is playing,

[1.9] where the first navigation image associated with the first segment of the first video is displayed by the video player at a first location overlaying the first segment of the first video, the first location indicative of a position of the first segment in the first video, and

[1.10] where the second navigation image associated with second segment of the first video is displayed by the video

player at a second location overlaying the first segment of the first video, the second location indicative of a position of the second segment in the first video, wherein the second segment is later in time than the first segment,

[1.11] where the first navigation image is associated with a first link, comprising a first URL, to a first networked destination, the first associated navigation image from a source other than the first video, and the second navigation image is associated with a second link, comprising a second URL, to a second networked destination, the second associated navigation image from a source other than the first video;

[1.12] wherein in response to detecting that the second user has selected the first or the second navigation image displayed by the video player at the first location or the second location overlaying the first segment, a respective link, comprising a respective URL to a respective network destination is activated, and the respective network destination corresponding to the respective URL is accessed by the second user terminal;

[1.13] provide a share control displayed in association with the video player, wherein in response to detecting activation of the share control, a link to content of the first video is shared with a first recipient.

Ex. 1001, 57:2–58:10.

E. Prior Art and Asserted Grounds²

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3, 5, 9, 16	103	Fink-722 ³ , Kilar ⁴
2, 4, 10, 11, 17, 18	103	Fink-772, Kilar, Fink-475 ⁵
1, 3, 9, 16	103	Nordhagen ⁶ , Roberts ⁷
2, 4, 5, 10, 11, 17, 18	103	Nordhagen, Roberts, Kilar

Pet. 1–2.

II. ANALYSIS

A. Principles of Law

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).

² Patent Owner attempts to swear behind Roberts and Kilar to disqualify each reference as prior art. PO Resp. 10–20. Because we determine that Petitioner has not met its burden to show that the challenged claims are obvious based on the asserted grounds of unpatentability, we need not reach this issue.

³ U.S. Patent Application Publication No. 2009/0144772 A1, published June 4, 2009 (Ex. 1006) (“Fink-722”).

⁴ U.S. Patent Application Publication No. 2013/0004138 A1, published Jan. 3, 2013 (Ex. 1005) (“Kilar”).

⁵ U.S. Patent Application Publication No. 2009/0300475 A1, published Dec. 3, 2009 (Ex. 1007) (“Fink-475”).

⁶ U.S. Patent Application Publication No. 2009/0055742 A1, published Feb. 26, 2009 (Ex. 1008) (“Nordhagen”).

⁷ U.S. Patent Application Publication No. 2011/0138326 A1, published June 9, 2011 (Ex. 1004) (“Roberts”).

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

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends that a person of ordinary skill in the art (“POSA”) at the time of the invention of the ’519 patent would have had the following education and experience: “a Bachelor’s degree in Electrical Engineering, Computer Engineering, or Computer Science (or the equivalent degree) plus approximately two years of work experience with technologies relating to content annotation and/or content sharing among multiple users.” Pet. 15.

Petitioner adds that “[m]ore education can supplement work experience and vice versa.” *Id.* (citing Ex. 1002 ¶¶ 1–21).

Patent Owner does not dispute this level of skill. PO Resp. 9.

We adopt Petitioner’s proposal as reasonable and consistent with the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art).

C. Claim Construction

We apply the same claim construction standard used by Article III federal courts, 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 ’519 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.*

Neither Petitioner nor Patent Owner provides any explicit construction of any claim terms. *See* Pet. 14; PO Resp. 9.

Upon review of the parties’ arguments and based on the evidentiary record, we determine that no claim terms require explicit 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. Unpatentability over Fink-722 and Kilar

Petitioner contends that claims are unpatentable over Fink-722 and Kilar. Pet. 23–46. Patent Owner disputes Petitioner’s contentions. PO Resp. 20–34.

1. Summary of Fink-722

Fink-722 is a U.S. Patent Application Publication titled, “Video Object Tag Creation and Processing” and published on June 4, 2009. Ex. 1006, code (43), (54).

Fink describes associating a product in a video with an advertisement to be presented during playback of the video. *Id.* ¶ 3. Figure 1 of Fink-722 is reproduced below.

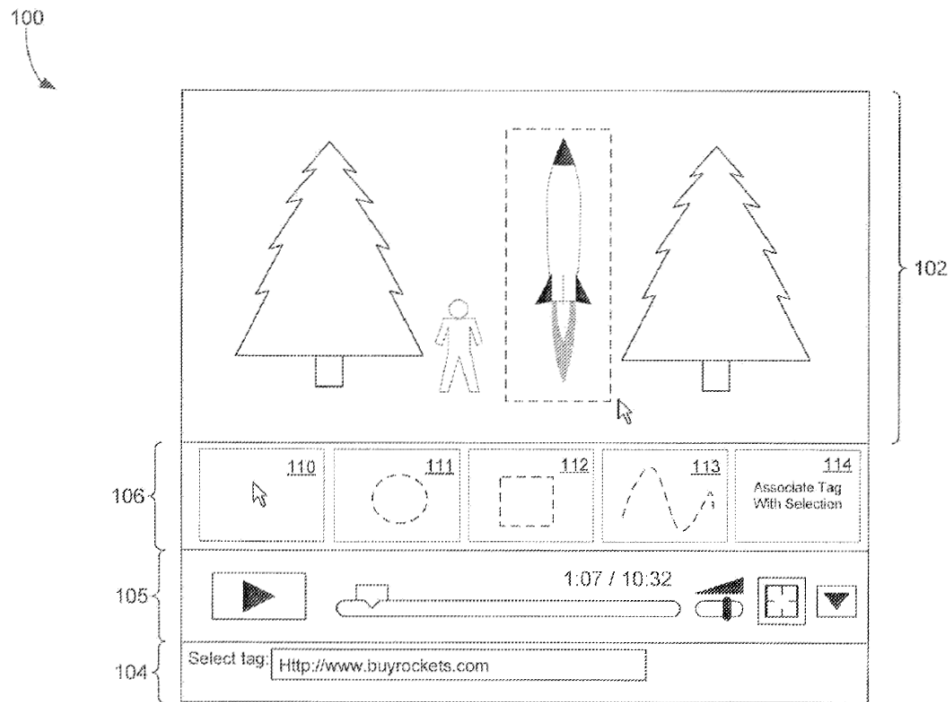


FIG. 1

Figure 1 depicts user interface 100 for associating tags with objects in a video content. *Id.* ¶ 15. User interface 100 includes video content display 102, selection tool display 106, media controls display 105, and tag selection

display 104. *Id.* ¶ 22. Using the tools of selection tool display 106, a user may select objects in video content item display 102, such as selecting a rocket ship with rectangular selection tool 112. *Id.* ¶ 34. A user may, then, associate a tag, for example a website for purchasing a model of the rocket, with the object by entering the website in tag selection display 104 and selecting “Associate Tag with Selection” button 114. *Id.* ¶ 35.

Additional frames of the video content may be analyzed, using object or image recognition techniques, to locate additional occurrences of the selected object, which may also be associated with the tag. *Id.* ¶¶ 64–65. Additionally, rather than selecting an object in video content item display 102, a user may upload an image file of an object, and objects in the video content that match the uploaded images may be associated with the tag. *Id.* ¶¶ 67–68.

Figure 3 of Fink-722 is reproduced below.

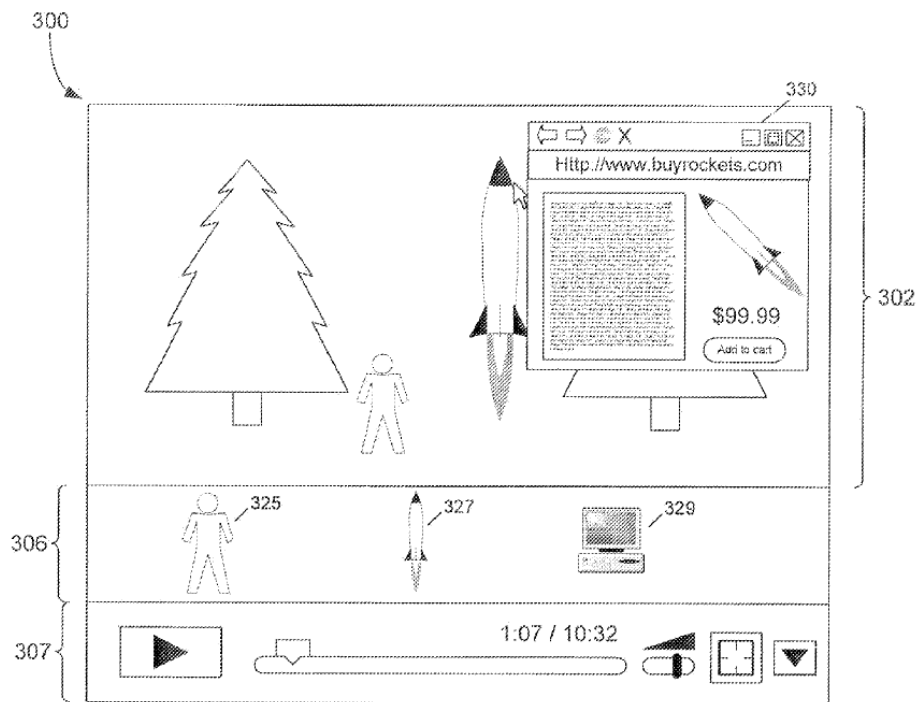


FIG. 3

Figure 3 depicts user interface 300 for playing and interacting with the video content and interacting with the tags. *Id.* ¶ 17. User interface 300 includes video content display 302, object display 306, and media control display 307. *Id.* ¶¶ 48–49. A user interacts with the video content playing in the video content display 302 by clicking on an object, such as a rocket ship. *Id.* ¶ 50. A tag associated with the object is then retrieved and the tag is processed by retrieving and presenting data referred to by the tag. *Id.* ¶ 50. For example, after retrieving the tag for the rocket ship, the website for purchasing a model of the rocket is presented in browser 330. *Id.* ¶ 50.

Object display 306 displays objects, such as human 325, rocket 327, and computer 329, from the video content that have an associated tag. *Id.* ¶¶ 49–51. In some embodiments, object display 306 shows objects appearing in the current frame of video content display 302 or all objects appearing in the current and previous frames of video content display 302, and, in another embodiment, shows a listing of all tagged objects regardless of when an object appears in the video content. *Id.* ¶ 49. In addition to clicking on the object in video content display 302, a user may click on the object in object display 306. *Id.* ¶ 51.

2. *Summary of Kilar*

Kilar is a U.S. Patent Application Publication titled, “Commenting Correlated to Temporal Point of Video Data” and published on January 3, 2013. Ex. 1005, code (43), (54).

Figure 4 of Kilar is reproduced below.

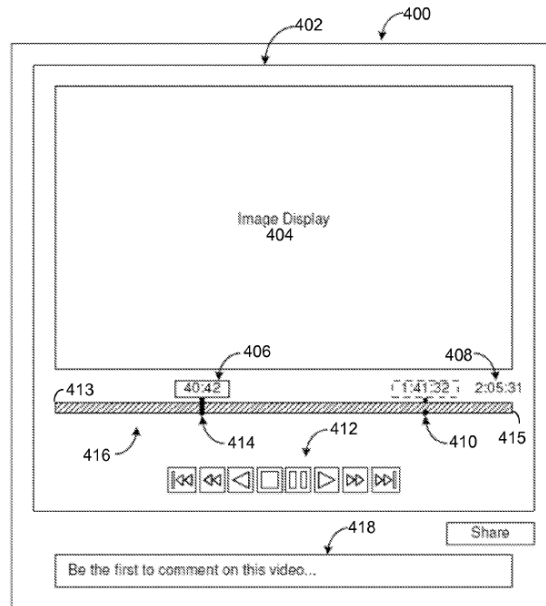


FIG. 4

Figure 4 depicts a screen-shot of a user interface for enabling comments to be linked to portions of a video file. *Id.* ¶ 22. “Using the comment window 418, an end user viewing a video file that is already produced and distributed to multiple users may associate comments or other data at any temporal point that the end user selects in a video file.” *Id.* ¶ 65. Comments may include, for example, typed or spoken text, a digital photograph, or other video data into comment window 418. *Id.* ¶ 66. Comments are associated with a temporal point, portion, segment, or subject of a video file. *Id.* ¶ 56. Comments with digital video data may generate a Flash™ overlay. *Id.* ¶¶ 93, 118.

3. *Independent Claim 1*⁸

Petitioner contends that the combination of Fink-772 and Kilar teaches all the elements of independent claim 1, and in particular, element 1.4. Pet. 29–53; *see also* Pet. Reply 14–18. Claim 1, element 1.4 states:

provide over the network to the first user terminal a user interface that enables the first user to define a plurality of segments within the first video and associate a given navigation image from a source other than the first video with a respective segment in the first video, wherein the user interface enables the user to provide a link to a given image from a source other than the first video or to upload a given image from a source other than the first video to the video system.

Ex. 1001, 59:17–22 (emphases added).

As teaching element 1.4, Petitioner first points to Fink-722’s objects in object display 306 (i.e., human 325, rocket ship 327, and computer 329) as corresponding to the claimed navigation images. Pet. 23, 28 (“The images 325, 327, 329 associated with tags and displayed in the Fig. 3 are ‘navigation images,’ as these images, when selected by a user in the Fig. 3 interface, cause navigation to a designated website associated with the tag.”). Petitioner next points to Fink-772’s description of a user uploading an image file used to identify objects in the video content to tag, instead of a user selecting the object from the video content. Pet. 28–29 (citing Ex. 1006 ¶¶ 47, 67); Pet. Reply 16 (citing Ex. 1006 ¶¶ 3, 22–23, 29–36, 49–51).

⁸ In its Reply, Petitioner asserts that Patent Owner “does not challenge that a [POSA] would have had reason to modify Fink-722 based on Kilar, and merely alleges shortcoming of Kilar” and therefore, Patent Owner “has waived any argument challenging the obviousness of combining Kilar with Fink-722.” Pet. Reply 16. We determine that the Patent Owner’s Response raises arguments sufficient to challenge the obviousness of combining Fink-722 and Kilar. *See, e.g.*, PO Resp. 24. We, thus, do not agree that Patent Owner waived such arguments. *See* Sur-Reply 15.

Petitioner states:

To the extent Fink-772 does not explicitly describe (i) navigation images from sources other than the first video, with the user interface enabling the user to provide a link to or upload a given image to the video system to associate with the tag . . . , a POSA would have found it obvious to incorporate these aspects, as taught by Kilar, in Fink-772.

Pet. 23.

With respect to Kilar, Petitioner points to Kilar's description of a user making a comment by providing a digital photograph in comment window 418. Pet. 30 (citing Ex. 1005 ¶ 66); Pet. Reply 17 (citing Ex. 1005 ¶¶ 6–7, 65–70). Petitioner argues that Kilar teaches “the broad concept of customizing images associated with a tag, where a user uploads his/her own image that forms part of the tag.” Pet. Reply 17.

Petitioner contends:

A POSA would have been motivated to modify Fink-772 to provide an option to include user-provided navigation images, as taught by Kilar. A POSA would have recognized that such option would have provided improved customization of Fink-772's advertisement display component, allowing other images such as a brand logo to be used and displayed for representing the tagged advertisement. A POSA would have appreciated that such an option would have allowed Fink-772's system to provide the opportunity to an advertiser to utilize more attention-capturing images to represent the tagged advertisement.

Pet. 24.

Patent Owner disputes that Fink-772 and Kilar teach “a given navigation image from a source other than the first video with a respective segment in the first video.” PO Resp. 20–21. Patent Owner argues that Fink-772 discloses a user manually selecting an object from the current frame of the video and not from a source other than the video and that

[E]ven though a user may also upload an image and have the video content analyzed to tag every occurrence in the uploaded image, the resulting tags are the same as if the user manually tagged the object using the method described above. Ex. 1006, [0047]; [0067]; *See* Exhibit 2092, ¶¶53.

PO Resp. 23–24

Patent Owner further argues that “Kilar does not cure the deficiencies of Fink-722.” *Id.* at 24. Patent Owner contends that “[w]hile Kilar discloses that ‘comments’ may contain a link to an image, Kilar does not disclose that the ‘comment’ contains a navigation image associated with a segment, and Petitioner does not so assert.” *Id.*

Consistent with our determination in our Institution Decision and after consideration of the arguments presented during trial, we are not persuaded by Petitioner that a POSA would be motivated to make the proposed modification, particularly, in light of the different uses of Fink-722’s objects and Kilar’s digital photograph. *See* Dec. 15–19. Our reviewing court has stated that “obviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). “[O]bviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Fink-722’s objects in object display 306 (i.e., human 325, rocket ship 327, and computer 329) are not navigation images from a source other than the first video, as required by claim 1. Fink-722 discloses that the objects in object display 306 are selected by a user from the video content using

selection tool 100, 111, 112, or 113 or are selected from the video content by matching one or more images of the object from an image file with the objects in the video content. Ex. 1006 ¶¶ 30–31, 66–67. Either way, the objects displayed in object display 306 are from the video content and not from a source other than the first video.

Kilar teaches a user making a comment by, for example, providing text, an audio file, a digital photograph or other video data to a comment window. Ex. 1005 ¶¶ 65–66. Kilar discloses that an end user viewing a video file, that is already produced and distributed, may associate comments at temporal points that the end user selected in the video file. *Id.* ¶ 65.

Petitioner “propose[s] providing customization of Fink-772’s display object images to ‘allow[] other images such as a brand logo to be used and displayed for representing the tagged advertisement.’” Pet. Reply 17–18. Petitioner asserts that a POSA would have been motivated “to provide the opportunity to an advertiser to utilize more attention-capturing images to represent the tagged advertisement.” Pet. 24.

Petitioner’s motivation is conclusory, insufficiently supported, and appears to be hindsight-based. We are not persuaded that a POSA would have modified Fink-772’s display object images to allow other images to be used and displayed for representing the tagged item from the video, given Kilar. The Petition cites to the testimony of Dr. Adam Porter to support its alleged motivation. *Id.* at 25 (citing Ex. 1002 ¶¶ 53–63); Pet. Reply 18 (citing Ex. 1002 ¶ 59). But Dr. Porter’s testimony is similarly conclusory as it merely mimics the Petition and provides no further explanation or reasoning as to why a POSA would have been so motivated. *See* Ex. 1002 ¶ 59.

Additionally, Petitioner's alleged motivation is contrary to the focus of Fink-772. Fink-772's invention is focused on associating a tag referring to a media content item with an object in video content. *See, e.g.*, Ex. 1006 ¶¶ 3–13. Fink-722 discloses that “[w]hen an object appears in the object display 306 the user is made aware that there is a tag associated with the object. The user may the click on the object in the video content item display 302” *Id.* ¶ 51. Fink-722 does not disclose the objects in object display 306 are anything other than from the video content. *See generally id.*

Kilar also does not support Petitioner's motivation as Kilar's digital photograph is a comment on a video from an end user. *See* Ex. 1005 ¶¶ 6–7, 65–66. Kilar does not teach an advertiser uploading a digital photo of a brand logo in the comment window to provide more attention-capturing images to represent the tagged advertisement. *See generally id.*

It is Petitioner's burden to show that claim 1 is unpatentable based on Fink-722 and Kilar. We determine that Petitioner fails to meet its burden because it does not sufficiently show that a POSA would have modified Fink-722 based on Kilar, as proposed by Petitioner. We determine that Petitioner fails to show by a preponderance of the evidence that claim 1 is unpatentable over Fink-772 and Kilar.

4. *Independent Claims 9 and 16*

Independent claims 9 and 16 recite similar elements to claim 1's element 1.4. *See* Ex. 1001, 59:1–60:9, 60:54–62:13. Both parties refer us to the same arguments provided for claim 1's element 1.4. Pet. 40–45; PO Resp. 30–34.

Petitioner does not provide any further explanation or citations to evidence. *See* Pet. 40–45. For the same reasons as above, Petitioner fails to

show that the combination of Fink-772 and Kilar teaches all the limitations of independent claims 9 and 16. Petitioner, thus, fails to show by a preponderance of the evidence that claims 9 and 16 are unpatentable over Fink-772 and Kilar.

5. *Dependent Claims 3 and 5*

Petitioner argues that dependent claims 3 and 5 are unpatentable over Fink-772 and Kilar. Pet. 39, 45. Petitioner's arguments for these claims do not remedy the deficiencies discussed above for the challenged independent claims. Petitioner fails to show that the combination of Fink-772 and Kilar describes all the limitations of these challenged dependent claims. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”). Petitioner fails to show by a preponderance of the evidence that claims 3 and 5 are unpatentable over Fink-772 and Kilar.

E. *Unpatentability over Fink-772, Kilar, and Fink-475*

Petitioner challenges dependent claims 2, 4, 10, 11, 17, and 18 as unpatentable over Fink-772, Kilar, and Fink-475. Pet. 46–51. Patent Owner responds that the addition of Fink-475 does not remedy the deficiencies of the combination of Fink-772 and Kilar with respect to the independent claims and the “Petition does not so allege.” PO Resp. 34.

For the reasons discussed above with respect to the challenged independent claims, Petitioner fails to show that the combination of Fink-772, Kilar, and Fink-475 discloses all the limitations of these challenged dependent claims. Petitioner, thus, fails to show by a preponderance of the evidence that claims 2, 4, 10, 11, 17, and 18 are unpatentable over Fink-772, Kilar, and Fink-475.

F. Unpatentability over Nordhagen and Roberts

Petitioner contends that claims are unpatentable over Nordhagen and Roberts. Pet. 52–82. Patent Owner disputes Petitioner’s contentions. PO Resp. 35–53.

1. Summary of Nordhagen

Nordhagen is a U.S. Patent Application Publication titled, “Media Data Presented with Time-Based Metadata” and published on February 26, 2009. Ex. 1008, code (43), (54). Nordhagen discloses “providing supplemental time-based metadata during the rendering of one or more media files.” *Id.* ¶ 2. For example, media file 100 may be a movie and during play of the movie, a sub-window displays metadata 200 at times triggered by tags 114 that are time coded to movie scenes. *Id.* ¶ 28.

Figure 2B of Nordhagen is reproduced below.

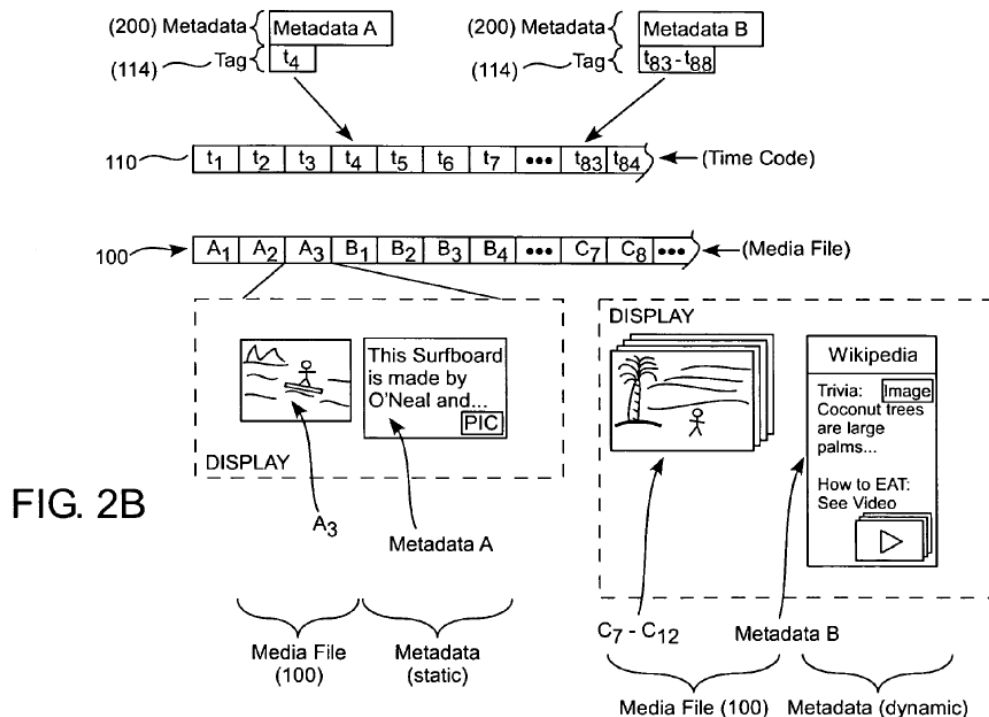


Figure 2B depicts an example media file 100 having assigned metadata 200 and tags 114, and the display of metadata 200 related to particular content of a media file using time code 110. *Id.* ¶ 15. Tags 114 can refer to metadata of a variety of formats, such as “text, audio clips, video clips, user comments, images, links to other data, links to the Internet, webpage content, and combinations thereof.” *Id.* ¶ 32.

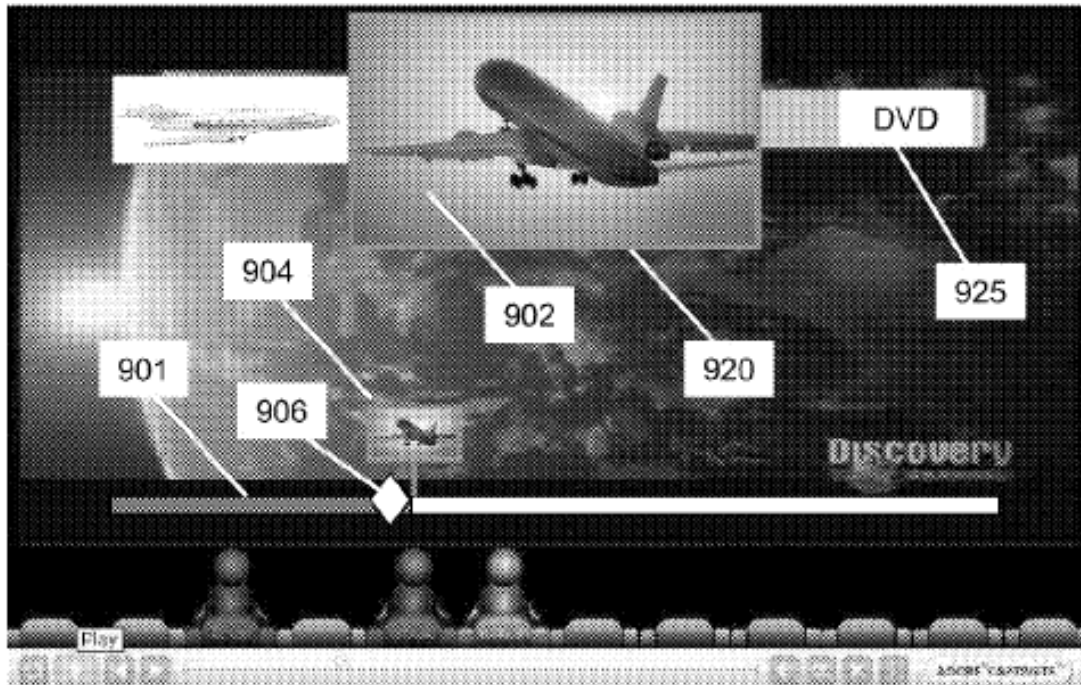
[M]edia file 100 partA3 is linked or associated with metadata A, and metadata A is provided with tag 114 that is linked to time code t4. Thus, when the media file 100 reaches time t4, the display of the media file 100 may be showing a surfer riding a surfboard. The metadata A may be information about the surfboard, such as the maker and a more detailed picture of the surfboard. A link may also be provided in the metadata A, to allow the user to view more info, seek a commercial transaction to purchase, etc.

Id. ¶ 33.

2. *Summary of Roberts*

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.*

3. *Independent Claim 1*

Petitioner contends that the combination of Nordhagen and Roberts teaches all the elements of independent claim 1. Pet. 29–53; Pet. Reply 22–30. Patent Owner disagrees and, in particular, Patent Owner disputes that the combination teaches element 1.8 of claim 1. PO Resp. 35–43; Sur-Reply 18–24.

Based on the evidence and arguments presented during trial, we determine that Petitioner has not shown that the combination of Nordhagen and Roberts teaches element 1.8 of claim 1.

Claim 1, element 1.8 states:

enable the video player to play the first video, including multiple segments of the first video, and automatically display:

a first navigation image associated with a corresponding first segment of the first video, and

a second navigation image associated with a corresponding second segment of the first video, the second segment later in time than the first segment,

while the first segment of the first video is playing.

Ex. 1001, 57:34–43. Notably, element 1.8 requires that the first navigation image and the second navigation image are automatically displayed while the first segment of the first video is playing and that the first segment is before the second segment in time.

Petitioner relies upon a combination of Nordhagen and Roberts to teach element 1.8. Pet. 52–56, 63–69. According to Petitioner, Nordhagen discloses automatically displaying a first navigation image, associated with a

first segment of the media while the first segment of the media is playing.
Id. at 63–69 (citing Ex. 1008 ¶¶ 32–34, Fig. 2B, claims 5–6). Petitioner states:

To the extent, for first/second navigation images corresponding to first/second video segments, Nordhagen does not explicitly describe (i) displaying the second navigation image during playback of the first video segment . . . a POSA would have found it obvious to incorporate these aspects, as taught by Roberts, in Nordhagen.

Pet. 52.

To cure this deficiency of Nordhagen, Petitioner points to Roberts’ “carousel GUI” (i.e., advertising GUI 902). Pet. 52–55 (citing Ex. 1004 ¶ 58, Fig. 9), 64–69 (citing Ex. 1004 ¶¶ 58–61, Fig. 9, Fig. 10). Based on Roberts’ GUI 902, the Petition asserts that “Roberts teaches displaying the navigation images (e.g., advertisements) during video playback, such that even during playback of a particular video segment corresponding to an advertisement, advertisements corresponding to other video segments are also displayed.” Pet. 67; *see also* Ex. 1002 ¶¶ 210 (corresponding testimony of Dr. Porter). In its Reply, Petitioner further explains that

Roberts describes the carousel displaying multiple advertisement images corresponding to the different tags. Ex. 1004, ¶[0061]. The middle advertisement in the carousel is enlarged and corresponds to the current tag in the video playback, the carousel rotates in coordination with playback to change which advertisement is shown enlarged in the middle. *Id.*, ¶¶[0059]–[0061]; Figs. 9–10; ¶[0060] (rewinding video to view a previous advertisement). Therefore, the enlarged advertisement clearly has, on one side, an advertisement corresponding to a tag prior in time, and on the other side, an advertisement corresponding to a tag later in time.

Pet. Reply 23.

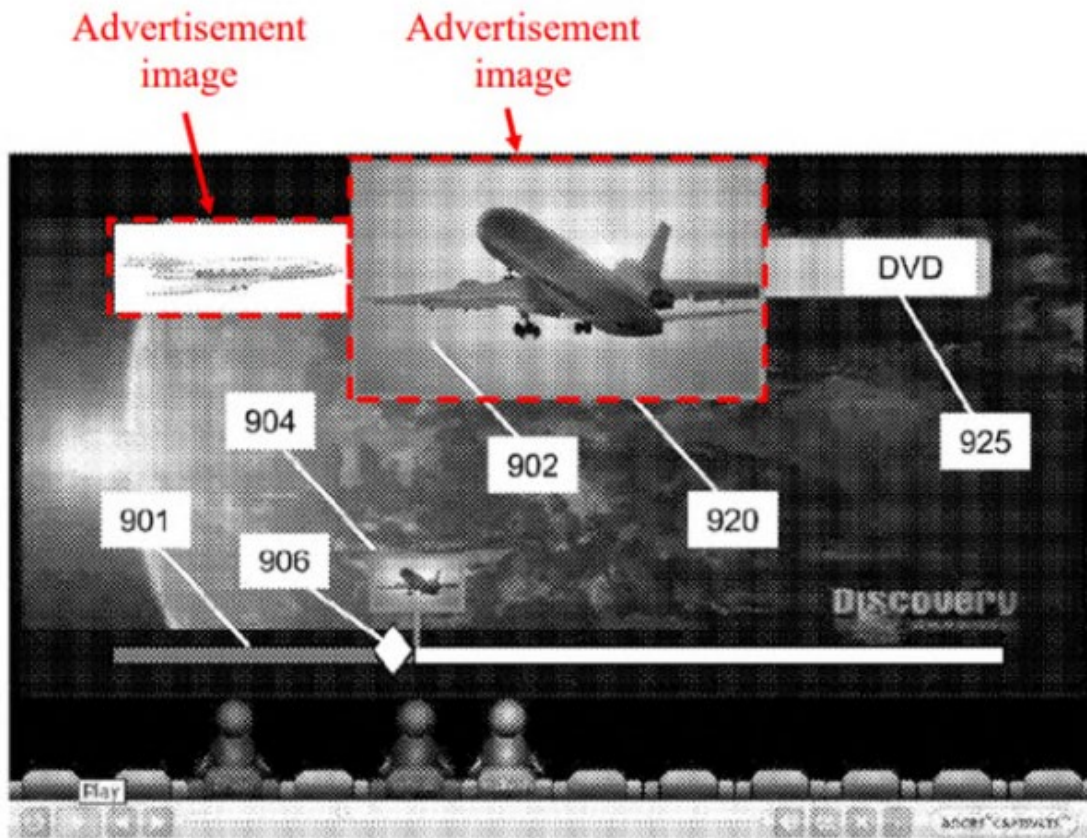
Petitioner contends:

A POSA would have been motivated to modify Nordhagen to include Robert's carousel GUI to concurrently display multiple advertisements corresponding to different tags and video segments and provide selection of the navigation images, in order to expand the advertising display and capabilities for the video and lengthen the amount of playback time that an advertisement is presented without impeding the presentation of other advertisements. *A POSA would have recognized that Roberts' advertisement carousel GUI would have displayed upcoming advertisements, allowing a viewer to view the advertisement even prior to the corresponding video segment and digest the contents of the advertisement in advance.* A POSA would have appreciated that such expanded display opportunity would have improved the chances of the advertisement being selected, thereby improving the use of advertisements within the video system.

Pet. 54–55 (emphasis added); *see also* Ex. 1002 ¶¶ 187–188 (corresponding testimony of Dr. Porter).

Patent Owner disputes that Roberts teaches element 1.8. PO Resp. 35–41; Sur-Reply 18–22. Patent Owner disagrees that Roberts' description of GUI 902 teaches this limitation because Roberts is silent as to how its advertisement images in GUI 902 are associated with different segments of a video and is silent as to whether the second advertisement image is displayed while a first segment is playing. *Id.*

Roberts' Figure 9 is reproduced below with annotations added by
Petitioner. Pet. 54; Ex. 1002 ¶ 126.



900
FIG. 9

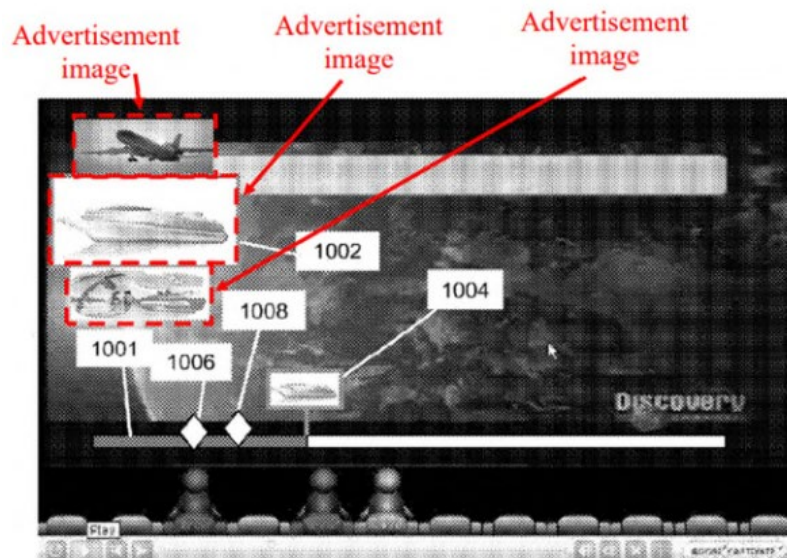
Figure 9 depicts an embodiment showing screen shot 900 having “a series of advertisements” in GUI 902. Ex. 1004 ¶ 59. Roberts describes GUI 902 as “a horizontal carousel GUI or a pop up window that allows for rotations through the various advertisements with one of the advertisements being shown more prominently as the GUI is rotated.” *Id.* GUI 902 include three advertisements in an un-numbered frame, frame 920, and frame 925. *Id.* ¶ 59. Roberts only describes the advertisements in frames 920 and 925. In this regard, Roberts states:

Frame 920 of GUI 902 depicts an advertisement for traveling by air which is based on metadata associated with the tag 906, while frame 925 is an advertisement for a DVD of or related to the media programming. In this example, the subject matter of the advertisement can differ and can be presented in the same GUI carousel.

Id. ¶ 59. As can be seen from the passage above, Roberts only describes the advertisement in frame 920 being based upon a tag. Roberts is silent as to the advertisement in the un-numbered frame and, in particular, Roberts is silent as to what the advertisement in the un-numbered frame is based upon.

Roberts' Figure 9 and corresponding description, thus, does not support Petitioner's assertion that "Roberts displays the navigation images (*e.g.*, advertisements) during video playback, such that even during playback of a particular video segment corresponding to an advertisement, advertisements corresponding to other video segments are also displayed" (Pet. 67).

Robert's Figure 10 is reproduced below with annotations made by Petitioner. Pet. 68; Ex. 1002 ¶ 211.



1000
FIG. 10

Figure 10 depicts screen shot 1000 having a vertical as opposed to a horizontal GUI 1002. *Id.* ¶ 61. Based on the shading of timeline 1001, Figure 10 appears to show the program further along in time than the time corresponding to tag 1008 (which Petitioner alleges corresponds to the claimed second segment). *Id.* at Fig. 10. Figure 10, thus, does not explicitly depict a screen shot at a time corresponding to tag 1006 (which Petitioner alleges corresponds to the first segment). With respect to Figure 10, Roberts states:

Screenshot 1000 of FIG. 10 illustrates an advertisement GUI 1002 (vertical as opposed to the horizontal GUI 902) which can be generated based on user tags 1006 and 1008. In this example, multiple advertisements are displayed based on metadata associated with the tags 1006 and 1008. Similarly, the timeline 1001 can present the advertisement icon 1004.

Id. ¶ 61. As can be seen from this passage and Fig. 10 above, Roberts depicts and describes three advertisements (i.e., a plane advertisement, a boat advertisement, and an island vacation advertisement) based on two tags, 1006 and 1008, but does not provide any sufficiently detailed description of how tags 1006 and 1008 correspond to the three advertisements. In particular, Roberts is silent as to whether the plane advertisement or island vacation advertisement depicted in Figure 10 or some other advertisement not depicted in Figure 10 corresponds to tag 1006.

During oral argument, Petitioner argued that because Roberts discloses rewinding the programming to further view advertisements in the GUI, that each advertisement in the GUI must correspond to different video segments marked by the tags. *See* Tr. 15:11–25, 22:19–23:26; *see also* Pet. Reply 23 (citing Ex. 1004 ¶ 60 (“rewinding video to view a previous advertisement”)). Based on this, Petitioner contends that a POSA would

have known that the plane advertisement or the island vacation advertisement depicted in Figure 10 corresponds to tag 1006 and, at the time corresponding to tag 1006 (the alleged first segment), either the plane advertisement or the island vacation advertisement would be shown enlarged in the middle frame of the GUI and the boat advertisement, which corresponds to tag 1008, would be shown either in the frame above or below. *See, e.g.,* Tr. 16:26–12, 22:10–21.

Referring to Figure 9, Roberts states:

As 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 programming to further view the advertisement.

Id. ¶ 60. Roberts, however, does not explicitly disclose how the rewinding affects the GUI and, in particular, how it affects the rotation of the GUI. *See* Tr. 22:19–23:26.

We are not persuaded by Petitioner that Roberts’ statement above necessarily means that each advertisement in the GUI must correspond to a tag on the timeline and that each advertisement must be arranged in the GUI such that it follows the order of the tags on the timeline. *See id.* To the contrary, Roberts suggests that advertisements that do not correspond to a tag may be included in the GUI. *See id.* ¶ 59 (describing that the advertisement in frame 925 being an advertisement for a DVD of or related to the media programming, as opposed to a tag, like the advertisement in frame 920). The record also suggests that at a particular point in the timeline an advertisement may not be shown in GUI; for example, the advertisement corresponding to tag 1006 may not be shown in the GUI at the time depicted in Figure 10. *See, e.g.,* Tr. 18:8–11 (“So if there is an advertisement . . . not

being shown by being rotated out then the rewinding -- it's clear from Paragraph 60 that the rewinding then causes counter-rotation, if you will, of the carousels so that the advertisement then reappears.) We, thus, are not persuaded by Petitioner that at a time corresponding to tag 1006 (which Petitioner alleges corresponds to the first segment), the GUI would necessarily depict both an advertisement image associated with tag 1006 and tag 1008.

It is Petitioner's burden to show that claim 1 is unpatentable based on Nordhagen and Roberts. We determine that Petitioner fails to meet its burden because it does not sufficiently show that Roberts teaches the claimed first navigation image and the second navigation image that is automatically displayed while the first segment of the first video is playing. Petitioner fails to show by a preponderance of the evidence that claim 1 is unpatentable over Nordhagen and Roberts.

4. *Independent Claims 9 and 16*

Both parties refer us to the same analysis and arguments provided for claim 1. Pet. 77–82; PO Resp. 48–50. For the same reasons above, we determine that Petitioner fails to show by a preponderance of the evidence that claims 9 and 16 are unpatentable over Nordhagen and Roberts.

5. *Dependent Claim 3*

Petitioner challenges dependent claim 3 is unpatentable over Nordhagen and Roberts. Pet. 76–77. Patent Owner does not address the additional elements of claim 3, but argues that the combination of Nordhagen and Roberts fails to render claim 3 unpatentable for the same reason it fails to render the challenged independent claims obvious. PO Resp. 50–51. On the full record, we determine that Petitioner fails to show

by a preponderance of the evidence that claim 3 is unpatentable over Nordhagen and Roberts.

G. Unpatentability over Nordhagen, Roberts, and Kilar

Petitioner challenges dependent claims 2, 4, 5, 10, 11, 17, and 18 as unpatentable over Nordhagen, Roberts, and Kilar. Pet. 82–90.

Patent Owner does not address the additional elements of these dependent claims, but argues that the addition of Kilar does not remedy the deficiencies of the combination of Nordhagen and Roberts with respect to the independent claims. PO Resp. 51. For the reasons discussed above with respect to the challenged independent claims, we determine that Petitioner fails to show by a preponderance of the evidence that claims 2, 4, 5, 10, 11, 17, and 18 are unpatentable over Nordhagen, Roberts, and Kilar.

III. PETITIONER’S MOTION TO EXCLUDE

Petitioner filed a Motion to Exclude Patent Owner’s Exhibits 2090 and 2091 (“the Motion”). Paper 29, 1. Patent Owner opposed the Motion. Paper 31.

Exhibits 2090 and 2091 are declarations of Narbeh Avedissian and Nikhil Sreenath, the co-inventors of the ’519 patent. Ex. 1001, code (72); Ex. 2090; Ex. 2091. Patent Owner submitted the declarations in support of its attempt to “swear behind Roberts and Kilar 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.

Because of our disposition of this case based on the disclosures of Roberts and Kilar, it is not necessary to reach the issue of conception and

reduction to practice. Therefore, we do not rely on Exhibits 2090 and 2091 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, 9–11, and 16–18 of the '519 patent are unpatentable.

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 3, 5, 9, 16	103	Fink-722, Kilar		1, 3, 5, 9, 16
2, 4, 10, 11, 17, 18	103	Fink-772, Kilar, Fink-475		2, 4, 10, 11, 17, 18
1, 3, 9, 16	103	Nordhagen, Roberts		1, 3, 9, 16
2, 4, 5, 10, 11, 17, 18	103	Nordhagen, Roberts, Kilar		2, 4, 5, 10, 11, 17, 18
Overall Outcome				1–5, 9–11, 16–18

V. ORDER

Accordingly, it is:

ORDERED that claims 1–5, 9–11, and 16–18 of the '519 patent have not been shown to be unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude (Paper 29) 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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