

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GO1 PTY, LTD.,
Petitioner,

v.

OPENSESAME, INC.,
Patent Owner.

IPR2022-01439
Patent 8,784,113 B2

Before STACY B. MARGOLIES, THU A. DANG, and KEVIN C. TROCK,
Administrative Patent Judges.

MARGOLIES, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, GO1 Pty, Ltd. (“Petitioner”) challenges the patentability of claims 1–16 of U.S. Patent No. 8,784,113 B2 (Ex. 1001, “the ’113 patent”), owned by OpenSesame, Inc. (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has not shown by a preponderance of the evidence that claims 1–16 of the ’113 patent are unpatentable.

A. Procedural History

GO1 Pty, Ltd. (“Petitioner”) filed a petition for *inter partes* review of claims 1–16 of U.S. Patent No. 8,784,113 B2 (Ex. 1001, “the ’113 patent”). Paper 1 (“Pet.”). OpenSesame, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). On February 27, 2023, we instituted an *inter partes* review of claims 1–16 of the ’113 patent on the following grounds:

Claims Challenged	35 U.S.C. § ¹	References/Basis
1–16	103	Sperle, ² Madison ³
7, 8	103	Sperle, Madison, Kimball ⁴

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 12, “PO Resp.”), Petitioner filed a Reply (Paper 14, “Reply”), and Patent Owner filed a Sur-reply (Paper 19, “Sur-reply”). Also, Patent Owner filed a Contingent Motion to Amend (Paper 11, “MTA”), Petitioner filed an Opposition to the MTA (Paper 15, “MTA Opp.”), we issued Preliminary Guidance on the MTA (Paper 18, “Preliminary Guidance” or “PG”), Petitioner filed a Reply to the Preliminary Guidance (Paper 20, “MTA Reply”), and Patent Owner filed a Sur-reply regarding the Preliminary Guidance (Paper 24, “MTA Sur-reply”).

Petitioner relies on the Declaration of Kevin Almeroth (Ex. 1002) and the Reply Declaration of Kevin Almeroth (Ex. 1024). Patent Owner relies on the Supplemental Declaration of Bryan Bergeron, MD (Ex. 2002).

We held an oral argument on November 28, 2023. A copy of the transcript of that argument was entered into the record. Paper 31 (“Tr.”).

¹ The Leahy-Smith America Invents Act (“AIA”) amended 35 U.S.C. §§ 102, 103. *See* Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011). Because the effective filing date of the challenged claims is before March 16, 2013 (the effective date of the relevant amendments), the pre-AIA version of § 103 applies.

² U.S. Patent Application Publication No. 2007/0111180 A1, published May 17, 2007 (Ex. 1005).

³ U.S. Patent Application Publication No. 2004/0015703 A1, published Jan. 22, 2004 (Ex. 1006).

⁴ U.S. Patent Application Publication No. 2006/0204942 A1, published Sept. 14, 2006 (Ex. 1007)

B. Related Matters

The parties identify the following judicial proceeding in which the '113 patent is asserted and which may affect, or be affected by, a decision in this proceeding: *OpenSesame, Inc. v. GO1 Pty, Ltd.*, Case No. 3:21-cv-01258-SB (D. Oregon). Pet. 2; Paper 4, 2; *see* 37 C.F.R. § 42.8(b)(2).

C. Real Parties in Interest

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

D. The '113 Patent

The '113 patent is titled “Open and Interactive E-Learning System and Method.” Ex. 1001, code (54). The '113 patent describes as background that learning management systems (LMSs) conventionally are “closed learning systems” in which access is “one-way rather than interactive, i.e., [i]ndividual students each review the teaching content in its ‘canned’ form.” *Id.* at 1:23–36. The '113 patent notes that “[t]he Sharable Content Object Reference Model (SCORM) and Aviation Industry Computer-Based Training Committee (AICC) standards claim to offer . . . an interoperable e-learning content standard [but] do not guarantee interoperability.” *Id.* at 1:59–62. The '113 patent adds that vendors use AICC to “centrally host and manage content” but “do not provide for secure but distributable central storage of a broad range of content.” *Id.* at 2:7–14.

The '113 patent describes a system (called “OPENSESAME”) to solve the above problems by “abstracting the actual courseware (e.g., e-learning course content) from the LMS via a proxy SCORM package (called ‘SESAMESEED’).” *Id.* at 2:49–62. The proxy “enforce[s] access control,” “provide[s] access to the latest version(s) of the content,”

“provide[s] status updates to the LMS system,” and “relieve[s] the LMS system of the burden of hosting and playing the content.” *Id.* at 2:52–62.

Figure 3 of the '113 patent is shown below.

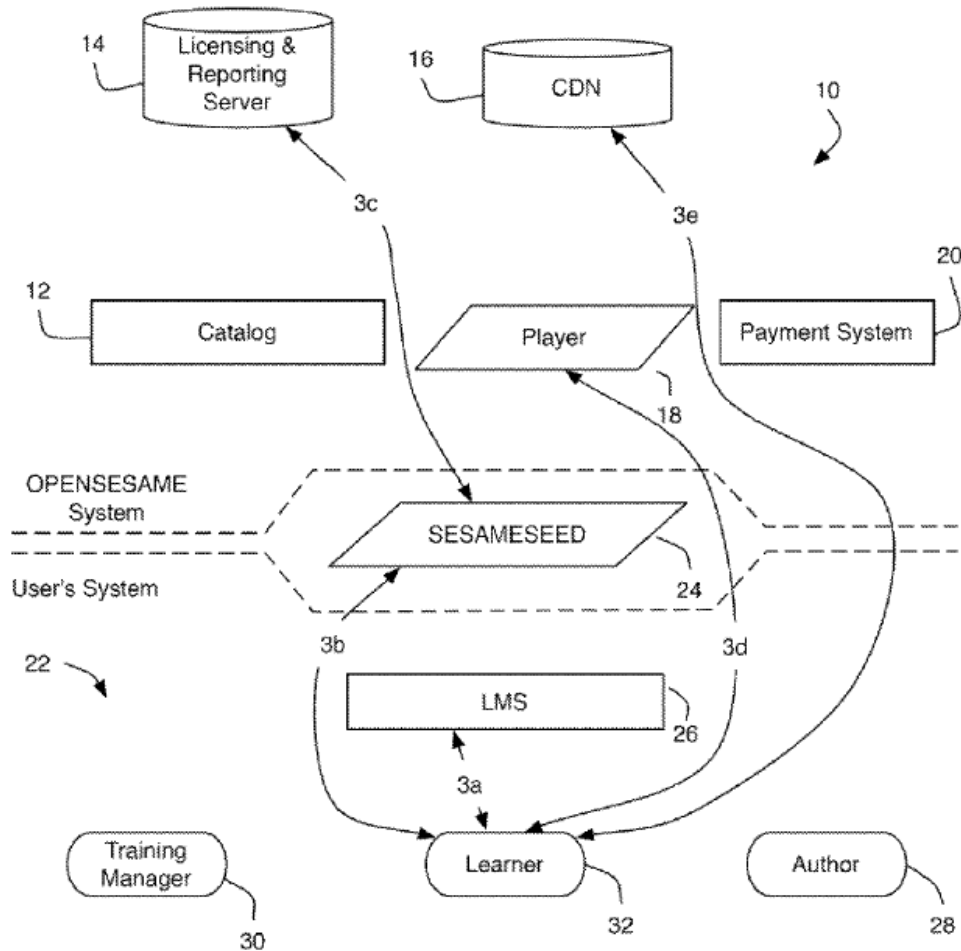


Figure 3

Learner launches course from his/her LMS

Figure 3, above, illustrates the OPENSESAME system architecture and highlights how a learner would use the system. *Id.* at 2:19–30, 3:14–23. OPENSESAME system 10 includes OPENSESAME catalog (e.g., e-learning course catalog) 12, OPENSESAME licensing and reporting server

(e.g., a digital rights management server) 14, content delivery network (CDN) 16, OPENSESAME player (e.g., content player) 18, and payment system 20. *Id.* at 3:17–23. User system 22 includes SESAMESEED proxy 24, LMS 26, author 28, training manager 30, and learner 32. *Id.* at 3:23–26.

The '113 patent discloses that “the SESAMESEED proxy bridges the network-side and the client-side, originating and interacting with the network-side, but being stored and executed during operation at the client side.” *Id.* at 7:8–11. According to the patent, “this dual nature” of the proxy “enables several of the enhanced capabilities of the invented system and method.” *Id.* at 7:11–13. In Figure 3 above, “the SESAMESEED exists both in the LMS (at 3a) and in the learner’s browser (3b), acting as the link between the invented System 10, the learner 32, and the LMS 26.” *Id.* at 8:58–63.

As illustrated in Figure 3, at 3a, the learner requests a course from the learner’s LMS and the LMS responds with the location of the course. *Id.* at 8:64–67. At 3b, the learner requests the course, and the learner’s browser loads the course, which is “actually a SESAMESEED proxy provided from the LMS.” *Id.* at 9:1–4. At 3c, the proxy makes a licensing request to the licensing/reporting server, which returns either a script containing a player URL or a signal indicating that access is denied. *Id.* at 9:5–11. At 3d, if authorization succeeds, the proxy instructs the learner’s web browser to load the player URL, and, once loaded, the player instructs the learner’s browser to load the course content from the CDN. *Id.* at 9:18–22. At 3e, the learner’s browser requests content from the CDN and the content is loaded from the CDN into the user’s browser. *Id.* at 9:28–30.

E. Illustrative Claim

Among the challenged claims (claims 1–16), claims 1, 5, and 11 are independent. Claim 1 reads as follows, with the key limitation emphasized:

1. An e-learning delivery system, comprising:
 - a licensing/reporting server;
 - a network-side content player operably coupled with each of the licensing/reporting server and a content delivery network comprising stored e-learning content; and
 - a proxy comprising coded instructions stored on a non-transitional computing device-readable medium at the network-side, wherein the proxy instructions identify a specific instance of licensed content, and wherein the proxy instructions are configured when executed on a client-side computing device to enable a user to access and interact with the licensed content via a browser of the computing device and are further configured to report a status of the user's interaction with the content to one or both of the licensing/reporting server and a learning management system (LMS);
- wherein the licensing/reporting server includes coded instructions configured when executed to cause the licensing/reporting server to verify a validity status of the user license to the specific instance of content, and ***upon verifying the validity of the license, the instructions are further configured to cause the licensing/reporting server to provide to the proxy a location designator for accessing the content player;***
- wherein the proxy instructions are further configured, when executed on the client-side computing device in response to a request for access to the specific instance of content, to:
 - cause the client-side computing device to request verification by the licensing/reporting server of the validity status of a license to the specific instance of content; and
 - cause the client-side computing device to instruct a browser to access the content player via the location designator;
- and

wherein the proxy instructions are further configured to relay information to a client-side Learning Management System (LMS) including information indicating a status of content played by the content player.

Id. at 16:48–17:19 (emphasis added).

Independent claims 5 and 11 include a limitation similar to the one emphasized above. Claim 5 recites “[a] method for delivering e-learning standard-complaint content, comprising: . . . ***providing, from the licensing/reporting server to the proxy in response to a successful license verification request received from the proxy, the content player location designator.***” Claim 11 recites “[a]n e-learning proxy comprising: instructions stored on a non-transitory computing-device-readable medium, wherein the instructions are configured when executed on a computing device to cause the computing device to: . . . ***receive from the licensing/reporting server, in response to a successful verification of the license, a location designator for a content player.***”

II. DISCUSSION

A. Principles of Law

To prevail in its challenge to Patent Owner’s patent claims, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “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’’)). The burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

A 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 of the invention to a person having ordinary skill in the art. *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 the following: (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) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). “A determination of whether a patent claim is invalid as obvious under § 103 requires consideration of all four *Graham* factors, and it is error to reach a conclusion of obviousness until all those factors are considered.” *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1048 (Fed. Cir. 2016) (en banc) (citations omitted). “This requirement is in recognition of the fact that each of the *Graham* factors helps inform the ultimate obviousness determination.” *Id.*

B. Level of Ordinary Skill

Petitioner asserts that a person having ordinary skill in the art would have had “a bachelor’s degree in electrical engineering, computer engineering, computer science, or a related field, and at least two years of experience in the research, design, development, and/or testing of systems

for delivering educational content over networks such as the Internet, or the equivalent, with additional education substituting for experience and vice versa.” Pet. 8 (citing, e.g., Ex. 1002 ¶ 41).

Patent Owner states that it “generally agrees with Petitioner’s proposed level of ordinary skill in the art.” PO Resp. 10. Patent Owner adds that “the level of ordinary skill in the art is more often premised not upon obtaining a formal degree in computer engineering, computer science, etc., but through years of hands-on experience in the field, often coupled with formal coursework that may or may not lead to a degree in the enumerated fields.” *Id.* at 11 (citing, e.g., Ex. 2002 ¶ 18).

We determine that the level of ordinary skill proposed by Petitioner is consistent with the challenged patent and the asserted prior art, and we therefore adopt that level.

C. Claim Construction

In an *inter partes* review based on a petition filed on or after November 13, 2018, we apply the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), following the standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b) (2020); 83 Fed. Reg. 51,340, 51,340–41, 51,343 (Oct. 11, 2018). In applying such standard, claim terms are generally given their ordinary and customary meaning, as would be understood by a person of ordinary skill in the art, at the time of the invention and in the context of the entire patent disclosure. *Phillips*, 415 F.3d at 1312–13. “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution

history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Neither party proposes express constructions for any claim terms. *See* Pet. 8 (“To resolve the particular grounds presented in this Petition, Petitioner does not believe that any term requires explicit construction.”); PO Resp. 11 (“Patent Owner believes that the patent claims at issue can be interpreted without the need for the formal construction of any claim terms.”).

We determine that no claim terms require express construction in order to analyze the patentability issues presented.

D. Asserted Obviousness over Sperle and Madison

Petitioner asserts that claims 1–16 of the ’113 patent are unpatentable as obvious over the combination of Sperle and Madison. Pet. 3, 15–73. As explained below, Petitioner does not persuasively show that claims 1–16 are unpatentable as obvious over the combination of Sperle and Madison.

1. Summary of Sperle

Sperle is a U.S. patent application publication titled “Delivery Methods for Remote Learning System Courses.” Ex. 1005, code (54). Sperle discloses that “enterprises are often faced with the challenge of lifelong learning to train a (perhaps globally) distributed workforce, update partners or suppliers about new products and developments, [and] educate apprentices or new hires.” *Id.* ¶ 2. According to Sperle, many companies must identify third-party providers to provide the necessary training and identify courses that are relevant to their employees, “which can be time consuming and costly.” *Id.* Sperle discloses a system that proposes learning

units based on a learner's personal data, tracks progress through courses, and coordinates the personalized learning experience. *Id.* ¶ 11.

Figure 1 of Sperle is shown below.

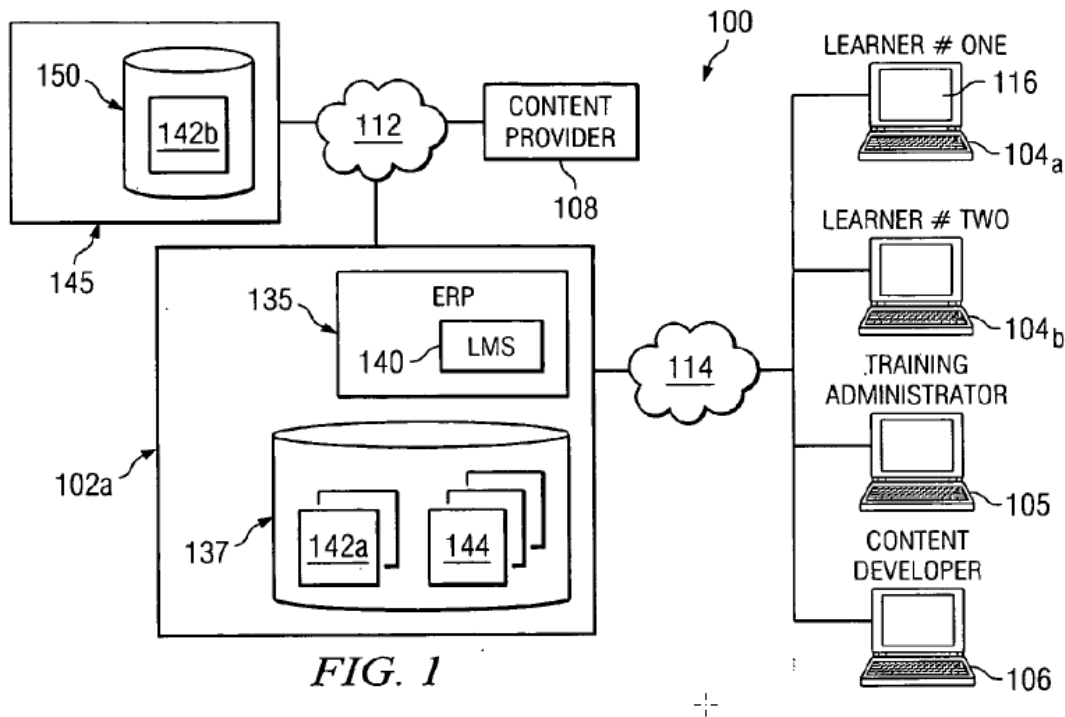


Figure 1, above, illustrates environment 100 for learning management system (LMS) 140. *Id.* ¶ 11. Sperle discloses that environment 100 “is typically a distributed client/server system that spans one or more networks such as external network 112 or internal network 114.” *Id.* ¶ 13.

Environment 100 includes server 102a and one or more learners 104 or other users on clients. *Id.* Environment 100 also is communicably coupled with external content provider 108 and external learning management system 145 via external network 112. *Id.* ¶¶ 11, 13. According to Sperle, training administrator 105 may customize teaching scenarios by using web services to integrate external content from external content provider 108 or external learning management system 145. *Id.* ¶ 11. Internal server 102a includes

local memory 137, which includes local course catalog 142a and course profiles 144. *Id.* ¶¶ 14, 15.

Sperle discloses that “course catalog 142 includes information indicating specific checks that may be performed for a course,” such as whether the course “has a valid license.” *Id.* ¶ 16. Internal server 102a also includes enterprise resource planning (ERP) solution 135, which may implement analytics that enable the entity or user to evaluate performance and analyze operations. *Id.* ¶ 18. According to Sperle, LMS 140 is often fully integrated with ERP solution 135. *Id.* ¶ 19. Sperle discloses that LMS 140 “offers robust reporting capabilities, including ad hoc reporting and business intelligence.” *Id.* ¶ 11.

Figure 2 of Sperle is shown below.

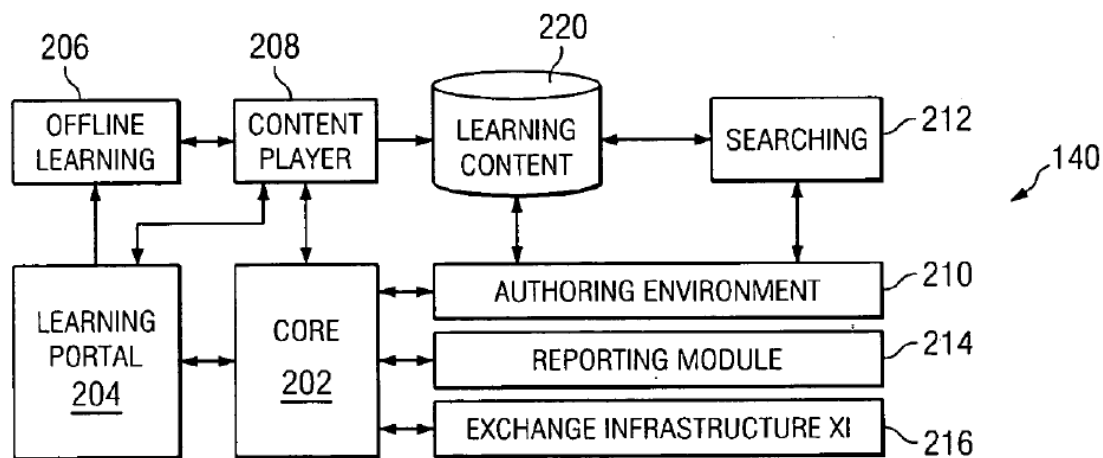


FIG. 2

Figure 2 illustrates an implementation of LMS 140. *Id.* ¶ 28. Sperle discloses that “[r]eporting functions 214 . . . keep track of learners’ learning activities and the associated costs at all times.” *Id.* ¶ 34. According to Sperle, “[t]here is a wide range of reporting options available in training

management to enable the trainer to keep track of participants, rooms, course locations, and so on.” *Id.*

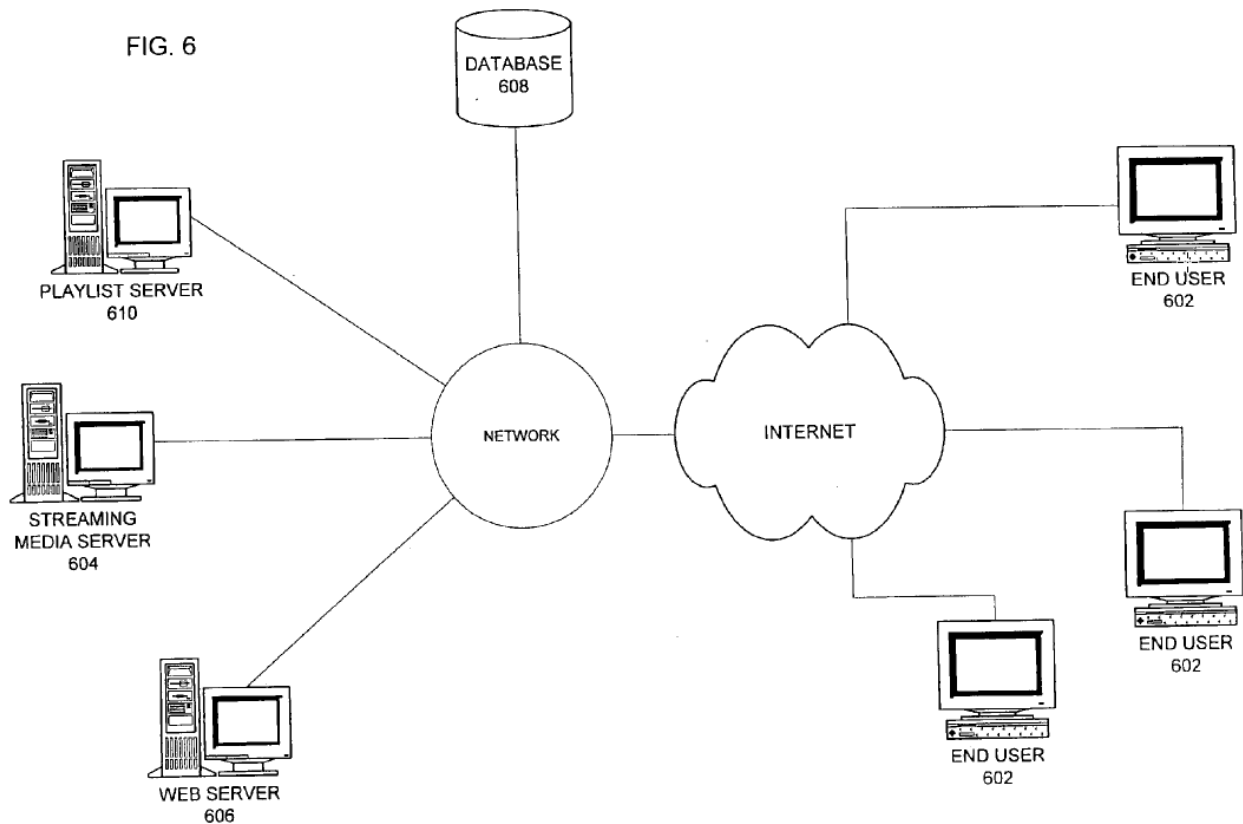
2. *Summary of Madison*

Madison is a U.S. patent application publication titled “System and Method for Controlling Access to Digital Content, Including Streaming Media.” Ex. 1006, code (54). Madison discloses that “streaming media may be used for any of a number of purposes, including . . . distance learning.” *Id.* ¶ 4. According to Madison, a streaming media server “typically includes a software plug-in of compiled code that contains the logic for determining whether or not to grant access to the streaming media.” *Id.* ¶ 6. Such an authentication plug-in, according to Madison, “is often complicated and difficult to develop and maintain.” *Id.*

Madison discloses an improved system in which a web server “cryptographically generates a ticket in response to an end user’s request for access to a file.” *Id.* ¶ 8. Madison discloses that, “[p]rior to a media server providing access to the requested file, the media server generates an authorization ticket, preferably using the same cryptographic algorithm as the web server.” *Id.* ¶ 9. According to Madison, “[t]he media server determines whether to grant access to the file by comparing the ticket, as generated by the web server, to the ticket, as generated by the media server.” *Id.* If the tickets match, the media server grants the end user access to requested media content. *Id.* ¶ 10.

Figure 6 of Madison, below, shows an embodiment of the system. *Id.*

¶ 16.



As illustrated in Figure 6 above, the system includes end user processors 602, one or more streaming media servers 604, one or more web servers 606, playlist server 610, and database 608, all of which couple to the Internet or other network. *Id.* ¶ 68.

Madison describes the steps for granting access to a streaming media file as follows: An end user requests access to a playlist having one item of secure content. *Id.* ¶ 72. Web server 606 provides a web page requesting the end user to log in to an authorization application. *Id.* In response, the end user provides the end-user's user ID and credit card information and requests access to a particular streaming media content file. *Id.* Web server

606, in turn, generates an authorization ticket by applying a private key (obtained from database 608), stream ID, end user ID and time values. *Id.* ¶¶ 75, 76. Web server 606 returns the ticket and end user ID to the web browser running on end user processor 602. *Id.* ¶ 76. A script running on end user process 602 then causes a call to be made to playlist server 610. *Id.* ¶ 79.

Playlist server 610 generates a redirector file, such as an ASX file. *Id.* The playlist server then passes the ASX redirector file to the media player at end user processor 602. *Id.* ¶ 81. An example redirector file is shown below (*id.*):

```
<ASX>
  <ENTRY>
    <REF href="mms://mediaserver.company.com/stream 1 .asf?
      ID=123456&TICKET=uvw123xyz& USER_ID=abc
      123def">
  <ENTRY>
<ASX>
```

As illustrated above, Madison's example redirector file includes a URL prefix (mms://), a host name of the appropriate media server (mediaserver.company.com), the filename (stream 1 .asf), the requested item of content stream ID (123456), the ticket, and the end user ID. *Id.*

According to Madison, after end user processor 602 receives the ASX file, end user process 602 requests the streaming media content by making a call to mediaserver.company.com, as identified in the ASX file. *Id.* ¶ 83. In response, streaming media server 604 proceeds to determine whether or not to grant the end user access to the requested content. *Id.* ¶ 84. Specifically, streaming media server 604 independently generates an authentication ticket and compares it to the ticket generated by web server 606. *Id.* If a ticket

generated by media server 604 matches the ticket generated by web server 606, media server 604 grants the end user access to the requested content.
Id.

3. Analysis

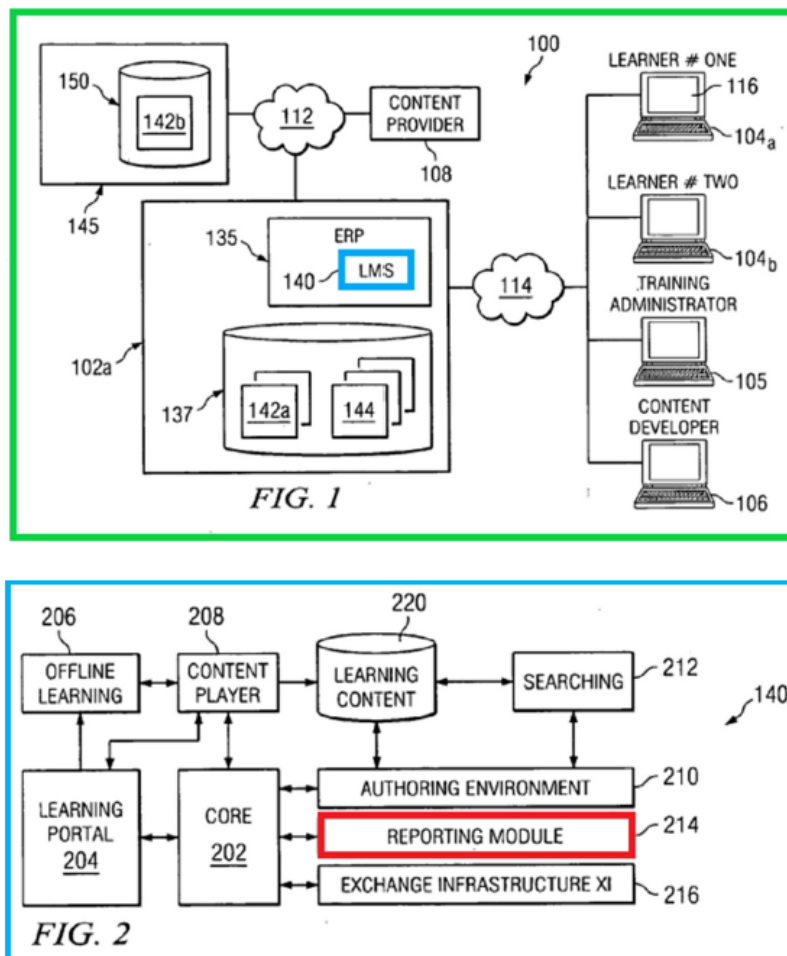
a. Independent claim 1

Petitioner does not establish that the combination of Sperle and Madison teaches the limitation of claim 1 that the licensing/reporting server includes coded instructions configured such that, “upon verifying the validity of the license, . . . cause the licensing/reporting server to provide the proxy a location designator for accessing the content player.” Petitioner does not rely on either reference for teaching this limitation. Rather, Petitioner asserts that a person of ordinary skill in the art “would have considered it obvious.” Pet. 44 (citing Ex. 1002 (Almeroth Decl.) ¶ 136). In its Reply, Petitioner reinforces its reliance on testimony beyond the teachings of the references, asserting that an ordinarily skilled artisan would not require Madison to specify instructions that operate in a manner identical to this limitation because a skilled artisan is a person of ordinary creativity, not an automaton. Pet. Reply 12 (citing *KSR*, 550 U.S. at 421; Ex. 1024 (Almeroth Reply Decl.) ¶¶ 90–91). As explained below, Petitioner relies on unsupported, conclusory testimony from Dr. Almeroth to fill in gaps in the prior art references. We therefore determine Petitioner does not meet its burden in showing claim 1 is unpatentable as obvious over Sperle and Madison.

We first describe Petitioner’s contentions regarding the applicable claim limitations, and then we address why Petitioner’s showing regarding the location designator limitation is insufficient.

i. Petitioner's contentions—licensing/reporting server

Claim 1 recites an e-learning delivery system that includes “a licensing/reporting server.” Petitioner asserts that the combination of Sperle and Madison teaches the claimed licensing/reporting server. Pet. 22–28; Ex. 1002 ¶¶ 90–101. Petitioner's combination can be illustrated by the following annotated figures from the Petition. First, shown below are Petitioner's annotated Figures 1 and 2 from Sperle (Pet. 23):



As illustrated above, Petitioner annotates Figures 1 and 2 from Sperle to identify reporting module 214 (in red), which is part of the server-side Learning Management System 140 (in light blue). Pet. 23.

Petitioner combines Madison’s teaching of authorization software that determines whether to grant or deny access to specific content with Sperle’s teachings regarding the reporting module, as illustrated by Petitioner’s figure below (Pet. 28):

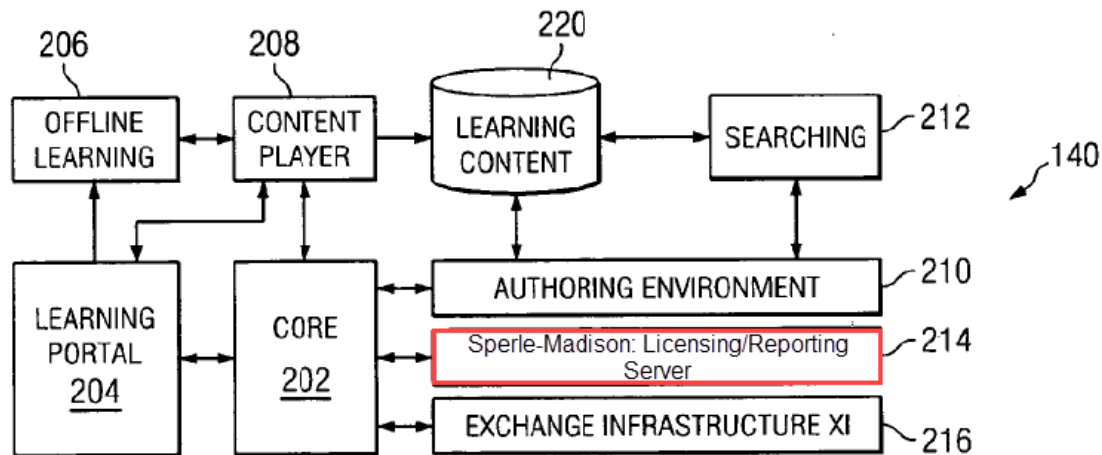


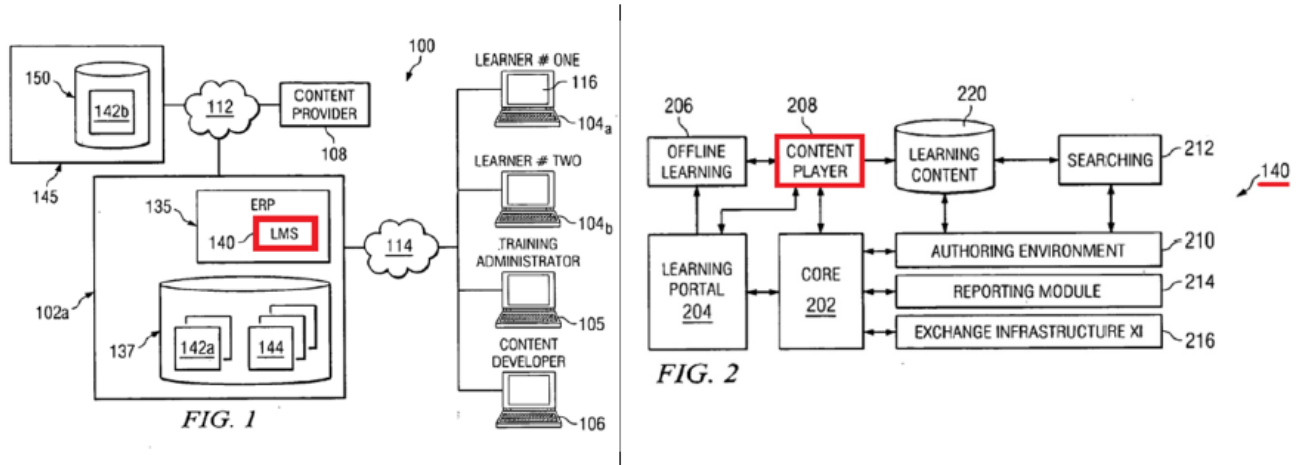
FIG. 2

Illustrated above is Petitioner’s modification of Sperle Figure 2 to include (in red) the licensing/reporting server taught by the combination of Sperle and Madison. Pet. 28. Petitioner asserts that a person of ordinary skill in the art would have readily integrated Madison’s web server with authorization software and media server with similar authorization software into the reporting module of Sperle, obtaining a licensing/reporting server as claimed. Pet. 26–28; Ex. 1002 ¶¶ 99–101.

ii. Petitioner’s contentions—network-side content player

Claim 1 recites that the e-learning delivery system also includes “a network-side content player operably coupled with each of the licensing/reporting server and a content delivery network comprising stored e-learning content.” Petitioner argues that the combination of Sperle and Madison teaches the network-side content player. Pet. 28–31; Ex. 1002

¶¶ 102–108. Petitioner relies on the following annotated versions of Sperle Figures 1 and 2 (Pet. 29):



Illustrated above are Petitioner’s annotated Figures 1 and 2 to of Sperle to illustrate (in red) that the network-side LMS 140 includes Content Player 208. Pet. 29. According to Petitioner, Sperle discloses that content player 208 is coupled to (i) reporting module 214, which as modified by the combination with Madison is the claimed licensing/reporting server, through core 202; and (ii) content delivery network (network 112 in Figure 1) through Learning Content 220. Pet. 28–30; Ex. 1005, Figs. 1, 2; Ex. 1002 ¶ 104.

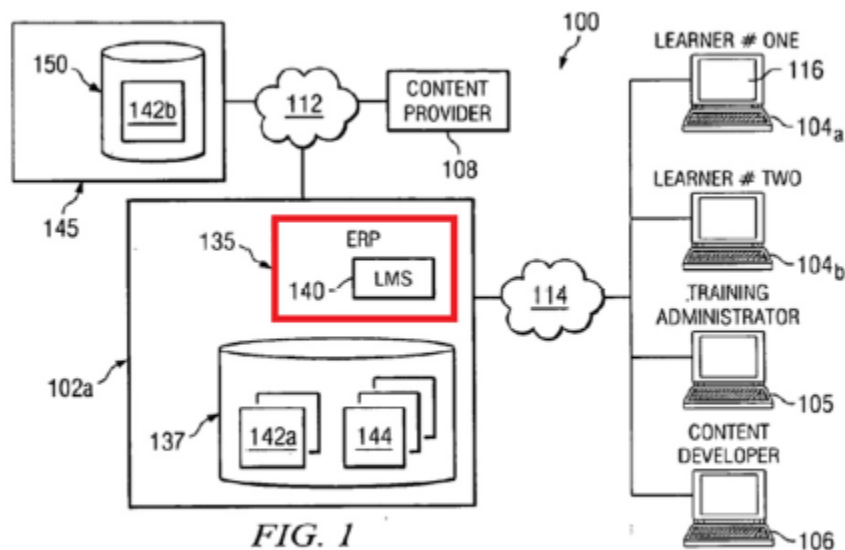
iii. Petitioner’s contentions—proxy comprising coded instructions that identify a specific instance of licensed content

Claim 1 also recites that the e-learning delivery system includes “a proxy comprising coded instructions stored on a non-transitory computing device-readable medium at the network-side, wherein the proxy instructions identify a specific instance of licensed content.”

Petitioner asserts that the combination of Sperle and Madison teaches the claimed proxy in that a skilled artisan would have been motivated to use Madison’s access control software and redirector file with Sperle’s system

components to enforce licensing restrictions placed on the e-learning content and to identify a specific instance of that content. Pet. 32–38; Ex. 1002 ¶¶ 109–122.

Petitioner relies on Sperle’s teaching of an Enterprise Resource Planning (ERP) solution, as illustrated in Petitioner’s annotation of Sperle Figure 1 below (Pet. 33):



Shown above is Petitioner’s annotation of Sperle Figure 1 to illustrate (in red) the ERP solution, which according to Petitioner implements functionalities of LMS 140 and may be stored and executed both on the network and remotely on a user terminal. Pet. 33–34.

Petitioner also relies on Madison’s teaching that—in response to a user requesting certain streaming media—the network-side playlist server “generates a redirector file” that “contains a link to the requested content, along with the ticket and public key (i.e., stream ID and end user ID).” Pet. 36–37 (citing Ex. 1006 ¶¶ 72–79). Petitioner asserts that a person of

ordinary skill in the art “implementing Sperle would have utilized the access control software from Madison, including Madison’s redirector file and the network-side software that creates it, as the claimed proxy instructions.” *Id.* at 37 (citing Ex. 1002 ¶¶ 121–122). According to Petitioner, a person of ordinary skill in the art “would have been motivated to utilize Madison’s network-side proxy instructions, including its various access-control software and redirector file, to achieve the access restrictions and distribution improvements discussed by Madison (*i.e.*, to enforce licensing restrictions place on the e-learning content) and to identify the specific instance of that licensed content.” *Id.* (citing Ex. 1002 ¶ 121).

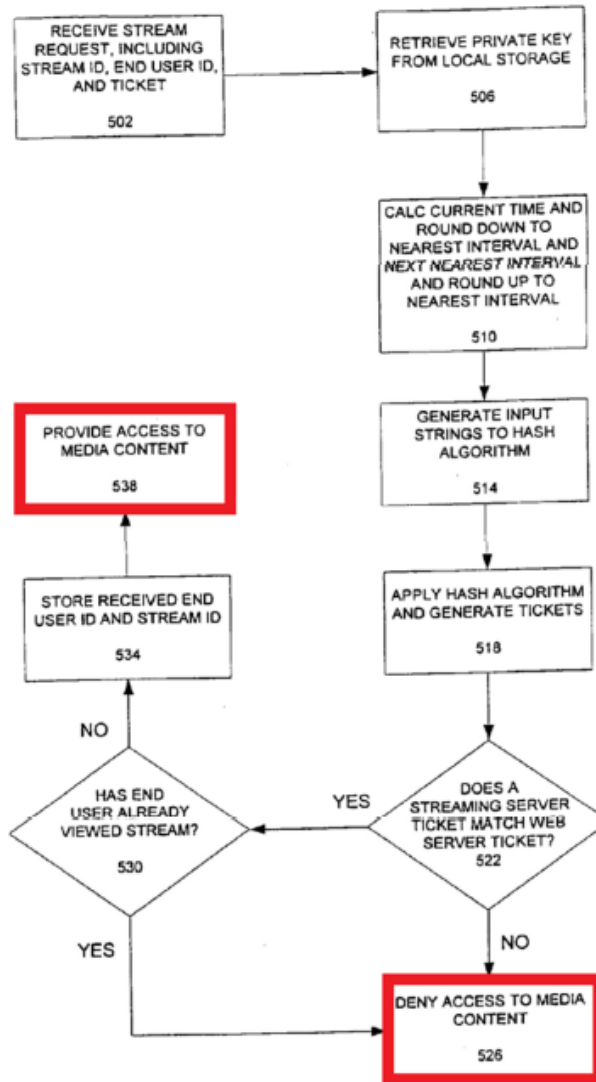
iv. Petitioner’s contentions—verify a validity status of the user license

Claim 1 further recites “wherein the licensing/reporting server includes coded instructions configured when executed to cause the licensing/reporting server to ***verify a validity status of the user license*** to the specific instance of content.”

Petitioner relies on the combination of Sperle and Madison for teaching this claim limitation. Pet. 41–43; Ex. 1002 ¶¶ 129–133. Specifically, Petitioner relies on Sperle’s discussion of “licenses and encryption generally” and on Madison for “specific implementation details.” Pet. 41. Petitioner maintains that Madison teaches a series of steps (which would have been implemented as coded instructions on the licensing/reporting server) between a user request and the ultimate provision of media, including verifying the validity of a user’s access request. *Id.* at 41–42 (citing Ex. 1006 ¶¶ 68–97). Petitioner cites to step 522 of Madison’s Figure 5 as disclosing a check for whether a streaming server

ticket matches a web server ticket. Pet. 42–43. Petitioner further illustrates Madison’s teachings by annotating Madison’s Figure 5 as follows (Pet. 43):

FIG. 5



Illustrated above is Petitioner’s annotated version of Madison Figure 5, with red boxes showing the options of providing or denying access to media content based on a check of whether the streaming server ticket matches the web server ticket. Pet. 43; Ex. 1006, Fig. 5.

Petitioner further explains in its Reply how “Madison’s software causes the client device to request verification of the license”:

After logging into the system, the end user requests “access to the particular streaming media content file” by sending a “stream request” to the web server, which, in turn, “issues a request to the database 108 for the private key for use in generating the authorization ticket.” When the user accesses the redirector file in its browser to access the requested content, the “authorization ticket” is provided back to the network for verification. Upon receiving this authorization ticket information, “streaming media server 104 either denies or provides access to the requested streaming media content based on a comparison of the tickets as generated by the streaming media server 104 and web server 106.”

Pet. Reply 10–11 (citations omitted).

Petitioner therefore relies—for the verifying the validity of the license—on Madison’s teachings of a sequence of steps in which a redirector file is sent to a user *before* the streaming media server determines whether to deny or grant access.

v. *Petitioner’s contentions—providing a location designator*

Claim 1 further recites that the licensing/reporting server includes coded instructions such that, “***upon verifying the validity of the license***, the instructions are further configured to ***cause the licensing/reporting server to provide to the proxy a location designator*** for accessing the content player.”

Petitioner asserts that the combination of Sperle and Madison teaches this limitation. Pet. 44–45. Specifically, Petitioner asserts that the combination of Sperle and Madison “teaches coded instructions in the licensing/reporting server configured to provide Madison’s redirector file (i.e. the claimed ‘proxy’) with a location designator for accessing the content player.” *Id.* at 44. According to Petitioner, a person of ordinary skill in the art “would have considered it obvious that the licensing/reporting server would provide a location designator URL to the redirector file proxy for

accessing content because each piece of content contains an unique ID that is generated by the licensing/reporting server.” *Id.* (citing Ex. 1006 ¶ 81). Petitioner adds that “[t]he user device in Madison uses the URL in the redirector file to direct the user device to the media server.” *Id.* (citing Ex. 1006 ¶ 91).

In support of the Petition, Petitioner’s declarant, Dr. Almeroth, does not add anything beyond what is stated in the Petition, other than noting that the URL links in Madison’s redirector file are the claimed location designators for accessing content. Ex. 1002 ¶¶ 134–136. Neither Petitioner nor Dr. Almeroth address the claim requirement of “upon verifying the validity of the license.” *See* Pet. 44–45.

In its Reply, Petitioner responds to Patent Owner’s argument that, in Madison, the validity of the license is verified *after* the redirector file (which includes a location designator (URL)) is generated and thus the steps in Madison are in the reverse order from the claim requirement of verifying license validity *before* providing a location designator. Pet. Reply 12 (citing PO Resp. 33). Petitioner’s response is as follows:

These arguments fail because a [person of ordinary skill in the art] would not require Madison to specify “proxy instructions” that operate in an identical manner to limitation [1.f] to be motivated to combine the disclosures of Sperle-Madison with a reasonable expectation of success in achieving the purported claimed invention. A [person of ordinary skill in the art] is a person of ordinary creativity, not an automaton. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Moreover, there is no material difference—and [Patent Owner] does not identify one—between the request for streaming media content, in combination with an authorization ticket that is provided back to the network for verification, and “request[ing] verification ... of the validity status of a license to the specific instance of content.” Nor does [Patent Owner] explain what consequences

exist, if any, for the “steps in Madison” being in “reverse order compared to the claim element.” [A person of ordinary skill in the art] would have viewed these alleged differences, if any exist, as inconsequential, and they would not prevent a motivation to combine Sperle and Madison.

Pet. Reply 12–13.

Petitioner therefore reiterates in its Reply that it is relying on the ordinary creativity of a skilled artisan and not any express disclosure in Sperle or Madison for establishing that it would have been obvious for the licensing/reporting server (Madison’s server authorization software integrated into Sperle’s reporting module) to have instructions that, *upon verifying the validity of the license*, cause the licensing/reporting server to provide to the proxy (redirector file and authorization software) a location designator (URL) for accessing the content player.

vi. Analysis

Petitioner’s assertions and testimonial evidence are not sufficiently supported by the references or contemporaneous evidence to establish that the “location designator” limitation would have been obvious to one of ordinary skill in the art considering the teachings of Sperle and Madison. We agree with Patent Owner that Petitioner’s showing for this claim limitation is insufficient. *See* PO Resp. 32–38; PO Sur-reply 13–15; Ex. 2002 ¶¶ 107–124.

First, Petitioner does not rely on any express disclosure in Sperle or Madison for this limitation. Pet. 44–45. Sperle discloses performing a “check” to determine whether a course “has a valid license” (Ex. 1005 ¶ 16), but does not provide any details for that license check, as Petitioner acknowledges (Pet. 40–44). Madison discloses generating a redirector file

that includes a URL pointing to the media server to access the content. Ex. 1006 ¶¶ 77–82. However, that URL is placed in the redirector file *before* the web server compares authorization tickets to determine whether the user is licensed to the requested content. *Id.* ¶¶ 77–84; Ex. 2002 ¶¶ 107–124. According to Madison, a redirector file is generated first, sent back to the user, and then when the user uses the redirector file to access the content, the media server determines whether or not to grant the end user access to the request. Ex. 1006 Fig. 5, ¶¶ 77–84. It is this last step of determining whether to grant access that Petitioner relies on for teaching the “verifying a validity status of the user license” limitation of claim 1. Pet. 41–43. Thus, Madison does not disclose “upon verifying the validity of the license,” causing a licensing server “to provide to a proxy a location designator” for accessing the content player. *See* Ex. 2002 ¶¶ 115–120, 123–124.

Petitioner acknowledges that Madison teaches generating a redirector file with the URL *before* the authorization check, but asserts that it does not matter because the key inquiry under *KSR* is whether a person ordinarily skilled in the art—“a person of ordinary creativity, not an automaton”—would have been motivated to combine the disclosures in Sperle and Madison to achieve the claimed invention. Pet. Reply 12. In the Petition, Petitioner relies on Dr. Almeroth to provide such an explanation. Pet. 45 (citing Ex. 1002 ¶ 136).

Dr. Almeroth, however, does not provide a persuasive explanation. Dr. Almeroth first says that a person of ordinary skill in the art “would have considered it obvious that the licensing/reporting server would provide a location designator URL to the redirector file proxy for accessing content because each piece of content contains a unique ID that is generated by the

licensing/reporting server.” Ex. 1002 ¶ 136. Dr. Almeroth then points to the URL link in the redirector file and states that the user device in Madison uses the URL in the redirector file to direct the user device to the media server. *Id.* Neither of these statements address the requirement in the claim that, “upon verifying the validity of the license,” the instructions are configured to “cause the licensing/reporting server to provide to the proxy” the URL. Dr. Almeroth then testifies that a person of ordinary skill in the art “would have understood that, in the combined system, the content would be accessed via Sperle’s content player 208, such that the reference to the media server in the ASX URLs would point to the network location of Sperle’s content player 208.” *Id.* This statement addresses only the last portion of the claim limitation.

Thus, the Petition and supporting evidence (Dr. Almeroth’s declaration testimony) do not address the entirety of the location designator claim limitation.

On reply, Petitioner relies on additional testimony from Dr. Almeroth. Pet. Reply 13 (citing Ex. 1024 ¶¶ 90–91). Dr. Almeroth opines that “[t]here is no practical difference between the request for streaming media content, in combination with an authorization ticket that is provided back to the network for verification; and ‘request[ing] verification . . . of the validity status of a license to the specific instance of content.’” Ex. 1024 ¶ 90.

According to Dr. Almeroth, a person of ordinary skill in the art “would view them as insubstantially different, if at all, and would still be motivated to combine Sperle and Madison.” *Id.* Dr. Almeroth adds that “there is no reason why the combination would not be an obvious design choice.” *Id.* Dr. Almeroth also testifies that “there is no clear significance to the fact that

the ‘steps in Madison’ are in ‘reverse order compared to the claim element’” and that a skilled artisan “would view them as insubstantially different, if different at all, and would still be motivated to combine Sperle and Madison.” *Id.* ¶91.

Dr. Almeroth’s testimony does not persuasively show why a person of ordinary skill in the art—considering the teachings of Sperle and Madison—would have performed the redirector file creation and authorization differently from what Madison teaches such that, upon determining that the user was authorized, the URL is provided from the licensing server to the proxy, as required by the claim. Petitioner relies on Madison’s disclosures regarding the redirector file for teaching other elements of the claim—the proxy and the verifying of the validity status of the user license—yet fails to provide a persuasive analysis for why a skilled artisan would go beyond what is taught in Madison and provide the URL to the proxy “upon verifying the validity of the license” rather than prior to that verification. Dr. Almeroth does not point to design considerations at the time of the invention to show why the differences between the art and claimed invention are “insubstantially different” or that the modification would merely be a “design choice.” Ex. 1024 ¶¶ 90–91. Rather, Dr. Almeroth provides conclusory testimony that is not supported by any evidence contemporaneous with the claimed invention. In fact, Dr. Almeroth does not provide any technical explanation for his generic conclusions. The evidence of record is simply insufficient for us to conclude that an ordinarily skilled artisan would have come up with the claimed invention in view of the teachings of Sperle and Madison.

Petitioner therefore fails to establish that the combination of Sperle and Madison teaches to one of ordinary skill in the art the limitation of claim 1 of “wherein the licensing/reporting server includes coded instructions when executed to cause the licensing/reporting server to verify a validity status of the user license to the specific instance of content, and ***upon verifying the validity of the license***, the instructions are further configured to ***cause the licensing/reporting server to provide to the proxy a location designator for accessing the content player.***”

vii. Conclusion regarding claim 1

For the above reasons, Petitioner does not persuasively show that the subject matter of claim 1 would have been obvious over the combination of Sperle and Madison.

b. Dependent claims 2–4

Claims 2–4 depend from claim 1. Petitioner relies on its analysis of the limitations recited in claim 1 when addressing dependent claims 2–4. Pet. 50–54. Therefore, for the reasons explained above in connection with claim 1, Petitioner does not persuasively show that the subject matter of claims 2, 3, or 4 would have been obvious over the combination of Sperle and Madison.

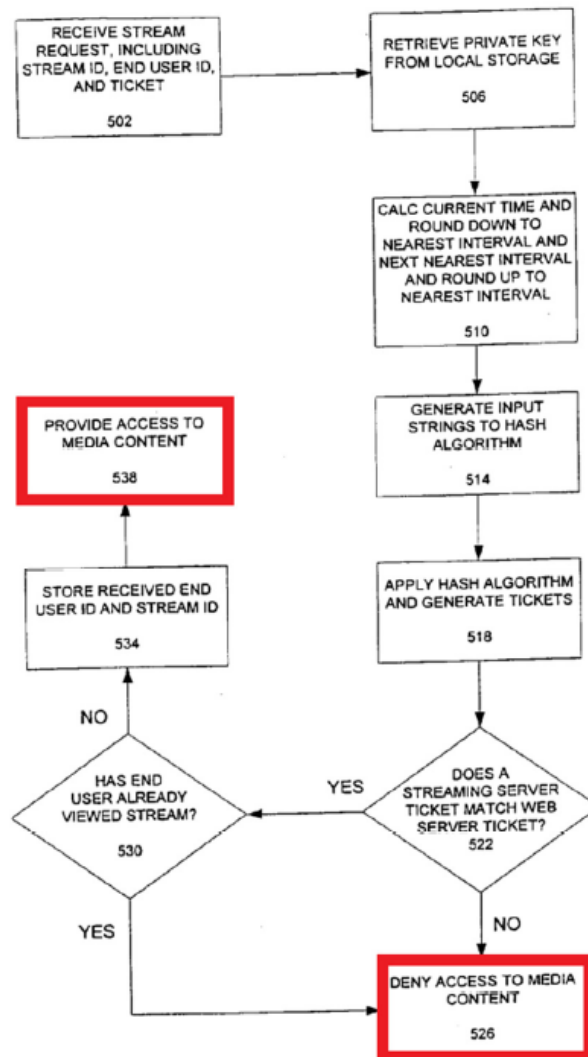
c. Independent claim 5

Claim 5 (a method claim) recites a location designator limitation similar to that of claim 1 (a system claim). Specifically, claim 5 recites “providing, from the licensing/reporting server to the proxy ***in response to a successful license verification request received from the proxy***, the content player location designator.” Petitioner primarily relies on the same analysis for this limitation as it does for the corresponding limitation in claim 1, but

adds additional discussion that similarly does not persuasively address the “in response to a successful license verification request” requirement. Pet. 56–57; Pet. Reply 19.

Petitioner asserts that Madison teaches this limitation of claim 5. Pet. 56 (citing Ex. 1002 ¶¶ 162–163). Petitioner maintains that, “[a]s discussed above for element [1.f.], Madison teaches that, upon verifying the validity of the license, the licensing/reporting server . . . provides, to the proxy, a location designator for accessing the content player.” *Id.* at 56–57. Petitioner states that “[s]uch a success response is show in Madison’s Figure 5, element 538.” *Id.* at 57. Petitioner again points to the red highlighted boxes from Madison’s Figure 5 below as it does for the license verification limitation of claim 1 (*compare* Pet. 57, *with* Pet. 43):

FIG. 5



Shown above is Petitioner’s annotated version of Madison Figure 5, highlighting in red box 538 for providing access to media content after determining that tickets match (and the user is authorized). Pet. 57. The highlighted boxes, along with step 522, illustrate determining whether or not the user is authorized (i.e., verifying the validity of the license), but do not address the other portions of the claim limitation.

Petitioner asserts that a person of ordinary skill in the art “would have understood that, because the content is played network-side in Sperle by content player 208, and not delivered as part of the proxy to the user, the

reporting/licensing server must provide the end-user with a location designator URL.” *Id.* at 57. Thus, according to Petitioner, an ordinarily skilled artisan “would have considered it obvious that the licensing/reporting server would provide a location designator URL to the redirector file proxy for accessing content.” *Id.* (citing Ex. 1002 ¶ 163). Dr. Almeroth does not provide any additional analysis other than what is stated in the Petition. *See* Ex. 1002 ¶¶ 162–163; Ex. 1024 ¶ 110.

As explained above in connection with claim 1, Petitioner’s analysis does not address the entirety of the limitation, which requires “in response to a successful license verification request received from the proxy,” providing from the licensing/reporting server to the proxy the content player location designator. Madison discloses a different sequence: generating a redirector file with a content player location designator, sending that redirector file to the user, verifying that the user is authorized to have access, and then granting that access. Neither Petitioner nor Dr. Almeroth explain how the combination of Sperle and Madison teaches the specific order required by the claim limitation. In addressing the claim 5 limitation, Petitioner separately addresses portions of the limitation, but does not address the entirety of the limitation that dictates that the location designator is provided “in response to a successful license verification request.”

For these reasons and for the reasons explained above in connection with claim 1, Petitioner does not show that the subject matter of claim 5 would have been obvious over the combination of Sperle and Madison.

d. Dependent claims 6–10

Claims 6–10 depend directly or indirectly from claim 5. Petitioner relies on its analysis of the limitations recited in claim 5 when addressing

dependent claims 6–10. Pet. 62–66. Therefore, for the reasons explained above in connection with claim 5, Petitioner does not persuasively show that the subject matter of any of claims 6–10 would have been obvious over the combination of Sperle and Madison.

e. Independent claim 11

Claim 11—directed to an e-learning proxy comprising instructions stored on a non-transitory computing-device-readable medium—recites a location designator limitation similar to that recited in claim 1 (system claim) and claim 5 (method claim). Specifically, claim 11 recites that the instructions are configured when executed on a computing device to cause the computing device to “receive from the licensing/reporting server, *in response to a successful verification of the license*, a location designator for a content player.” Petitioner relies on the same analysis for this limitation as it does for the corresponding limitation in claim 1. Pet. 67–68; Pet. Reply 19; Ex. 1002 ¶ 183. Neither Petitioner nor Dr. Almeroth provide any additional analysis beyond the analysis for claim 1.

As explained above in connection with claim 1, neither Sperle nor Madison discloses a licensing/reporting server sending a location designator for a content player “in response to a successful verification of the license.” *See infra* Section II.D.3.a.vi. Petitioner relies on unsupported, conclusory testimony from Dr. Almeroth to show that this feature would have been obvious to a person of ordinary skill in the art in view of the teachings of Sperle and Madison. *Id.* For the reasons explained above in connection with the “location designator” limitation of claim 1—the analysis of which Petitioner relies on for this similar limitation in claim 11—Petitioner does

not establish that the subject matter of claim 11 would have been obvious over the combination of Sperle and Madison.

f. Dependent claims 12–16

Claims 12–16 depend from claim 11. Petitioner relies on its analysis of the limitations recited in claim 11 when addressing dependent claims 12–16. Pet. 70–73. Therefore, for the reasons explained above in connection with claim 1 and 11, Petitioner does not persuasively show that the subject matter of any of claims 12–16 would have been obvious over the combination of Sperle and Madison.

E. Asserted Obviousness over Sperle, Madison, and Kimball

Petitioner also asserts that claims 7 and 8 of the '113 patent are unpatentable as obvious over the combination of Sperle, Madison, and Kimball. Pet. 3, 73–76. Claims 7 and 8 depend directly or indirectly from claim 5. Claim 7 recites that the content delivery method of claim 5 further comprises “receiving at the licensing/reporting server a rating of e-learning content provided from a user.” Claim 8 depends from claim 7 and adds the step of “storing the rating information at a network-side catalog operably coupled with the licensing/reporting server.”

Petitioner relies on Kimball for its teaching of a rating system. *Id.* at 73–76. Petitioner relies on its analysis of claim 5 for the limitations of that claim that are incorporated into claims 7 and 8. *Id.* at 75–76.

For the reasons explained above in connection with claim 5, Petitioner does not persuasively show that the subject matter of claims 7 or 8 would have been obvious over the combination of Sperle, Madison, and Kimball.

F. Patent Owner's Contingent Motion to Amend

Patent Owner filed a contingent motion to amend, asserting that “should any of claims 1, 5, and 11 survive the inter partes review, Patent Owner requests that this contingent motion to amend be considered moot and no substitute claims entered.” MTA 1. Because we determine that Petitioner has not established that any of independent claims 1, 5, and 11—indeed, any of the challenged claims 1–16—are unpatentable, Patent Owner's motion to amend is moot.

III. CONCLUSION

For the reasons explained above, Petitioner does not show that claims 1–16 are unpatentable as obvious over Sperle and Madison or that claims 7 and 8 are unpatentable as obvious over Sperle, Madison, and Kimball.

The table below summarizes our conclusions as to the challenged claims.

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1–16	103	Sperle, Madison		1–16
7, 8	103	Sperle, Madison, Kimball		7, 8
Overall Outcome				1–16

IV. ORDER

Accordingly, it is

ORDERED that, based on a preponderance of the evidence, claims 1–16 of U.S. Patent No. 8,784,113 B2 have not been shown to be unpatentable; and

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

IPR2022-01439
Patent 8,784,113 B2

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