

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.

IPR2022-00959
Patent 8,595,069 B2

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

DROESCH, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Roku, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 3–5, 8–18, 20–25, and 27–31 of U.S. Patent No. 8,595,069 B2 (Ex. 1001, “the ’069 Patent”). Paper 2 (“Pet.”). Petitioner filed a Declaration of Samrat Bhattacharjee, Ph.D. with its Petition. Ex. 1003. Intent IQ, LLC (“Patent Owner”)¹ timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted unless it is determined that “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).

For the reasons provided below, we determine, based on the record before us, that Petitioner has not established a reasonable likelihood Petitioner would prevail in showing at least one of the challenged claims is unpatentable.

B. Related Matters

The parties indicate the ’069 Patent is the subject of *Roku, Inc. v. AlmondNet, Inc.; et al.*, 1:21-cv-01035 (D. Del.) and *AlmondNet, Inc., et al. v. Roku, Inc.*, 6:21-cv-00731 (W.D. Tex.). Pet. 1–2; Paper 4, 1.

¹ Patent Owner indicates AlmondNet, Inc. is a licensee. Paper 4, 1.

C. The '069 Patent (Ex. 1001)

The '069 Patent relates to “online advertisements [that] are targeted based on observed viewing of or interacting with a television advertisement by a television viewer.” Ex. 1001, 1:16–18. The '069 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 9:3–7. The '069 Patent discloses that the use of PII [(Personally Identifiable Information)] or not, and dynamic device addresses” must be addressed for cross-media targeting and cross-media tracking. *Id.* at 9:7–10.

Figure 2 of the '069 Patent is reproduced below.

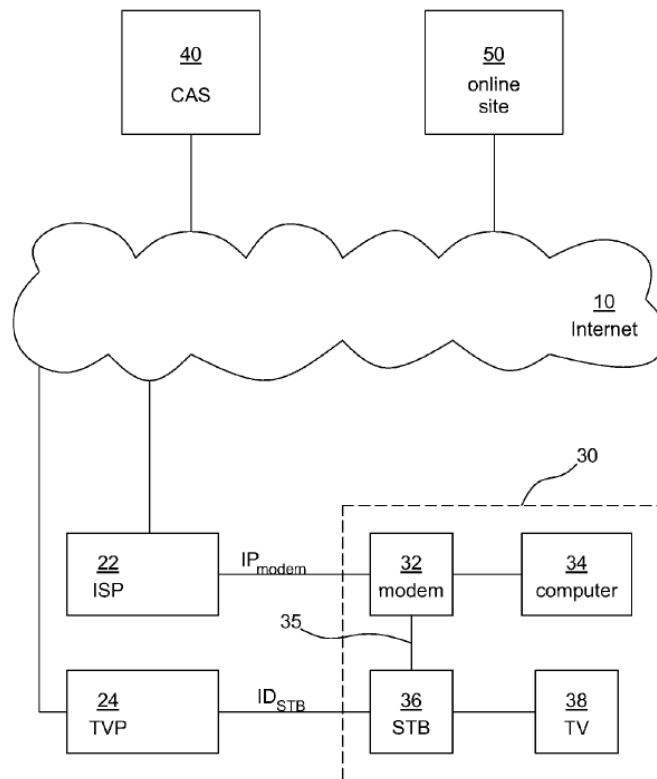


Figure 2 depicts a schematic illustration of a system for targeting online advertisements based on television viewing or interacting behavior, where the user's modem includes a modem IP address that is shared by a set-top box (STB). *See* Ex. 1001, 10:20–30. As illustrated in Figure 2, the user's modem 32 (an online access device) is connected to Internet service provider (ISP) 22 to provide online access via computer 34 (an online user interface device), and the user's STB 36 is connected to television provider (TVP) 24 to provide television service via television 38. *See id.* at 12:11–16.

Connection 35 between modem 32 and STB 36 enables STB 36 to obtain online access via the same IP address as the user's online access (i.e., via modem 32). *See id.* at 12:64–67. By this arrangement, the user's STB 36 can periodically contact a central ad server (CAS) 40 (or multiple CASs) via the IP address of modem 32. *See id.* at 19:2–4. 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 19:27–30. 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 19:31–35.

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) . . . and can receive television service from any suitable television service provider through STB 36.” *Id.* at 19:35–40.

The common IP address enables delivery of targeted online ads to modem 32 based on television access through STB 36 having the common IP address (or based on other user profile information derived from television activity observed as

originating from the STB IP address of STB 36, i.e., from the common IP address). The existence of the common IP address associates the online access IP address and the set-top box IP address. This need not necessarily include PII.

Ex. 1001, 19:56–63.

D. Illustrative Claim

Claims 1, 18, and 25 are independent. Claims 3–5 and 8–17 depend from claim 1, claims 20–24 depend from claim 18, and claims 27–31 depend from claim 25. *See* Ex. 1001, 24:50–28:32. Claim 1 is illustrative and reproduced below.

1. A computer-implemented method of dealing with online activity of a first user having a first set-top box and a first online user interface device, the method comprising:

(a) receiving at a computer a notification, wherein the notification: (i) includes or references a first set-top box identifier, and (ii) results from and signifies a first television advertisement presented using the first set-top box that corresponds to the first set-top box identifier; and

(b) using the notification, automatically with the computer causing a first action to be taken with respect to online activity through the first online user interface device subsequent to presentation of the first television advertisement, which first online user interface device corresponds, at a time of the first action, to a first online user interface device identifier;

(c) wherein the first online user interface device identifier and the first set top box identifier are associated without using personally identifiable information pertaining to a user of the set-top box that corresponds to the first set-top box identifier, based on automatically recognizing that the first online user interface device corresponding to the first online user interface device identifier and the first 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, 24:50–25:8.

E. Asserted Patentability Challenges and Asserted Prior Art

Petitioner asserts that claims 1, 3–5, 8–18, 20–25, and 27–31 are unpatentable based on the following grounds (Pet. 10):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3–5, 8, 17, 18, 20, 21, 25, 27, 28	103(a) ²	Madhavan ³ , Whitehead ⁴
9, 10	103(a)	Madhavan, Whitehead, Vallier ⁵
11–16, 22–24, 29–31	103(a)	Madhavan, Whitehead, Varghese ⁶

II. ANALYSIS

A. Claim Construction

In an *inter partes* review proceeding, the Board applies the same claim construction standard as applied in federal courts in a civil action under 35 U.S.C. § 282(b), which is generally referred to as the *Phillips* standard. *See* 37 C.F.R. § 42.100(b) (2021); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under the *Phillips* standard, “words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips*, 415 F.3d at 1312.

According to Petitioner, “for the purposes of this proceeding and the analysis presented herein, no claim term requires express construction.” Pet. 9. Patent Owner does not address claim construction. *See* Prelim. Resp.

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the application that issued as the ’069 Patent was before to March 16, 2013, we apply the pre-AIA version of § 103. *See* Ex. 1001, code (22).

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

⁴ US 2008/0281697 A1, published Nov. 13, 2008 (Ex. 1015).

⁵ US 9,495,682 B2, issued Nov. 15, 2016 (Ex. 1011).

⁶ US 7,908,645 B2, issued Mar. 15, 2011 (Ex. 1016).

As demonstrated in the analysis below, we need not construe expressly any claim terms or phrases 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))).

B. The Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art “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.” Pet. 9 (citing Ex. 1003 ¶ 15). According to Petitioner, “a person with less formal education but more experience, or more formal education but less experience, could have also met the relevant standard for [a person of ordinary skill in the art].” *Id.* (citing Ex. 1003 ¶ 15). Patent Owner does not comment on Petitioner’s definition and does not offer an alternate definition. *See* Prelim. Resp. We adopt Petitioner’s definition of a person of ordinary skill in the art because it is consistent with the level of skill reflected by the ’069 Patent Specification and the asserted prior art.

C. Principles of Law

A claim is unpatentable under 35 U.S.C. § 103 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 the 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) if in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).⁷

D. Patentability Challenge to Claims 1, 3–5, 8, 17, 18, 20, 21, 25, 27, and 28 over Madhavan and Whitehead

1. Overview of Madhavan (Ex. 1008)

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.

⁷ Neither Petitioner nor Patent Owner present evidence related to secondary considerations.

Figure 1 of Madhavan is reproduced below.

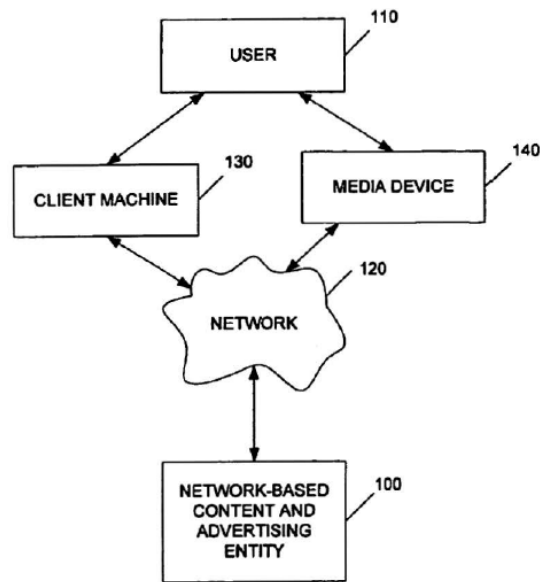


Figure 1 depicts a block diagram showing a conventional network architecture. *See* Ex. 1008, 2:14–15. Network-based content and advertising entity 100 enables automatic matching of advertising information to events or actions and interests of users. *See id.* at 4:28–31. Entity 100 is coupled via network 120 to one or more user entities 110, i.e., users, which are coupled to network 120 through client machine 130 and/or at least one media device 140. *See id.* at 4:37–41. When user 110 “inputs various data and initiates multiple events or actions, such as, for example, advertisement clicks, search queries, search clicks, sponsored listing clicks, page views, advertisement views, or other types of events,” web servers within “entity 100 transmit content information related to the user actions via the network 120 to be displayed on the client machine 130 for the user 110.” *Id.* at 8:1–8.

2. Overview of Whitehead (Ex. 1015)

Whitehead is directed to systems and methods that collect addressability information about users accessing a service provider’s IP-

based network communication services, and send marketing content to the user through various distribution channels by using the addressability information. Ex. 1015, code (57). Whitehead describes a system that can comprise a user, a user interface module, a service provider, and an external service module. *See id.* ¶ 29. The user can be an individual, or a group that uses IP-based services provided through a service provider, such as “residential broadband data service [is] provided to a family, [or] enterprise data services provided to employees of a company.” *Id.* ¶ 30. Where the user interface module implements at least one network, it “can provide local networking functions, including, but not limited to, local address assignment, host configuration, network address translation, security and access control.” *Id.* ¶ 32. “The user interface module [] can comprise a wide range of devices, software, applications, equipment and cabling including, but not limited to, PCs, laptops, IP-enabled mobile devices (handheld computers, cellular telephones), telephones, cameras, microphones, displays, televisions, set-top-boxes.” *Id.* ¶ 33. “The user interface module [also] 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.

Whitehead discloses that when using the IP-based services, “[t]he period in time during which a specific user [] is associated with a specific IP address can be the user’s IP access session.” Ex. 1015 ¶ 69. Whitehead further discloses:

For each IP access session, the user 30 can be associated uniquely with an IP address. This property can have two important implications: 1) for each IP access session, the IP address can be used to identify the user 30 and can be used to

communicate with the user 30 for the duration of the IP access session; and 2) any information collected during the IP access session concerning the use of services and based on the IP address can be associated with the user 30. Thus, any IP service usage that reveals relevant marketing information about the user 30 can be collected during the IP access session and 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.

Ex. 1015 ¶ 78.

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." Ex. 1015 ¶¶ 83, 85, Fig. 3. "The continuity of the association between the user [] 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." *Id.*

¶ 109.

Figure 5 of Whitehead is reproduced below.

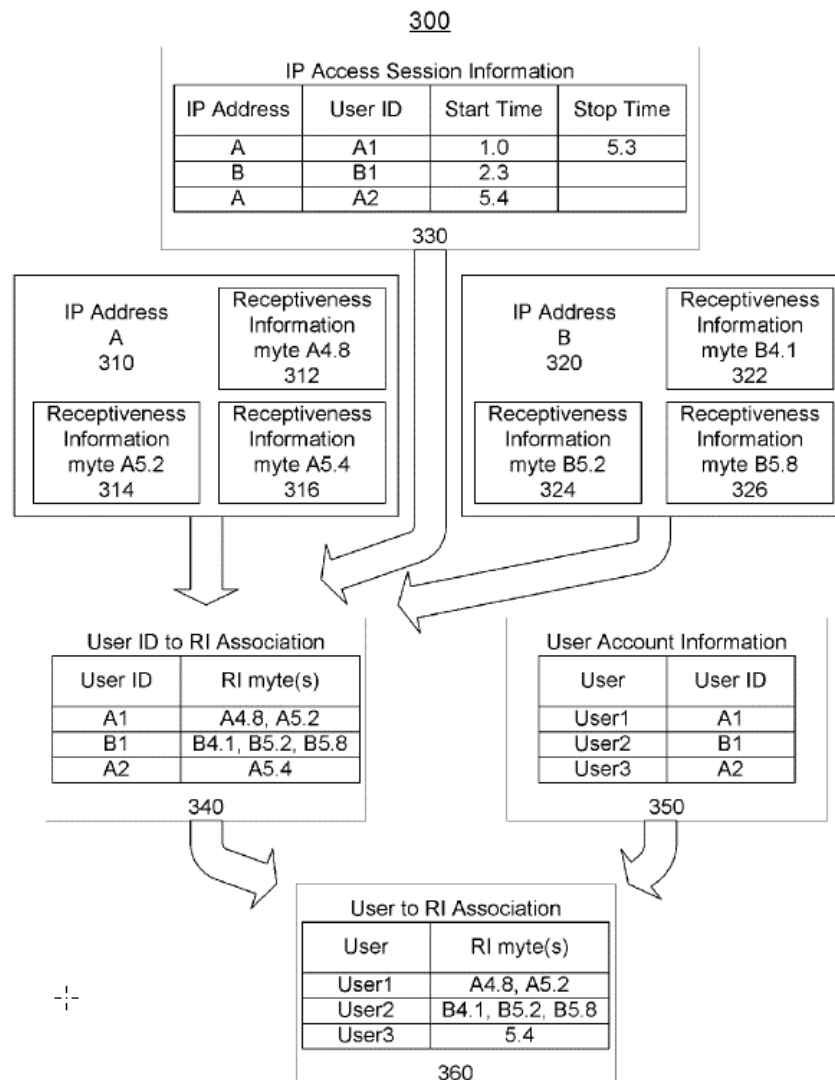


Figure 5 depicts “a block diagram showing relationships between information to enable associating IP address-keyed receptiveness information to users.” Ex. 1015 ¶¶ 12, 110. Block 330 represents IP access session information indicating, for example, the allocation of “IP address A to user (User1) with 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 example, “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. Analysis of Independent Claim 1

Based on the current record, Petitioner does not sufficiently show that the combination of Madhavan and Whitehead teaches or suggests “wherein the first online user interface device identifier and the first set-top box identifier are associated without using personally identifiable information pertaining to a user of the set top box that corresponds to the first set-top box identifier,” as recited in claim 1.

Petitioner asserts that the combination of Madhavan and Whitehead teaches a “first online user interface device identifier” and a “first set top box identifier” corresponding respectively to an online user interface of client machine and set-top box of media device 140. *See* Pet. 27–38. Specifically, Petitioner contends that Madhavan’s client machine 130 and media device 140 respectively teach “a first online user interface device” and “a first set-top box” (*see id.* at 27 (citing Ex. 1003 ¶¶ 52–59)), Whitehead describes user device IDs and set top box IDs (*see id.* at 27–28

(quoting Ex. 1015 ¶¶ 41, 66, 101, 118, 123)), and that “it would have been obvious to provide device identifiers for identifying the respective devices and tracking user behavior, as described in Whitehead” (*id.* at 27 (citing Ex. 1003 ¶ 61)). More specifically, Petitioner relies on the embodiment shown in Whitehead’s Figure 5, and asserts 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 39–40 (citing Ex. 1003 ¶ 79).

Petitioner’s annotated version of Whitehead’s Figure 5 (Pet. 41) is reproduced below.

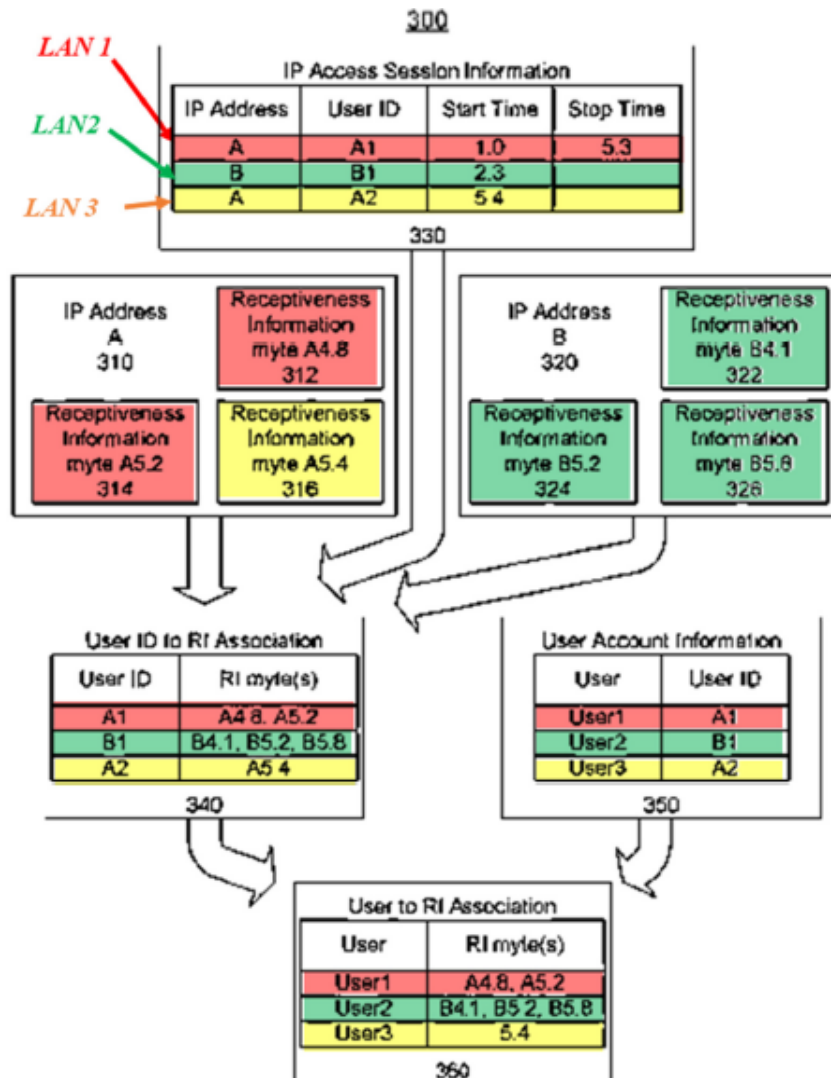


Figure 5 depicts “a block diagram showing relationships between information to enable associating IP address-keyed receptiveness information to users,” with Petitioner’s annotations to indicate “IP address ‘A’ and timestamp [1.0-5.3] for LAN 1 (annotated in red), IP address ‘B’ and timestamp [2.3, no stop time] for LAN 2 (annotated in green), and IP address ‘A’ and timestamp [5.4, no stop time] for LAN 3 (annotated in yellow)” and RI-mytes “‘A4.8 312’ and ‘A5.2 314’ in red, ‘B4.1 322’, ‘B5.2 324’, ‘B5.8 326’ in green, [and] ‘A5.3 316’ in yellow.” Ex. 1015 ¶¶ 12, 110; Pet. 40, 42. Petitioner asserts 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. 41–42 (quoting Ex. 1015 ¶¶ 69, 80, claim 3; citing Ex. 1003 ¶ 80). Specifically, Petitioner contends 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 (‘A4.8 312’ and ‘A5.2 314’ in red, ‘B4.1 322’, ‘B5.2 324’, ‘B5.8 326’ in green, ‘A5.3 316’ in yellow) include usage data collected from different user devices and their corresponding device identifiers are associated,” and “Whitehead describes that a receptiveness information myte (RI-myte) may include a corresponding device ID.” *Id.* at 42 (citing Ex. 1015 ¶ 246; Ex. 1003 ¶¶ 81–83). According to Petitioner, “Whitehead describes that 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 43 (citing Ex. 1003 ¶ 85).

Patent Owner disputes Petitioner’s contention that Whitehead teaches associating identifiers without using PII, and argues that instead

“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 contends 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 asserts that Whitehead’s “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 “Whitehead 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 contends that the “User” field contains personally identifiable information because “the ‘User’ data relied upon by the Figure 5[] process includes the actual identity of the user.” *Id.* at 14.

We agree with Patent Owner’s arguments. Petitioner’s primary argument is that Whitehead’s 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. 39–44; *see also id.* at 39–40 (“[A]s shown in FIG. 5 below, Whitehead describes using IP access session information to associate devices and their RI-mytes.”), 42 (“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.”). Whitehead’s Figure 5, however, discloses using PII in making that association.

Specifically, Whitehead discloses that “[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.” Ex. 1015 ¶ 113; *see id.* at Fig. 5. Based on 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 discloses that “Block 350 can represent user account information maintained by the service provider 40” and that “[t]he user account information can associate each user with the user’s user ID.” *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 specific user.” *Id.* Stated differently, Whitehead’s 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, 7:51–52 (“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 ’069 Patent Specification 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, 7:53–60. 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 emphasizes that Whitehead teaches “the importance [of] associating devices of . . . user 30 with an IP address for each IP access session.” Pet. 43 (quoting Ex. 1015 ¶¶ 78–78; citing Ex. 1003 ¶ 84); *see also id.* at 19 (referring to “Whitehead’s teachings of associating devices of a common local area network based on a common IP address of a corresponding router”). Although Whitehead’s Figure 5 embodiment discloses associating RI-mytes (and included device identifiers) in part by using non-PII, for example, a dynamic IP address, it does not sufficiently show that Whitehead teaches associating device identifiers *without* using PII, as claimed. An IP address is not sufficient to associate RI-mytes as being related to the same IP access session in Whitehead, because, as Petitioner notes, “the same IP address (e.g., ‘A’) may be assigned to different home routers/LANs at different times.” Pet. 40; *see also* Ex. 1015 ¶ 112. As noted above and shown in Figure 5, Whitehead associates RI-mytes related to the same IP access session with User IDs relating to the respective IP access session, and Petitioner acknowledges as much by stating the following:

Using the corresponding IP access session information, the associated usage data and device identifiers are associated to the same user ID (e.g., ‘user 1,’ ‘user 2,’ and ‘user 3’ respectively) representing the corresponding user profile, and the association based on automatically recognizing that they are connected to a common local area network because they are associated with the same IP access session.

Pet. 42 (citing Ex. 1003 ¶¶ 81, 82). Petitioner makes no argument that Whitehead’s User IDs are not PII (*see id.* at 39–44) and, as discussed above,

Whitehead's Figure 5 uses the User IDs in Blocks 330, 340, and 360 as part of its association. *See* Ex. 1015 ¶¶ 113–114.

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. *See* Ex. 1015, Fig. 5. Rather, as discussed above, RI-mytes are associated in block 340 of Figure 5 with the "User ID" field. *See Id.* ¶ 114, Fig. 5. Moreover, Petitioner does not specifically explain why one with ordinary skill in the art would modify the embodiment of Whitehead's Figure 5 to perform an association using a timestamp but without using a User ID. *See* Pet. 39–44.

We also agree with Patent Owner's following additional arguments: (1) certain other portions of Whitehead cited by Petitioner regarding anonymous techniques that use non-PII are unrelated to the Figure 5 embodiment; and (2) Petitioner fails to explain why one with ordinary skill in the art would modify Figure 5 to make associations between device identifiers without using PII. *See* Prelim. Resp. 15–19. Petitioner's general reliance on Whitehead's various disclosures regarding the use of non-PII information is insufficient to show that the combination of Madhavan and Whitehead teaches the disputed limitation. *See* Pet. 43–44. In particular, Petitioner relies on Whitehead's disclosure that "[t]he distinction between

⁸ *See* Pet. 40 ("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 43 ("[T]he IP session information identified by an IP address and timestamp achieves anonymous marketing using non-PII information.").

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. Petitioner also relies on Whitehead’s disclosure that “the use of an IP 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, however, does not show 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. 43–44. Petitioner also does not specifically explain why, in view of these disclosures, one of ordinary skill in the art would associate RI-mytes from the different devices in the Figure 5 embodiment without using the “User ID” field. *See id.*

In conclusion, having reviewed the Petition and Preliminary Response, we determine that Petitioner has not established a reasonable likelihood that Petitioner will prevail in showing claim 1 is unpatentable over Madhavan and Whitehead. Independent claims 18 and 25 also recite limitations nearly identical to the aforementioned disputed limitation of claim 1. *See* Ex. 1001, 26:44–48, 27:30–28:1. For the same reasons as those explained above addressing claim 1, Petitioner has not established a reasonable likelihood that Petitioner will prevail in showing claims 18 and 25 are unpatentable over Madhavan and Whitehead. Due to their dependence from claims 1, 18, and 25, Petitioner also has not established a

reasonable likelihood that Petitioner will prevail in showing claims 3–5, 8, 17, 18, 20, 21, 25, 27, and 28 are unpatentable over Madhavan and Whitehead.

E. Patentability Challenges to Claims 9–16, 22–24, and 29–31

Petitioner asserts that dependent claims 9 and 10 are unpatentable over Madhavan, Whitehead, and Vallier and dependent claims 11–16, 22–24, and 29–31 are unpatentable over Madhavan, Whitehead, and Varghese. Pet. 62–80. These additional patentability challenges do not remedy the deficient contentions in the Petition identified above with respect to the “without using personally identifiable information,” recited in independent claims 1, 18, and 25. Accordingly, Petitioner has not established a reasonable likelihood that Petitioner will prevail in showing claims 9 and 10 are unpatentable over Madhavan, Whitehead, and Vallier, and that claims 11–16, 22–24, and 29–31 are unpatentable over Madhavan, Whitehead, and Varghese.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not established a reasonable likelihood that Petitioner would prevail in showing at least one of the challenged claims of the '069 Patent is unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby:

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

IPR2022-00959
Patent 8,595,069 B2

PETITIONER:

David O'Brien
Hong Shi
Jonathan Bowser
Raghav Bajaj
HAYNES AND BOONE, LLP
David.obrien.ipr@haynesboone.com
Hong.shi.ipr@haynesboone.com
Jon.bowser.ipr@haynesboone.com
Raghav.bajaj.ipr@haynesboone.com

PATENT OWNER:

Reza Mirzaie
Jonathan Link
RUSS, AUGUST & KABAT
rmirzaie@raklaw.com
jlink@raklaw.com