

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

ALMONDNET, INC. and INTENT IQ, LLC,
Patent Owner.

IPR2022-00953
Patent 8,566,164 B2

Before KRISTEN L. DROESCH, AMANDA F. WIEKER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Roku Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–3, 6–14, 16–18, 20, 21, 23–25, 27, and 28 of U.S. Patent No. 8,566,164 B2 (Ex. 1001, “the ’164 patent”). Intent IQ, LLC (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 7, “Prelim. Resp.”).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). “When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.108(a) (2021).

For the reasons set forth below, upon consideration of the parties’ contentions and the evidence of record, we conclude that Petitioner has not established a reasonable likelihood of prevailing in demonstrating the unpatentability of at least one challenged claim of the ’164 patent. Accordingly, we deny Petitioner’s request and do not institute an *inter partes* review.

B. *Real Parties in Interest*

Petitioner identifies itself as the real party in interest. Pet. 1.

Patent Owner identifies itself as the real party in interest. Paper 5, 1 (Patent Owner’s Mandatory Notices). Patent Owner also identifies AlmondNet, Inc. as a licensee of the ’164 patent.

C. Related Matters

The parties identify the following district court proceedings involving the ’164 patent: *Roku, Inc. v. AlmondNet, Inc.*, 1:21-cv-01035 (D. Del.); *AlmondNet, Inc. v. Roku, Inc.*, 6:21-cv-00731 (W.D. Tex.); and *AlmondNet, Inc. v. Samsung Electronics Co., Ltd.*, 6:21-cv-00891 (W.D. Tex). Pet. 1; Paper 5, 1.

D. The ’164 Patent

The ’164 patent “relates to online access and targeted delivery or presentation of advertisements.” Ex. 1001, 1:7–8. Specifically, the ’164 patent describes targeting online advertisements “based on observed viewing of or interacting with a television advertisement by a television viewer.” *Id.* at 1:8–11. The ’164 patent explains that tracking and recording user behavior in one medium, such as television, in response to observed behavior in another medium, such as the internet, is desirable to “enable an advertiser to target future ads more accurately, to evaluate the effectiveness of particular ads or ad campaigns, or for other purposes.” *Id.* at 8:65–67. Yet, the use of dynamic device addresses that enable online access creates significant technological problems for cross-media targeting and tracking of ads. *Id.* at 8:67–9:3.

Figure 2 of the ’164 patent is reproduced below.

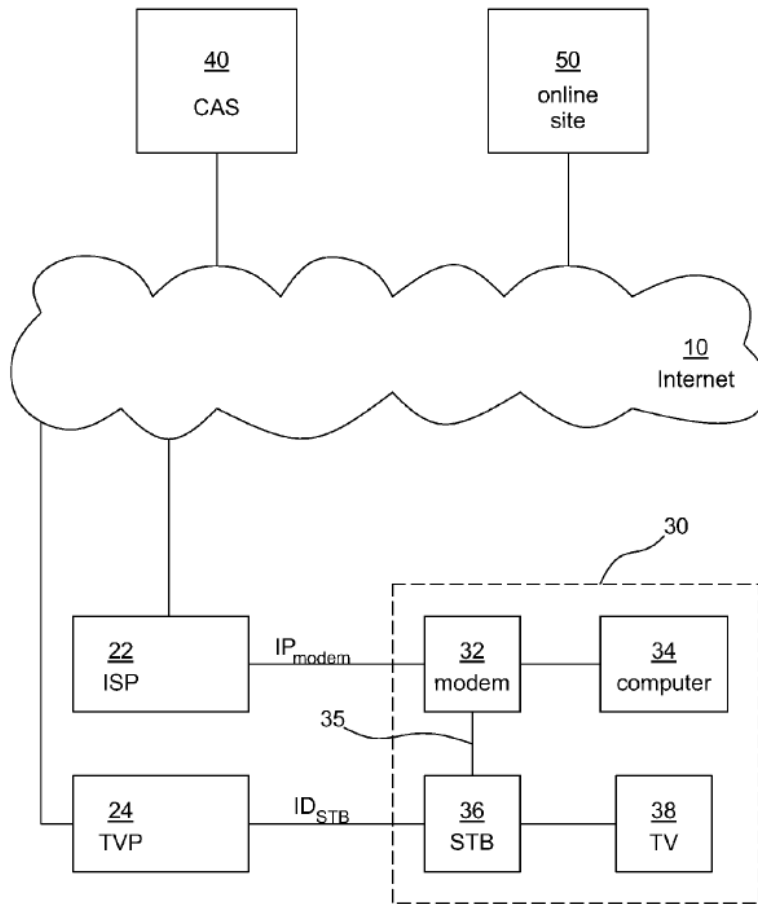


FIG. 2

Figure 2 illustrates schematically a system for targeting online advertisements based on television viewing or interacting behavior, where the user's modem includes a modem IP address that is shared by a set-top box (STB). Ex. 1001, 10:14–21.

In Figure 2, “a user's modem 32 (an online access device) is connected to Internet service provider (ISP) 22 for providing online access via computer 34 (an online user interface device), and that user's STB 36 is connected to television provider (TVP) 24 to provide television service via television 38.” *Id.* at 12:2–8. “[C]onnection 35 between the user's modem 32 and the user's STB 36 enables STB 36 also to obtain online

access via the same IP address as the user's online access (i.e., via modem 32)." *Id.* at 12:55–59. By this arrangement, "a user's STB 36 can periodically contact a CAS [(central ad server)] 40 (or multiple CASs) via the IP address of the user's modem 32 that is therefore common to STB 36." *Id.* at 18:61–64. This "common IP address can, at least initially, comprise the electronic association that enables targeted online advertising or tracking/recording based on observed user behavior related to a television advertisement." *Id.* at 19:20–24. In an exemplary embodiment, "STB 36 can be connected to a local area network (LAN) that shares modem 32 for online access," so that "network traffic is routed to a common IP address (i.e., the IP address of modem 32) for STB 36 and other devices connected to the LAN." *Id.* at 19:24–28. Therefore, a "user can receive online access from any online service provider via any suitable modem 32 (from cable, DSL, wireless, satellite, or any other transmission system) or other suitable online access device and can receive television service from any suitable television service provider through STB 36." *Id.* at 19:28–34.

E. Illustrative Claims

Of the challenged claims, claims 1, 16, and 23 are independent. Each of challenged claims 2, 3, 6–14, 17, 18, 20, 21, 24, 25, 27, and 28 depend, either directly or indirectly, from claims 1, 16, or 23. Claim 1, reproduced below, is illustrative of the claimed invention.

1. A method implemented using a programmed hardware computer system coupled to the Internet, the method comprising:

(a) with the computer system automatically causing, in response to online activity from a first online user interface device, a first selected online advertisement to be directed to the first online user interface device, which online user interface device corresponds, at a time the first selected online advertisement is directed, to a first online access identifier;

(b) wherein the first selected online advertisement is selected based on information from a first user profile, which first user profile references or includes a first set-top box identifier that the computer system has electronically associated with the first online access identifier;

(c) wherein the information in part (b) is derived at least in part from automatically collected first data related to user behavior with respect to at least one television advertisement delivered to a set-top box, which set-top box corresponds, at a time of that user behavior, to the first set-top box identifier; and

(d) wherein the first set-top box identifier and the first online access identifier are associated without using personally identifiable information pertaining to either a user of the first online user interface device or a user of the set-top box that corresponds to the first set-top box identifier, based on automatically recognizing that the online user interface device corresponding to the first online access identifier and the set-top box corresponding to the first set-top box identifier are connected, independently of each other, to a common local area network.

Ex. 1001, 24:43–25:8.

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–3, 6–14, 16–18, 20, 21, 23–25, 27, and 28 are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–3, 6, 12, 14, 16–18, 21, 23–25, 28	103(a)	Madhavan, ² Whitehead ³
7, 8	103(a)	Madhavan· Whitehead, Vallier ⁴
9, 10, 13	103(a)	Madhavan· Whitehead, Varghese ⁵
11, 20, 27	103(a)	Madhavan· Whitehead, Beyda ⁶

Petitioner also relies on a Declaration of Dr. Samrat Bhattacharjee, filed as Exhibit 1003.

II. ANALYSIS

A. Legal Standards

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) if in evidence, “secondary considerations” of non-obviousness such as

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the application that lead to the issuance of the ’164 patent was filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability. *See* Ex. 1001, code (22).

² US 8,180,674 B2, issued May 15, 2012, filed Oct. 3, 2006 (Ex. 1008).

³ US 2008/0281697 A1, published Nov, 13, 2008, filed June 29, 2007 (Ex. 1015).

⁴ US 9,495,682 B2, issued Nov. 15, 2016, filed Aug. 31, 2006 (Ex. 1011).

⁵ US 7,908,645 B2, issued Mar. 15, 2011, filed Apr. 28, 2006 (Ex. 1016).

⁶ US 9,928,522 B2, issued Mar. 27, 2018, filed Dec. 17, 2004 (Ex. 1014).

“commercial success, long-felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in any particular case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that “it is error to reach a conclusion of obviousness until all those factors are considered,” *WBIP v. Kohler*, 829 F.3d 1317, 1328 (Fed. Cir. 2016).⁷

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Env’t. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376,

⁷ Because neither party addresses objective evidence of non-obviousness, we focus solely on the first three *Graham* factors.

1381–82 (Fed. Cir. 1983)). “Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case.” *Id.*

Petitioner contends that a person having ordinary skill in the art (“POSITA”) “would have a bachelor’s or the equivalent degree in electrical and/or computer engineering or a related field and 2–3 years of experience in computer and networking systems including systems for online content delivery such as targeted advertisements,” and that more experience might compensate for less formal education or vice versa. Pet. 9 (citing Ex. 1003 ¶ 15). Patent Owner does not address the level of ordinary skill in the art. *See* Prelim. Resp.

For purpose of this proceeding, we adopt the Petitioner’s proposed level of skill.

C. Claim Construction

In *inter partes* review proceedings based on petitions filed on or after November 13, 2018, such as this one, we construe claims using the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), as articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. *See* 37 C.F.R. § 42.100(b). In applying that standard, claim terms generally are given their ordinary and customary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips*, 415 F.3d at 1312–13.

Petitioner asserts that “no claim term requires express construction,” and so the “Petition analyzes the claims consistent with ordinary and customary meaning as would be understood by POSITA in light of the

specification.” Pet. 9. Patent Owner does not address claim construction. *See* Prelim. Resp.

At this juncture, we do not discern a dispute between the parties regarding the meaning of any claim limitations, nor do we discern the need to expressly construe any claim limitations to resolve the controversy before us. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Obviousness over Madhavan and Whitehead

Petitioner asserts that claims 1–3, 6, 12, 14, 16–18, 21, 23–25, and 28 would have been obvious over Madhavan and Whitehead. Pet. 15–65.

1. Overview of Madhavan

Madhavan discloses “a system and method to facilitate targeting of advertisements based on mutual information sharing between devices over a network, such as the Internet.” Ex. 1008, 1:8–11. When a user connects to a media device and performs a specific action, such as watching a broadcast television program on the network-enabled television set, the action is transmitted to the entity via the network and is “stored within the entity along with respective categories associated with each user action.” *Id.* at 1:55–62. If the user subsequently connects to the entity through a client machine and the network, “then the entity selects advertisements to be displayed within the display area of the client machine along with content information requested by the user, such that each selected advertisement is related to the previously stored events or actions and their respective categories.” *Id.* at 1:64–2:3.

Figure 1 of Madhavan is reproduced below.

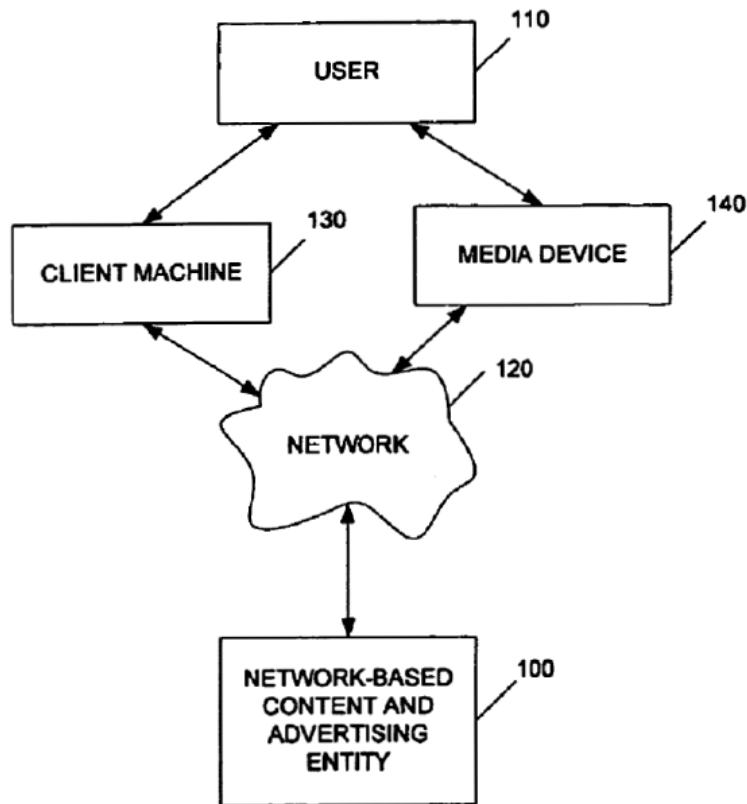


Figure 1 depicts a block diagram showing a conventional network architecture. Ex. 1008, 2:14–15.

As shown in Figure 1, “entity 100 is coupled via a network 120 to one or more user entities 110, such as, for example, users and/or agents of such users.” Ex. 1008, 4:37–39. User entities 100 are coupled to network 120 through client machine 130 and at least one media device 140. *Id.* at 4:39–42. Examples of client device 130 include “a cellular phone, a PDA or other wireless device.” *Id.* at 5:8. Media devices 140 can include a “network-enabled television set” and a “digital video recording device.” *Id.* at 9:9–13.

2. Overview of Whitehead

Whitehead relates to “collecting addressability information about users accessing a service provider’s IP-based network communication

services, collecting information sufficient to identify when the user is accessing the . . . services, collecting data from video services usage by the user and using the collected data to associate the user with certain marketing content.” Ex. 1015, code (57). Whitehead discloses a system for delivering IP-based services as shown in Whitehead’s Figure 1. *Id.* ¶ 29. The system 20 includes a user 30, which “can be an individual or group that uses IP-based services provided by and through the service provider 40.” *Id.* ¶ 30. User interface module 32 provides a way for user 30 to connect a device to service provider 40’s infrastructure and interact with IP-based services. *Id.* ¶ 31. For example, “user interface module 32 can comprise a private network that contains multiple IP-enabled devices, e.g., PCs, laptops, set-top boxes, etc. all accessed through a single IP connection managed by a home-router.” *Id.* ¶ 80.

When using the IP-based services, “[t]he period in time during which a specific user 30 is associated with a specific IP address can be the user’s IP access session.” *Id.* ¶ 69. An IP address can be used to associate information collected during an IP access session with user 30 so that it can be “used later in that session to send marketing content addressed to the IP access session IP address over an IP-based communication channel or processed and associated with the user 30 for subsequent use.” *Id.* ¶ 78. In a particular embodiment for providing targeted marketing services, Whitehead’s system can collect “receptiveness information,” which is “information that pertains to an individual’s or a group’s potential receptiveness to marketing content, e.g., a propensity to purchase a product.” *Id.* ¶¶ 83, 85. “The continuity of the association between the user 30 and an IP address during an IP access session can allow any receptiveness

information keyed to the IP address during the IP access session to be associated with the user 30.” *Id.* ¶ 109.

Whitehead’s Figure 5, which Petitioner focuses on, shows a way of associating IP address-keyed receptiveness information to users. *Id.* ¶ 110. As shown in Figure 5, block 330 represents IP access session information indicating, for example, the allocation of “IP address A to user (User1) with user ID A1 at time 1.0,” and the de-allocation of “IP address A from User1 at time 5.3.” *Id.* ¶ 112. Block 310 represents “mytes of receptiveness information generated using IP Address A over a given period of time,” where “[a] myte can be defined as an individual unit of marketing information.” *Id.* ¶ 110. For instance, “Block 312 can represent an RI-myte generated at time 4.8 (RI-myte A4.8)” and “Block 314 can represent an RI-myte generated at time 5.2 (RI-myte A5.2).” *Id.* Whitehead explains that, “[by] combining the information available in Block 310 with the information available in Block 330, the service provider 40 can associate each RI-myte with the user ID using IP address A when the RI myte was generated,” as shown in block 340. *Id.* ¶ 113. Additionally, block 350 represents “user account information maintained by the service provider 40.” *Id.* ¶ 114. “By combining the information available in Block 350 with the information available in Block 340, the service provider 40 can associate each RI-myte with a specific user and other information associated with that user,” as shown in block 360. *Id.*

3. *Reasonable Likelihood Analysis*

Based on the current record, Petitioner does not sufficiently show that the combination of Madhavan and Whitehead teaches or suggests “wherein the first set-top box identifier and the first online access identifier are

associated without using personally identifiable information,” as recited in claim 1.

Petitioner argues that the combination of Madhavan and Whitehead teaches a “first online user interface device identifier” and a “first set top box identifier.” *See* Pet. 25–37. Specifically, Petitioner argues that Madhavan’s client machine 130 and media device 140 respectively teach “a first online user interface device” and “a first set-top box” (*id.* 28 (citing Ex. 1003 ¶ 64)), that “Whitehead describes providing device identifiers for identifying the respective devices and for tracking user behavior” (*id.* at 28 (citing Ex. 1015 ¶¶ 41, 66, 101, 118, 123; Ex. 1003 ¶ 64)), and that a person having ordinary skill in the art would have used “device identifiers for identifying a device and linking associated data in Madhavan and Whitehead” (*id.* at 28–29 (citing Ex. 1003 ¶ 65; Ex 1016, 24:50–25:53)). Further, Petitioner argues that “Whitehead describes that the devices in a common local area network and their identifiers are associated without using any personally identifiable information (PII).” *Id.* at 42 (citing Ex. 1003 ¶ 88). In particular, Petitioner relies on the embodiment shown in Whitehead’s Figure 5, and we reproduce Petitioner’s annotated version below.

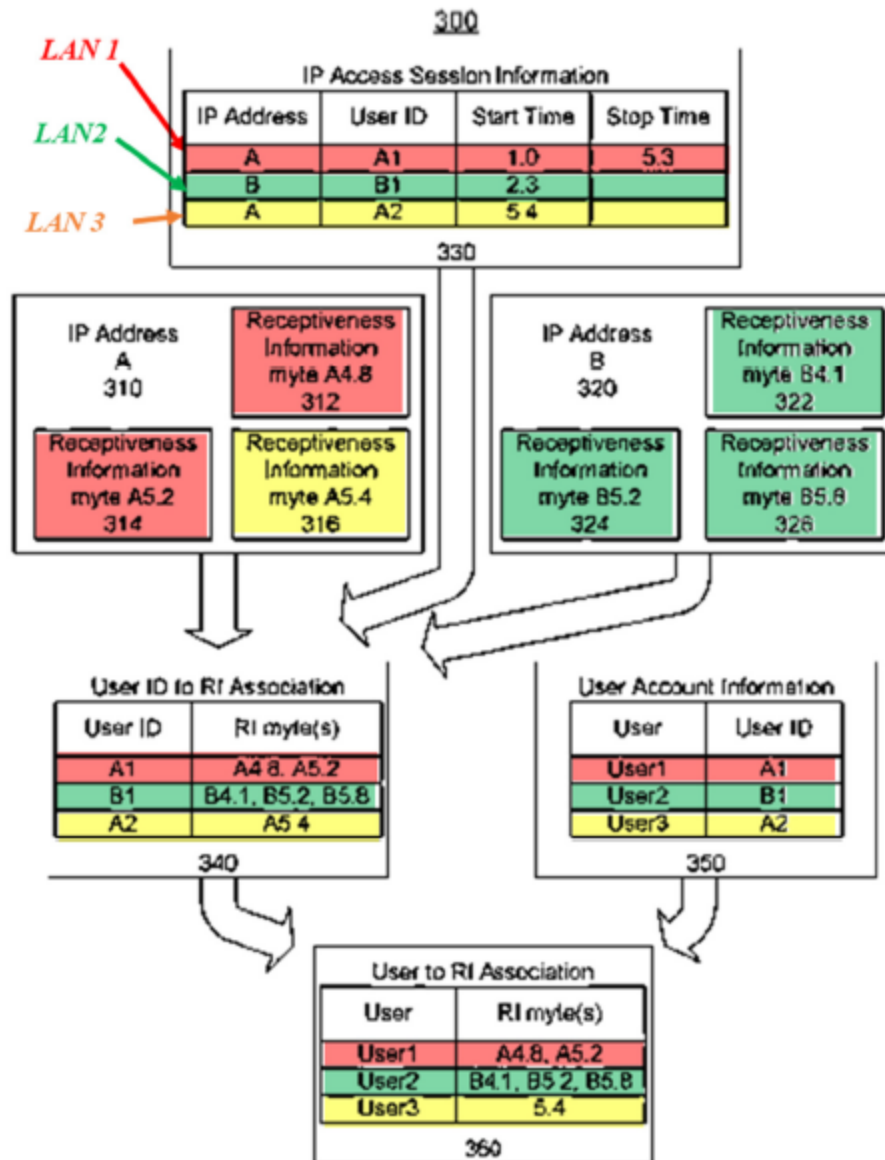


Figure 5

ROKU-1015, FIG. 5, annotated

Pet. 44. Whitehead Figure 5 “is a block diagram showing relationships between information to enable associating IP address-keyed receptiveness information to users, according to an exemplary embodiment.” Ex. 1015

¶ 12. Petitioner has annotated the drawing with colors to indicate users A1 (red), B1 (green), and A2 (yellow). Pet. 44.

Petitioner argues that by using IP access session information, “Whitehead associates user devices (e.g., PCs, set-to[p] boxes, etc.) coupled to a common home network and their corresponding device IDs using non-PII information.” Pet. 44–45 (citing Ex. 1015 ¶¶ 69, 80, claim 3; Ex. 1003 ¶ 89). Specifically, Petitioner argues that a person having ordinary skill in the art “would have understood that as shown in annotated FIG. 5 of Whitehead, RI-mytes of the same annotated color . . . include usage data collected from different user devices and their corresponding device identifiers are associated,” where “Whitehead describes that a receptiveness information myte (RI-myte) may include a corresponding device ID.” *Id.* at 45–46 (citing Ex. 1015 ¶ 246; Ex. 1003 ¶¶ 90–92). In addition, Petitioner argues that Whitehead’s “using the IP session information identified by an IP address and timestamp achieves anonymous marketing using non-PII information, and the desirability of anonymous marketing techniques that use non-PII information.” *Id.* at 47.

Patent Owner disagrees with Petitioner’s argument that Whitehead teaches associating identifiers without using PII and, instead, argues that “Whitehead’s Figure 5 performs what the Petition alleges to be an association of device identifiers by using both ‘User’ and ‘User ID’ information . . . which Whitehead discloses as constituting PII.” Prelim. Resp. 6–7. In particular, Patent Owner argues that “Whitehead’s Figure 5 can only arrive at the association of RI mytes to users in Block 360 by using the ‘User’ and ‘User ID’ fields of in Blocks 330, 340, and 350.” *Id.* at 11. Patent Owner argues that the “User ID” field contains personally identifiable information because “Whitehead describes the ‘User ID’ of Figure 5 as a ‘unique user ID assigned to the user 30 by the service provider 40’” and “makes it painfully clear that the ‘unique user ID’ used in Figure 5 qualifies

as ‘direct identification information’—i.e., ‘information that . . . directly . . . identifies the user.’” *Id.* at 12 (quoting Ex. 1015 ¶ 75). Patent Owner further argues that the “User” field contains personally identifiable information because “the ‘User’ data relied upon by the Figure 5’s process includes the actual identity of the user.” *Id.* at 14. In addition, Patent Owner argues that certain other portions of Whitehead that Petitioner cites regarding anonymous techniques that use non-PII are unrelated to the Figure 5 embodiment, and that Petitioner fails to explain why one would have modified Figure 5 to make associations between device identifiers without using PII. *Id.* at 15–19. We agree with Patent Owner’s arguments.

The gravamen of Petitioner’s argument is that Whitehead Figure 5 shows how RI mytes from different devices on the same network can be automatically associated—as seen in Blocks 340 and 360—without using PII. *See* Pet. 42–48; *see also id.* at 42–43 (“Specifically, as shown in FIG. 5 below, Whitehead describes using IP access session information to associate devices and their RI-mytes.”), 45 (“Using the corresponding IP access session information, the associated usage data and device identifiers are associated to the same user ID (e.g., ‘User1,’ ‘User2,’ and ‘User3’ respectively) representing the corresponding user profile.”). However, Whitehead Figure 5 uses PII in making that association.

Specifically, Whitehead describes how “[b]y combining the information available in Block 310 with the information available in Block 330”—which includes the “User ID”—“the service provider 40 can associate each RI-myte with the user ID using IP address A when the RI myte was generated.” *Id.* at Fig. 5, ¶ 113. Because of that association, “the service provider 40 can associate RI-mytes A4.8 and A5.2 with user ID A1, RI-mytes B4.1, B5.2 and B5.8 with user ID B1 and RI-myte A5.4 with user

ID A2 as represented in Block 340.” *Id.* ¶ 113. Whitehead further describes how “Block 350 can represent user account information maintained by the service provider 40 in at least one module” and that “[t]he user account information can associate each user with the user’s user ID.” Ex. 1015 ¶ 114. According to Whitehead, “[b]y combining the information available in Block 350 with the information available in Block 340, the service provider 40 can associate each RI-myte with a specific user and other information associated with that specific user.” *Id.* Stated differently, Whitehead Figure 5 teaches using, *inter alia*, a “User ID” in associating the RI mytes with the users and their devices. But that User ID is personally identifiable information. *See* Ex. 1001, 7:61–62 (“Personally Identifiable Information (PII)—information that can be used to identify a specific person.”).

Moreover, in describing the association between RI-mytes and Users in block 360 of Figure 5, Whitehead states that “[t]his association with each specific user can include association with each specific user’s name, address, telephone number or any other addressability information associated with the specific user.” Ex. 1015 ¶ 114. The Specification of the ’164 patent defines PII as including “name, . . . street address, . . . phone number (home, work, wireless), . . . or any other information that can assist in identifying a specific person.” Ex. 1001, 7:44–53. Accordingly, one of ordinary skill in the art would have understood that Whitehead’s “User” field contains “personally identifiable information” as recited in claim 1.

Petitioner stresses Whitehead teaches “associating devices of . . . user 30 with an IP address for each IP access session.” Pet. 46; *see also id.* at 20 (referring to “Whitehead’s teachings of associating devices of a common local area network based on a common IP address of a

corresponding router”). But to be clear, the fact that Whitehead’s Figure 5 embodiment associates RI-mytes (and included device identifiers) in part by using non-PII, for example, a dynamic IP address, does not show that Whitehead teaches associating device identifiers *without* PII as claimed. Petitioner makes no argument that Whitehead’s User IDs are not PII (*see id.* at 42–48) and, as discussed above, Whitehead’s Figure 5 uses the User IDs in Blocks 330, 340, and 360 as part of its association.

To the extent Petitioner asserts that the combination of an IP address and a timestamp is sufficient to associate two device identifiers without using PII,⁸ Whitehead’s Figure 5 does not expressly show making an association between RI-mytes based on timestamps without using User IDs. Rather, as discussed above, RI-mytes are associated in block 340 of Figure 5 with the “User ID” field. Moreover, Petitioner does not specifically explain why one would want to make a modification to Figure 5 to perform an association with a timestamp but not a User ID. *See id.* at 42–48.

We are also not persuaded by Petitioner’s general reliance on Whitehead’s various disclosures regarding the use of non-PII information. Pet. 47. Namely, Whitehead describes that “[t]he distinction between PII and non-PII addressability information can be important to targeted marketers because anonymous marketing techniques can be considered more desirable, from a privacy standpoint, than non-anonymous marketing techniques.” Ex. 1015 ¶ 88. Whitehead also describes that “the use of an IP

⁸ *See* Pet. 43 (“Each IP access session is identified by a timestamp and an IP address of a router of a local area network, e.g., IP address ‘A’ and timestamp [1.0-5.3] for LAN 1 (annotated in red).”); *id.* at 47 (“[T]he IP session information identified by an IP address and timestamp achieves anonymous marketing using non-PII information.”).

address and timestamp to identify the TAM [target audience member] can be selected where the service provider 40 wishes to operate the marketing service in an anonymous manner.” *Id.* ¶ 207. Petitioner also points to Whitehead’s claim 6 (Pet. 44), which recites that “associating the user with addressability information does not involve the association of personally identifiable information” (Ex. 1015, p. 25). Petitioner does not show, however, that these disclosures relate to forming an association between RI-mytes (and included device identifiers) in Whitehead’s Figure 5 embodiment upon which Petitioner primarily relies. *See* Pet. 47. Nor has Petitioner specifically explained why, in view of these disclosures, one of ordinary skill in the art would have associated RI-mytes from the different devices in the Figure 5 embodiment without using the “User ID” field.

In conclusion, having reviewed the Petition and Patent Owner’s arguments in opposition, we determine that Petitioner has not shown a reasonable likelihood of prevailing on its assertion that claim 1, and similar independent claims 16 and 23, would have been unpatentable as obvious over Madhavan and Whitehead. Because of their dependence from claims 1, 16, and 23, we therefore determine that Petitioner has also failed to demonstrate a reasonable likelihood of prevailing on its assertion that claims 2, 3, 6, 12, 14, 17, 18, 21, 24, 25, and 28 would have been unpatentable as obvious over Madhavan and Whitehead.

E. Remaining Grounds

Petitioner asserts that claims 7 and 8 would have been obvious over Madhavan, Whitehead, and Vallier. Pet. 66–69. Petitioner further asserts that claims 9, 10, and 13 would have been obvious over Madhavan, Whitehead, and Varghese. Pet. 69–76. And Petitioner further asserts that claims 11, 20, and 27 would have been obvious over Madhavan, Whitehead,

and Beyda. Pet. 76–80. None of these grounds addresses the deficiencies identified above with respect to the “without using personally identifiable information” contentions in the Petition for independent claims 1, 16, and 23. Accordingly, we determine that the remaining grounds, because they challenge claims that directly or indirectly depend from claims 1, 16, and 23, also fail to show the reasonable likelihood threshold of institution.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not established a reasonable likelihood of prevailing on its assertion that any of claims 1–3, 6–14, 16–18, 20, 21, 23–25, 27, and 28 of the ’164 patent are unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2022-00953
Patent 8,566,164 B2

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