

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

INTENT IQ, LLC,
Patent Owner.

IPR2024-00420
Patent 11,564,015 B2

Before THOMAS L. GIANNETTI, LYNNE H. BROWNE, and
STACEY G. WHITE, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

FreeWheel Media, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review (“IPR”) of claims 1–26 of U.S. Patent No. 11,564,015 B2 (Ex. 1001, “’015 patent”). Paper 2 (“Pet.”). The ’015 patent is also the subject of a second petition for *inter partes* review filed by Petitioner on the same day as this request. Pet. viii; see IPR2024-00419.

Patent Owner Intent IQ filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Patent Owner’s Preliminary Response does not address the merits of Petitioner’s challenge to patentability. Instead, Patent Owner contends that the Board should exercise its discretion to deny one of the two parallel petitions Petitioner has filed challenging the same claims of the ’015 patent. See Prelim. Resp. 1, 5–8. Alternatively, Patent Owner contends the Board should deny institution because the Petition “violates” the particularity requirement of 35 U.S.C. § 312(a)(3) “by setting forth *fifteen* express grounds of invalidity based on *nine* prior art references.” *Id.* at 1–2, 9–13.

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. For the reasons provided below, we are persuaded, based on the record before us, to exercise our discretion to deny institution in this proceeding based on the filing by Petitioner of a parallel petition in IPR2024-00419.

B. Related Matters

The parties indicate the ’015 patent is or was the subject of the following district court proceedings: *AlmondNet, Inc. v. Freewheel Media, Inc.*, 1:23-cv-00220-MN (D. Del.); *AlmondNet, Inc. and Intent IQ, LLC v.*

Viant Technology Inc. et al., 1:23-cv-00174 (D. Del.). Pet. vii; Paper 6, 1. As noted previously, the '015 patent is also the subject of a second petition for *inter partes* review in IPR2024-00419, filed by Petitioner on the same day as this request. Pet. viii. In addition to the two separate petitions challenging the '015 patent, Petitioner has filed ten other petitions for *inter partes* review of patents related to the '015 patent.¹

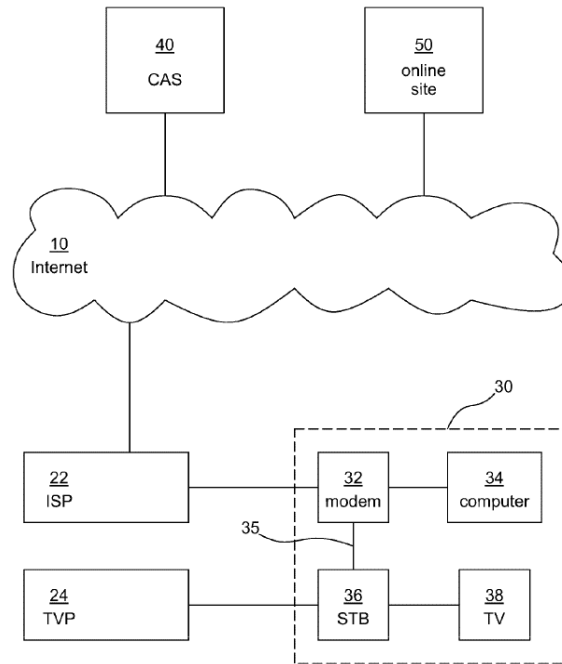
The parties disclose also that patents related to the '015 patent have been involved in numerous district court litigations and proceeding before the PTO. *See* Pet. ix–xiii; Paper 6, 1.

C. The '015 Patent (Ex. 1101)

The '015 patent discloses a method for delivering targeted television advertisements based on online behavior. *See* Ex. 1101, Abstract. The patent describes using existing devices and technologies such as a set-top box (STB) (“a device that connects a television and a signal source”), a central ad server (CAS) (“a computer server that manages delivery of online advertisements to visitors of online sites”), and profiles or partial profiles that “can contain any quantity of profile information, such as, in one example, just an online access IP address used by a person at the time his profile was collected and the identity of the profile provider.” *Id.* at 1:49–2:7, 4:61–5:17, 6:3–24.

¹ Those ten additional petitions are the following: IPR2024-00413, IPR2024-00414, IPR2024-00415, IPR2024-00416, IPR2024-00417, IPR2024-00418, IPR2024-00421, IPR2024-00422, IPR2021-00423, and IPR2024-00424.

This is illustrated in Figure 7 of the '015 patent reproduced below:



In this example, Figure 7 depicts CAS 40 and online site 50 connected to Internet 10, modem 32 connected to computer 34, STB 36, and Internet service provider (ISP) 22, and STB 36 connected to TV 38 and television provider (TVP) 24. *See* Ex. 1101, 13:5–13. An identifier can be assigned to STB 36, such as an equipment serial number, a device MAC address, a username, a pseudonym, a tag, or other identifying code or data element, and may include the IP address STB 36 is using when in contact with CAS 40. *See id.* at 15:30–47. Once an STB is confirmed to have been using a certain IP address at a certain date and time (for example, by having a uniquely tagged STB consecutively communicate with the CAS using the same IP address), a CAS database can be searched to find all computers, mobile devices, and other STBs that used the same IP address at the same date and time. *Id.* at 18:59–66. Those will be assumed to be devices that are part of the same household and same LAN. Then, an association or link is created

among the devices by linking the device identifiers or tags with the STB's identifier in the CAS database. *Id.* at 18:67–19:4.

Once the association is created, profile information collected about the computers and mobile devices before and after the association was created can be used to target ads to the STB, regardless of the IP addresses used by the computers and mobile devices (such as cell phones) to access the web at the time the profiles were collected. Ex. 1101, 19:13–19.

D. Illustrative Claim

Claims 1–26 (all claims) are challenged. Claims 1 and 14 are independent. Claim 1 is illustrative and is reproduced below.²

[1A] A computer system comprising at least one hardware server computer, wherein the computer system is programmed and connected to perform a method of using common IP addresses to identify associations among multiple electronic devices and using an identified association to cause cross-device action, the method comprising:

[1B] (a) with the computer system, creating an electronic database containing a multitude of associations, each indicating an association between device identifiers of two or more Internet-accessing electronic devices of a multitude of Internet-accessing electronic devices, wherein:

[1C] (i) each of the associations is determined using stored data relating to Internet access by various of the multitude of devices, the stored data comprising (A) a device identifier of one of the Internet-accessing devices, (B) an IP address through which the one of the devices accessed the Internet, and (C) a timestamp identifying when the one of the devices accessed the Internet;

[1D] (ii) at least some of the associations indicate association between at least two devices of the two or more

² Paragraph labels provided by Petitioner have been added in brackets. See Ex. 1102, Lett Decl. App. C.

Internet-accessing electronic devices, which association is determined by using the stored data to determine that both of the at least two devices have accessed the Internet via a common IP address at respective times satisfying a predetermined time-relation criterion;

[1E] (iii) at least some of the associations indicate association between at least two devices of the two or more Internet-accessing electronic devices, which association is determined without use of personally identifiable information; and

[1F] (iv) the computer system determining the associations accesses the Internet without using any of the common IP addresses of the associations identified in part (ii); and

[1G] (b) when the computer system and a first device identified in a first association are in communication with one another, with the computer system using a device identifier of the first device and user profile information associated with a device identifier of a second device identified in the first association to cause an automatic action to be taken with respect to the first device, wherein:

[1H] (i) the first association is one of the associations identified in part (a)(ii); and

[1I] (ii) the first association was stored in the electronic database described in part (a) prior to the computer system and the first device being in communication with one another as described in part (b).

Ex. 1101, 24:25–25:9.

E. Prior Art and Other Evidence

The Petition relies on the following references (Pet. 3–4):

Name	Reference	Pub. Date	Exhibit No.
Banga507	US2006/0265507 A1	Nov. 23, 2006	1115
Ashbaugh	US 8,930,239 B2	Jan. 6, 2015	1119
Madhavan	US 8,180,674 B2	May 15, 2012	1122
Park	US 2006/0039386 A1	Feb. 23, 2006	1123
Martinez	US 2008/0120178 A1	May 22, 2008	1124
Kato	US 2004/0003292 A1	Jan. 1, 2004	1125
Brookes	US 5,428,778	Jun. 27, 1995	1126
Koran	US 8,438,170 B2	May 7, 2013	1127
Sitaraman	US 6,427,170 B1	Jul. 30, 2022	1160

In addition, Petitioner submits the Declaration of David B. Lett in support of its Petition. Ex. 1102 (“Lett Decl.”).

F. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–26 are unpatentable based on the following grounds (Pet. 4–5):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–10, 13–23, 26	103(a) ³	Madhavan, Park, Martinez
1–10, 13–23, 26	103(a)	Madhavan, Park, Martinez, Kato
1–10, 13–23, 26	103(a)	Madhavan, Park, Martinez, Brookes
1–10, 13–23, 26	103(a)	Madhavan, Park, Martinez, Kato, Brookes
1–10, 12–23, 25, 26	103(a)	Madhavan, Park, Martinez, Koran

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §103 effective March 16, 2013. Because the ’015 patent asserts a filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of §103.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–10, 12–23, 25, 26	103(a)	Madhavan, Park, Martinez, Kato, Koran
11, 24	103(a)	Madhavan, Park, Martinez, Ashbaugh
11, 24	103(a)	Madhavan, Park, Martinez, Kato, Ashbaugh
12, 25	103(a)	Madhavan, Park, Martinez, Banga507
12, 25	103(a)	Madhavan, Park, Martinez, Kato, Banga507
1–10, 13–23, 26	103(a)	Madhavan, Park, Martinez, Sitaraman
1–10, 13–23, 26	103(a)	Madhavan, Park, Martinez, Brookes, Sitaraman
1–10, 12–23, 25, 26	103(a)	Madhavan, Park, Martinez, Koran, Sitaraman
11, 24	103(a)	Madahavan, Park, Martinez, Ashbaugh, Sitaraman
12, 25	103(a)	Madahavan, Park, Martinez, Banga507, Sitaraman

II. DISCRETIONARY DENIAL

Patent Owner contends that institution of trial should be denied because “Petitioner has not and cannot justify the simultaneously filed parallel petitions directed towards the ’015 patent and challenging the same claims—claims 1-26.” Prelim. Resp. 5. For the reasons that follow, we agree and therefore exercise our discretion under 35 U.S.C. § 314 to deny institution.⁴

As discussed *supra*, this is the second of two petitions filed concurrently by Petitioner challenging claims 1–26 of the ’015 patent. Consistent with the Board’s practice for handling parallel petitions,

⁴ We have discretion to deny this parallel petition under 35 U.S.C. § 314(a).

Petitioner filed a Petition Ranking (Paper 3, “Notice”). See Patent Trial and Appeal Board Consolidated Trial Practice Guide 59–60 (November 2019) (“Practice Guide”).⁵ In the Notice, between the two petitions challenging the ’015 patent, Petitioner ranks this Petition second and the petition in IPR2024-00419 first. Notice 1. In our separate decision in IPR2024-00419, entered concurrently with this decision, we institute *inter partes* review of claims 1–26 of the ’015 patent on all grounds stated in the Petition.

In support of its decision to file two separate petitions challenging the same claims, Petitioner makes three arguments. Notice 1–5. First, Petitioner argues that the Petition relies on two references (Madhavan and Martinez) that were not asserted in IPR2024-00419, but which were before the Board in prior *inter partes* reviews of “various ancestors” of the ’015 patent. *Id.* at 2 (citing IPR2022-01420, as an example). Petitioner asserts that this Petition “relies on a new reference (Park) in combination with Madhavan and Martinez, to present a new combination never before considered.” *Id.* Next, Petitioner asserts that because its primary references in this case (Madhavan) and IPR2024-00419 (Baig) qualify as prior art under 35 U.S.C. § 102(e), Patent Owner “could attempt to antedate these references.” *Id.* at 3. Finally, Petitioner asserts that “[t]he prior art used in the petitions teach the claims in different ways.” *Id.* Consequently, the two petitions “address any attempt by Patent Owner to (improperly) assert narrow claim constructions.” *Id.* at 3–4. We do not find these arguments persuasive.

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Our Practice Guide provides guidance on handling situations involving multiple petitions by a single petitioner challenging the same patent claims:

Based on the Board’s experience, *one petition should be sufficient* to challenge the claims of a patent in most situations. . . . In addition, *multiple petitions by a petitioner are not necessary in the vast majority of cases*. To date, a substantial majority of patents have been challenged with a single petition.

Practice Guide 59 (emphasis added). The Practice Guide provides examples of “circumstances in which more than one petition may be necessary.” *Id.* None of these examples are pertinent here. For example, a second petition might be justified “when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.* Petitioner does not argue that the number of claims in the parallel litigation is “large.” And while Petitioner does argue that the prior art relied upon on might be antedated, Patent Owner responds by stipulating “that it will not attempt to antedate or disqualify the voluminous prior art relied upon by Petitioner.” Prelim. Resp. 7 (internal quotation marks omitted).

Petitioner’s remaining arguments are no more persuasive. Responding to Petitioner’s argument that different prior art is involved in the two petitions, Patent Owner points out, “[n]early all parallel petitions involve different proposed prior art.” Prelim. Resp. 6. We agree. Petitioner’s desire to double the available word count is an insufficient justification for a second petition. As our Practice Guide cautions, “[t]wo or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent

owner and could raise fairness, timing, and efficiency concerns.” Practice Guide 59. This is especially concerning here, where the instituted trial in IPR2024-00419 will involve nine references and eleven grounds. Adding an additional fifteen grounds and nine references from this Petition to the mix would create an “unnecessary burden.”

Finally, we do not see merit in Petitioner’s argument that a second petition is necessary because of the “possibility” Patent Owner might assert narrow claim constructions. Notice 3–5. Petitioner’s argument is based on conjecture. In fact, the Petition states that “no express [claim] construction is necessary at this time.” Pet. 7 (citing Lett Decl. ¶ 135).

In sum, in the words of our Practice Guide, Petitioner fails to show “why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” Practice Guide 60.

III. CONCLUSION

For the foregoing reasons, we are not persuaded that the facts presented by Petitioner justify a second petition challenging the same claims of the ’015 patent as the petition in IPR2024-00419. We therefore exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied and *inter partes* review of claims 1–26 of the ’015 patent is not instituted.

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