

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SAFECAST LIMITED LLC,
Patent Owner.

IPR2023-00652
Patent 9,392,302 B2

Record of Oral Hearing
Held: July 18, 2024

Before THU A. DANG, KARL D. EASTHOM, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Thursday, July 18, 2024, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

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JUDGE EASTHOM: All right. This is Judge Easthom. Judge Dang and Judge Ogden are also on this remote appeal hearing for *Google, LLC, v. SafeCast Limited, LLC*, IPR2023-00652, U.S. Patent No. 9,392,302 B2, which we will refer to as the '302 patent.

We appreciate the parties' willingness to be here by video. If you have a problem hearing anything or the line stops, please contact the Board personnel that helped you set this up. When you are not speaking, please mute yourself. Please introduce yourself when you begin speaking, and pause before speaking after we ask a question, so the Court Reporter creates a good record.

Each party will have a total of thirty minutes to present arguments at this hearing. Petitioner will start. Patent Owner will respond, and then Petitioner may follow with rebuttal if it reserves time for it. And finally, Patent Owner may run with its own rebuttal if it reserves time for it.

With that, may we please have appearances by Petitioner, Google?

MS. LIANG: Yes. Good afternoon, Your Honors. I'm Amy Liang, arguing for Petitioner Google LLC. And with me are Tim Fink and Ben Haber, as well as Elizabeth Wyle and Michael Lavine of Google.

JUDGE EASTHOM: Welcome, everyone. Okay. Welcome, Ms. Liang.

How about -- who do we have for SafeCast?

MR. HENRY: Hello, Your Honor. I'm Jacob Henry for SafeCast.

JUDGE EASTHOM: Did you say, Henry? Okay. Welcome, Mr. Henry.

1 MR. HENRY: I apologize. Jacob Henry.

2 JUDGE EASTHOM: No, I misheard you. It sounded a little bit like
3 Ramey to me, so I wasn't sure. But I see it. Thank you. And I don't need
4 you to apologize. Welcome.

5 Okay. Petitioner, why don't we get started, Ms. Liang?

6 MS. LIANG: Sure. And I'd like to share my screen to present our
7 demonstratives, if I can.

8 JUDGE EASTHOM: You sure may. And you don't have to. We
9 have them all, but it's up to you. And also, would you like to reserve time
10 for rebuttal?

11 MS. LIANG: Yes. I would like to reserve half of my time for
12 rebuttal.

13 JUDGE EASTHOM: Okay. I'll try to remind you when that time
14 approaches.

15 MS. LIANG: Appreciate it.

16 MR. HENRY: If I may, this is counsel for Patent Owner. We've
17 waived argument. So, that may adjust your -- you may want to adjust your
18 strategy with regard to rebuttal. I don't think you're going to need one.

19 JUDGE EASTHOM: Oh, okay. Thank you, Mr. Henry. You won't
20 be presenting any argument?

21 MR. HENRY: I will not.

22 JUDGE EASTHOM: Okay.

23 MR. HENRY: Also a fan of not hiding the ball.

24 MS. LIANG: Okay.

25 JUDGE EASTHOM: Okay. I appreciate that. Thank you.

1 MS. LIANG: Understood. In that case, I will use my time
2 accordingly for our opening presentation. And if Your Honors have
3 questions, I'm more than happy to answer that in my time.

4 All right. So, to start, we requested this short hearing today to give
5 the Board an opportunity to ask any questions about the papers that the
6 parties have submitted, including the petition as well as the Patent Owner's
7 Sur-reply, which Petitioner didn't have a chance to respond to in writing.

8 As shown here, the petition presented two grounds for unpatentability.
9 Ground 1 is the combination of Plotnick with Parekh. And Ground 2 applies
10 the Patent Owner's infringement claim construction and shows that Plotnick
11 alone renders that claim construction -- or claim interpretation obvious for
12 all of the challenged claims.

13 Here's a roadmap of what I'll be presenting today. I'll start with an
14 overview of the '302 patent, as well as the prior art, and then I'll move into
15 Ground 1, specifically the two disputed claim elements: the first field related
16 to a local broadcasting time regulation, and then the second disputed claim
17 element, the second field related to the number of time for the ads previously
18 shown. And then I'll briefly touch on Ground 2 for which, as I state here,
19 there are no material disputes.

20 Here we see exemplary Claim 1, with the disputed claim elements
21 highlighted. The first field related to local broadcasting time regulation, and
22 the second field that shows the -- that's related to the number of times the
23 advertisement was previously shown.

24 Starting with our base prior art reference for Ground 1 and the only
25 prior art reference in Ground 2, this is one paragraph of Plotnick. So, this
26 just provides an overview of Plotnick in a single paragraph.

1 Essentially, Plotnick teaches a PDR that has the content recorded, the
2 advertisements recorded, control data that is associated with each ad. So, it's
3 ad metadata that helps control when the ads are played, and to whom they're
4 played, and has other types of delivery instructions related to the
5 advertisement.

6 Plotnick does not explicitly teach that the time of day considerations
7 should be related to local broadcasting regulations. And so, --

8 JUDGE EASTHOM: Ms. Liang, can I interrupt you for a second?
9 Now, I see the control data includes description of the ad content, target
10 audience, delivery instructions. And then, what about time of day? Where's
11 your best teaching for that, the control data?

12 MS. LIANG: Yes.

13 JUDGE EASTHOM: I read -- I think you have another slide directed
14 toward these ad cues. And is that your argument that it says these ad cues
15 can be different -- or they will vary based on the time of day. And so, you're
16 sort of inferring that the control data is part of the data that controls the ad
17 cue?

18 MS. LIANG: Yes. There are two different aspects of Plotnick that
19 we rely on.

20 First, here in the control data, it talks about descriptions of the ad
21 content and the target audience, delivery instructions, which we understand
22 to include the time of day instructions.

23 So, not only is the time of day instructions relevant to when the
24 advertisement is played, but for purposes of the regulation, the descriptions
25 of the ad content and the target audience are also relevant.

26 JUDGE EASTHOM: Okay. Okay. I see.

1 MS. LIANG: Yes. And the time of day is not explicitly mentioned
2 here, but it is at Plotnick, which is Exhibit 1005, paragraphs 154 and 194.
3 And it's also found in the application that was incorporated by reference in
4 Plotnick. That's Exhibit 1006 at paragraph 51, which describes that, because
5 Plotnick is recording the content, the appropriateness of the ad schedule can
6 change depending on when the content is being played back. So, it can
7 change depending on time of day. And so, when those circumstances
8 change, the advertisement should be changed as well.

9 JUDGE EASTHOM: Okay.

10 MS. LIANG: All right. So, here, we see that Parekh teaches that
11 when you're considering criteria for when to select an ad or when to include
12 it, that should include consideration of FCC regulations, including the FCC
13 safe harbor regulation that was cited in the prosecution of the '302 patent.

14 Here, we show Ground 1 and highlight the disputed claim elements in
15 red. But, as you'll see, most of the claim elements of Claim 1 are not
16 disputed. So, out of all the claim elements, only two, the first field and the
17 second field, are in dispute.

18 Diving into the parties' dispute about the first field claim element.
19 There are five issues that underlie this dispute. The first is that Patent
20 Owner is applying an incorrect claim interpretation that's too narrow and
21 does not match with the claim say. So, here we see a paper nine, page ten,
22 and paper eleven -- paper eleven, page eighteen. The Patent Owner's
23 primary argument is that the first field must include the broadcasting time
24 regulation itself, but that's not what the claims say.

25 On the top left, we show the claim element 1(c)(1), and it says that the
26 first field is related to a local broadcasting time regulation. So, the patent

1 itself also describes field -- metadata fields that are related to a local
2 broadcasting time regulation, rather than including the regulation itself.

3 For instance, Exhibit 1001, Column 6, lines four through 12, it
4 describes two different examples where the content of the ad, for instance,
5 whether it -- it advertises alcoholic drinks, is used to determine when it's
6 played. In another example, it uses keywords, including the word politician,
7 to determine when that type of advertisement can be played. And in the '302
8 patent at Column 4, line 23, which is part of Table 1, it shows that one of the
9 fields in the advertisement header is warnings. And in the warnings field, it
10 contains key words to help the system determine whether to apply viewing
11 regulations.

12 And the Patent Owner admits in its Sur-reply at page 15 that content,
13 what is in the content is used to apply FCC time regulations. So, essentially,
14 they admit that content descriptors are related to broadcasting time
15 regulations.

16 Now, if we apply the correct claim interpretation of the first field,
17 there's no dispute that Plotnick and Parekh do teach that claim interpretation.
18 So, Plotnick here, paragraphs 154 and 194, describe control data, which is
19 metadata associated with each advertisement. And as we discussed before, it
20 describes the ad content. It describes who should be viewing the ad, so the
21 target audience. And then delivery instructions, which include for instance,
22 what time of day the advertisement should be shown.

23 JUDGE EASTHOM: What about your friend's specific argument
24 back -- can you go back to the slide --

25 MS. LIANG: Sure.

1 JUDGE EASTHOM: The previous, please. The what time of day it
2 is there. They seem to be arguing that that would be more -- I'm not sure if
3 it's controlled by something else, like the rules or. But if anything's in the
4 metadata, it would be the term profanity, which I -- I assume from the
5 previous argument that would be okay. That would satisfy the claim.

6 But, so, maybe I'm answering my own question. Is that what you're --
7 how do we know that the what time of day it is on the right is actually part
8 of the metadata, other than what you say? I guess you're inferring that from
9 delivery instructions? Maybe from the left? I don't know.

10 MS. LIANG: Yes. I think that the local broadcasting time regulation
11 can be applied in two different ways. The first is there is, a separate, kind of
12 like a rules application module. We'll go over later. That actually applies
13 the rules based on the metadata that's associated with each advertisement.

14 So, you know, if the rule says, for instance, don't show an
15 advertisement with profanity before 8:00 p.m., then the metadata that says
16 this ad contains profanity would be the first field related to the local
17 broadcasting time regulation.

18 On the other hand, if that is already included and embedded in the
19 delivery instructions, which, yes, our position is that the delivery instructions
20 include the time of day that the advertisement should be shown.

21 But, if that's already baked into the delivery instructions, and it says,
22 don't show this advertisement before 8:00 p.m., then that explicitly teaches
23 the time of day within the delivery instructions already.

24 JUDGE EASTHOM: The delivery instructions -- you mean the
25 metadata? Or --

26 MS. LIANG: That's right.

1 JUDGE EASTHOM: Okay. Thank you.

2 MS. LIANG: So, here, we show the combination of Plotnick and
3 Parekh, where Parekh teaches that the relative appropriateness of the ad can
4 change, depending on circumstances, including the time of day. And then --
5 and that's at Exhibit 1006, paragraph 51. And Parekh on the right side, at
6 Exhibit 1007, Column 11, lines 26 through 36, specifically says that the time
7 of day considerations should include, for instance, the FCC safe harbor
8 regulation.

9 And again, the Patent Owner's Sur-reply admits that Parekh teaches
10 that the content of the advertisement is used to apply the FCC safe harbor
11 regulations. And that's the Sur-reply at pages 14 through 15.

12 The Patent Owner's next argument attacks motivation to combine
13 Plotnick and Parekh. But they only raise attorney arguments, starting by
14 arguing that Parekh only teaches FCC regulations, but not a PVR, whereas
15 Plotnick teaches a PVR that chooses ads based on what time of day it is, but
16 it doesn't mention a local broadcasting regulation.

17 But that was the purpose of the combination of Plotnick and Parekh.
18 That Plotnick's teaching of determining what time of day it is doesn't
19 expressly mention a local broadcasting regulation, which is why a person of
20 ordinary skill in the art would have looked to the Parekh teaching.

21 JUDGE EASTHOM: What about your friend's argument that the --
22 in Plotnick, that's the salesforce that lays down the local broadcasting
23 regulation?

24 MS. LIANG: Yes. So, in Plotnick, if it is the sales force that is
25 applying it and putting it in, I think it's called the delivering instructions
26 metadata, I think that would beat the claims as well, because the regulation

1 is then being again, baked in to the time of day delivery instructions, are in
2 the metadata.

3 JUDGE EASTHOM: So it doesn't really matter who actually applies
4 it. It's just as long as there is a broadcast -- a regulation by a broadcast
5 authority. Is that what you're saying?

6 MS. LIANG: That's right. As long as there's a local broadcasting
7 time regulation that is considered by the playback system, when it's deciding
8 to pick the ad for that time of day. At -- whether it's the sales force entering
9 those restrictions into the metadata, or the advertising system carrying the
10 rules and applying it on the fly, I think either of those would work, because
11 all the claims say is that the local broadcasting time regulation must be
12 applied. It doesn't specify who is entering the regulations.

13 Regarding the motivation to combine dispute, Petitioner's expert
14 submitted un rebutted testimony about motivation to combine. And then,
15 here are just some examples at Exhibit 1002, paragraph 129, Exhibit 1040,
16 paragraph 227, and Exhibit 1014, paragraph 228. And specifically, at
17 paragraph 228, the expert says that, in order to find a standard of accepted
18 rules for what time of day an advertisement should be played, a person
19 skilled in the art would have looked to the broadcasting regulations like FCC
20 regulation for indecent and profane content, because those would represent
21 the type of media rules that were broadly accepted and broadly applied to
22 television content at that time.

23 Patent Owner raises two additional arguments about Parekh, an
24 argument about regulators, which is a new argument that they raised in their
25 Sur-reply, and then another argument about airability, which I'll address
26 next.

1 Starting with the regulators argument, the Patent Owner argues that in
2 Parekh, the regulators, this time, rather than the sales force, so they say that
3 in Parekh, it's the regulators who are creating and applying the regulation.
4 But, Parekh is clear that the Parekh system itself uses a rules engine to apply
5 the regulation, that while the regulation might come from the regulator, it's
6 still a rule engine within Parekh that's actually applying those rules.

7 And turning to the disputes about airability in Parekh. Patent Owner
8 raises two different arguments about the airability disclosure in Parekh.
9 First, in the Patent Owner response, paper nine at twelve, they start by
10 arguing that, because Parekh will filter out certain content that can't be
11 played at all, that it teaches away from this later step of applying a local
12 broadcast and time regulation based on time of day.

13 Then in its Sur-reply, the Patent Owner shifts to a separate argument.
14 A different argument saying that because the Parekh metadata includes
15 information about whether the content is profane, that the metadata wouldn't
16 include the local broadcasting time regulation itself, which is just a call back
17 to the overly narrow and incorrect claims construction that they applied in
18 the first instance.

19 Regarding the first argument that Parekh's airability teaching teaches
20 away from application of the FCC regulation, that airability teaching is just
21 an irrelevant precursor step. But, it's irrelevant in the sense that it doesn't
22 alter the teaching of Parekh that we are relying on. So, at Parekh Exhibit
23 1007, Column 10, lines 59 through Column 11, line 13, it describes that
24 before the content is even included in the media database, it's analyzed for
25 airability to determine if it can be played on air at all, regardless of time of
26 day.

1 After that airability, you know, filtering process, once it gets into the
2 media database, then Parekh will apply business rules based on time of day.

3 JUDGE EASTHOM: Can you go back a slide, please, Ms. Liang?

4 MS. LIANG: Sure.

5 JUDGE EASTHOM: I wasn't sure I understood your argument,
6 because I thought here and your friends argument was that if it's illegal, it's
7 going to fail. If it's illegal -- or profane -- I guess illegal doesn't matter. But
8 if it's profane, it's going to fail with the review. Right? It's not going to even
9 go into the -- this seems to contradict the later one, the later sentence about
10 the rules, but -- the later passage. Correct?

11 But, here, it seems to say, if it's profane, it's rejected. And you don't
12 even -- you don't -- so you don't put it into the Safe Harbor category with the
13 metadata.

14 MS. LIANG: So, here, I think it's teaching that if there are -- if
15 there's an illegal recording or a level of profanity, that it can't be played at
16 all, that it would be filtered out. But I don't think, you know, Parekh does go
17 on to teach that the safe harbor regulation is applied in a later set. And so, I
18 think the -- both the combination of those two teachings teaches that --

19 JUDGE EASTHOM: So, the quick -- I guess, the quick answer is,
20 you're saying this is just -- you already said it. This is referring to a high -- a
21 super high level of profanity.

22 MS. LIANG: That's right. That's right. This is a level where it
23 couldn't be played on air regardless of time of day. And I think the Patent
24 Owner admits that, too, here, in paper 11, at page 15. They go on to admit
25 that the metadata of Parekh's advertisement includes content about the --
26 whether the advertisement includes profanity material. So, that means that

1 that advertisement passed review, but there's kind of a flag, or some
2 metadata in there that says this has some profanity. So, you know, at the
3 later step, this might not be played at certain times of day.

4 JUDGE EASTHOM: Okay. Sure. I think you have about seven
5 minutes left on your time.

6 MS. LIANG: Okay, thank you. If there are no other questions about
7 the first field, I'll quickly move on to the second field.

8 For the second field, the Patent Owner simply argues that Plotnick does not
9 teach the second field, that it doesn't have a metadata field that includes the
10 number of times the advertisement was shown.

11 But Plotnick, at paragraphs 163 and 170 says that after presenting an
12 ad to the viewer, the system updates the ad metadata and transmits an
13 insertion report. And that insertion report is used to build the advertiser,
14 and can tell the advertiser what was played.

15 And the Petitioner's expert at Exhibit 1002, paragraph 130 further
16 explains that a person of skill in the art reading these disclosures of Plotnick
17 would have understood that the insertion report includes a metric that
18 includes the number of times that the advertisement was shown, because
19 that's how the advertiser would be billed.

20 Finally, I'll go over Ground 2. As I described before, Ground 2
21 applies the Patent Owner's infringement claim consider -- claim construction
22 from the District Court case. And the Petitioner showed that Plotnick alone
23 renders that claim interpretation obvious. The Patent Owner doesn't dispute
24 that.

1 Instead, the Patent Owner only does -- only argues that its
2 infringement claim construction from the district court case was a false
3 claim construction.

4 JUDGE EASTHOM: Well, if I -- I looked at Exhibit 1022, the claim
5 construction, briefly today, and it said in there that Patent Owner needed
6 more information for some of the steps, like 1(f), and I think the one right
7 before that.

8 MS. LIANG: Yes.

9 JUDGE EASTHOM: So, I'm going to switch -- does that mean that
10 maybe that claim construction is a little loose, and we can't really use it? Or
11 how do we use that?

12 MS. LIANG: We -- those were the Patent Owner's preliminary
13 infringement contentions before the parties got deep into discovery.
14 However, whether it needs more evidence -- whether it needed more
15 evidence in the district court case for Google to make its infringement
16 argument is not the same as how it was applying the -- how it was
17 interpreting the claims for purposes of infringement.

18 So, the exhibit shows that there infringement read was quite broad.
19 We do not agree with that infringement read. But if the Board decides that
20 that infringement read is correct, then we think that Plotnick renders that
21 interpretation obvious.

22 JUDGE EASTHOM: Okay.

23 So, and then, just another quick question. It seems to be that you're
24 equating metadata in -- with header, header data and header fields. And the
25 way I read your briefing is, is that well, it has different metadata that are in
26 different fields.

1 And then how do you get to it being a header. Are you using
2 obviousness? I noticed your expert cited to a few patents, and I think you
3 did it in your petition. So, that discuss header as being structures for media.
4 What's your take on that? Are they the same? Or are they just obvious
5 variants? Or what --

6 MS. LIANG: I think that our expert testified that it would have been -
7 - a person of skill in the art, seeing the control data disclosure, would have
8 understood that the metadata are being kept in different fields, so that they're
9 not, you know, all scrambled together. And so, it's, it's inherent in the
10 disclosure of the control data of Plotnick.

11 JUDGE EASTHOM: But, how does that get you a header? Why do
12 you use -- if they're in different fields, why do you -- why is that a header?

13 MS. LIANG: Oh. I see. I see.

14 JUDGE EASTHOM: Or, in a header, I should say. Sorry I wasn't
15 that clear about my question, probably.

16 MS. LIANG: Yes. Because the metadata is associated with each
17 advertisement, and I think it was in Plotnick, that the metadata kind of
18 travels with the advertisement content itself. As our expert cited to
19 contemporaneous references, that type of metadata with typically or would
20 have been obvious to a person with skill in the art to include as a header,
21 because header is metadata. It's carried with content to help control or
22 provide extra information about what to do with the content.

23 JUDGE EASTHOM: Okay. And you have two more minutes. I
24 don't know if you were finished. I interrupted your -- well, I hope I didn't. I
25 mean --

1 MS. LIANG: No. Unless there any other questions, I will conclude
2 my arguments here.

3 JUDGE EASTHOM: One second. Let me just make sure our -- I'm
4 having trouble seeing the rest of the panel.

5 (Pause.)

6 JUDGE EASTHOM: Okay. I want to thank you both for appearing
7 here at the video hearing.

8 With that, this hearing is adjourned. We would ask that you please
9 stay on the line in case the Court Reporter has any questions for you. Thank
10 you.

11 MS. LIANG: Sure. Thank you very much.

12 JUDGE EASTHOM: We're adjourned.

13 (Whereupon, the proceedings at 1:33 p.m. were concluded.)

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