UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FREEWHEEL MEDIA, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

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Patent No. 7,861,260
Filing Date: April 17, 2007
Issue Date: December 28, 2010
Title: TARGETED TELEVISION ADVERTISEMENTS BASED ON ONLINE BEHAVIOR

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*Inter Partes* Review No.: IPR2024-00421

**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. 7,861,260 ("the '260 Patent") filed in IPR2024-00421, IPR2024-00422, IPR2024-00423, and IPR2024-00424. *See* "CONSOLIDATED TRIAL PRACTICE GUIDE UPDATE (Nov. 2019)" at 59-60.

The '260 Patent has 152 claims. To properly address the extraordinarily large number of claims, Petitioner was required to file two petitions, covering different claims, for each primary reference (Baig and Madhavan). The four petitions listed below should more appropriately be considered two petitions, each consisting of two parts to cover the enormous number of claims. Thus, at a minimum, to address all 152 claims, the Board should institute Petitions 1A along with 1B (IPR2024-00421 and IPR2024-00422, respectively), and/or 2A along with 2B (IPR2024-00423 and IPR2024-00424, respectively).

***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 |
|---|---|---|
| 1A | IPR2024-00421 | Baig-Costa-Zwicky, Baig-Costa-Banga690 |
| 1B | IPR2024-00422 | Baig-Costa-Zwicky, Baig-Costa-Banga690 |
| 2A | IPR2024-00423 | Madhavan-Park, Madhavan-Park-Kato, Madhavan-Park-Martinez, Madhavan-Park-Kato-Martinez |
| 2B | IPR2024-00424 | Madhavan-Park, Madhavan-Park-Kato, |

| | | |
|---|---|---|
| | | Madhavan-Park-Martinez, Madhavan-Park-Kato-Martinez |

Material differences between the petition pairs are discussed below.

**(1)** ***Use of Prior Art from Prior Related Proceedings***: Petitions 1A/1B include two primary grounds. The first relies on a primary reference (Baig) and a secondary reference (Zwicky) that were used in *Meta Platforms, Inc. v. AlmondNet Inc. et al.*, Case No. IPR2022-00773, an instituted IPR filed against a grandchild of the '260 Patent: U.S. Patent No. 8,677,398 (the "'398 Patent"). In that IPR, Baig was similarly used as a primary reference in combination with Zwicky. Petitions 1A/1B's second ground also uses the same primary reference Baig, but in combination with a different 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. Unlike that IPR, Petitions 1A/1B rely on Banga690 in combination with Baig to form a combination never before considered. Petition 1A/1B also use a new reference (Costa) not used in any related IPR.

Petitions 2A/2B rely on a primary reference (Madhavan) and a secondary reference (Martinez) that were used in IPRs of various descendants of the '260 Patent. Madhavan and Martinez, for example, were used in *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. Petitions 2A/2B, however, rely on new references (Park and Kato), never used in any related IPR, in combination with Madhavan and Martinez to present new arguments. 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 Petitions 2A/2B and did not rely on the secondary references (Park, Kato, Martinez) applied in Petitions 2A/2B. Petitions 1A/1B and Petitions 2A/2B, therefore, include new arguments and combinations not presented in any of the previous IPRs.

**(2) *Different Prior Art Dates 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 '260 Patent's earliest possible priority date by virtue of Baig's priority to a provisional application. Baig thus raises potential priority issues (e.g., under *Dynamic Drinkware*) inapplicable to Madhavan. Madhavan's priority date (October 2006) is also earlier 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 Petitions 1A/1B involve individuals using different devices to access a common access point/hotspot, whereas the combinations in Petitions 2A/2B involve a single user accessing a home network using different devices. Accordingly, Petitions 1A/1B and 2A/2B challenge the claims in different ways to address any attempt by Patent Owner to (improperly) narrowly construe the claimed "user" as requiring a single individual, and relatedly argue that the recited "online user interface device" and "set-top box" must both be associated with the same individual.

Further, Baig-Costa-Zwicky/Baig-Costa-Banga690 (Petitions 1A/1B and Madhavan-Park/Madhavan-Park-Kato (Petitions 2A/2B) have different disclosures, or levels of disclosure, regarding the claimed "television advertisement." The plain and ordinary meaning of the claimed "television advertisement" is broad and includes any advertisement to be displayed on a television. But if Patent Owner argues that this term requires advertisements that are displayed as part of television programming, Madhavan more explicitly discloses such advertising. While Baig-Costa-Zwicky/Baig-Costa-Banga690 also render such television advertisements obvious, Baig-Costa-Zwicky/Baig-Costa-Banga690's systems further provide web-

based advertisements that are displayed on a television through a set-top box.

Additionally, primary reference Baig of Petitions 1A/1B clearly discloses electronic association based on a common IP address. In fact, Patent Owner tacitly acknowledged in at least IPR2022-0773 that Baig discloses this concept. IPR2022-0733, Paper 13, 6-11; *see also id.*, Paper 6, 16-18. Petitions 2A/2B rely on Madhavan in combination with one or more secondary references (e.g., Kato) to teach the claimed electronic association. However, Petitioner notes that Patent Owner has argued that Madhavan (combined with different secondary references) did not teach electronic associations of device identifiers "based on recognizing the devices were connected to a common LAN." IPR2022-01420, Paper 9, 7-19.

In sum, depending on Patent Owner's arguments regarding the claim limitations, the disclosures in the relied-upon references, and the asserted combinations, the use of these different references and combinations in Petitions 1A/1B and Petitions 2A/2B could be material.

Accordingly, the Board should consider all four concurrently filed petitions and not exercise its discretion to deny institution of any one in view of the others. At a minimum, one of the split petition pairs (1A/1B or 2A/2B), should be instituted.

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 to the following:

INTENT IQ, LLC
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Dated: March 1, 2024

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