

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DRAFTKINGS INC.,
Petitioner,

v.

WINVIEW INC.,
Patent Owner.

IPR2022-01351
Patent 9,878,243 B2

Before HUBERT C. LORIN, MICHAEL R. ZECHER, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

This is a Final Written Decision in an *inter partes* review challenging the patentability of claims 1, 3, 4, and 6 of U.S. Patent No. 9,878,243 B2 (Ex. 1001, “the ’243 patent”). We have jurisdiction under 35 U.S.C. § 6.

Petitioner has the burden of proving unpatentability of a claim by a preponderance of the evidence. 35 U.S.C. § 316(e). Having reviewed the arguments of the parties and the supporting evidence, we find that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 3, 4, and 6 are unpatentable.

A. Background

DraftKings, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 3, 4, and 6 of the ’243 patent. WinView, Inc. (“Patent Owner”; “WinView”) did not file a Preliminary Response.

After the Decision on Institution (Paper 8, “Dec. on Insti.”), Patent Owner filed a Patent Owner Response (Paper 16, “PO Resp.”); Petitioner filed a Reply (Paper 19, “Pet. Reply”); and Patent Owner filed a Sur-reply (Paper 20, “PO Sur-reply”).

On November 2, 2023, the parties presented arguments at oral hearing, the transcript of which is of record. Paper 29.

B. Related Proceedings

Patent Owner has made us aware that another petitioner filed petitions requesting an *inter partes* review in of *FanDuel, Inc. v. WinView Inc.*, IPR2022-01306 and *FanDuel, Inc. v. WinView Inc.*, IPR2022-01307. Papers 6, 1, and 25, 1. Both of these petitions were granted on January 31, 2023

(IPR2022-1306, Paper 7 (institution decision), IPR2022-01307, Paper 6 (institution decision)), and final written decisions addressing the challenged claims are entered concurrently herewith.

C. Real Party in Interest

Petitioner identifies DraftKings Inc. (Nevada), DraftKings Inc. (Delaware), and Crown Gaming Inc. as real parties in interest. Pet. 1.

Patent Owner states that “[t]he real-party-in-interest in Patent Owner is WinView IP Holdings LLC, and WinView Technology Inc. as its sole General Partner (‘WinView’).” Paper 25, 1.

D. The ’243 patent (Ex. 1001)

1. Disclosure

The ’243 patent, titled “Methodology For Equalizing Systemic Latencies In Television Reception In Connection With Games Of Skill Played In Connection With Live Television Programming,” relates to games of skill that rely on watching live or taped televised events. Ex. 1001, code (54), 2:29–31.

The ’243 patent describes problems with playing games of skill that rely on watching televised events due to delay issues. “Games of skill that rely on participation by watching an event on a television have potential latency issues since television signal reception is not synchronized nationwide.” Ex. 1001, 2:29–31. “[T]o maintain user enjoyment and fairness for all participants, these delays must be neutralized.” *Id.* at 2:41–42.

The ’243 patent describes solving the latency issue through “a system and method to effectively equalize systemic propagation delay variances to a required level dictated by the demands and rules of a particular game, so that

a material competitive advantage is not obtained and the user experience is optimized for all players.” Ex. 1001, 6:38–43. Fig. 1, reproduced below, illustrates a flowchart of a process of preventing latency.

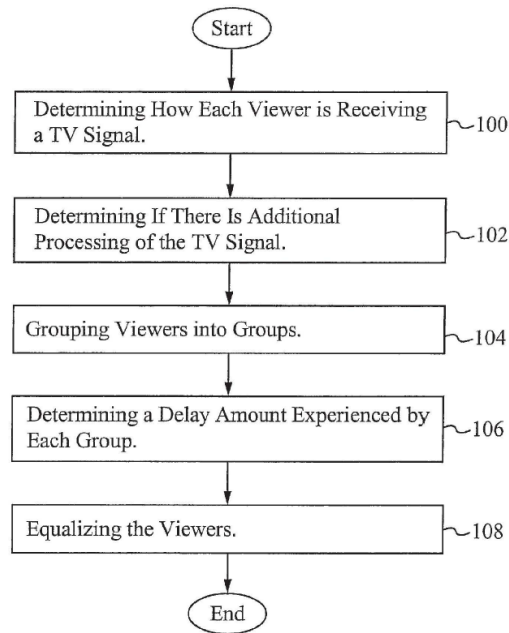


Fig. 1

Fig. 1 of '243 patent illustrates a flowchart of a process of preventing potential latency issues experienced when playing games of skill that rely on participation by watching an event on a television. *Id.* at 4:58–60, 8:22–24.

The methods of “equalizing” (step 108) “include time stamping on . . . game ‘lock out’ signals, imposing a time stamp on the entire data stream so that competitors receiving their television information is slightly behind or ahead of others gain no material competitive advantage.” Ex. 1001, 8:36–40, Fig. 1, step 108.

2. Claims 1, 3, 4, and 6

Petitioner challenges claims 1, 3, 4, and 6. Pet. 1. Claim 1 is independent and claims 3, 4, and 6 depend therefrom.

Claim 1 is reproduced below.

1. 1[preamble]¹ A method of equalizing effects of latency differences in a game of skill or chance or other entertainment comprising:

- a. 1[a] receiving an online broadcast of content;
- b. 1[b] synchronizing the game of skill or chance or other entertainment with the online broadcast of content; and
- c. 1[c] presenting the online broadcast of content and synchronized game data.

Ex. 1001, 15:2–8.

E. Asserted References and Testimonial Evidence

Petitioner relies on the following references:

Name	Reference	Exhibit No.
Wallace	U.S. Patent Application Publication No. 2004/0244057, published Dec. 2, 2004	1003
Fahy	U.S. Patent Application Publication No. 2004/0261128, published Dec. 23, 2004	1004

Petitioner also relies on the Declarations of Kevin Jeffay, Ph.D. (Exs. 1002, 1022) and the Deposition transcript of Patent Owner’s declarant, Prashant Shenoy, Ph.D. (Ex. 1021), as support for the various contentions.

Patent Owner relies on the Declaration of Dr. Shenoy (Ex. 2001) and the Deposition transcript of Petitioner’s declarant, Dr. Jeffay (Ex. 2002), as support for the various contentions.

¹ Petitioner’s designations to reference the elements of claim 1 are set forth in brackets. Pet. 25–62. Herein we refer to the elements of claim 1 using Petitioner’s designations.

F. Asserted Grounds

Petitioner contends that claims 1, 3, 4, and 6 of the '243 patent are unpatentable under the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
I	1, 3, 4, 6	103(a) ²	Wallace, Fahy
II	1, 3, 4, 6	103(a)	Wallace

Pet. 4.

G. Overview of the Prior Art References

1. Wallace (Ex. 1003)

Wallace “deals with the problem of executing interactive television applications [such as an interactive game] that are related to, or synchronized with, broadcast video signals.” Ex. 1003 ¶ 14. Problems come about when the broadcast includes, for example, commercials that “may delay, interrupt or create discontinuities within the original taped

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. The '243 patent claims the benefit of earlier-filed applications having effective filing dates before the effective date of the applicable AIA amendments (March 16, 2013). See Ex. 1001, (60), (63), 1:10–36. This is not in dispute and therefore we refer to the pre-AIA versions of 35 U.S.C. § 103 throughout this Decision. We note that, while Petitioner “does not concede that any of the challenged claims are entitled to benefit” of U.S. Provisional Application No. 60/791,793, filed on April 12, 2006, that Patent Owner contended in the co-pending litigation, no further argument is presented. Pet. 3 n. 1 (citing Ex. 1013 ¶ 22).

source material.” *Id.* ¶ 48. In order to play an interactive game related to a broadcast successfully, “[s]ynchronization of the operation of the (local) application and the (remote) broadcast is essential.” *Id.* ¶ 7.

Wallace describes a synchronization technique whereby event data (e.g., segments of a game) associated with times they occur in a broadcast are recorded in an index. Ex. 1003 ¶ 49.

The broadcaster receives the content from the content provider including the base source broadcast content (e.g. the game show edited without commercials), and the index of events and times. The broadcaster, or another entity, would transmit the events and times to IRDs [integrated receiver decoders] for storage in advance of live broadcast of the program.

Id. When the broadcast is received, it is received concurrently with a reference time. *Id.* ¶ 50. “Each of the events fire [sic, are] based on this reference time.” *Id.* This is accomplished by comparing the event time and the reference time to find a “match or exceeding a threshold.” *Id.* ¶ 51. “Upon reaching the timing threshold, the event application would be triggered at the first receiver in response to the determined reference time.”

Id. To exemplify,

if 2 minutes of commercials is inserted at the beginning of the broadcast, then the reference time would be set back two minutes so that the first event does not fire (e.g. the first question is not displayed on the viewer's television) until after the commercials are over.

Id. ¶ 50.

2. *Fahy* (Ex. 1004)

Fahy relates to placement of auxiliary content in an information stream such as conventional television programming. Ex. 1004 ¶ 4, 18. The

placement is done in advance through markers added at the head-end of the program stream. *Id.* ¶ 25.

The head-end is equipped with a communications receiver for receiving a broadcast over a telecommunications network. *Id.* ¶ 20. The head-end “conditions the channel signals, mixes the signals, and performs other alterations on those signals and then places the video and/or audio signals onto the cables . . . leading to the location of the end-user system,” such as a set-top box. *Id.* 20–21.

In one embodiment, the head-end may “download auxiliary content . . . to [a] hard disk . . . , and, additionally, replace, delete, or modify content.” *Id.* at 40. For example, “[i]n a deletion operation, the broadcaster deletes all commercials from a particular program for a price.” *Id.* at 41.

II. ANALYSIS

A. Principles of Law for Patentability

A patent claim is unpatentable under 35 U.S.C. § 103(a) 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 ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion does not shift to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

B. Level of Ordinary Skill in the Art

Petitioner contends a person of ordinary skill in the art “would have had the equivalent of a Bachelor’s Degree in computer science, computer engineering, or a related subject and two or more years of experience in the field of multimedia networking. Less work experience may be compensated for by a higher level of education, such as a Master’s Degree, and vice versa.” Pet. 3 (citing Ex. 1002 ¶ 26).

Patent Owner acknowledges Petitioner’s contention but “takes no position with respect to Petitioner’s proposed level of skill.” PO Resp. 15.

Petitioner’s proposed definition of a person of ordinary skill in the art is consistent with the ’243 patent, and we adopt that definition for our analysis in this decision. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

C. Claim Construction

“[Claims] of a patent . . . shall be construed using the same claim construction standard that would be used to construe the [claims] in a civil action under 35 U.S.C. 282(b), including construing the [claims] in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100 (2019); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005).

Only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Before the Decision on Institution, apart from the preamble of claim 1, neither party proposed a construction for a claim term. *See* Pet. 21–24; Patent Owner did not file a Preliminary Response.

Petitioner proposes construing the preamble of claim 1 as limiting the claim, which Patent Owner agrees with. Pet. 21–24; PO Resp. 1. Consistent therewith, we will treat the preamble as limiting claim 1 when we analyze the parties’ arguments under the asserted obviousness ground based on the combination of Wallace and Fahy.

1. “latency” and “latency differences”

In the Petition, Petitioner argues that “[t]he combination of Wallace and Fahy teaches ‘latency differences.’ Both Wallace and Fahy disclose the same kind of latency as the ’243 patent, namely, latency caused by inserting commercials into broadcast TV [television] programs.” Pet. 29. In particular,

Wallace addresses latency in its interactive game of skill or chance or other entertainment caused by inserting commercials into the recorded game shows to form the TV broadcast. [Ex. 1003 ¶ 0048] (“[I]f a set of commercials is inserted before the first question is asked...the first question may not be asked until 00:6:05 into the broadcast content. ***Commercials... may delay, interrupt or create discontinuities within the original taped source material.***”).

Id. (citing Ex. 1002 ¶ 72) (emphasis Petitioner’s). By arguing that Wallace addresses latency that is the “same kind of latency as the ’243 patent,” Petitioner implicitly construes the terms “latency” and “latency differences” in the preamble of claim 1 broadly as covering a single source of latency, such as delays caused by commercials that, e.g., Wallace teaches.

In the Institution Decision, we applied a construction of “latency” and “latency differences” in line with Petitioner’s implicit construction. Dec. on Insti. 11–13. *See, e.g.*, Pet. 12. There we determined that

Petitioner provides sufficient evidence on this record to support its contention that the combination of Wallace and Fahy would have led one of ordinary skill in the art to address latency when the broadcast includes different commercials of “different length, timing, and/or frequency that alter when different segments of [a] TV program are aired.” Pet. 32 (citing [Ex. 1002] ¶ 77).

Dec. on Insti. 13.

During trial, Patent Owner proposes construing the terms “latency” and “latency differences” to mean “the length of time it takes a television signal to reach a viewer” and “variances in [such] latency between different users,’ respectively.” PO Resp. 15–16. These constructions of “latency” and “latency differences” are narrower in scope than Petitioner’s implicit construction; that is, under Patent Owner’s construction, disclosure of a

single source of latency would be insufficient to meet the claims. *See id.* at 19–20 (“Petitioner appears to argue that by addressing a single latency source (commercials), Wallace sufficiently discloses the limitations of claim 1 of the ’243 Patent. But claim 1 of the ’243 Patent requires more – it requires equalizing the effects of all latency differences whatever their source.”)

For the following reasons, we do not agree that the intrinsic evidence requires limiting “latency differences” and “variances in latency” such that a single source of latency is excluded from the scope of the claims.

There are two aspects to Patent Owner’s proposed construction: (a) one concerning the source of the “latency” and (b) another concerning the type of “latency.” *See* PO Sur-reply 4:

Patent Owner’s proposed construction of “latency” – “the length of time it takes a television signal to reach a viewer” – captures precisely this concept that [(a)] all sources of latency need to be equalized, as each contributes to [(b)] the length of time it takes a television signal to reach a viewer.

We note the parties’ debate over whether “latency” and “latency differences” are in controversy. *Cf.* Pet. Reply 10–11, PO Sur-reply 8–10. Petitioner contends that the parties have agreed that inserting commercials into a broadcast creates a “latency” and results in “latency differences.” *See* Pet. Reply 10:

Patent Owner and Dr. Shenoy agree with Petitioner that (1) inserting commercials into a broadcast, as in Wallace and Fahy, creates “latency,” and (2) inserting different commercials into the broadcast, as in Fahy, creates “latency differences.” POR, pp. 2 (describing “**commercials**” as “**latency issues**”), 11 (“**Fahy’s** system [for inserting commercials] **creates latency differences between users**”), 17 (Wallace discloses “**latency**

difference resulting from *commercials*”), 19 (“Fahy teaches *inserting commercials* dynamically, which would *create latency differences*”), 19–20 (inserting “*commercials*” is a “*latency source*”), 28 (Wallace “equaliz[es] *latency differences*” from “*commercial delays*”); [Ex. 2001] ¶ 42 (Fahy’s “*inserting commercials* of different frequency, duration and timing for different users” creates “*varying latency differences* between users”); [Ex. 2001] 52:4–13, 161:3–10, 162:19–163:3. [Ex. 1022] ¶ 23.

However, Patent Owner does not argue that the asserted references fail to teach latency. “Patent Owner does not dispute that latency is a type of delay.” PO Sur-reply 8. Instead, Patent Owner proposes a construction of “latency” which would preclude Wallace’s “limited teaching of addressing a single source of latency in the context of taped programs” from the scope of the claims. PO Sur-reply 2. We need to address Patent Owner’s proposed construction of “latency” and “latency differences” to resolve the controversy over whether Wallace teaches the claimed subject matter as Petitioner contends. Pet. 29.

(a) source of latency

Patent Owner argues that “claim 1 of the ’243 Patent requires . . . equalizing the effects of all latency differences *whatever their source*.” PO Resp. 20 (emphasis added). In support, Patent Owner submits that

The ’243 Patent makes clear that potential sources of latency issues are: “1) systemic propagation delays in the delivery of a television signal to a receiver, 2) arbitrarily imposed delays of a broadcast television signal and 3) variances in precise broadcast times of segments of taped television programs between local and national commercials.”

Id. at 17–18 (quoting Ex. 1001, 5:14–24). Patent Owner adds that

Petitioner's expert, Dr. Jeffay, acknowledges that this is an accurate description of potential causes of latency. Ex. 2002 at 10:10–14. Dr. Jeffay further testified that a system that fails to address systemic propagation delays fails to equalize the effects of latency difference as required in the preamble of claim 1 of the '243 Patent. Ex. 2002 at 12:14–18 (“If all three sources of latency were present, then if one was trying to equalize the effects of latency, then they would. Have to – they would have to deal with each of these three sources of latency.”).

Id. at 18. Said differently, Patent Owner takes the view that claim 1 is limited to equalizing the effects for the group of “all potential sources of latency differences.” PO Sur-reply 7.

Petitioner disagrees. Pet. Reply 17–18. Petitioner argues, *inter alia*, that:

Neither Patent Owner nor Dr. Shenoy provides any intrinsic evidence supporting a requirement that the challenged claims require addressing “*all*” latency differences, “*whatever the source*.” The challenged claims do not. Claim 1 does not recite “equalizing effects of latency differences whatever their source,” “equalizing effects of *all* latency differences,” or “equalizing effects of latency *differences due to propagation delays*.” It only recites “equalizing effects of latency differences.”

Id. at 17 (citing Ex. 1022 ¶ 36).

Patent Owner responds that “Petitioner’s implied construction that the challenged claims are not directed to the equalization of all latency differences should be rejected.” PO Sur-reply 5.

We begin our analysis by first looking to the claim. “Claim construction begins, as it must, with the words of the claims.” *Vehicular Techs. Corp. v. Titan Wheel Int’l*, 141 F.3d 1084, 1088 (Fed. Cir. 1998). The preamble of claim 1 recites “equalizing effects of latency differences in a

game of skill or chance or other entertainment.” Ex. 1001, 15:2–3. The phrase “latency differences” is not preceded by a qualifier such as “all.” Nor is a source of “latency differences” specified. Nothing in the preamble or in the body of the claim would suggest to one of ordinary skill in the art that the claimed method is limited to addressing the group of *all* potential sources of latency.

We next look to the specification because “[t]he written description [may] suppl[y] additional context for understanding whether the claim language limits the patent scope.” *Abtox, Inc. v. Exitron Corp.*, 122 F.3d 1019, 1024 (Fed. Cir. 1997) (quoted in *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000)).

In that regard, we have reviewed the passage in the ’243 patent that Patent Owner relies on in its Patent Owner Response. Ex. 1001, 5:14–24; PO Resp. 17–18. There is no indication in this passage that patentee intended to equalize the effects of latency for *all* potential sources of latency. The passage begins by stating that “[t]he present invention addresses three separate classes of latency issues for the length of time it takes a television signal to reach a viewer in producing real-time entertainment such as games of skill synchronized with television programming.” Ex. 1001, 5:14–18. Then the three latency issues are described in turn; that is,

- 1) systemic propagation delays in the delivery of a television signal to a receiver, 2) arbitrarily imposed delays of a broadcast television signal and 3) variances in precise broadcast times of segments of taped television programs between local and national commercials, sold through syndication to individual television stations.

Id. at 18–24. The ’243 patent later states that “the methods of handling latency [that] have been described [] as handling a specific scenario such as delays in television signal reception . . . are able to be used in conjunction with each other as well,” informing one of ordinary skill in the art reading the ’243 patent that each latency issue may be addressed separately or “in conjunction.” As Dr. Jeffay testifies, “the ’243 patent includes separate descriptions of how to handle three respective latency issues, and it teaches that these separate descriptions are not required to be used together, and instead merely states that the separate descriptions are ‘able to be used in conjunction with each other.’” Ex. 1022 ¶ 37 (quoting Ex. 1001, 14:47–56) (citing Ex. 1001, 5:14–24).

Turning to the extrinsic evidence, Patent Owner also argues that Dr. Jeffay has “testified that a system that fails to address systemic propagation delays³ fails to equalize the effects of latency difference as required in the preamble of claim 1 of the ’243 Patent.” PO Resp. 18 (citing Ex. 2002, 12:14–18). But that does not sufficiently support Patent Owner’s argument. Dr. Jeffay did not testify that such a system *must* address systemic propagation delays, along with all other potential “latency differences,” to satisfy the claim. Rather, Dr. Jeffay testified that a system that fails to address systemic propagation delays, *if present*, would not meet the preamble of the claim. Only “[i]f all three source of latency were *present*, then if one was trying to equalize the effects of latency, then they would. Have to – they would have to deal with each of these three sources of

³ “[S]ystemic propagation delays” is one of the three classes of latency issues addressed in the ’243 patent. Ex. 1001, 5:18–24.

latency.” Ex. 2002, 12:14–18 (emphasis added). Thus, consistent with Dr. Jeffay’s testimony, the preamble of the claim is satisfied if the system addresses any delay (i.e., “latency”), even one, *if present*. Ex. 1001, 5:21–24.

We have reviewed all the evidence that bears on the construction of the “source of latency” but do not find sufficient support for construing the term “latency” such that the claim is limited to equalizing the effects of “all latency differences whatever their source” as Patent Owner argues. PO Resp. 20.

(b) type of latency

Patent Owner argues that “the term ‘latency’ in the context of the ’243 Patent should be construed to mean ‘the length of time it takes a television signal to reach a viewer.’” PO Resp. 15–16. In support, Patent Owner submits that

[t]his construction is supported by the plain meaning of “latency,” which in the fields of computing and networking refers to the delay between an instruction and its result. Ex. 2001, ¶33. Further the specification defines latency in this way in the context of television broadcast, which is consistent with its plain meaning. Ex. 1001, 5:15. This construction is consistent with the deposition testimony of Petitioner’s expert, Dr. Jeffay. Ex. 2002 at 7:17 – 8:17.

PO Resp. 16.

Patent Owner also relies on the testimony of Dr. Shenoy. PO Resp. 16 (citing Ex. 2001 ¶ 33). According to Dr. Shenoy, the plain meaning of “latency,” in the fields of computing and networking, which “refers to the delay between an instruction and its result,” is “consistent with and supported by its usage in the specification of the ’243 Patent. Ex. 1001,

2:46–56, 5:14–24.” Ex. 2001 ¶ 33. We reproduce below the passages from the ’243 patent (Ex. 1001) that Dr. Shenoy relies upon:

A method of and system for handling latency issues encountered in producing real-time entertainment such as games of skill synchronized with live or taped televised events is described herein. There are multiple situations that are dealt with regarding latencies in receiving a television signal with respect to real-time entertainment based on the unfolding games played along with the telecasts. Systemic delays, arbitrarily imposed delays of a broadcast signal and variances in the precise broadcast times of taped television programs have to be equalized so as to provide fair entertainment.

Id. at 2:46–56.

The present invention addresses three separate classes of latency issues for the length of time it takes a television signal to reach a viewer in producing real-time entertainment such as games of skill synchronized with television programming. The latency issues are: 1) systemic propagation delays in the delivery of a television signal to a receiver, 2) arbitrarily imposed delays of a broadcast television signal and 3) variances in precise broadcast times of segments of taped television programs between local and national commercials, sold through syndication to individual television stations.

Id. at 5:14–24.

Patent Owner also relies on the deposition testimony of Dr. Jeffay, reproduced below. PO Resp. 16 (citing Ex. 2002, 7:17–8:17).

Q Okay. And within that preamble you see the word latency. Does that have a meaning to a person of ordinary skill in the art that you can define for us?

A Latency is typically used to indicate some form of delay.

Q Okay. And then in this context, what

would the delay be trying -- what kind of delay would it be capturing?

A Well, what the '243 patent describes is delay differences between a broadcast of content and the progression of a game -- differences in -- because there are differences in the delay of the transmission and receipt of broadcast content that that will affect your ability to have a game of skill or chance, an effective game of skill or chance.

Q So in this context latency would refer to the delay of receiving a television broadcast?

A It is -- it is that different users, different viewers or consumers of the content are going to potentially receive that content at different times. And so there is going to be differences in the times at which the content is received.

Petitioner maintains that “latency” should be construed broadly; that is, it “should be construed as ‘delay’ in the context of the '243 patent.” Pet. Reply 11. Petitioner provides several reasons. Pet. Reply 12–14.

Petitioner explains, *inter alia*, that “construing ‘latency’ as ‘delay’ is consistent with the term’s plain and ordinary meaning at the time of the '243 patent, as confirmed by Dr. Shenoy and Dr. Jeffay.” Pet. Reply 13 (citing Ex. 1021, 52:4–13, 119:6–22; Ex. 1022 ¶ 28). The relied-on testimony is reproduced below.

Q You agree with me that latency differences arise as a result of inserting different commercials into television broadcasts, correct?

A Broadly speaking, when you insert a commercial into a television program which is, say, prerecorded, the broadcast of the rest of that program will get delayed, creating a

latency.

Ex. 1021, 52:4–13.

Q And according to the '243 patent, two of those three sources of latency relate to delays, right?

A Well, there are three types of latencies. There is one, systemic propagation delays. A second one is arbitrarily imposed delays. So those are the two that have the word “delays” in them. The third one talks about variances in the broadcast times of segments of taped programs.

Q So according to the '243 patent, two of those sources, propagation delays and arbitrarily imposed delays, relate to delays, correct?

A So the two terms there, the systemic propagation delays and arbitrarily imposed delays, do relate to delays of various kinds.

Id. at 119:6–22.

Third, construing “latency” as “delay” is consistent with the term’s plain and ordinary meaning at the time of the '243 patent. In particular, in the context of multimedia networking, a POSITA [person of ordinary skill in the art] would have understood the term latency to relate to delays. Dr. Shenoy agrees. [Ex. 1021], 119:6–22, 52:4–13.

Ex. 1022 ¶ 28.

Petitioner also contends that “dependent claims 7 and 8, which specify ‘determining an amount of *delay*’ and ‘equalizing...through adjustment of the amount of delay,’ confirm that latency refers to *delay*.” Pet. Reply 12 (citing Ex. 1022 ¶ 26).

Further, according to Petitioner, “Patent Owner’s proposed construction of [‘latency’ as] ‘the length of time it takes a television signal to reach a viewer’ (POR, pp. 15–16) is not consistent with the intrinsic evidence and the term’s plain and ordinary meaning. For example, the claims do not include the term ‘television signal’ (*id.*, pp. 15–16), and instead use the term ‘broadcast.’” Pet. Reply 13. “In addition, the specification at [column] 5:[line] 15 quoted by Patent Owner as supposedly supporting its construction (*id.*, p. 16) merely states, “latency issues for the length of time it takes a television signal to reach a viewer” [Ex. 1001], 5:15–16. This specification language relates to ‘latency issues,’ not the term ‘latency’ itself.” *Id.*

Patent Owner responds that “latency is used in the ’243 Patent in a specific technological context that Petitioner’s proposed construction [i.e., “delay”] fails to address. . . [I]n the context of the ’243 Patent, construing latency as merely ‘delay’ renders the term devoid of the relevant context in which it is used, namely by neglecting to specify any reference for such ‘delay’ or define what is being delayed.” PO Sur-reply 8. According to Patent Owner, “[t]he ’243 Patent uses ‘latency’ in the field of computing and networking. In this context, latency refers to the delay between an instruction and its result. [Ex. 2001 ¶ 33]. Further the ’243 patent specification defines latency in this way in the context of television broadcast. Ex. 1001, 5:15.” *Id.* at 9.

“The words of a claim are generally given their ordinary meaning, which is ‘the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.’” *Data Engine*

Technologies LLC v. Google LLC, 10 F.4th 1375, 1381–82 (Fed. Cir. 2021) (quoting *Phillips*, 415 F.3d at 1312–13).

Claim 1 calls for a method of equalizing effects of latency differences in a game of skill or chance or other entertainment comprising synchronizing the game of skill or chance or other entertainment with online broadcast of content. Ex. 1001, 15:2–6. When Dr. Jeffay was asked during his deposition if “latency” in the preamble “[has] a meaning to a person of ordinary skill in the art that you can define for us,” he responded that “[a] [l]atency is typically used to indicate some form of delay.” Ex. 2002, 7:17–22 (cited at PO Resp. 16). When Dr. Shenoy was asked during his deposition if “latency differences arise as a result of inserting different commercials into television broadcasts,” he responded that “[b]roadly speaking, when you insert a commercial into a television program which is, say, prerecorded, the broadcast of the rest of that program will get delayed, creating a latency.” Ex. 1021, 52:4–13 (cited at Pet Reply 13). Thus, there appears to be no dispute between the parties and their declarants that, in the context of the claim a person of ordinary skill in the art at the time of the invention would understand the term “latency” as used in the preamble to mean “delay.”

However, according to Patent Owner, when read in light of the Specification, the term “latency” has a more specific meaning that relates to “the fields of computing and networking” wherein it “refers to the delay between an instruction and its result.” PO Resp. 16. According to Patent Owner, the term “latency” should be construed “in the context of television broadcast.” PO Sur-reply 9.

The difficulty with Patent Owner’s argument is that the word “television” is not recited in the claim. Instead, the claim uses the term “online broadcast,” which suggests the method applies to a broader array of technology, not just television. We see nothing in the claim language to suggest that one of ordinary skill in the art would have understood the claimed method to be limited to equalizing latency differences associated with a “television” broadcast. We recognize, as Dr. Jeffay has testified (Ex. 2002, 7:17 – 8:17; PO Resp. 16), that the ’243 patent concentrates on latency issues associated with television broadcasts. *See* Ex. 1001, 2:46–56, 5:14–24 (cited in Ex. 2001 ¶ 33; PO Resp. 16) (reproduced above). But neither the ’243 patent specification nor the claims limit the invention to television broadcasts. *Cf. Brookhill–Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1301 (Fed. Cir. 2003) (“No statement in the written description . . . constitutes a limitation on the scope of the invention”). The ’243 patent states that “[t]he present invention addresses three separate classes of latency *issues* for the length of time it takes a television signal to reach a viewer in producing real-time entertainment such as games of skill synchronized with television programming.” Ex. 1001, 5:14–18. We agree with Petitioner that this passage from the specification relates to “latency issues,” but does not limit the term “latency” itself. Pet. Reply 13. To read the claim as limited to addressing latency issues associated with the length of time it takes a television signal to reach a viewer would “unnecessarily import[] limitations from the specification into the claims.” *E-Pass Technologies, Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

We have reviewed all the evidence bearing on the construction of the “type of latency” but do not find sufficient support for construing the term

“latency” such that only latency issues for the length of time it takes a television signal to reach a viewer are addressed, as Patent Owner argues.

PO Resp. 15–16.

2. Conclusion

For the foregoing reasons, we do not agree with Patent Owner that the intrinsic record limits the plain and ordinary meaning of “latency” and “latency differences” to mean “the length of time it takes a television signal to reach a viewer” and “variances in [such] latency between different users” as Patent Owner proposes. PO Resp. 15–16.

Accordingly, we maintain the preliminary construction of the terms we applied in the Decision on Institution; that is, a construction in line with Petitioner’s implicit construction, whereby the terms “latency” and “latency differences” broadly cover equalizing the effects of any single source of delay.

D. Ground I—Obviousness Over the Combination of Wallace and Fahy

Petitioner challenges claims 1, 3, 4, and 6 as unpatentable under 35 U.S.C. § 103(a) over Wallace and Fahy. Pet. 25–69.

1. Claim 1

1[preamble] “[a] method of equalizing effects of latency differences in a game of skill or chance or other entertainment”

The parties agree to construe the preamble as limiting. *See* Pet. 21 (the preamble of claim 1 “should be construed as limiting the claim”) (citing Ex. 1002 ¶ 61); PO Resp. 15 (“Patent Owner agrees with Petitioner that the preamble of claim 1 should be construed as limiting”) (citing Pet. 21–24; Ex. 2001 ¶ 32).

“a game of skill or chance or other entertainment”

Petitioner contends that Wallace discloses an “interactive multiple-choice game” that “requires skill to answer the trivia game questions correctly.” Pet. 26 (citing Ex. 1003 ¶¶ 46, 47; Ex. 1002 ¶ 68). Dr. Jeffay testifies that “[Wallace’s] interactive multiple-choice game is a game of skill because it requires skill to answer the trivia game questions correctly.” Ex. 1002 ¶ 68; Pet. 26–27.

Petitioner further explains that Wallace’s interactive game is provided to a user via a set top box, “so that the users can play the game alongside the TV game show broadcast.” Pet. 27 (citing Ex. 1003 ¶¶ 49, 46). According to Petitioner, “the ’243 patent discloses the same type of game (answering multiple choice questions) played alongside the same type of TV broadcast (a recorded trivia game show) as Wallace.” Pet. 28 (citing Ex. 1001, 10:47–50, 11:1–5, 11:49–54, 12:42–44; Ex. 1002 ¶ 70).

We have reviewed Wallace. As Petitioner contends, Wallace discloses “an interactive game show.” Ex. 1003 ¶ 46; Pet. 26. Since an interactive game show is a game of skill according to Dr. Jeffay (Ex. 1002 ¶ 68; Pet. 26), Wallace discloses “a game of skill” as Petitioner contends.

Patent Owner has provided no substantive argument challenging Petitioner’s contention. *See generally* PO Resp. 17–20.

Accordingly, based on our review of the evidence of record, Petitioner has shown that Wallace teaches “a game of skill or chance or other entertainment” as set forth in the preamble.

“latency differences”

Petitioner contends that “[b]oth Wallace and Fahy disclose the same kind of latency as the ’243 patent, namely, latency caused by inserting commercials into broadcast TV programs.” Pet. 29 (citing Ex. 1002 ¶ 71). See also Pet. 33–34 (citing Ex. 1001, 10:47–62, 11:14–18, 11:25–39; Ex. 1002 ¶ 78).

Petitioner quotes Wallace as stating: “[I]f a set of commercials is inserted before the first question is asked . . . the first question may not be asked until 00:6:05 into the broadcast content. ***Commercials . . . may delay, interrupt or create discontinuities with the original taped source material.***” Pet. 29 (quoting Ex. 1003 ¶ 48; citing Ex. 1002 ¶ 72). Emphasis Petitioner’s. Based on this disclosure, Dr. Jeffay testifies that “Wallace addresses latency in its interactive game of skill or chance or other entertainment caused by inserting commercials into the recorded game shows to form the TV broadcast.” Ex. 1002 ¶ 72; Pet. 29.

We have reviewed Wallace. As Petitioner contends, Wallace discloses that commercials “may delay, interrupt or create discontinuities within the original taped source material,” as Petitioner contends. Ex. 1003 ¶ 48; Pet. 29. Given that Dr. Jeffay (Ex. 1002 ¶ 72; Pet. 29) indicates that this addresses “latency,” Petitioner’s contention that Wallace discloses “latency differences” is sufficiently demonstrated.

Patent Owner argues that Wallace does not disclose “latency differences” because, *inter alia*, “Wallace, only teaches synchronization of a game of skill with a broadcast in the context of a predetermined latency

difference resulting from commercials.” PO Resp. 17. “But claim 1 of the ’243 Patent requires more – it requires equalizing the effects of all latency differences whatever their source.” *Id.* at 20.

Patent Owner’s argument is predicated on “latency” being construed as meaning “the length of time it takes a television signal to reach a viewer.” PO Resp. 15–16. For the reasons discussed in § II.C., we do not agree with Patent Owner that the intrinsic record limits the plain and ordinary meaning of “latency” and “latency differences” to mean “the length of time it takes a television signal to reach a viewer” and “variances in [such] latency between different users” as Patent Owner proposes. Rather the terms broadly to cover any single source of delay. Given that construction, Patent Owner’s argument does not undermine Petitioner’s contention that Wallace discloses “latency differences” as claimed.

Regarding Fahy, we note Petitioner relies on Fahy for its disclosure of “commercials [that] can be inserted into the stream for a TV program, and . . . that the inserted commercials can be *different* for different broadcasts.” Pet. 29 (citing Ex. 1004 ¶¶ 45–51). Emphasis Petitioner’s. Petitioner explains that “Fahy discloses that commercials can be different among broadcasts of a program in [the following] three ways” (*id.* at 30 (citing Ex. 1002 ¶ 73)): (1) “different commercials can have different lengths, *e.g.*, based on the user’s subscription” (*id.* (citing Ex. 1004 ¶ 47; Ex. 1002 ¶ 74)); (2) “commercials can be placed at different times during the program” (*id.* at 31 (citing Ex. 1004, Fig. 6, ¶¶ 47, 51, Table 2; Ex. 1002 ¶ 75)); and (3) “different broadcasts have different frequencies of commercials” (*id.* at 32 (Ex. 1004, Fig. 6, ¶ 47; Ex. 1002 ¶ 76)).

Patent Owner argues that “Fahy does not discuss latency at all.” PO Sur-reply 11 (citing Ex. 2001, 18; Ex. 1021, 103:16–104:17); *see* also PO Resp. 19. However, Dr. Shenoy testified that Fahy shows a case which “does cause latency differences.” Ex. 1021, 103:16–22 (referring to Figure 6 of Fahy).

Patent Owner also argues that “Fahy also does not teach ‘equalizing effects of latency differences’ as required.” PO Resp. 19. However, we read Petitioner as focusing on Wallace to show the asserted prior art teaches a “method of equalizing effects.” *See* Pet. 34, discussed below.

Based on our review of the evidence of record, Petitioner has sufficiently demonstrated that Wallace and Fahy, either individually or collectively, teach “latency differences” as set forth in the preamble.

“[a] method of equalizing effects”

Petitioner contends that “Wallace addresses commercial-based latency by synchronizing the interactive game to the TV game show broadcast.” Pet. 34 (citing Ex. 1003 ¶¶ 7, 26, 32, 46–51; Ex. 1002 ¶ 79). Dr. Jeffay explains that Wallace’s synchronizing⁴ “ensures that events in the interactive game are triggered at the right time regardless of commercials, thereby equalizing the effect of latency due to commercials.” Ex. 1002 ¶ 79; Pet. 34.

We have reviewed Wallace. Consistent with Petitioner’s contention, Wallace discloses, *inter alia*, that “synchronization of the operation of the (local) application and the (remote) broadcast is essential to the successful playing of the game.” Ex. 1003 ¶ 7; Pet. 34. Since Dr. Jeffay testifies that

⁴ Petitioner directs us to, *inter alia*, Petition at pages 15–18 for details about Wallace’s synchronization technique. Pet. 35.

doing so equalizes the effect of latency due to commercials, we agree with Petitioner's contention that Wallace discloses a "method of equalizing effects of latency differences in a game of skill or chance or other entertainment."

Patent Owner argues that "Wallace does not teach how to equalize the effects of latency caused by *systemic propagation delays* through synchronizing the game of skill with the broadcast content." PO Resp. 18 (emphasis added). But this argument depends on narrowly construing "latency" to mean "the length of time it takes a television signal to reach a viewer." PO Resp. 15–16. For the reasons discussed in § II.C., we do not agree with Patent Owner that the intrinsic record so limits the plain and ordinary meaning of "latency" and "latency differences." For the reasons discussed, the intrinsic record does not support limiting the claim to require the method to address systemic propagation delays, along with all other potential "latency differences," in order to satisfy the preamble. We construe the terms broadly as covering any single source of delay. Given this construction, Patent Owner's argument does not undermine Petitioner's contention that Wallace discloses a "method of equalizing effects."

For all the reasons discussed above relative to each of "a game of skill or chance or other entertainment," "latency differences," and "[a] method of equalizing effects," Petitioner shows that the combination of Wallace and Fahy teaches the entirety of what the preamble calls for; that is, "[a] method of equalizing effects of latency differences in a game of skill or chance or other entertainment."

1[a] “receiving an online broadcast of content;”

Petitioner contends, *inter alia*, that “Wallace explains that the IRDs receive a TV broadcast of trivia game show content over a digital broadcast stream using internet protocol (IP).” Pet. 42 (citing Ex. 1002 ¶ 92).

Petitioner further contends that Wallace “discloses that the TV broadcasts of trivia game show content sent over the digital broadcast stream are ‘online broadcasts,’ at least because they are sent using IP (internet protocol).” Pet. 44 (citing Ex. 1003 ¶ 21). Dr. Jeffay testifies that “[a person of ordinary skill in the art] would have understood ‘IP,’ a commonly used term, to refer to the Internet protocol suite TCP/IP – the suite of protocols used to transmit data over the Internet.” Ex. 1002 ¶ 94 (citing Ex. 10101, xi–ss (Preface”), 1–30); Pet. 44.

We have reviewed Wallace. As Petitioner contends, Wallace discloses, *inter alia*, supplying a “broadcast television signal, which may be conveyed by . . . IP.” to a multiplicity of IRDs. Ex. 1003 ¶ 21; Pet. 42–43. Given Dr. Jeffay’s testimony that “IP” is a commonly used term to refer to the suite of protocols used to transmit data over the Internet, we agree with Petitioner’s contention that Wallace discloses “receiving an online broadcast of content.”

Patent Owner has provided no substantive argument challenging Petitioner’s contention. *See generally* PO Resp. 17–20.

Petitioner further contends that

Because Wallace in combination with Fahy teaches that IRDs receive the same type of content (TV trivia game shows) as the ’243 patent, and that the content is broadcast online from a server using the Internet Protocol, the combination of Wallace and Fahy teaches receiving an online broadcast of content.

Pet. 45 (citing Ex. 1002 ¶ 96). Since Wallace, in light of Dr. Jeffay’s testimony, provides sufficient support for Petitioner’s contention that Wallace discloses a “receiving an online broadcast of content,” the combination of Wallace and Fahy provides sufficient support. Accordingly, in our view, Petitioner sufficiently demonstrates that the combination of Wallace and Fahy teaches “receiving an online broadcast of content” as claimed.

1[b] “synchronizing the game of skill or chance or other entertainment with the online broadcast of content;”

Petitioner contends that “[a]s described above with respect to the preamble of claim 1, Wallace discloses an interactive game of answering multiple-choice questions played on a user’s IRD alongside a broadcast of a recorded TV game show.” Pet. 46 (citing Ex. 1003 ¶¶ 45–52; Ex. 1002 ¶ 98). Petitioner details the technique Wallace discloses for “synchronizing” the interactive game and broadcast. Pet. 45–57. According to Petitioner, events of the interactive game are compared to an index of the associated times of the events so that, “[w]hen the reference time in the broadcast stream reaches the event time, the interactive game event is triggered to be displayed with the TV game show broadcast.” Pet. 53 (citing Ex. 1003, Abstr., ¶¶ 50–52; Ex. 1002 ¶ 104). Dr. Jeffay testifies that the “interactive game events are thus synchronized with the specific time in the game show broadcast when they should occur based on the match between the reference time of the TV broadcast and the event time in the index of events.” Ex. 1002 ¶ 104; Pet. 53.

We have reviewed Wallace. As Petitioner contends, Wallace discloses:

The event time [of the interactive game] and reference time [of the game show broadcast] would be compared or otherwise associated to find a match or exceeding a threshold. Upon reaching the timing threshold, the event application would be triggered at the first receiver in response to the determined reference time.

Ex. 1003 ¶ 51; Pet. 53. Given Dr. Jeffay’s testimony that “interactive game events are thus synchronized,” we agree with Petitioner’s contention that Wallace discloses “synchronizing the game of skill or chance or other entertainment with the online broadcast of content.” Ex. 1002 ¶ 104; Pet. 53.

Patent Owner agrees that Wallace “teaches synchronization of a game of skill with a broadcast in the context of a predetermined latency difference resulting from commercials.” PO Resp. 17.

But, according to Patent Owner, “[i]n the context of addressing varying latency differences, Wallace teaches against synchronization of the game of skill with the broadcast and discloses instead synchronization of the game of skill across all devices irrespective of the underlying broadcast timing.” PO Resp. 17 (citing Ex. 2001 ¶¶ 45–47). Since the claim does not exclude synchronizing a game of skill across all devices irrespective of the underlying broadcast timing, this argument does not undermine Petitioner’s contention.

Patent Owner further argues that “Wallace does not teach how to equalize the effects of latency caused by systemic propagation delays through synchronizing the game of skill with the broadcast content.” PO Resp. 18. For the reasons discussed in § II.C., we do not agree with Patent Owner that the intrinsic record so limits the plain and ordinary meaning of

“latency” and “latency differences.” For the reasons discussed, the intrinsic record does not support limiting the claim to require the method to address systemic propagation delays, along with all other potential “latency differences,” in order to satisfy the preamble. We construe the terms broadly as covering any single source of delay. Given this construction, Patent Owner’s argument does not undermine Petitioner’s contention that Wallace discloses a “synchronizing the game of skill or chance or other entertainment with the online broadcast of content” as broadly claimed.

Petitioner further contends that

the combination of Wallace and Fahy discloses synchronizing interactive game events with the appropriate time in the online TV broadcast of a game show by comparing a reference time in the TV broadcast to event times in an index of events and triggering the interactive game event when there is a match. . . . [T]he combination of Wallace and Fahy renders obvious synchronizing the game of skill or chance or other entertainment with the online broadcast of content.

Pet. 57–58 (citing Ex. 1002 ¶ 109). Since Wallace, in light of Dr. Jeffay’s testimony, provides sufficient support for Petitioner’s contention that Wallace discloses a “synchronizing the game of skill or chance or other entertainment with the online broadcast of content,” the combination of Wallace and Fahy provide sufficient support. Accordingly, in our view, Petitioner sufficiently demonstrates that the combination of Wallace and Fahy teaches “synchronizing the game of skill or chance or other entertainment with the online broadcast of content” as claimed.

1[c] “presenting the online broadcast of content and synchronized game data.”

Petitioner contends, *inter alia*, that “Wallace teaches and suggests that the trivia game show and the synchronized interactive game are ***displayed*** to the user.” Pet. 58 (citing, *inter alia*, Ex. 1002 ¶ 110). In support, Petitioner quotes Wallace; for example, “[A] television viewer sitting at home...***select[s] from a plurality of displayed answers using a remote control in synchronicity with the time at which a question is asked of the actual studio players within the broadcast content.***” *Id.* (quoting Ex. 1003 ¶ 46). Emphasis Petitioner’s. According to Dr. Jeffay, “[t]he data for the interactive game events that are displayed to the user are ‘synchronized game data’ because they are synchronized to the TV broadcast based on a match when comparing the event data and the index of event times stored in the IRD and the reference time.” Ex. 1002 ¶ 111; Pet. 59.

We have reviewed Wallace and we find it sufficiently shows “presenting the online broadcast of content and synchronized game data” as Petitioner contends. Patent Owner has provided no substantive argument challenging Petitioner’s contention. *See generally* PO Resp. 17–20.

Petitioner further contends that “the combination of Wallace and Fahy teaches presenting the online broadcast of content and synchronized game data to the IRDs.” Pet. 62 (citing Ex. 1002 ¶ 115). Since Wallace, in light of Dr. Jeffay’s testimony, provides sufficient support for Petitioner’s contention that Wallace discloses a “presenting the online broadcast of content and synchronized game data,” the combination of Wallace and Fahy provides sufficient support. Accordingly, in our view, Petitioner sufficiently

demonstrates that the combination of Wallace and Fahy teaches “presenting the online broadcast of content and synchronized game data” as claimed.

2. Motivation to Combine Wallace and Fahy

In order to demonstrate obviousness, a petitioner must demonstrate that a skilled artisan would have had a reason to combine the teachings of the prior art in the manner claimed in the patent and would have had a reasonable expectation of success in doing so. *KSR*, 550 U.S. at 406 (2007). “To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (‘[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’).” *Id.* at 418.

Petitioner contends that there is sufficient motivation to combine Wallace and Fahy by first contending that “Wallace and Fahy are in the same field of endeavor.” Pet. 36. “Wallace discloses displaying a locally stored game during the display of a TV broadcast with commercials . . . Fahy discloses displaying locally stored ‘auxiliary content’ during the display of a TV broadcast with commercials.” Pet. 36– 37 (citing Ex. 1004, *inter alia*, ¶ 18).

According to Petitioner,

A [person of ordinary skill in the art] implementing Wallace’s interactive game would have been motivated to (1) create multiple broadcasts of the same program with different commercials as taught by Fahy, and (2) use Wallace’s technique of synchronizing an interactive game to each of the broadcasts

just as Wallace does for its broadcast. For at least the following reasons, a [person of ordinary skill in the art] would have been motivated to combine Wallace and Fahy in this manner.

Pet. 37 (citing Ex. 1002 ¶ 83).

Petitioner then provides five reasons why one of ordinary skill in the art would be led to the claimed method given Wallace and Fahy. Pet. 37–41. Petitioner explains, *inter alia*, that “the combination of Wallace and Fahy set forth herein is merely a multiplication of parts with no functional difference.” Pet. 40 (reason five). In support, Dr. Jeffay testifies that the combination of Wallace and Fahy “duplicates (1) the broadcasts of Wallace so that there are multiple broadcasts (each with different commercials), and (2) the synchronization technique of Wallace so that an interactive game is synchronized to each of the broadcasts.” Ex. 1002 ¶ 89; Pet. 40–41. “In both instances, the functionality is the same for each broadcast – commercials are inserted and the reference time in the broadcast is adjusted so that the interactive game will be synchronized in view of the particular commercials in the broadcast.” *Id.*

Regarding a reasonable expectation of success, Petitioner contends, *inter alia*, that a “[person of ordinary skill in the art] would expect that Wallace’s synchronization technique would also work on multiple broadcasts [that Fahy teaches] just as it does on a single broadcast because such an application amounts to simply applying Wallace’s technique multiple times (once per broadcast).” Pet. 41.

Patent Owner argues that, for two reasons, “a [person of ordinary skill in the art] would [not] have found it obvious to apply the ‘reference times’ of Wallace in the broadcast environment created by Fahy’s teachings and

beyond.” PO Resp. 20. First, according to Patent Owner, “Wallace’s only discussion of dealing with differences in *systemic propagation delays* is to time the game of skill to a fixed clock rather than to the broadcast content.” *Id.* Emphasis added. Second, Patent Owner argues that Petitioner improperly extends “Wallace’s teaching of predetermined ‘reference times’ in the context of pre-recorded programs with fixed commercials . . . to any context, including live broadcasts having *varying systemic propagation delays* [which would] effectively allow Wallace to preempt the entire space of *television synchronization*.” *Id.* at 21 (emphasis added).

Patent Owner’s arguments do not persuasively undermine Petitioner’s articulation of a motivation to combine the teachings of Wallace and Fahy in reaching the claimed method. The argument is directed only to the first reason of the five reasons Petitioner gives as a motivation. Be that as it may, the principal difficulty with the argument is that it rests on Patent Owner’s view that the claim is directed to equalizing the latency differences from all sources, including from propagation delays. Patent Owner contends:

In sum, the ’243 Patent requires equalizing the latency differences from all sources and synchronizing the game of skill with the broadcast. No combination of Wallace and Fahy teaches that. Nor would such a teaching be obvious given that Wallace teaches a fundamentally different technique for latency differences resulting from propagation delays.

PO Resp. 25. From that perspective, Patent Owner argues that Wallace and Fahy are limited and Petitioner improperly “extends” their disclosure to cover techniques for equalizing other types of latency differences. *Id.* at 20–28; *see, e.g.*, 26 (“Wallace’s entire disclosure of synchronization is focused on a single broadcast having a single reference time.”). However,

for the reasons discussed in § II.C., we do not agree with Patent Owner that the intrinsic record so limits the plain and ordinary meaning of “latency” and “latency differences.” The intrinsic record does not support limiting the claim to require the method to address systemic propagation delays, along with all other potential “latency differences.” We construe the terms broadly as covering any single source of delay. Given this construction, Patent Owner’s argument does not undermine Petitioner’s articulation of a motivation to combine Wallace and Fahy (e.g., reason five) in reaching the claimed method with a reasonable expectation of success.

In our view, the evidence in this record put forward by Petitioner sufficiently demonstrates that a person of ordinary skill in the art would have been led to combine Wallace’s synchronization technique and Fahy’s multiple broadcasts, thereby reach a method falling within the scope of claim 1 with a reasonable expectation of success.

3. Conclusion as to claim 1

Accordingly, for all the reasons discussed with respect to claim 1, and given that the parties do not present arguments and evidence regarding objective indicia of nonobviousness, we find a preponderance of the evidence supports Petitioner’s position that the combination of Wallace and Fahy teaches the claimed subject matter and Petitioner has articulated a sufficient rationale for combining the teachings of the references with a reasonable expectation of success in arriving at the claimed subject matter.

3. Claims 3, 4 and 6

Petitioner contends that dependent claims 3, 4, and 6 would have been obvious over Wallace and Fahy, providing reasoning why the subject matter

of each claim would have been obvious to a person of ordinary skill in the art. Pet. 62–69 (citing, *inter alia*, Ex. 1002 ¶¶ 117–132). We have reviewed that analysis, supported by the testimony of Dr. Jeffay, and find it persuasive.

For example, regarding claim 3 which further limits claim 1 by call for “determining a start time of the online broadcast of content includes using a recognizable signal” (Ex. 1001, 15:13–15), Petitioner contends, *inter alia*, that Wallace teaches “reference times are included in the online broadcast of the game show and that the reference times are used by the IRDs to determine the start time of the game show.” Pet. 62–63. Dr. Jeffay explains that “Wallace discloses that IRDs receive a timing signal in the online broadcast content from the broadcast server called the ‘reference time.’” Ex. 1002 ¶ 118; Pet. 63. Further, “[t]he reference times are recognizable signals to the IRDs because . . . the IRDs use the reference times to compare with event times in the index of game events so that the IRD can launch interactive game events.” *Id.* (citing Ex. 1003 ¶¶ 32, 51–52). “To perform the comparison using the reference time, the reference time must be recognizable to the IRD.” *Id.* (citing Ex. 1003 ¶ 50).

We have reviewed Wallace. Consistent with Petitioner’s contention, Wallace discloses, *inter alia*, that “[a] reference time would be received at each IRD indicating . . . a zero time at which a timer within the IRD should start. Each of the events fire based on the reference time.” Ex. 1003 ¶ 50; Pet. 63. Since Dr. Jeffay testifies that the reference times are recognizable signals to the IRDs and use the reference times to compare with event times, we agree with Petitioner’s contention that Wallace discloses a “determining

a start time of the online broadcast of content includes using a recognizable signal,” as claimed in claim 3.

Patent Owner does not provide any specific arguments in response to Petitioner’s contentions with respect to claims 3, 4 and 6. PO Resp. 17–30.

For the relevant reasons discussed with respect to claim 1 and based on Petitioner’s arguments for each of the dependent claims, we find a preponderance of the evidence supports Petitioner’s position that the combination of Wallace and Fahy teaches the subject matter of claims 3, 4, and 6 and Petitioner has articulated a sufficient rationale for combining the teachings of the references with a reasonable expectation of success in arriving at the subject matter of each of claims 3, 4, and 6. *See* Pet. 62–69.

E. Ground II—Obviousness Over Wallace Alone

Ground II is presented “[i]f the Patent Owner argues that the preamble is not a limitation.” Pet. 69. Since Patent Owner argues that the preamble *is* limiting and we agree, we need not reach Ground II and, therefore, we do not address this asserted ground. PO Resp. 15 (“Patent Owner agrees with Petitioner that the preamble of claim 1 should be construed as limiting.”) (citing Pet. 21–24; Ex. 2001 ¶ 32).

III. CONCLUSION

For the foregoing reasons, Petitioner has proven by a preponderance of the evidence that the challenged claims of the ’243 patent are unpatentable, as summarized in the following table:

Claims	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 3, 4, 6	103	Wallace, Fahy	1, 3, 4, 6	

Overall Outcome			1, 3, 4, 6	
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IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 3, 4, and 6 of the '243 patent have been proven to be *unpatentable*;

FURTHER ORDERED that, because this is a Final Written Decision, parties to this proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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