UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

Patent No. 11,564,015
Filing Date: April 6, 2022
Issue Date: January 24, 2023
Title: TARGETED TELEVISION ADVERTISEMENTS BASED ON ONLINE BEHAVIOR

Inter Partes Review No.: IPR2024-00420

PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS

Pursuant to the Nov. 2019 update to the America Invents Act (AIA) Trial Practice Guide, Petitioner submits this notice of its ranking of petitions for *inter partes* review of U.S. Patent No. 11,564,015 (the "'015 Patent") filed in IPR2024-00419 and IPR2024-00420. *See* "CONSOLIDATED TRIAL PRACTICE GUIDE UPDATE (November 2019)" at 59-60.

Petitioner filed two petitions. Petition 1 (IPR2024-00419) asserts grounds combining various secondary references with the Baig reference. Petition 2 (IPR2024-00420) uses Madhavan as its primary reference.

Ordering of Petitions. Although Petitioner believes that its petitions are all meritorious and justified, given the positions Patent Owner may take at this stage, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Grounds
A	IPR2024-00419 (Petition 1)	Baig-Banga690-Banga507-McFarland; Baig-Zwicky-Damick; Baig-Satapati-Damick
B	IPR2024-00420 (Petition 2)	Madhavan-Park-Martinez; Madhavan-Park-Martinez-Kato; Madhavan-Park-Martinez-Brookes; Madhavan-Park-Martinez-Kato-Brookes; Madhavan-Park-Martinez-Koran; Madhavan-Park-Martinez-Kato-Koran; Madhavan-Park-Martinez-Sitaraman; Madhavan-Park-Martinez-Brookes-Sitaraman; Madhavan-Park-Martinez-Koran-Sitaraman

Material differences between the petitions are discussed below.

(1) ***Use of Prior Art from Prior Related Proceedings***: Petition 1 relies on a primary reference (Baig) and secondary references (Zwicky and Satapati) that were

used in *Meta Platforms, Inc. v. AlmondNet Inc. et al.*, Case No. IPR2022-00773, an instituted IPR filed against an ancestor of the ’015 Patent: U.S. Patent No. 8,677,398 (the “’398 Patent”). There, Baig was used as a primary reference in combination with Zwicky and Satapati, which Petition 1 uses in its second primary ground. Petition 1’s first primary ground uses a secondary reference (Banga690) that was asserted as an anticipatory reference in *Yahoo! Inc. v. Intent IQ, Inc.*, Case No. IPR2017-01299, another IPR filed against the ’398 Patent. Petition 1 relies on Banga690 in combination with Baig to form a combination never before considered.

Petition 2 relies on a primary reference (Madhavan) and a secondary reference (Martinez) that were used in IPRs of various ancestors of the ’015 Patent, for instance *Microsoft Corp. et al. v. Intent IQ, LLC*, Case No. IPR2022-1420, an IPR filed against the ’398 Patent. In that IPR, Madhavan and Martinez were asserted individually, and in combination, to disclose first and second devices connected to a common LAN. Petition 2, however, relies on a new reference (Park) in combination with Madhavan and Martinez, to present a new combination never before considered. Madhavan also was used in *Roku, Inc. v. AlmondNet, Inc. et al.*, Case No. IPR2022-01236, an IPR filed against the ’398 Patent, in *Roku, Inc. v. Intent IQ, LLC*, Case No. IPR2022-01315, an IPR filed against U.S. Patent No. 10,715,878 (the “’878 Patent”), and in *Roku, Inc. v. AlmondNet, Inc. et al.*, Case No. IPR2022-00953, an IPR filed against U.S. Patent No. 8,566,164 (the

"'164 Patent"). Those non-instituted IPRs relied on Madhavan in combination with secondary references (Baum, Whitehead) that are not part of the grounds in Petition 2, and did not rely on the secondary references (Park, Kato, Martinez, Brookes, Koran, Sitaraman) applied in Petition 2. Petition 1 and Petition 2, therefore, include new arguments and combinations that have not been presented in the previous IPRs.

(2) *Different Prior Art Date of References*: Each of the primary references (Baig, Madhavan) qualify as prior art under 35 U.S.C. § 102(e). Patent Owner, therefore, could attempt to antedate these references. In particular, Baig predates the '015 Patent's earliest possible priority date by virtue of Baig's priority to a provisional application. Thus, Patent Owner may challenge Baig's priority under *Dynamic Drinkware*, whereas no such challenge is applicable to Madhavan, which has an earlier priority date (October 2006) than that of Baig (November 2006). Depending on Patent Owner's attempt to antedate or disqualify these references, their respective priority dates could be material, justifying multiple petitions

(3) *Different Approaches to the Claim Limitations*: The prior art used in the petitions teach the claims in different ways. For instance, the combinations in Petition 1 involve individuals using different devices to access a common access point, whereas the combinations in Petition 2 involve a single user accessing a home network using different devices. Accordingly, Petition 1 and Petition 2 challenge the claims in different ways to address any attempt by Patent Owner to (improperly)

assert narrow claim constructions for the claimed "user profile," "first device" and "second device," and "cross-device action." Petition 1, for example, shows that a profile with information related to multiple users discloses the claimed "user profile." Petition 2, on the other hand, accounts for the possibility that Patent Owner may attempt to construe "user profile" narrowly as requiring profile information for a single individual. Petition 1 also shows that devices respectively associated with different users disclose the claimed "first device" and "second device." Petition 2, however, accounts for the possibility that Petitioner may argue the recited "first device" and "second device" must be associated with the same individual.

Additionally, Petition 1 relies on Baig in combination with one or more secondary references (e.g., Banga507) to teach the claimed database, and also relies on a POSA's understanding (in the Baig-Zwicky/Satapati-Damick combinations) that it would have been obvious for Baig's server to create the recited database and stores device identifiers therein. By contrast, Petition 2 shows that the primary reference Madhavan clearly discloses creating an "electronic database" containing a multitude of the claimed "associations" without reliance on any secondary reference.

Moreover, Baig-Banga690-Banga507-McFarland and Baig-Zwicky/Satapati-Damick (Petition 1) and Madhavan-Park-Martinez (Petition 2) have different disclosures, or levels of disclosure, regarding the associations that are determined based on devices accessing the Internet via a common IP address at times satisfying

the claimed "predetermined time-relation criterion." The plain and ordinary meaning of the claimed criterion is broad and includes any predetermined time-based metric. Petition 1 relies on the plain and ordinary meaning of this broadly claimed criterion. Petition 2, however, accounts for the possibility that Patent Owner may attempt to argue that this term requires the criterion to be associated with the timing of IP address reassignments by relying on Madhavan-Park-Martinez and Madhavan-Park-Martinez-Sitaraman that more explicitly provide this teaching. The combinations in Petition 2, therefore, are strong against such an overly narrow reading that, in fact, was argued by Patent Owner for similar claims in a prior IPR filed against the '878 Patent. *See Meta Platforms, Inc. v. AlmondNet Inc. et al.*, Case No. IPR2023-01281, Paper 6, 7-16 (November 24, 2023). In contrast to Petition 2, Petition 1 does not rely on IP address reassignments.

In sum, depending on Patent Owner's arguments regarding the claim limitations, potential constructions of certain claim terms, and the disclosures in the relied-upon references and combinations, the use of different references in Petition 1 and Petition 2 could be material.

Conclusion. In view of the material differences discussed above, the Board should consider both petitions and not exercise its discretion to deny institution of either of the two IPRs.

Dated: March 1, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS to be served via FedEx Priority Overnight on March 1, 2024, on the following:

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