

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BYTEDANCE LTD. and TIKTOK INC.,  
Petitioner,

v.

TRILLER, INC.,  
Patent Owner.

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IPR2021-00774  
Patent 9,691,429 B2

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Before GEORGIANNA W. BRADEN, MINN CHUNG, and  
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

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

On April 9, 2021, ByteDance Ltd. and TikTok Inc. (collectively “Petitioner”) filed a Petition requesting *inter partes* review of claims 11–19 of U.S. Patent No. 9,691,429 B2 (Ex. 1001, “the ’429 patent” or “the challenged patent”). Paper 2 (“Pet.”). Triller, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 5 (“Prelim. Resp.”).

We may institute an *inter partes* review if the information presented in the Petition and the Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. See 35 U.S.C. § 314. However, the Board has discretion to deny a petition even when a petitioner meets that threshold. *Id.*; see, e.g., *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). The PTAB’s Trial Practice Guide identifies considerations that may warrant exercise of this discretion. Consolidated Trial Practice Guide (Nov. 2019) (“Consolidated TPG”),<sup>1</sup> 55–63.

Having considered the parties’ submissions, we determine that it is appropriate in this case to exercise our discretion to deny institution of *inter partes* review pursuant to 35 U.S.C. § 314(a).

## I. BACKGROUND

### A. Related Matters

The parties identify two district court litigations that involve (or involved) the ’429 patent: *Triller, Inc. v. ByteDance, Inc.*, Case No. 6:20-cv-00693 (W.D. Tex.), and *ByteDance, Inc. v. Triller, Inc.*, Case No. 3:20-cv-07572 (N.D. Cal.). Pet. 75; Paper 4 (Patent Owner Mandatory Notice), 2.

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

The parties also identify IPR2021-00099 (Pet. 75–76; Paper 4, 2), in which Petitioner challenges claims 1–10 of the ’429 patent. *See ByteDance Ltd. v. Triller, Inc.*, IPR2021-00099, Paper 8 (PTAB Apr. 21, 2021) (“’099 Institution Decision”). That proceeding is pending, and we address it in more detail below.

*B. Real Parties in Interest*

Petitioner identifies ByteDance Ltd., ByteDance Inc., TikTok Inc., and TikTok Pte. Ltd. as real parties-in-interest. Pet. 75. Patent Owner identifies itself as a real party-in-interest, and Patent Owner notes that “Triller Holdco LLC is the parent corporation to Triller, Inc.” Paper 4, 2.

*C. The Petition’s Asserted Challenges to Patentability*

Petitioner asserts the following challenges to patentability (Pet. 1–2):

| <b>Claim(s) Challenged</b> | <b>35<br/>U.S.C. §</b> | <b>Reference(s)/Basis</b>                   |
|----------------------------|------------------------|---------------------------------------------|
| 11–16                      | 103 <sup>2</sup>       | Hozumi, <sup>3</sup> Herberger <sup>4</sup> |
| 17                         | 103                    | Hozumi, Yamamoto <sup>5</sup>               |
| 18, 19                     | 103                    | Hozumi, Yamamoto, Herberger                 |

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<sup>2</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of Section 103.

<sup>3</sup> US 2012/0148208 A1, published June 14, 2012 (Ex. 1005).

<sup>4</sup> US 7,512,886 B1, issued March 31, 2009 (Ex. 1022).

<sup>5</sup> US 2012/0076357 A1, published March 29, 2012 (Ex. 1023).

*D. Summary of the '429 Patent*

The '429 patent relates to “creating music videos that are synchronized to an audio track.” Ex. 1001, 2:26–28. A plurality of “video takes” may be captured via a user’s device and, while the plurality of video takes are being captured, they may be synchronized with the audio track. *Id.* at 2:34–37. For example, the audio track may play through the device’s speakers while the device’s camera captures a video take. *Id.* at 14:49–64; *see id.* at 10:19–21 (“By having the audio track playing while the various video takes are captured, the video takes may be captured ‘in sync’ with the audio track.”). A music video may then be created that includes the audio track and at least a subset of the video takes already synchronized to that audio track. *Id.* at 2:40–43. “The music video, in one embodiment, combines the various video takes and the selected audio track into one synchronized item . . . .” *Id.* at 22:20–24; *see id.* at 2:11–17 (desiring “music video using portions of multiple video[] takes taken at different times and at different locations that are automatically synchronized to a selected audio track”).

*E. Challenged Claims*

In this proceeding, Petitioner challenges claims 11–19 of the '429 patent. Of these, claims 11 and 17 are independent. Claim 11 recites:

11. A user device, comprising:  
at least one audio input component;  
at least one image capturing component;  
memory for storing: an audio track recorded by the at least one audio input component and a plurality of video takes captured by the at least one image capturing component; and  
at least one processor operable to:

determine, within the recorded audio track, at least one of a vocal phrase and a melodic phrase; and

synchronize each video take of the plurality of captured video takes to the recorded audio track as each video take of the plurality of video takes is being captured, wherein synchronizing further comprises playing, from a first beginning, the selected audio track at substantially the same time as a second beginning of capturing each video take of the plurality of video takes; and

create a music video comprising the recorded audio track and a portion of the plurality of captured video takes, wherein creating comprises:

displaying the portion based on at least one of the determined at least one vocal and one melodic phrase.

Ex. 1001, 27:44–28:3.

## II. DISCRETIONARY DENIAL

### *A. Summary of Relevant Facts*

Over five months before this Petition was filed, on October 28, 2020, Petitioner filed a petition seeking *inter partes* review of claims 1–10 of the challenged patent. *See ByteDance Ltd. v. Triller, Inc.*, IPR2021-00099 (the “’099 IPR”), Paper 2 (“’099 Petition”). In that proceeding, Patent Owner filed a preliminary response on February 17, 2021, and the Board instituted trial on April 21, 2021. *See* ’099 Institution Decision. The ’099 IPR is currently pending, and a final written decision is due in approximately six months. *See* 35 U.S.C. § 316(a)(11).

Petitioner filed this Petition on April 9, 2021 (Paper 3)—over seven weeks after Patent Owner’s preliminary response in the ’099 IPR, but before the Board’s institution decision—to seek review of the rest of the patent’s claims. The ’429 patent includes three independent claims, and nineteen

total claims. Independent claim 1 and its dependent claims are challenged in the '099 IPR, and the instant Petition challenges independent claims 11 and 17 and their respective dependent claims.

The distinct claim sets challenged in the two petitions have overlapping claimed subject matter. All three of the independent claims of the '429 patent recite selecting an audio track, capturing a plurality of video takes, and creating a music video that includes the audio track and some portion of the plurality of video takes. *See* Ex. 1001, 26:55–27:6 (claim 1), 27:44–28:3 (claim 11), 28:34–53 (claim 17). In addition, all three independent claims include a “beginning-beginning synchronization requirement”:

synchronizing each video take of the plurality of captured video takes with the selected audio track while each video take of the plurality of video takes is being captured, wherein synchronizing further comprises playing, from a first beginning, the selected audio track at substantially the same time as a second beginning of capturing each video take of the plurality of video takes  
Ex. 1001, 26:60–67 (claim 1), 27:54–61, 28:40–46 (substantially similar requirements in claims 11 and 17).

But each independent claim also includes limitations not found in the other two. *See* Pet. 71–72. Specifically, claim 1 specifies that the music video “compris[es] at least two video takes.” Ex. 1001, 27:3–6. Claim 11 specifies that the audio track is “recorded by [an] audio input component” in a user device, and that a processor in the device is operable to determine “at least one of a vocal phrase and a melodic phrase” in the audio and to display a portion of the plurality of video takes based on that determination. *Id.* at 27:47–48, 27:52–53, 28:1–3. Claim 17 requires determining “a number of faces within each video take . . . while each take . . . is being captured” and

“displaying the subset of the plurality of captured video takes based on the [determined] number of faces.” *Id.* at 28:37–39, 28:51–53. Other than these differences, the independent claims largely include commensurate limitations.

The two petitions likewise include overlapping contentions. In particular, both the instant Petition and the ’099 Petition rely on Hozumi for the claim limitations common to the independent claims. *See generally* Pet.; ’099 Petition 30–50. Both petitions specifically contend that Hozumi teaches or suggests the beginning-beginning synchronization requirement. *See* Pet. 26–34; ’099 Petition 33–38, 46–49. In the ’099 IPR, the Board expressed concerns regarding the sufficiency of Petitioner’s showing regarding Hozumi. *See* ’099 Institution Decision 37–42, 45.

### *B. Analysis*

Institution of *inter partes* review is discretionary. *See Cuozzo*, 136 S. Ct. at 2140 (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Patent Owner argues that we should exercise our discretion to deny institution based on the *General Plastic* factors. Prelim. Resp. 44–51 (citing *General Plastic Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) (“*General Plastic*”)). In *General Plastic*, the Board set forth seven non-exhaustive factors to be considered when determining whether to permit a “follow-on” petition challenging the same patent:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

*General Plastic*, Paper 19 at 15–16.

Petitioner argues that “subsequent Board decisions found denial under *General Plastic* inappropriate where, as here, a second petition exclusively challenges claims that were not addressed in the first petition.” Pet. 70–71 (citing *Mercedes-Benz v. Carucel*, IPR2019- 01644, Paper 9 at 12 (PTAB Mar. 26, 2020) (“*Mercedes-Benz*”); *Signify Holding B.V. v. Lighting Sci. Grp. Corp.*, IPR2020-00753, Paper 16 at 13–14 (PTAB Sept. 16, 2020) (“*Signify Holding*”). Petitioner contends that, because the Petition challenges claims that were not previously challenged, at least *General Plastic* factors 1, 2, 4 and 5 “favor institution,” as demonstrated by the Board's decisions in *Mercedes-Benz* and *Signify Holding*. Pet. 71–73.

Patent Owner disagrees with Petitioner's assertion that *General Plastic* is "categorically inapplicable" in this situation. Prelim. Resp. 45–46. In support, Patent Owner points to another Board decision that discretionarily denied a petition "in light of the overlap of references and issues involved, despite the fact that 'different claims [were] involved.'" *Id.* at 46 (alteration in original) (quoting *Fujifilm Corp. v. Sony Corp.*, IPR2018-00060, Paper 8 at 7–9 (PTAB Apr. 19, 2018) ("*Fujifilm*"). In addition, Patent Owner argues that *Mercedes-Benz* and *Signify Holding* are distinguishable on their facts. *Id.* at 47.

We agree with Patent Owner that the *General Plastic* framework is applicable to this situation. Indeed, in each of the cases cited by Petitioner, the Board evaluated the *General Plastic* factors when considering a second petition challenging different claims of the same patent. *See Signify Holding*, Paper 16 at 11–15; *Mercedes-Benz*, Paper 9 at 10–15; *see also Fujifilm*, Paper 8 at 7–9.

Also, we disagree with Petitioner's contention that two of our cases (*Mercedes-Benz* and *Signify Holding*) demonstrate that a majority of the *General Plastic* factors weigh in favor of institution. *See* Pet. 71–73. First, these cases are non-precedential decisions of the Board and are not binding on this panel. Second, both cases are readily distinguishable. In *Signify Holding*, "only 29 days elapsed between the filing of the[] two petitions," and there was a lack of overlapping subject matter between the claim sets challenged in the two petitions. *Signify Holding*, Paper 16 at 13. As noted above, however, this Petition was filed over *five months* after the earlier petition, and there are significant overlaps in claimed subject matter. In *Mercedes-Benz*, the petitioner explained that a second petition was being

filed “due to Patent Owner’s assertion of claims in the district court infringement action,” the challenged patent included 67 claims, and the Board was persuaded that “this [was] one of those cases” where more than one petition was necessary. *Mercedes-Benz*, Paper 9 at 7, 10–11. Here, however, Petitioner provides *no explanation* for the second petition or its timing, and the challenged patent includes nineteen, unremarkable claims.

A closer analogy can be found in the Board’s non-precedential decision in *Longi Green Energy Technology Co. v. Hanwha Solutions Corp.*, IPR2020-00047, Paper 18 (PTAB Apr. 27, 2020). In *Longi*, a petitioner filed a first petition challenging just three claims, and then, approximately six weeks after receiving the preliminary response, the petitioner filed a second petition challenging another thirteen claims using many of the same references. Paper 18 at 8–10. The Board evaluated the *General Plastic* factors and, ultimately, decided to exercise discretion to deny the petition. *Longi*, Paper 18 at 8–15.

With that background and context, we consider each of the *General Plastic* factors in this proceeding.

*1. Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent*

Petitioner previously filed a petition directed to the ’429 patent (in the ’099 IPR), but that petition was directed to a different claim set. Although there is overlap in the claimed subject matter involved, Petitioner does not challenge any claim previously challenged.

Accordingly, we determine that this factor weighs against exercising our discretion to deny institution.

*2. Factors 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it*

The Petition relies on Hozumi in combination with Herberger and/or Yamamoto. *See* Pet. 1 (table of grounds). The Hozumi reference is also asserted in the '099 IPR, so Petitioner knew of that reference when it filed the first petition. Regarding the secondary references, Petitioner states that it “prepared and filed the present Petition after searching revealed the additional prior art used to address claims 11–19 (*i.e.*, the Herberger and Yamamoto references).” Pet. 73. Petitioner, however, does not state *when* Herberger and Yamamoto were located. Indeed, Petitioner does not aver affirmatively that the references were found after filing the '099 Petition. Thus, Petitioner’s statement would be accurate if the references were found “after searching” but *before* filing the '099 Petition. *See id.*

Accordingly, this factor weighs in favor of invoking our discretion to deny institution.

*3. Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition*

Petitioner argues that this factor favors institution because “the claims challenged in this Petition, the grounds proposed in this Petition, and the prior art relied upon therein are unique, and are not addressed in the IPR2021-00099 Petition.” Pet. 73–74. Moreover, Petitioner asserts that “the application of the Hozumi reference to overlapping limitations of claims 1–19 is substantially the same in both petitions, and was not updated based on arguments in the Patent Owner Preliminary Response.” *Id.* at 73.

Patent Owner argues that its preliminary response in the '099 IPR “explained why Hozumi does not disclose a ‘plurality of video takes’ meeting the beginning-beginning synchronization requirement.” Prelim. Resp. 46. According to Patent Owner, the Board agreed with Patent Owner in the '099 Institution Decision, and “[t]o the extent” the Petition includes the same analysis, “there is no reason to come to any different conclusion about Hozumi.” *Id.* at 46–47. Patent Owner also argues that, “[t]o the extent Petitioners have included additional analysis in this Petition” that would affect the Board’s finding, “the policies of *General Plastic* highlighting the unfairness of successive petitions against a single patent are in full force.” *Id.* at 46; *see also id.* at 48–49.

On this record, we have some “road mapping” concerns. Although Patent Owner identifies no relevant differences between the instant Petition and the '099 Petition, Petitioner fails to provide any explanation for why the instant Petition was filed nearly two months after receiving Patent Owner’s preliminary response in the '099 IPR. This fact pattern is troubling because there are significant overlaps in the subject matter recited in the challenged claims and because Hozumi is a primary reference in both proceedings. But Petitioner did not have the benefit of the '099 Institution Decision (and the concerns articulated therein) at the time it filed the instant Petition.

Accordingly, this factor weighs slightly in favor of invoking our discretion to deny institution.

4. *Factors 4 and 5: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; and whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent*

As noted above, Petitioner knew of the Hozumi reference when it filed the '099 Petition, and Petitioner does not reveal when it learned of the Herberger and Yamamoto references. Petitioner contends that the two petitions challenge distinct claim sets, but does not provide any other explanation for the filing of two petitions or the time elapsed between them. *See* Pet. 71–72. Moreover, as noted above, we determine that the overlap in claimed subject matter and contentions between the two petitions is significant. On these facts, we are not persuaded that the five-month delay was justified.

Accordingly, these factors weigh in favor of invoking our discretion to deny institution.

5. *Factors 6 and 7: the finite resources of the Board; and the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review*

In view of the substantial overlap between the prior art references and claim limitations in the '099 IPR and the present Petition, the most efficient way to manage the two *inter partes* reviews would be to coordinate or consolidate the proceedings and adopt a common schedule. This might have been possible had Petitioner filed the present Petition at the same time, or shortly after, the '099 Petition. But Petitioner waited five months to file this Petition, and it is no longer feasible for the Board to adjust due dates to

coordinate the proceedings while still meeting the statutory mandate to issue a final written decision in the '099 IPR by April 21, 2022 (approximately six months after this Decision). Thus, instituting a second *inter partes* review would require an entirely separate proceeding involving numerous issues that likely will already have been considered and resolved in the '099 IPR. Our task would be complicated by the fact that the proceedings would have different evidentiary records. Moving forward with separate proceedings involving overlapping issues, but having different evidentiary records and schedules, would have a significant impact on the Board's resources.

Accordingly, these factors weigh slightly in favor of invoking our discretion to deny institution.

#### 6. *Other Considerations*

As noted above, the *General Plastic* factors are non-exhaustive, and other considerations may be relevant to the question of whether the Board should decline to institute trial. That is particularly the case here, where the facts do not align completely with the fact pattern of *General Plastic*, which addressed a “follow-on” petition challenging the same claims of the same patent (also known as a serial petition). Because the same Petitioner challenges different claims in this second Petition, our analysis is informed by those cases in which a petitioner files multiple petitions challenging the same patent at the same time (also known as parallel petitions). The Consolidated Trial Practice Guide provides the following guidance:

Based on the Board's experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden

on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. . . .

Nonetheless, the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references. In such cases two petitions by a petitioner may be needed, although this should be rare.

Consolidated TPG 59.

Petitioner has not explained why it could not have raised all of its challenges to the claims of the '429 patent in a single petition, and we are not persuaded that the facts justify two petitions. The '429 patent includes three independent claims and nineteen total claims, and these claims are neither unusually complex nor lengthy. The two petitions include significant overlaps in claimed subject matter and substantive contentions. Furthermore, even if there were a justification for two petitions, Petitioner does not explain why it did not file those two petitions on or around the same time.

Accordingly, these considerations weigh in favor of exercising our discretion to deny institution.

### 7. Conclusion

We have considered the circumstances and facts before us in view of the *General Plastic* factors and the guidance provided in the Consolidated Trial Practice Guide. No single factor is determinative of whether we exercise our discretion to deny institution under § 314(a), but having evaluated all of the factors on this record, we exercise our discretion under § 314(a) to deny institution of *inter partes* review.

### III. ORDER

It is:

ORDERED that the Petition is denied; and

FURTHER ORDERED that the requested *inter partes* review is not instituted with respect to claims 11–19 of the '429 patent.

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