

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.

IPR2022-01236
Patent 8,677,398 B2

Before KRISTEN L. DROESCH, THOMAS L. GIANNETTI, and
STACEY G. WHITE *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 13–17 and 19–26 of U.S. Patent No. 8,677,398 B2 (Ex. 1001, “’398 Patent”). Paper 2 (“Pet.”). Petitioner filed a Declaration of Samrat Bhattacharjee, Ph.D., with its Petition. Ex. 1003. Intent IQ, LLC (“Patent Owner”) 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).

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

B. Related Matters

The parties indicate the ’398 Patent is or has been involved in the following district court proceedings:

Roku, Inc. v. AlmondNet, Inc., 1:21-cv-01035 (D. Del.);
AlmondNet, Inc., v. Roku, Inc., 6:21-cv-00731 (W.D.Tex.) (stayed);
AlmondNet, Inc., v. Samsung Elecs. Co., Ltd., 6:21-cv-00891 (W.D.Tex.);
AlmondNet, Inc., v. Meta Platforms, Inc., 6:21-cv-00896 (W.D.Tex.);

AlmondNet, Inc., v. Microsoft Corp., 6:21-cv-00897 (W.D.Tex.); and
AlmondNet, Inc., v. Amazon.com, Inc., 6:21-cv-00898 (W.D.Tex).
Pet. 1–2; Paper 3, 1.

Petitioner also indicates the '398 Patent was the subject of the following district court proceedings:

AlmondNet, Inc. et al v. Yahoo! Inc., 1:16-cv-01557 (E.D.N.Y.) and
AlmondNet, Inc. et al v. Oath Holdings Inc. fka Yahoo!, 1:19-cv-00247 (D.Del.) (terminated).
Pet. 2.

The parties further indicate the '398 Patent is the subject of IPR2022-00773 (pending). Pet. 2; Paper 3, 1. Petitioner indicates the '398 Patent was the subject of IPR2017-01299 (institution denied). Pet. 2.

C. The '398 Patent (Ex. 1001)

The '398 Patent discloses a method for delivering targeted television advertisements based on online behavior. *See* Ex. 1001, Abstract.

Figure 7 of the '398 Patent is reproduced below:

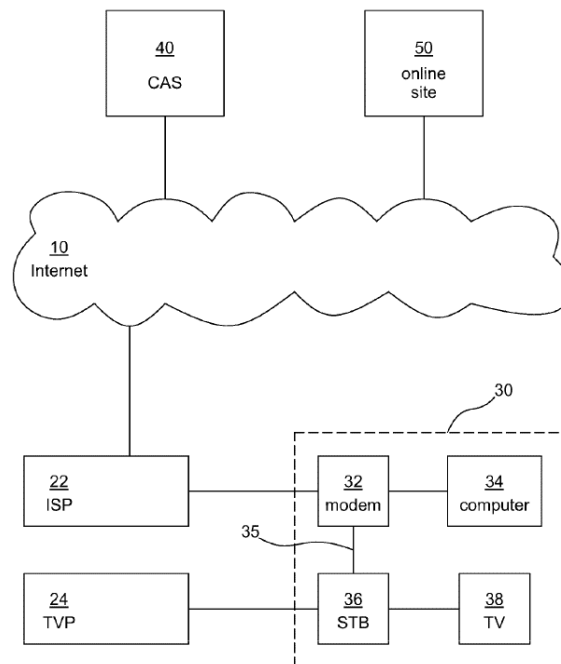


Figure 7 depicts central ad server (CAS) 40 and online site 50 connected to Internet 10, modem 32 connected to Internet service provider (ISP) 22, computer 34 and set-top box (STB) 36, and TV 38 connected to STB 36 and television provider (TVP) 24. *See* Ex. 1001, 12:47–13:21. An identifier can be assigned to STB 36, such as an equipment serial number or a portion thereof, a device MAC address or a portion thereof, a username, a pseudonym, a tag or other identifying code or data element, and may include the IP address STB 36 is using when in contact with CAS 40. *See id.* at 15:1–14.

Once a STB is confirmed to have been using a certain IP address at a certain date and time (for example by having a uniquely tagged STB consecutively communicate with the CAS using the same IP address . . .), the CAS database can be searched to find all computers, mobile devices, and other STBs that used the same IP address at the same date and time, and those will be assumed to be devices that are part of the same household and same LAN. Then, an association or link is created among the devices, by linking the device identifiers or tags with the STB's identifier in the CAS database

Once the association is created, profile information (both behavioral and demographic) collected about the computers and mobile devices before and after the association was created could be used to target ads to the STB, regardless of the IP addresses used by the computers and mobile devices (such as cell phones) to access the web at the time the profiles were collected.

Ex. 1001, 18:24–50.

D. Illustrative Claim

Claim 13 is independent, and claims 14–17 and 19–26 depend directly or indirectly therefrom. *See* Ex. 1001, 24:47–25:50. Claim 13 is illustrative and reproduced below:

13. A method implemented using a programmed hardware computer system, the method comprising:

- (a) based on first electronic profile data associated with an electronic identifier of a first device, automatically causing, with the computer system, an action to be taken with respect to a second device that is indicated at the time of the action by an electronic identifier electronically associated with the first device identifier;
- (b) wherein the electronic association between the first and second device identifiers is based on connection, before the action, of each of the first and second devices, independently of the other, to a common local area network, wherein the computer system is connected to the local area network through the Internet but is not in the local area network.

Ex. 1001, 24:47–61.

E. Asserted Challenges to Patentability and Asserted Prior Art

Petitioner asserts that claims 13–17 and 19–26 would have been unpatentable based on the following grounds (Pet. 9):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
13–17, 20–23	103(a) ¹	Madhavan, ² Baum ³
19	103(a)	Madhavan, Baum, Damick ⁴
24, 25	103(a)	Madhavan, Baum, Varghese ⁵

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103 effective March 16, 2013.

Because the '398 Patent has a filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of § 103.

² U.S. Patent No. 8,180,674 B2, issued May 15, 2012 (Ex. 1008).

³ U.S. Patent No. 7,843,923 B2, issued Nov. 30, 2010 (Ex. 1010).

⁴ U.S. Patent Application Pub. No. 2006/0242294 A1, published Oct. 26, 2006 (Ex. 1031).

⁵ U.S. Patent No. 7,908,645 B2, issued Mar. 15, 2011 (Ex. 1016).

II. ANALYSIS

A. Claim Construction

In an *inter partes* review proceeding, the Board applies the same claim construction standard as that 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); *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.

Petitioner asserts that “no claim term requires express construction.” Pet. 8–9. Likewise, “Patent Owner does not contend that any terms . . . require express construction.” Prelim. Resp. 5. As demonstrated in the analysis below, at this stage of the proceeding, we need not construe explicitly any claim terms or phrases. *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. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art “in April 2007 would have a bachelor’s or 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 “[a] person with less formal education but more experience, or more formal education but less experience, could have also met the relevant standard.” Pet. 8 (citing

Ex. 1003 ¶¶ 15–16). At this stage of the proceeding, Patent Owner does not challenge Petitioner’s definition. *See* Prelim. Resp. 4–5.

For the purpose of deciding whether to institute, 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 ’398 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).⁶

D. Challenge to Claims 13–17 and 20–23 over Madhavan and Baum

1. Overview of Madhavan (Ex. 1008)

Madhavan is directed to targeting advertisements via sharing of information between devices over a network. *See* Ex. 1008, 1:7–11.

⁶ The parties do not present evidence related to secondary considerations.

Figure 2 of Madhavan is reproduced below.

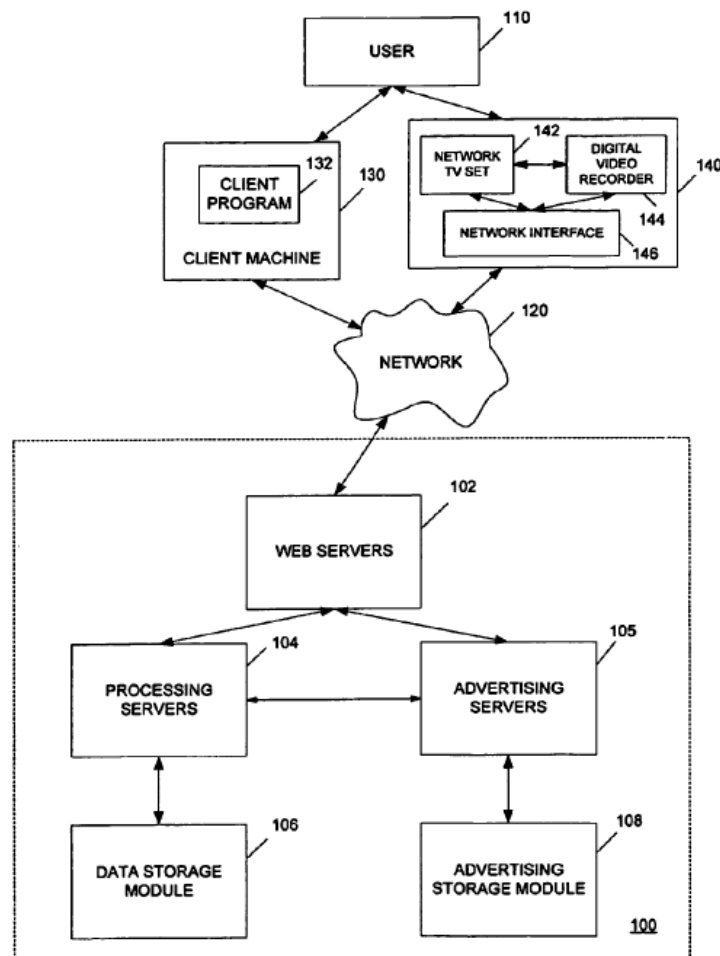


Figure 2 depicts network-based advertisement entity 100 coupled to user entity 110 via client machine 130 or media device 140 and network 120. *See* Ex. 1008, 4:37–45. Network-based advertising entity 100 “enable[s] automatic matching of advertising information to events or actions and interests of users.” *Id.* at 4:28–31. Client machine 130 includes client program 132, such as a browser, that allows user entity 110 to access advertisement entity 100 by way of network 120, such as for example, the Internet, wide area network (WAN), local area network (LAN), or wireless network. *See id.* at 5:3–15. Media device 140 can include “network-enabled television set 142, such as an Internet TV set” that may or may not be

coupled to a digital video recording device, and that communicates with advertisement entity 100. *See id.* at 5:28–32. Alternatively, both the network-based television set 142 and digital video recording device 144 are coupled to network-based advertisement entity 100 via network 120 and a network interface module 146. *See id.* at 5:32–36. Advertisement entity 100 may communicate with other network entities via web server 102 and advertising server 105. *See id.* at 5:18–27; Fig. 2. Another back-end server within network-based advertisement entity 100 is processing server 104 which is coupled to data storage module 106 whereas advertising storage module 108 is coupled to advertising server 105 that stores advertisements to be transmitted and displayed for users over the network 120. *See id.* at 4:57–65. Data storage module 106 may be a database including user tables 210, categories tables 220, and activity tables 230 pertinent to stored data related to the user. *See id.* at 4:61–62; 5:37–40; 5:48–52; Fig. 3.

When a user connects to one or more media devices and performs specific actions, such as, “watch[ing] a broadcast television program on the network-enabled television set or watches a television program which has been previously recorded onto the digital video recording device,” the actions are transmitted to and stored within the advertisement entity “along with respective categories associated with each user action.” Ex. 1008, 1:55–63. Thereafter, when user 110 connects to advertisement entity 100 through client machine 130, advertisement entity 100 selects advertisements from advertisement storage module 108 that are related to previously stored actions or categories from data storage module 106, for display on client machine 130. *See id.* at 1:64–2:3; 8:34–41; Fig. 6, step: 510. During the login process of user 110 onto client machine 130, processing server 104 of advertisement entity 100 receives “the user identification information such

as, for example, the unique IP address and/or password information associated with the user 110,” thereby allowing determination of “classification categories associated with each respective event or action input” by user 110. *Id.* at 8:43–48; 8:57–59. “[A]dvertisements related to the stored user actions or activities and their respective categories are transmitted to the user 110 to be displayed on one or more media devices 140 coupled to the user 110.” *See id.* at 9:4–8; Fig. 6, step: 520.

2. Overview of Baum (Ex. 1010)

Baum is directed to the determination of a port or a physical location associated with an IP device. *See Ex. 1010, 1:15–17.* Baum explains that dynamic allocation of IP addresses and re-use of IP addresses complicate correlation of a specific device or a physical location with an IP address. *See id.* at 4:26–32. Baum purports to resolve this problem by using an edge router associated with a table and a “simple look-up table operation.” *See id.* at 5:51–6:9.

Figure 5 of Baum is reproduced below.

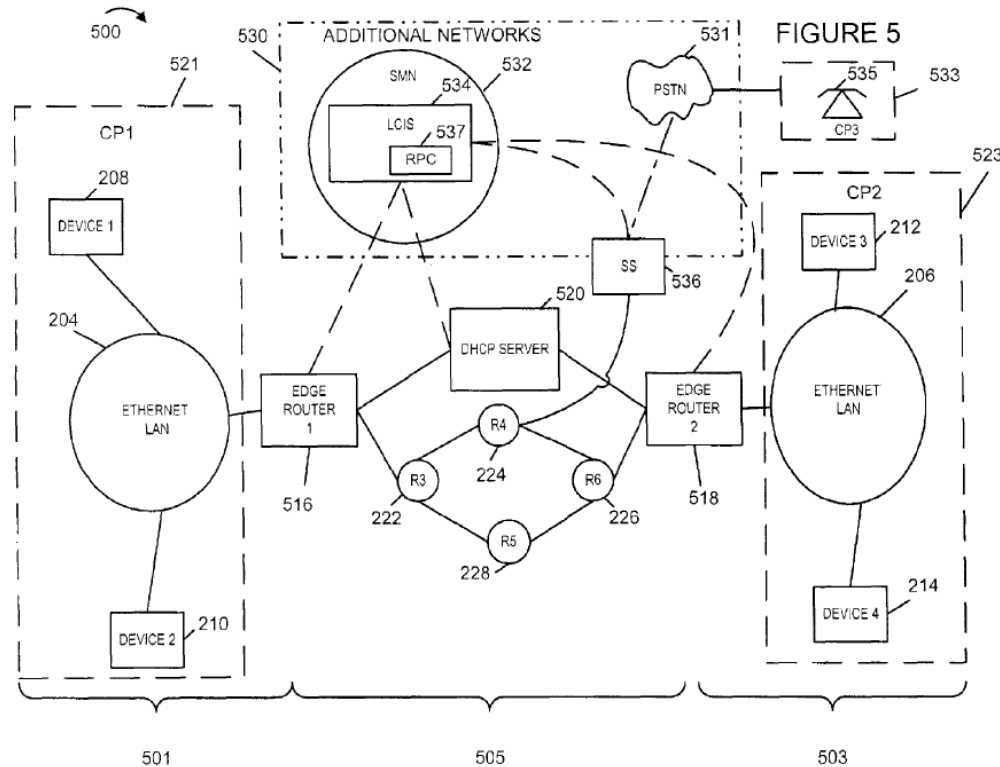


Figure 5 depicts communication system 500 including LAN 501 coupled to LAN 503 via IP-based network 505. *See* Ex. 1010, 12:4–5; 12:24–26. Baum explains that “LANs tend to be relatively limited geographically, e.g., to a single office or floor of a building. The offices and/or buildings are sometimes referred to as customer premises since the office and/or building is the premise of a communications customer, e.g., an IP service subscriber.” *Id.* at 6:23–27. LAN 501 is located at first customer premise (CP1) 521 and includes devices 208, 210 connected via Ethernet LAN 204. *Id.* at 12:16–17; Fig. 5. LAN 503 is located at second customer premise (CP2) 523 and includes devices 212, 214 connected via Ethernet LAN 206. *See id.* at 12:20–21; Fig. 5. IP-based network 505 includes first and second edge routers 516, 518 that interface with Ethernet LANs 204, 206, respectively. *See id.* at 12:29–31. IP-based network 505 further includes DHCP

(Dynamic Host Configuration Protocol) server 520 that is responsible for dynamically assigning IP addresses. *See id.* at 12:36–37; Fig. 5.

Communication system 500 may further include SMN (secure management network) 532 which includes LCIS (Location and Customer Information) server 534, which in turn, includes RPC (Router-Port to Customer) database 537, which includes sets of customer records. *See id.* at 6:62–7:1, 12:49–54; 12:64–13:4. Baum explains that “[i]ndividual customers and/or companies with multiple distinct locations e.g., different customer premises, are assigned different edge router ports for each distinct physical location. Thus, each edge router port assigned to a customer in accordance with the invention will correspond to a single physical location.” *Id.* at 6:56–61.

Figure 6 of Baum is reproduced below:

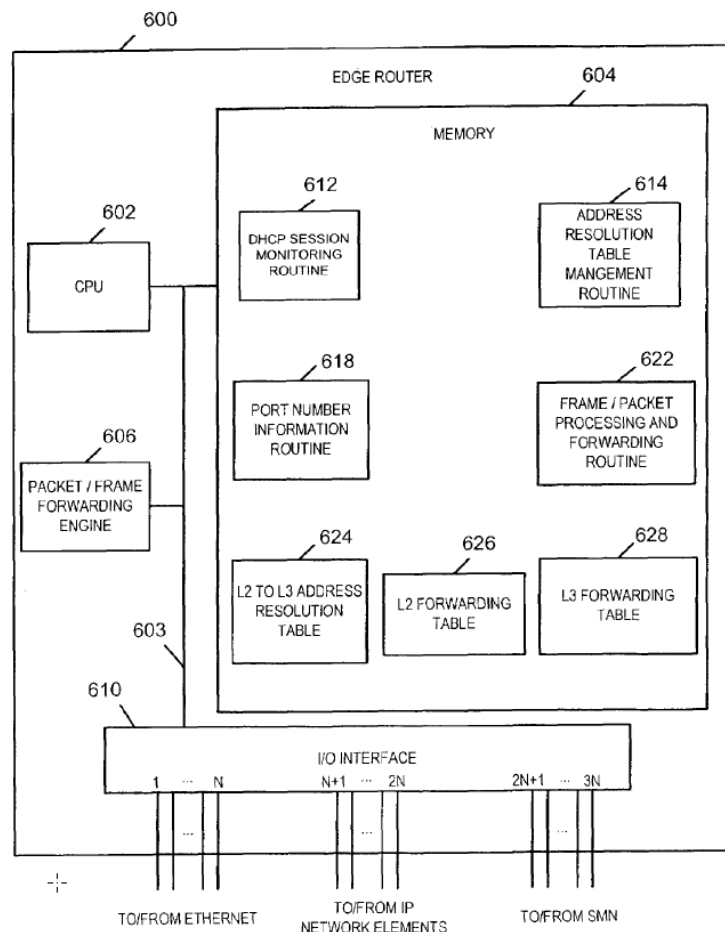


Figure 6 depicts edge router 600. *See* Ex. 1010, 11:44–45; 13:18. Edge router 600 may be used by any one of edge routers 516 or 518 of Figure 5. *See id.* at 13:18–20. Edge router 600 includes CPU 602, packet frame forwarding engine 606, memory 604, and I/O interface 610, which includes a plurality of ports used to connect edge router 600 to various networks. *See id.* at 13:20–24. Ports 1 through N are used to couple edge router 600 to one or more LANs, ports N+1 through 2N are used to connect to elements of IP network 505, and ports 2N+1 through 3N are used to couple edge router 600 to SMN 532 and LCIS 534. *See id.* at 13:24–30. Memory 604 includes L2 forwarding table 626, L3 forwarding table 628, L2 to L3 address resolution table 624, frame/packet processing forwarding routine 622, DHCP session monitoring routine 612, address resolution table management routine 614, and port number information routine 618. *See id.* at 13:31–36.

Figures 7–9 of Baum are reproduced below.

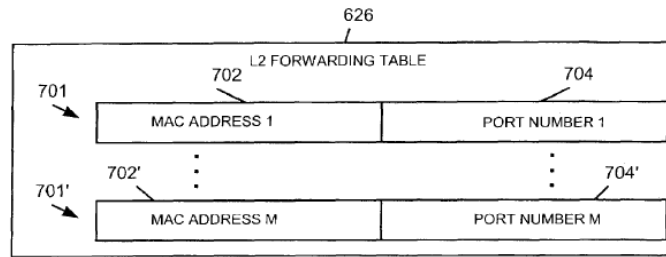


FIGURE 7

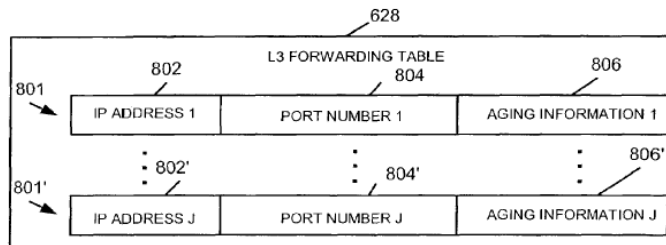


FIGURE 8

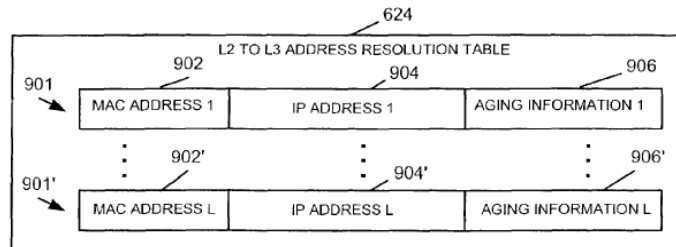


FIGURE 9

Figures 7–9 illustrate L2 forwarding table 626, L3 forwarding table 628, and L2 to L3 address resolution table 624, respectively. *See* Ex. 1010, 11:46–47; 13:40; 13:50–52; 13:62–64. Layer 2 forwarding table 626 includes information for forwarding received Ethernet frames according to the MAC destination address in the frame’s header. *See id.* at 13:37–39. Table 626 includes a plurality of entries 701, 701’ which includes MAC address 702, 702’ and port numbers 704, 704’. *See id.* at 13:41–43. Under the direction of forwarding routine 622, frames received by the edge router having a MAC address listed in L2 forwarding table 626 are output using the port 704, 704’ corresponding to the destination MAC address 702, 702’. *See id.* at 13:43–46; 14:51–56. Layer 3 forwarding table 628 is used by an edge

router “to forward IP packets in the IP domain.” *See id.* at 13:59–60. Layer 3 forwarding table 628 includes entries 801, 801’ which include IP addresses 802, 802’, port numbers 804, 804’, and aging information 806, 806’, respectively. *See id.* at 13:51–53. Under the direction of a forwarding routine, IP packets received by the edge router having a MAC address listed in the L2 forwarding table 626 (Fig. 7) are output using port 804, 804’ corresponding to the destination IP address. *See id.* at 13:56–60; *see also id.* at 14:46–56 (describing use of L2 forwarding table 626 in port number identification routine 618). L2 to L3 address resolution table 624, is used for converting between Layer 2 (e.g., MAC addresses) and Layer 3 (e.g., IP addresses) and includes a plurality of entries 901, 901’, each including MAC address 902, 902’, IP address 904, 904’, and aging information 906, 906’, respectively. *See id.* at 13:62–67; *see also id.* at 14:46–63 (describing use of L2 to L3 address resolution table 624 in port number identification routine 618). An address resolution table management routine 614 is used for deleting entries from L2 to L3 address resolution table 624 and L3 forwarding table 628 “after an entry has aged for a preselected period of time as indicated from the aging information stored for each entry.” *Id.* at 14:31–35; *see id.* at 13:53–56; 13:67–14:2; 14:31–35.

3. Analysis

Petitioner asserts that the teachings of Madhavan alone disclose both the preamble and the limitation

based on first electronic profile data associated with an electronic identifier of a first device, automatically causing, with the computer system, an action to be taken with respect to a second device that is indicated at the time of the action by an

electronic identifier electronically associated with the first device identifier

as recited in independent claim 13. *See* Pet. 28–37. In particular, Petitioner identifies Madhavan’s client machine 130 as teaching the claimed first device and TV set 142 or DVR 144 as teaching the second claimed device. *See id.* at 30 (citing Ex. 1003 ¶ 68; Ex. 1008, Fig. 2); 31 (reproducing Ex. 1008, Fig. 2 (with annotations)). Petitioner asserts that “Madhavan discloses *electronic identifiers* (e.g., unique IP addresses) for client machine 130, TV set 142, and DVR 144 identify the user and are associated with user *profile* data.” *Id.* at 30 (citing Ex. 1008, 7:14–22, 8:42–48). According to Petitioner, “because Madhavan uses device IP addresses to identify a corresponding user’s electronic profile data stored in user tables 210 and category tables 220 and activity tables linked thereto,” a person of ordinary skill in the art “would understand that the *electronic identifiers* for *first* and *second devices* used by a given user would be *associated with* the user’s *electronic profile data* and, indeed, each other.” *Id.* at 32–33 (citing Ex. 1003 ¶ 70; Ex. 1008, 8:63–67). Petitioner asserts that “Madhavan teaches that a user’s actions on a client machine 130 (*first device*) are stored in association with the user and the user’s TV set 142 or DVR 144 (*second device*), and targeted advertisements are then delivered to the user’s *second device* (TV set 142 or DVR 144).” *Id.* at 34; *see id.* at 34–35 (reproducing Ex. 1008, Fig. 6 (with added color); citing Ex. 1003 ¶ 74; Ex. 1008, 8:37–41). Petitioner also contends that Madhavan’s teaching of delivery of a targeted advertisement to a second device is “automatically causing, with the computer system, an action to be taken,” as required by claim 13. *See id.* at 35–37 (reproducing Ex. 1003, Fig. 6 (with color

annotations added); citing Ex. 1003 ¶¶ 76–81; Ex. 1008, 9:4–8, Fig. 6, step: 520).

Petitioner relies upon the combination of Madhavan and Baum to teach or suggest the limitation “wherein the electronic association between the first and second device identifiers is based on connection, before the action, of each of the first and second devices, independently of the other, to a common local area network,” (“the common LAN limitation”), recited in independent claim 13. *See* Pet. 37 (citing Ex. 1003 ¶ 84), 40–41 (citing Ex. 1003 ¶ 96); *see* Prelim. Resp. 9 (arguing the Petition does not allege that Madhavan alone discloses the common LAN limitation, citing Pet. 37–46). Petitioner further relies on the teachings of Baum to support its rationale to combine the teachings of Madhavan and Baum. *See* Pet. 25–28.

Specifically, Petitioner relies on Baum for teaching: (1) “an environment using dynamically-assigned IP addresses” (Pet. 25 (citing Ex. 1003 ¶ 51), *see id.* at 26 (relying on Baum for teaching IP addresses leased to users/host devices on a dynamic basis, citing Ex. 1003 ¶ 53; Ex. 1010, 3:39–45, 3:55–60, 4:20–21, 4:29–32), 27 (“DHCP-mediated dynamic allocation of IP addresses,” citing Ex. 1003 ¶ 56));⁷ and (2) “techniques for recognizing that particular device IP addresses connect to the Internet via a particular edge router and thereby determining that multiple devices are connected to a common LAN” (*id.* at 25 (citing Ex. 1003 ¶ 51), *see id.* at 26 (similar assertion, citing Ex. 1003 ¶¶ 53–55), 27 (similar assertions, citing Ex. 1003 ¶¶ 56, 59))⁸.

⁷ Claim 13 does not recite limitations directed to an environment using dynamically-assigned IP addresses. *See* Ex. 1001, 24:47–61.

⁸ Claim 13 does not recite limitations directed to recognizing particular device IP addresses connected to the Internet via a particular edge router and

As for reasons to combine the teachings of Madhavan and Baum, Petitioner asserts that a person of ordinary skill in the art

would have been motivated to apply Baum's techniques for recognizing that particular device IP addresses connect to the Internet via a particular edge router and thereby determining that multiple devices are connected to a common LAN to provide the obvious, beneficial, and predictable results of adapting Madhavan's method of targeting advertisements based on mutual sharing between IP-addressed devices on a common network *to operate in an environment using dynamically-assigned IP addresses*, as taught by Baum.

Pet. 25 (citing Ex. 1003 ¶ 51) (emphasis added). According to Petitioner, a person of ordinary skill in the art “would have been motivated to incorporate Baum's teachings in Madhavan to facilitate targeting of advertisements based on associations of device identifiers (e.g., IP addresses) *in networking environments where device IP addresses are dynamically assigned and therefore subject to change.*” *Id.* at 26 (citing Ex. 1003 ¶ 53) (emphasis added). In support of this argument, Petitioner points out that Baum explains that IP addresses are commonly leased on a dynamic basis to host devices, the IP addresses assigned to a particular device can change from moment to moment, therefore, the dynamic allocation of and re-use of IP addresses complicates attempts to correlate specific devices and physical locations with an IP address. *See id.* (citing Ex. 1010, 3:39–45, 3:55–60, 4:20–21, 4:29–32). Petitioner also contends that

Baum's techniques for reliably determining that multiple dynamic-IP-addressed devices are connected to a common LAN at a particular customer premise and thereby associating those devices would have provided a benefit—device identifier associations for targeted advertisements in a dynamic-IP

determining that multiple devices are connected to a common LAN. *See Ex. 1001, 24:47–61.*

environment—that would have been understood by POSITA and that would have motivated the combination.

Pet. 26–27 (citing Ex. 1003 ¶¶ 53–55). Petitioner further asserts that combining Madhavan’s associations of multiple device identifiers (e.g., unique IP addresses) for advertising targeted to devices associated with the same user profile with Baum’s automated recognition of multiple IP-addressed devices at a particular customer premise (with provider-assigned, globally-unique dynamic IP addresses) based on connection to a common LAN would have been no more than the combination of known elements according to known methods (DHCP-mediated dynamic allocation of IP addresses and router:port tracking in the course of assignment), and would have been obvious to POSITA to achieve the benefits of targeted advertising in an environment using dynamically-assigned IP addresses.

Pet. 27 (citing Ex. 1003 ¶¶ 56, 59).

Patent Owner challenges the sufficiency of Petitioner’s motivation to combine the teachings of Madhavan and Baum. *See* Pet. 24–25. We agree with the principle of Patent Owner’s argument. We, however, find that Petitioner’s rationale for combining the teachings of Madhavan and Baum is insufficient for different reasons.

In particular, we are not persuaded that the alleged beneficial result of the combination presented in the Petition—e.g., “facilitat[ing] targeting of advertisements based on associations of device identifiers (e.g., IP addresses) in networking environments where device IP addresses are dynamically assigned and therefore subject to change” (Pet. 26, *see id.* at 25–27 (similar articulations of benefit)), provides sufficient articulated rationale to explain why a person of ordinary skill in the art would “apply Baum’s techniques for recognizing that particular device IP addresses connect to the Internet via a particular edge router and thereby determining

that multiple devices are connected to a common LAN” to “Madhavan’s method of targeting advertisements based on mutual information sharing between IP-addressed devices on a common network” (*id.* at 25, *see id.* at 26–27 (similar articulations of combination)). We are not persuaded the Petition sufficiently explains why one of ordinary skill in the art would look to Baum’s teaching. In particular, Petitioner has not explained sufficiently why Madhavan would require the teachings of Baum to operate in an environment using dynamically assigned IP addresses. As such, it is unclear that a person of ordinary skill in the art would apply Baum’s edge routers and techniques for determining that multiple dynamic-IP addressed devices are connected to a common LAN in order to achieve the claimed invention. “The obviousness inquiry does not merely ask whether a skilled artisan could combine the references, but instead asks whether ‘they would have been motivated to do so.’” *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1359 (Fed. Cir. 2020) (quoting *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)).

Accordingly, we are not persuaded the Petition sets forth sufficient articulated reasoning with rational underpinning why a person of ordinary skill in the art would have combined the teachings of Madhavan and Baum to achieve the claimed invention, including the electronic association based on connection to a common LAN limitation, unequivocally identified in the Petition as taught by the combination of Madhavan and Baum (*see* Pet. 37, 40–41). We also agree with Patent Owner’s argument that “a mere assertion that references are analogous art provides no reason for the specific modification proposed by the Petition.” Prelim. Resp. 28 (emphasis omitted); *see* Pet. 25–26 (asserting that Madhavan and Baum are analogous art to the ’398 Patent).

Accordingly, based on the record before us, Petitioner does not establish a reasonable likelihood it would prevail in showing that the subject matter of independent claim 13 is unpatentable as obvious over Madhavan and Baum. Due to the dependency of claims 14–17, 20–23, and 26 ultimately from independent claim 13, (*see* Ex. 1001, 24:62–25:14, 25:26–39, 25:47–50), and for the same reasons as those addressing claim 13, Petitioner does not establish a reasonable likelihood it would prevail in showing that the subject matter of dependent claims 14–17, 20–23, and 26 are unpatentable over Madhavan and Baum.

E. Challenge to Claim 19 over Madhavan, Baum, and Damick

Claim 19 depends ultimately from independent claim 13. *See* Ex. 1001, 25:19–25. As applied by Petitioner, the teachings of Damick do not remedy the deficiencies of the combined teachings of Madhavan and Baum discussed in the preceding section addressing independent claim 13. *See* Pet. 73–82. Therefore, for the same reasons as those addressing claim 13, Petitioner does not establish a reasonable likelihood it would prevail in showing claim 19 is unpatentable over Madhavan, Baum, and Damick.

F. Challenge to Claims 24 and 25 over Madhavan, Baum, and Varghese

Claims 24 and 25 depend ultimately from independent claim 13. *See* Ex. 1001, 25:40–46. As applied by Petitioner, the teachings of Varghese do not remedy the deficiencies of the combined teachings of Madhavan and Baum discussed in the preceding section addressing independent claim 13. *See* Pet. 83–88. Therefore, for the same reasons as those addressing claim 13, Petitioner does not establish a reasonable likelihood it would

prevail in showing claims 24 and 25 are unpatentable over Madhavan, Baum, and Varghese.

F. Discretion under 35 U.S.C. § 314

Patent Owner argues that the Board should exercise its discretion to deny institution of inter partes review under 35 U.S.C. § 314. *See* Prelim. Resp. 28–42. Because we deny institution on the merits of the proposed patentability challenges to claims 13–17 and 19–26, we need not address Patent Owner’s arguments urging discretionary denial of institution.

III. CONCLUSION

For the foregoing reasons, we determine there is not a reasonable likelihood that Petitioner would prevail in showing at least one of the challenged claims of the ’398 Patent is unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied, and no *inter partes* review is instituted.

IPR2022-01236
Patent 8,677,398 B2

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