

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

ROBOCAST, INC.,
Patent Owner.

IPR2022-01125
Patent 8,965,932 B2

Before PATRICK M. BOUCHER, NABEEL U. KHAN, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

Unified Patents, LLC (“Petitioner”) filed a Petition pursuant to
35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–9, 13–
15, 17, 18, 20, 22–27, and 33–43 of U.S. Patent No. 8,965,932 B2

(Ex. 1001, “the ’932 patent”). Paper 2 (“Pet.”). Robocast, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply and Patent Owner filed a Sur-reply. Papers 11 (“Reply”), 12 (“Sur-reply”).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny the Petition and do not institute an *inter partes* review.

I. BACKGROUND

A. The ’932 Patent

The ’932 patent is a continuation of U.S. Patent No. 7,155,451 (Ex. 2007, “the ’451 patent”) and “relates generally to computer networks, and specifically to a method of sequencing and scheduling web pages.” Ex. 1001, code 63, 1:22–24. The ’932 patent explains that, at the time of filing, methods for a user “to access services, information and entertainment on the Web . . . typically require[d] a significant amount of user effort and decision-making to drive the web surfing experience.” *Id.* at 5:51–6:4. For example, the user might “make certain choices, position the mouse pointer and click the mouse buttons appropriately to indicate the decisions,” or “may type in a URL or access a bookmark to visit a favorite search engine.” *Id.* at 5:51–61. This perceived difficulty is addressed by the patent by responding to a “triggering event, such as a mouse click on a single ‘link’ [with] the presentation of a series of resources instead of one resource at a time.” *Id.* at 2:59–61. “This arrangement of resources[] is defined as a ‘show structure’

or ‘structure,’ which contains a set of nodes,” each of which “represents a resource such as a web page, an executable file, or a data file stored at a predetermined location and accessed via its corresponding address.” *Id.* at 2:61–65.

Figure 2B of the ’932 patent is reproduced below.

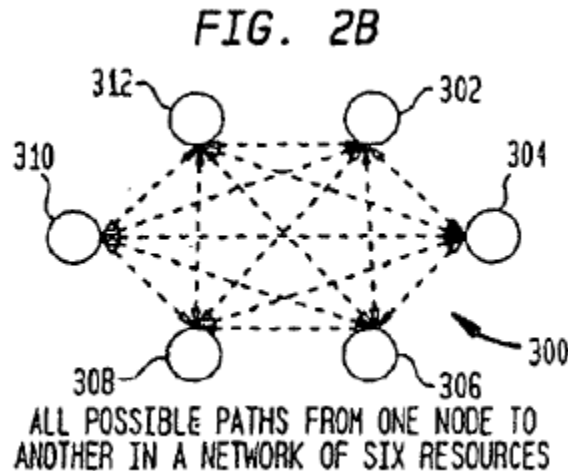


Figure 2B illustrates an array 300 of nodes 302, 304, 306, 308, 310, 312 that are available for presentation, with each node in the array accessible from the other nodes. *Id.* at 7:3–6. “For a typical show or presentations, an arrangement of these nodes or a portion of these nodes is selected for presentation.” *Id.* at 7:6–9. Examples of such arrangements or portions of nodes are provided in Figures 2C–2F (not reproduced here), and include such structures as “a show structure that simultaneously spans multiple paths from the same starting node” or “spans multiple paths concurrently.” *Id.* at 7:12–15, 7:26–28.

B. Illustrative Claims

Challenged independent claims 1 and 22 are representative of the challenged claims, and are reproduced below.

1. A method for providing content via a communications network on a user's computer, obtained from a plurality of resources in an organized arrangement comprising the steps of:

- creating a show structure of nodes, each node identifying a resource from a plurality of accessible resources, at least some of which are network accessible resources;
- without requiring user input, automatically accessing a plurality of said network accessible resources identified by a corresponding node; and
- causing content from said network accessible resources corresponding to each of said accessed resources to be automatically accessed and presented through said user's computer in accordance with said show structure such that during said presentation of at least some of said content from said accessed resources, at least some of said other network accessible resources are being accessed,

wherein said step of creating further comprises the step of providing interactively variable duration information, representing the duration that said content corresponding to said resource is presented so as to enable a user to vary said duration.

Ex. 1001, 17:42–64

22. A method for providing in a sequential arrangement to a user's computer, content derived via a communications network from a plurality of resources, the method comprising the steps of:

- receiving a request for a user defined online search from a remote user;
- providing a plurality of search results and their corresponding resource locators in response to said request, automatically creating a show structure of nodes based on said search results, each node identifying a resource from a plurality of accessible resources via said communications network;
- without requiring user input automatically accessing a plurality of said resources;
- retrieving content corresponding to each of said accessed resources; and

automatically accessing and presenting said retrieved content through said user's computer in accordance with said show structure such that during said presentation of at least some of said content from said accessed resources, at least some of said other network accessible resources are being accessed.

Id. at 18:54–19:8.

C. Evidence

Petitioner relies on the following references:

Henley	US 5,761,417	June 2, 1998	Ex. 1013
Reisman	US 6,594,692 B1	July 15, 2003	Ex. 1014
Shoham	US 5,855,015	Dec. 29, 1998	Ex. 1015
Richardson	US 5,809,247	Sept. 15, 1998	Ex. 1016

In addition, Petitioner relies on a Declaration by Benjamin Bederson, Ph.D. Ex. 1012. Patent Owner relies on a Declaration by Kevin Almeroth, Ph.D. Ex. 2005.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–9, 13–15, 17, 18, 20, 22–27, and 33–43 on the following grounds. Pet. 3.

Claim(s) Challenged	35 U.S.C. §¹	References
1, 2, 4, 5, 7–9, 13–15, 20	102	Henley

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C §§ 102 and 103. The ’932 patent resulted from an application filed on December 21, 2005, claiming the benefit of the filing dates of earlier applications. Ex. 1001 at codes (22), (60), (63). We accordingly apply the pre-AIA versions of §§ 102 and 103 herein.

Claim(s) Challenged	35 U.S.C. §¹	References
1, 2, 4, 5, 7–9, 13–15, 20	103(a)	Henley
3, 5, 6, 17, 18	103(a)	Henley, Reisman
22–27, 33–43	103(a)	Shoham, Richardson

E. Real Parties in Interest

The parties identify only themselves as real parties in interest. Pet. 1; Paper 4, 2.

F. Related Matters

Both parties identify the following related matters as involving the '932 patent: (1) *Robocast, Inc. v. Netflix, Inc.*, No. 1:22-cv-00305 (D. Del.); and (2) *Robocast, Inc. v. YouTube, LLC*, No. 1:22-cv-00304 (D. Del.) (collectively, “the related litigation”). Pet. 1; Paper 4, 2.

II. JURISDICTION OVER EXPIRED PATENTS

Patent Owner states that “[t]he '932 Patent expired long before the Petition was filed on June 30, 2022,” and that “[w]ith the expiration of the patent, the Board ceased to have jurisdiction over the '932 Patent.” Prelim. Resp. 10. Petitioner does not dispute that the '932 patent had expired when the Petition was filed, but contends that the Board nonetheless “has jurisdiction in this [*inter partes* review].” Reply 1. We agree with Petitioner that such jurisdiction is consistent with our statutory authority in view of Supreme Court and Federal Circuit precedent, and USPTO regulations, .

Patent Owner grounds its argument on the Supreme Court’s pronouncement that “patents are public franchises that the Government grants to the inventors of new and useful improvements.” Prelim. Resp. 8–

9; *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1373 (2018). According to Patent Owner, “so long as the public franchise exists, the [U.S. Patent and Trademark Office] may have jurisdiction to amend and cancel the claims of the patent (e.g., via *inter partes* review.)” Prelim. Resp. 9. But “[w]hen a patent expires,” Patent Owner says, “the public franchise ceases to exist and the franchisee (e.g., the patent owner) no longer has the right to exclude others.” *Id.* Patent Owner reasons that, after the patent expires, “[a]t most, the franchisee may be entitled to collect damages” and thereby that “[e]xpiration of the patent removes the patent from the [Office’s] jurisdiction and returns it to the sole jurisdiction of the Article III courts, which have exclusive authority to govern claims for damages.” *Id.*

In *Oil States*, the Supreme Court also explained that “[i]nter partes review is ‘a second look at an earlier administrative grant of a patent.’” *Oil States*, 138 S. Ct. at 1374 (quoting *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016)). Other panels of the Board have relied on this statement in concluding that the Board has jurisdiction over expired patents in *inter partes* review proceedings. *Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00922, Paper 10 at 17–18 (PTAB Nov. 29, 2021); *Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00921, Paper 24 at 36–38 (PTAB Dec. 5, 2022).

Patent Owner criticizes such reliance because, in *Oil States*, the Supreme Court “emphasize[d] the narrowness of [its] holding” as addressing “only the precise constitutional challenges that *Oil States* raised.” Sur-reply 1 (quoting *Oil States*, 138 S. Ct. at 1379 (alterations by Patent Owner)). According to Patent Owner, “[t]he ‘precise constitutional

challenge’ in *Oil States* . . . did not involve an expired patent as is the case here, and the Supreme Court has yet to address the PTAB’s jurisdiction to conduct inter partes review of expired patents.” *Id.* But even if Patent Owner is correct that the Supreme Court has not specifically addressed whether the Board has jurisdiction over expired patents, that fact does not warrant discounting the logical consequences of what the Supreme Court has decided.

This is particularly so because the Court provided context for its statement, specifically identifying the types of constitutional questions it recognized as left unaddressed by explaining that its “decision should not be misconstrued as suggesting that patents are not property for purposes of the Due Process Clause or the Takings Clause.” *Oil States*, 138 S. Ct. at 1379. In addition, we note that the Supreme Court explicitly recognized that “[t]he America Invents Act replaced inter partes reexamination with inter partes review,” and that *inter partes* reexamination has regularly considered expired patents. *Oil States*, 138 S. Ct. at 1371; *see generally In re Rambus, Inc.*, 753 F.3d 1253, 1255–56 (Fed. Cir. 2014) (discussing procedures for *inter partes* reexamination of expired patent).

The Federal Circuit has also affirmed the Board’s determination with respect to expired claims in *inter partes* review. *See, e.g., Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1279 (Fed. Cir. 2017) (noting that “[t]he Board construes claims of an expired patent in accordance with *Phillips* . . . [and] [u]nder that standard, words of a claim are generally given their ordinary and customary meaning’.”). This is consistent with our contemporaneous interpretation of our regulations as demonstrating that expired patents are properly considered to be within our jurisdiction. 37

C.F.R. § 42.100(b); *see also, e.g.*, 87 Fed. Reg. 51,341 (Oct. 11, 2018) (Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board)² (“The claim construction standard adopted in this final rule also is consistent with the same standard that the Office has applied in interpreting claims of expired patents and soon-to-be expired patents.”).

Furthermore, the statutes governing *inter partes* review do not limit them to unexpired patents. *See* 35 U.S.C. §§ 311(b), 311(c), 315. Petitioner additionally draws our attention to *Sony Corp. v. Iancu*, 924 F.3d 1235, 1239–41 (Fed. Cir. 2019), in which “the Federal Circuit affirmed that a case or controversy before the PTAB existed when a patent was expired, and it articulated the importance of the Board’s review of expired patents since expired patents can be asserted for past infringement.” Reply 2–3.

Although Patent Owner contends that none of these factors alone is dispositive, they are collectively consistent with the Board’s jurisdiction extending to cover expired patents. More particularly, Patent Owner does not adequately explain why the Board’s authority to take “a second look at an earlier administrative grant of a patent” ends when the patent term expires even though the rights granted by the patent are not yet exhausted. We accordingly disagree that the Board lacks jurisdiction over expired patents.

² Available at <https://www.federalregister.gov/d/2018-22006/p-13>.

III. ANALYSIS³

A. Legal Principles

Petitioner makes both anticipation and obviousness challenges. To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). While the elements must be arranged in the same way as is recited in the claim, “the reference need not satisfy an *ipsissimis verbis* test.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009); *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990). Identity of terminology between the anticipatory prior art reference and the claim is not required. Prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

³ Petitioner filed claim charts as Exhibits 1017 and 1018. As Patent Owner observes, “the Petition repeatedly cites to non-substantive paragraphs of its witness’s declaration, which in turn merely cite to the entirety of the claim charts of Exhibits 1017 and 1018.” Prelim. Resp. 15. Patent Owner characterizes these exhibits as “argument, separate from the Petition, and intended to supplement the Petition and Dr. Bederson’s declaration.” *Id.* Patent Owner adds that “the Petition does not cite Exhibits 1017 and 1018 with any particularity, but instead merely notes that certain paragraphs of Dr. Bederson’s declaration cite to the exhibits *in their entireties*.” *Id.*

Our regulations provide that “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). Our analysis does not rely on arguments presented only in the claim charts of Exhibits 1017 and 1018.

A claim is unpatentable for obviousness 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 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 nonobviousness, i.e., secondary considerations.⁴ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); see *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

⁴ The parties do not meaningfully address objective indicia of nonobviousness, which accordingly do not form part of our analysis. See Pet. 79–80 (Petitioner asserting that it “is unaware of any evidence of secondary considerations,” but providing limited arguments because Petitioner “is aware” that Patent Owner “has made allegations that evidence exists” outside the record before us).

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 of 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). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Petitioner proposes that a person of ordinary skill in the art “would have had a bachelor’s degree in electrical engineering, computer engineering, or a related subject and two or more years of experience working with computer networks and the accessing and presentation of networked resources to users in the 1996 timeframe.” Pet. 10 (citing Ex. 1012 ¶ 51). Petitioner adds that “[t]his description is approximate, and a higher level of education or specific skill might make up for less experience and vice-versa.” *Id.*

Patent Owner proposes that a person of ordinary skill in the art “would have the equivalent of a four-year degree from an accredited institution (usually denoted as a B.S. degree) in computer science, computer engineering or the equivalent, and experience with, or exposure to, topics in

computer networking, multimedia, and web systems. A person of ordinary skill in the art would also have approximately 3-5 years of professional experience with these topics.” Prelim. Resp. 6. In addition, Patent Owner say that “[a]dditional graduate education could substitute for professional experience, while significant experience in the field might substitute for formal education.” *Id.* (citing Ex. 2005 ¶ 28).

Both parties support their proposals with testimony by their respective experts. *See* Ex. 1012 ¶ 51; Ex. 2005 ¶ 28. Although the proposals differ in certain respects, they do not differ in ways that affect our decision to deny institution of the proceeding. Both proposals include baccalaureate degrees and experience in generally related fields, with both parties indicating that additional education or experience could compensate for some lack in the other. For purposes of this Decision, we adopt Petitioner’s proposal, which we find consistent with the level of skill reflected by 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

The Board uses “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with 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.” 37 C.F.R. § 42.100(b) (2019); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Certain terms recited in the challenged claims were construed during prior litigation of the ’451 patent, i.e., the parent of the challenged

'932 patent. Ex. 1011 (claim construction order in cases involving Microsoft and Apple); Ex. 2009, 5 (clarification of certain claim constructions on summary judgment). Patent Owner advocates that we adopt such prior constructions in this proceeding, and Petitioner “does not dispute” such constructions. Pet. 10–13; Prelim. Resp. 6–8. We have reviewed the court’s claim-construction order, and adopt its construction of the following terms for purposes of this Decision.

First, we construe “node,” which is recited in multiple claims, as “an identifier of a resource that includes an address to the resource and the duration for which the resource’s content is to be presented by default.” *See* Ex. 1011, 16–17; Pet. 12; Prelim. Resp. 7.

Second, we construe “show structure of nodes,” which is recited in challenged independent claims 1 and 22, as well as in challenged dependent claim 4, as “a structure that is arranged for the display of content by specifying one or more paths through a plurality of nodes. The show structure of nodes specifies the duration of any display,” but there is no durational requirement separate from the construction of “node.” *See* Ex. 1011, 2–13; Pet. 11–12; Prelim. Resp. 7.

Third, we construe “interactively variable duration information,” which is recited in challenged independent claim 1, as well as challenged dependent claims 2 and 26, as “a parameter specifying how long a content is to be displayed by default before a subsequent content is displayed, where the viewer of the content can change the parameter.” Ex. 1011, 22–23; Pet. 13; Prelim. Resp. 7.

For purposes of this Decision, we accord all other terms recited in the challenged claims their plain and ordinary meaning. *See* Ex. 1011, 17–20,

26–29 (court adopting plain and ordinary meaning of “plurality of accessible resources,” “content,” “without requiring user input,” “in accordance with said show structure,” “providing,” and “search results”); Pet. 13–14.

D. Overview of the Prior Art

1. Henley

Henley “relates to a system for delivery of multimedia data and, more particularly, an interactive video server system that provides video simultaneously to a plurality of terminals with minimal buffering.”

Ex. 1013, 1:33–36. Specifically, the system described by Henley provides “an ability to deliver many isochronous data streams from a single copy of data.” *Id.* at 2:63–3:2. Figure 1 of Henley is reproduced below.

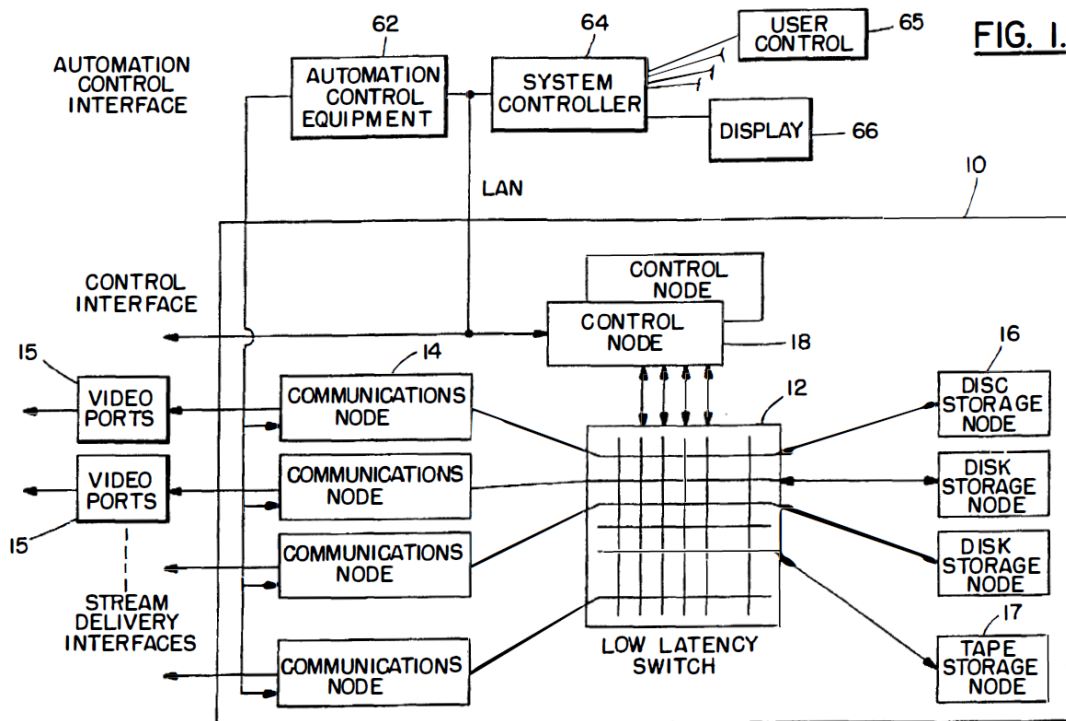


Figure 1, above, is a block diagram of a media streamer. *Id.* at 3:47–48.

Users may access data stored in storage nodes 16, 17 via low latency switch

12 and communications nodes 14, which “enabl[e] the ‘playing’ (delivering data isochronously) . . . over an externally defined interface.” *Id.* at 6:19–46.

In video applications, such as for playing a movie, the media streamer serves multiple streams from a single copy of the data by partitioning the data to reside in multiple file components, referred to as “stripes.” *Id.* at 28:55–29:3. “Each stripe is allowed to exist on a different disk volume, thereby allowing the logical file to span multiple physical disks.” *Id.* at 29:3–5. This concept is illustrated with Figures 16 and 17 of Henley, which are reproduced below.

FIG. 16.

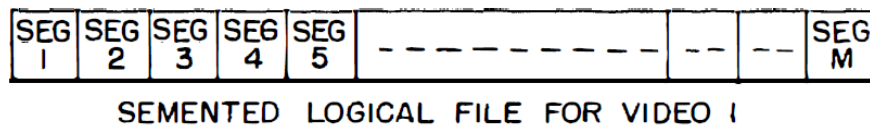


FIG. 17.

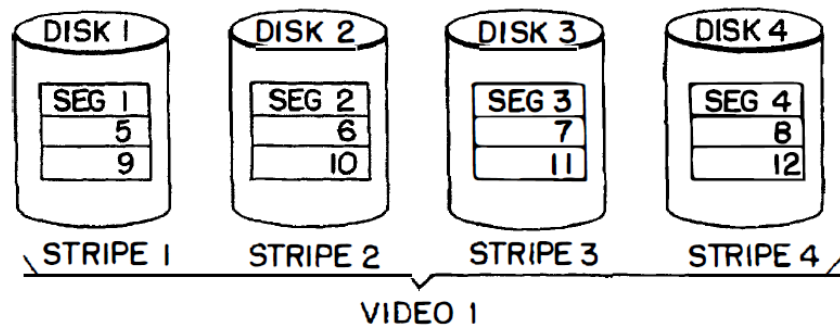


Figure 16 (top) “illustrates a segmented logical file for a video 1” and Figure 17 (bottom) “illustrates how the various segments of video 1 are striped across a plurality of disk drives.” *Id.* at 4:26–28. In this illustration, video 1 is segmented into M segments: “A segment of data is placed in the first stripe, followed by a next segment that is placed in the second stripe, etc. When a segment has been written to each of the stripes, the next

segment is written to the first stripe.” *Id.* at 29:12–16. If there are four stripes, as shown in Figure 17, stripe 1 contains file segments 1, 5, 9, etc.; stripe 2 contains file segments 2, 6, 10, etc.; stripe 3 contains file segments 3, 7, 11, etc.; and stripe 4 contains file segments 4, 8, 12, etc. *Id.* at 29:39–46.

Figure 8 of Henley is reproduced below.

FIG. 8.

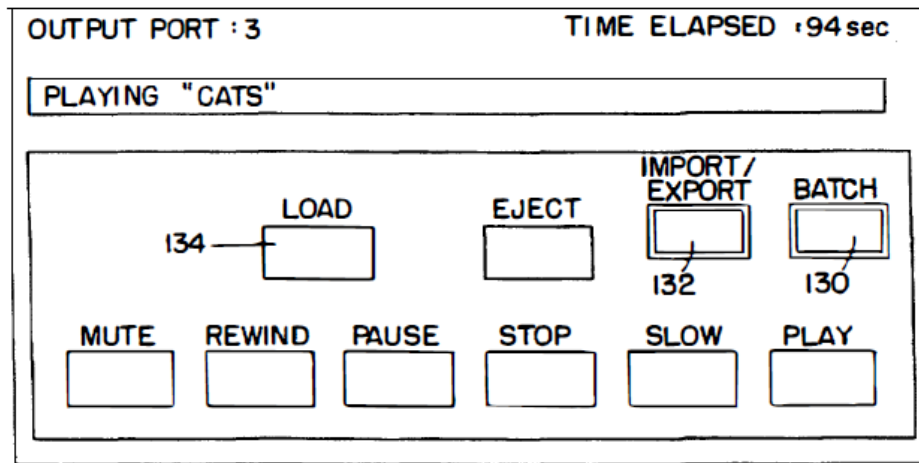


Figure 8 illustrates a “media streamer graphical user interface” in the form of “a display panel showing a plurality of ‘soft’ keys used to operate the media streamer.” *Id.* at 4:5–6, 19:12–13. Henley explains that the media streamer “provides three general types of user functions,” which are illustrated in Figure 8. *Id.* at 19:24–28. First, “Import/Export functions are used to move video data into and out of the media stream,” and may be invoked when “the user clicks on the ‘Import/Export’ soft button 132.” *Id.* at 19:29–49. Second, the media streamer is provided with “a set of VCR-like play controls,” such as “Load, Eject, Play, Slow, Pause, Stop, Rewind, Fast Forward and Mute,” as shown in Figure 8. *Id.* at 19:50–67. Third, “to support specific application requirements, such as the broadcasting

industry,” several “advanced user controls” are provided. *Id.* at 29:1–41. These include a “Play List” feature that may be accessed with the “Load” button shown in Figure 8 to “set up multiple videos and their sequence to be played on a port.” *Id.* at 20:5–6, 20:10–22.

2. *Reisman*

Reisman relates to “a computer-implemented software component that can be used to facilitate the distribution of information objects from a remote source to a large number of customers or subscribers.” Ex. 1014, 1:14–18. Reisman discloses accessing content like “entertainments with audio [and] video” using URLs via an internet network and displaying content using a web browser. *Id.* at 36:24–39:4. Reisman includes the following disclosure:

This facility is of particular value for sophisticated multimedia applications which may require content from multiple sources to be assembled into a coherent work such as a television commercial, a training video or “mini-movie”, using moving video frames, text content, voice, photographs, special effects and so on, for highly interactive processes such as extended, free-flowing browsing and searching of relatively unbounded network content, and where dynamic contributions or interactions among multiple participants are to be accommodated, as in conferencing or real-time gaming applications involving interactions between multiple network users.

Id. at 34:55–67.

3. *Shoham*

Shoham relates to “a system and method for retrieval of hyperlinked information resources.” Ex. 1015, 1:14–15. The system and method make

use of “heuristics” for both exploration of hyperlinked resources and presentation of resources of interest to a user. *Id.* at 3:60–67. “Preferably, the heuristics used are those based on discrete features which are amenable to adaptation using techniques from machine learning,” and may identify several features that take values from a given scale (such as “yes/no,” a numeric scale, or a scale with values such as “poor, good, better, best, etc.”). *Id.* at 8:1–8.

Figure 4 of Shoham is reproduced below.

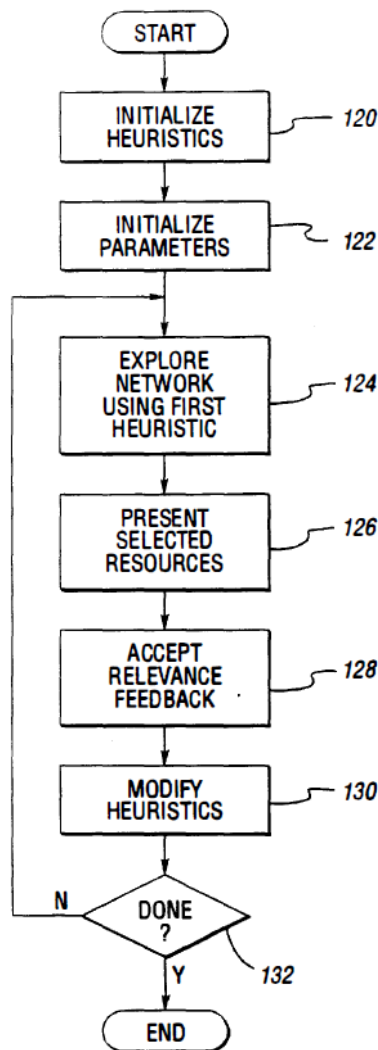


Fig. 4

Figure 4 is a flow chart that illustrates retrieval of information from resources accessible over a hyperlinked networked. *Id.* at 5:35–37. Exploration and presentation heuristics are initialized at step 120, and various system parameters (such as “fixed number of resources to present to the user, the amount of time for the system to explore the network before returning results, the initial node to begin exploration, and how often to

revisit nodes [of the network] which have been previously searched”) are selected at step 122. *Id.* at 7:65–66, 8:39–45.

At block 124, the hyperlinked network is explored using the exploration heuristic “established at block 120 or as subsequently modified by the system” to select information resources that appear relevant according to the exploration heuristic. *Id.* at 8:45–50. “The exploration process may be repeatedly executed to locate interesting information resources as determined by the system parameters.” *Id.* at 8:50–53. Selected information resources are presented to the user at block 126 based on the presentation heuristic, which “may be the same, similar to, or different from the exploration heuristic.” *Id.* at 8:54–57.

The user actively or passively provides relevance feedback for each of the presented information resources at block 128. *Id.* at 8:61–9:8. The presentation and/or exploration heuristics are modified at block 130 “based on the selected resources and the active and/or passive feedback received from the user.” *Id.* at 9:9–12. “Any of a number of learning methods may be utilized such as neural network techniques, nearest neighbor techniques, or various other adaptive strategies.” *Id.* at 9:19–21. Based on factors such as “a predetermined number of selected resources, a predetermined time, an interrupt generated by the user or the system, etc.,” a determination is made at block 132 whether the process should continue or terminate. *Id.* at 9:34–40.

4. Richardson

Richardson relates to “methodologies and tools for a user to locate and view information on the Internet or any Intranet.” Ex. 1016, 1:7–9.

Specifically, Richardson describes “guided touring of websites.” *Id.* at 2:5–9. A user connects to a “tour operator” website, which “provides the user with a directory of available guided tours” for selection of one of the tours. *Id.* at 4:27–35. The tour operator provides the user with a “web tour viewer,” accompanied by a definition of the “tour stops (i.e. websites)” for the selected tour, and corresponding media complements for the tour stops. *Id.* at 4:35–39. The web tour viewer connects “to the tour stops in accordance with the tour step definition, and renders the corresponding media complements at each of the tour stops.” *Id.* at 4:39–42. The system allows for “dynamic user modification,” which allows “temporarily stopping and resuming the connection, and/or shortening a particular connection, and skipping forward or backward, to the immediate following or preceding one, or any particular unvisited or visited one of the one or more web sites.” *Id.* at 2:15–23.

E. Challenges over Henley

Petitioner challenges claims 1, 2, 4, 5, 7–9, 13–15, and 20 as anticipated by, or unpatentable for obviousness over, Henley. Pet. 18–37.

1. Independent Claim 1

Patent Owner accurately observes that, “[u]nlike the ’932 Patent, Henley does not relate to the delivery of Internet content to viewers via URLs or otherwise.” Prelim. Resp. 18. Rather, as Patent Owner asserts, “Henley describes a centralized system designed for the storage and delivery of multimedia data streams ‘over traditional interfaces’ used in either the broadcast industry or computer industry.” *Id.* (citing Ex. 1013, 2:54–57). In

particular, Henley provides delivery of “many isochronous data streams from a single copy of data,” with specific application to “the broadcasting industry,” such as a cable television headend that distributes content to viewers’ “TV sets and set top boxes.” *Id.* (quoting Ex. 1013, 2:63–66, 12:48–50, 20:1–3).

Despite this different focus, Petitioner nevertheless contends that Henley anticipates independent claim 1 by describing steps that result in “a method for providing content via a communications network on a user’s computer, obtained from a plurality of resources in an organized arrangement,” as recited in the claim’s preamble. Pet. 18–19. That is, Petitioner draws the following correspondences between elements recited in the preamble and disclosure by Henley: (1) the recited “content” and Henley’s isochronous data streams of video and/or audio content; (2) the recited “communications network” and Henley’s low latency switch 12; (3) the recited “user’s computer” and a display that uses Henley’s “various output’s such as TV sets and set top boxes attached via a network”; (4) the recited “plurality of resources” and Henley’s storage nodes 16, 17; and (5) the recited “organized arrangement” and Henley’s series of related contents striped across servers, as well as Henley’s playlist of unrelated contents. *Id.* at 18.

In brief, Petitioner reasons that Henley teaches the creation of a show structure that meets the steps recited in the claim’s body by automatically accessing and sequentially playing the striped segments. *Id.* at 20–26. According to Petitioner, user ability to vary content duration is disclosed with time-limit information associated with Henley’s Play List and the VCR-like play controls shown in Figure 8, reproduced above. *Id.* at 26–28.

Patent Owner fundamentally disputes Petitioner’s analysis based on a different reading of Henley: “Henley is not concerned with, and does not describe, the presentation of the resources to the *viewer or end user*, or the end user’s interface or controls.” Prelim. Resp. 22. That is, Patent Owner reads Henley as implicitly distinguishing between different types of “users,” namely media viewers and media-streamer operators. *See id.* at 27 (“Because Henley is directed to a system for use by broadcasters, Henley also discusses functionalities available to ‘users’ or operators of that system. Unlike the viewers, the system operator users are not referred to as ‘end users.’”). Patent Owner acknowledges that Henley “is admittedly somewhat inconsistent” in making the distinction unambiguous, but contends that “the context of Henley’s usage of ‘user’ makes it clear when it is referring to the system operator as opposed to the end user.” *Id.* at 27–28 (citing Ex. 2005 ¶¶ 31–32).

Dr. Almeroth’s supporting testimony specifically addresses this distinction. *See* Ex. 2005 ¶ 30 (“Henley discloses a ‘video optimized stream server system 10,’ also referred to as ‘media streamer,’ for *use by broadcasters* to deliver content to *end users*, or viewers.”). In particular, Dr. Almeroth observes that, in Figure 1 of Henley, reproduced above, system controller 64 is illustrated graphically as connected to multiple user controls 65, but is shown connected only to a single display 66. *Id.* ¶ 31. This structure, in combination with Henley’s description of the drawing, leads Dr. Almeroth to conclude that user control 65 “corresponds to a ‘set top box[]’” for an end user, and that system controller 64 corresponds to a separate “‘user interface’ for the operator.” *Id.*

Specifically, Dr. Almeroth points to Henley’s description of system controller 64 as “respond[ing] to inputs from *user control set top boxes 65* to cause commands to be generated that enable media streamer 10 to access a requested video presentation.” *Id.*; Ex. 1013, 8:30–32 (emphasis added). Dr. Almeroth also notes Henley’s explanation that “[s]ystem controller 64 is further provided with a user interface and display facility 66 which enables a user to input commands, such as by hard or soft buttons, and other data to enable an identification of video presentations, the scheduling of video presentations, and control over the playing of a video presentation.” Ex. 2005 ¶ 31; Ex. 1013, 8:33–38. These disclosures by Henley support Dr. Almeroth’s conclusion that “[t]his ‘user interface and display facility 66’ is for an operator—not an end user.” *See* Ex. 2005 ¶ 31.

Dr. Almeroth provides additional reasoning to support this conclusion. For example, Henley explains that “[s]ystem controller 64 responds to inputs from user control set top boxes 65 to cause commands to be generated that enable media streamer 10 to access a requested video presentation.” Ex. 1013, 8:30–32. In light of this, because an end user would interact with the set-top box shown as user control 65, Dr. Almeroth reasons that “it would make no sense” for display 66 to be for the end user. Ex. 2005 ¶ 32. We agree with this reasoning.

In addition, Dr. Almeroth observes that Henley describes two types of interfaces for media streamer 10, a command line interface and a graphical user interface. *Id.* ¶ 33 (citing Ex. 1013, 18:47–50). Because the command line interface can be used for “batch” functionality, Dr. Almeroth reasons, and we agree, that the command line interface is for broadcast operators, rather than for end users. *Id.* With respect to the graphical user interface

shown in Figure 8, reproduced above, Dr. Almeroth further reasons that a person of skill in the art would understand that it relates to operator controls, rather than end-user controls, because Henley specifically describes it as showing keys “used to operate the media streamer.” *Id.* ¶ 34; Ex. 1013, 4:5–6. In other words, according to Dr. Almeroth, “[t]he graphical user interface corresponds to the command line interface.” Ex. 2005 ¶ 34.

Dr. Almeroth’s reasoning is compelling. Notably, Figure 8 shows “Batch” button 130 and “Import/Export” button 132 to “move video data into and out of the media streamer.” *See* Ex. 1013, 19:20–22, 19:30–31. As Dr. Almeroth testifies, these are not functions that a person of ordinary skill in the art would understand to be available for end users, but are appropriate for broadcast operators: “None of these commands are consistent with those that would be available to an end user of, e.g., a set top box or pay-per-view system.” Ex. 2005 ¶ 35. In light of this compelling testimony, we agree with Patent Owner and find that “Henley . . . does not describe . . . the end user’s interface or controls.” *See* Prelim. Resp. 22.

This finding supports Patent Owner’s basis for disputing the sufficiency of Petitioner’s showing with respect to at least the limitation of independent claim 1 that recites “providing interactively variable duration information, representing the duration that said content corresponding to said resource is presented so as to enable a user to vary said duration.” Ex. 1001, 17:60–64. For this limitation, Petitioner relies on Henley’s “Play List” feature through use of a VS-CONNECT-LIST command, which “support[s] automation control systems in the broadcast industry.” Pet. 26; Ex. 1013, 10:15–17. Because Henley’s system “periodically checks the elapsed playing time of each video against their specified time limit,”

Petitioner contends that the limitation is met. Pet. 26–27; Ex. 1013, 21:66–67. Alternatively, Petitioner contends that some of the controls shown in Figure 8 of Henley, such as Play, Slow, Pause, Stop, and Rewind, as well as Fast Forward allow a user to vary the “duration that said content corresponding to said resource is presented.” Pet. 27–28.

But in light of our findings above, we necessarily agree with Patent Owner that Petitioner “conflates the viewer/end user with the user or system operator of Henley’s system” and improperly “relies on disclosure discussing commands available to the ‘operator’ of the media streamer system as opposed to the end user.” Prelim. Resp. 29. Petitioner thus makes an insufficient showing with respect to this limitation because Petitioner relies on system operator controls that are not taught by Henley as available to the viewer or end user.

We conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge of independent claim 1 as anticipated by Henley. Petitioner’s obviousness challenge of claim 1 over Henley relies on Dr. Bederson’s testimony in contending that certain features, if not expressly taught by Henley, would have been obvious variants, such as storing content in different locations and associating duration information with both entire programs and program segments. Pet. 35–36 (citing, *inter alia*, Ex. 1012 ¶¶ 86–89). These contentions do not remedy the deficiencies with Petitioner’s anticipation analysis, and we accordingly also conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge of independent claim 1 for obviousness over Henley.

2. Dependent Claims 2–9, 13–15, 17, 18, and 20

Each of claims 2–9, 13–15, 17, 18, and 20 depends directly or indirectly from independent claim 1. Ex. 1001, 17:65–18:21, 18:30–38, 18:42–46, 18:50–51. Petitioner challenges claims 2, 4, 7–9, 13–15, and 20 as anticipated by, or unpatentable for obviousness over, Henley, and challenges claims 3, 5, 6, 17, and 18 as unpatentable for obviousness over Henley and Reisman. Pet. 28–42. We have reviewed Petitioner’s arguments, which do not remedy the deficiencies discussed above with respect to underlying independent claim 1.

We accordingly conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its anticipation or obviousness challenges of claims 2, 4, 7–9, 13–15, and 20 over Henley, nor on its obviousness challenge of claims 3, 5, 6, 17, and 18 over Henley and Reisman.

F. Challenges over Shoham and Richardson

Petitioner challenges claims 22–27 and 32–43 as unpatentable for obviousness over Shoham and Richardson. Pet. 43–79.

1. Independent Claim 22

In addressing its challenge to independent claim 22, Petitioner relies on Shoham for most limitations, but relies on Richardson for additional elements, usually if “further disclosure is required.” See Pet. 54, 56, 63–67. “Petitioner proposes modifying *Shoham* with the explicit teachings in *Richardson* for presenting content, e.g., associating a duration with each address, details of how to present one content after another, details of the

types of content accessed and the user's interface for viewing the content.”
Id. at 47.

For some of these features, Petitioner relies on two aspects of Shoham in explaining its reasoning for effecting the modification. First, Petitioner characterizes Shoham as disclosing “a system for presenting users with online search results that uses an exploration heuristic to identify results and a presentation heuristic to present results to users,” but “does not provide details on how to present content when the presentation heuristic is different from the exploration heuristic.” *Id.* at 48. Second, Petitioner notes that one passive way that a user may provide relevance feedback in Shoham is “the length of time which elapses while viewing a particular information resource.” *Id.*; Ex. 1015, 9:4–8. Petitioner contends that, in light of these two aspects, a person of ordinary skill in the art “would have turned to *Richardson*.” Pet. 50. Petitioner specifically notes Richardson's disclosure “that each resource is presented for ‘a predetermined duration,’” that Richardson “provides detailed information on how to implement such timed presentations,” and that Richardson “even describes how to allow the user to pause, restart, or skip the current content.” *Id.* at 50–51 (citing Ex. 1016, 27–28, 9:11–12:48, 11:15–34). According to Petitioner, these aspects of Richardson “would allow the [combined] system to accomplish *Shoham*'s stated functions of monitoring how long a particular information resource is viewed.” *Id.* at 51.

Patent Owner disputes Petitioner's rationale as “contrived and based entirely on hindsight reconstruction, impermissibly using the claim as a guide to piece together disparate teachings from the two references.” Prelim. Resp. 60 (citing *Cheese Sys., Inc. v. Tetra Pak Cheese and Power*

Sys., Inc., 725 F.3d 1341, 1352 (Fed. Cir. 2013)). Patent Owner specifically highlights the different objectives of Shoham and Richardson. *Id.* at 60–61. According to Patent Owner, “Shoham’s objective is to improve a user’s ability to define and identify their information needs when users ‘have difficulty expressing that need explicitly in a format appropriate for the information retrieval system.’” *Id.* (quoting Ex. 1015, 3:45–49). “On the other hand,” Patent Owner says, “Richardson’s guided web tours take away from the user’s decision-making ability as to information of interest” because “once the user selects a guided tour, the information selected for the viewer is identical to the information selected for every other viewer of the same tour.” *Id.* at 60–61. “Given the very different objectives of Shoham and Richardson and their approaches to presenting web content to users,” Patent Owner concludes that a person of ordinary skill in the art “would not have been motivated to combine the two.” *Id.* at 61.

We agree with Patent Owner. This is true not only with respect to the high-level argument Patent Owner makes with respect to combining the teachings, but also when considering the more limited combinations Petitioner specifically proposes. This is illustrated, for example, with independent claim 22’s requirement of “automatically creating a show structure of nodes based on said search results, each node identifying a resource from a plurality of accessible resources via said communications network.” Ex. 1001, 18:61–65.

In addressing this limitation, Petitioner contends that Shoham “discloses or suggests this element” because of Shoham’s disclosure of a user “enter[ing] ‘a specific or general query’ to ‘select[] at least one information resource for presentation to a user.’” Pet. 60 (quoting Ex. 1015,

8:25–26). But as Patent Owner points out, “said search results” in this limitation refers to the “plurality of search results” provided “in response to said request.” Prelim. Resp. 50; Ex. 1001, 18:60–61. And as Patent Owner also points out, when describing the user entering “a specific or general query,” Shoham makes clear that such a step is “to initialize the heuristics.” Prelim. Resp. 50; Ex. 1015, 8:25–27. The search itself is performed, according to Shoham, using “heuristic search techniques,” not with the user-defined query. Ex. 1015, 8:32–53; *see* Prelim. Resp. 50.

Petitioner’s alternative reliance on Richardson further highlights one of the difficulties with Petitioner’s proposed combination of references. *See* Pet. 61 (arguing that a person of ordinary skill in the art “would have been motivated to look for implementation details in *Richardson*”). Specifically, Petitioner observes that Richardson discloses presenting each tour stop for a “predetermined duration” and providing the user with the ability to pause, restart, or skip the current content. *Id.* at 61–62. On this point, Petitioner directs our attention to Richardson’s discussion of “tour stop descriptor” entries, which include “the tour stop’s domain address, its associated media complements, and the durations of the stay at the stop and/or the durations of the associated media complements.” Pet. 62; Ex. 1016, 9:44–49. But this reference to “durations of the stay at the stop” clearly refers to the “predetermined duration” that is subject to change by the user, not to the actual time spent by the user at the tour stop.

This is evident from Figure 23 of Richardson, which illustrates navigation methods. *See* Ex. 1016, 3:1–2. If a user requests to advance to the next stop or return to the previous stop before the “predetermined duration” has expired, the timer is simply stopped and the user is advanced

or backed up. *Id.* at 11:15–24. If the user requests to pause and the timer is enabled, the timer is stopped; if the user requests to rejoin and the time is not enabled, the timer is started. *Id.* at 11:25–34. Thus, as Patent Owner points out, “[t]here is no disclosure that Richardson keeps track of the amount of time a user actually spends on [a tour] stop, in contrast to Shoham’s passive monitoring for relevance, which requires this information.” Prelim.

Resp. 52.

Moreover, Petitioner relies on Shoham’s exploration and presentation heuristics to be the same for at least the “without user interaction” limitation, Pet. 63, but relies on Shoham’s teaching that those heuristics may be different for other limitations, *id.* at 61. Petitioner does not sufficiently explain why applying Richardson’s features to the presentation heuristic only is consistent with its reliance on Shoham’s teaching that both heuristics should be the same.

We thus determine that Petitioner does not adequately articulate sufficient reasoning with some rational underpinning to effect the specific combination of Shoham and Richardson that it proposes in the context of the “automatically creating” limitation. We also thus determine that, even if combined in the manner Petitioner proposes, the combination does not meet the requirements of the limitation.

We further agree with Patent Owner that Petitioner presents insufficiently compelling reasoning for other aspects of its proposed combination. Although Petitioner points to Richardson’s teaching of “associating a duration with each address,” Patent Owner correctly points out that “Shoham does not *control* the duration of presentation of a resource, as doing so would be counter to Shoham’s disclosure of *passively*

monitoring the amount of time the *user* decides to view the resource.”

Pet. 47; Prelim. Resp. 61. Petitioner also points to Richardson’s “details of how to present one content after another,” but we agree with Patent Owner that “Petitioner fails to explain why such details are even relevant to Shoham, which is directed to *what* and *how much* information to present, not *how* it is presented.” Pet. 47; Prelim. Resp. 61. Indeed, Petitioner concedes that Shoham “does not provide many details about how a different presentation heuristic presents contents.” Pet. 44. And in addressing Petitioner’s incorporation of Richardson’s “details of the types of content accessed and the user’s interface for viewing the content,” Patent Owner persuasively observes that “Richardson’s user interface does not present search results and does not allow for users to identify content of interest, whether actively or passively, a necessary element of any user interface suitable for use with Shoham’s system.” Pet. 47; Prelim. Resp. 62.

We thus determine that Petitioner does not adequately articulate sufficient reasoning with some rational underpinning to support the legal conclusion of obviousness, and that the combination of Shoham and Richardson, even if effected, does not meet all limitations of independent claim 22. We conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge of independent claim 22 for obviousness over Shoham and Richardson.

2. Claims 23–27 and 32–43

Each of claims 23–27 and 32–43 depends directly or indirectly from independent claim 22. Ex. 1001, 19:9–30, 19:44–67. Petitioner challenges these claims as unpatentable for obviousness over Shoham and Richardson.

Pet. 67–79. We have reviewed Petitioner’s arguments, which do not remedy the deficiencies discussed above with respect to underlying independent claim 22.

We accordingly conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenges of claims 23–27 and 32–43 as unpatentable for obviousness over Shoham and Richardson.

IV. DISCRETIONARY DENIAL

As noted above, the ’932 patent is the subject of parallel proceedings in the form of the related litigation. *Supra*, § I.F. Patent Owner asks that we exercise our discretion to deny the Petition based on the state of the related litigation. Prelim. Resp. 10–14. Patent Owner additionally asks that we exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition because Petitioner’s challenges based on Shoham and Richardson “raise[] substantially the same prior art and arguments considered during prosecution of the parent ‘451 Patent, and Petitioner failed to allege any error in the Examiner’s consideration of the art in connection with similar claim 22 of the ‘451 Patent.” *Id.* at 44.

Because we deny the Petition on the merits, we do not reach these issues.

V. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition does not establish a reasonable likelihood that Petitioner would prevail in showing that at least one of claims 1–9, 13–15, 17, 18, 20,

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22–27, and 33–43 of the '932 patent is unpatentable. Accordingly, we deny the Petition and decline to institute an *inter partes* review.

VI. ORDER

In consideration of the foregoing, it is
ORDERED that the Petition is *denied*, and no trial is instituted.

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