UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,

Petitioner,

v.

INTENT IQ, LLC,

Patent Owner.

IPR2024-00421
Patent 7,861,260 B2

PATENT OWNER'S RESPONSE

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Patent Owner's Exhibit List for IPR2024-00421

Pursuant to 37 C.F.R. § 42.63(e), Patent Owner Intent IQ, LLC hereby submits its exhibit list associated with the above-captioned *inter partes* review of U.S. Patent No. 7,861,260.

Exhibit No.	Description
2001	Declaration of Erik de la Iglesia in support of Patent Owner's Response
2002	*Curriculum vitae* of Erik de la Iglesia
2003	December 19, 2024 deposition transcript of David Lett

I. Introduction

Only two grounds of the Petition, Grounds A and B, challenge the only independent claims (claims 1, 26, 38, and 61). Both challenges fail. Specifically, both Grounds A and B rely on a combination of, *inter alia*, the "Baig" reference with the "Costa" reference.

The Petition's combination entails adding a set-top box ("STB") disclosed in Costa to a public wireless hotspot of a retail location disclosed in Baig (of which the Petition's sole example is a coffee shop). According to the Petition, not only would it be obvious for a multitude of coffee shops to add a STB to display television content, but also that the STBs would be used to display the website provided by Baig's content server to coffee shop patrons even though that website does not provide television or streaming services. Displaying Baig's website's content on the STB is necessary to the Petition's theory, because that is how the ads would allegedly be targeted to the STB in the claimed manner. The Petition, however, provides no plausible motivation to make this modification.

As an initial matter, coffee shops would not have wanted to include televisions because they are distracting, costly, and generally inconsistent with how patrons use coffee shops. And the Petition further fails to show why the STBs that would allegedly be obvious to add to public wireless hotspots of coffee shops would be used to display Baig's website content, because that content doesn't include

streaming or television service, and the Petition proposes no modification to Baig's content server to provide these services. Instead, Baig's website provides services such as file-sharing, online chat, and auction services, and the Petition provides no evidence that anyone would have found it obvious to display a website providing these services on a television at a coffee shop (nor does the Petition even address who would be controlling the STB in allegedly navigating to Baig's website).

Accordingly, all challenged claims should be found not unpatentable.

II. Claim Construction

The Federal Circuit has held that "only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy." *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). This principle applies equally to IPR proceedings. *See, e.g., Apple Inc. v. Uniloc Luxembourg S.A.*, IPR2018-00420, Paper 7 at 8 (PTAB Aug. 6, 2018).

The Petition does not propose an express construction of any terms. *See* Pet. 6. Patent Owner does not contend that any terms in the challenged claims require express construction for purposes of evaluating the Petition's invalidity grounds.

III. The Petition's Grounds A-B fail because the Petition fails to motivate its proposed modification to Baig.

The Petition contends that the "four independent claims—claims 1, 26, 38, and 61…. only differ in trivial ways." Pet. 6. The Petition first analyzes claim 1, and

then largely incorporates its claim 1 analysis into its analysis of the other independent claims; this response follows a similar approach.

As explained below, none of the challenged independent claims are obvious because the Petition fails to motivate its proposed modification to Baig in view of Costa in a manner that would satisfy all claim requirements. *See* Ex. 2001, ¶¶29-55.

A. Independent Claim 1

Claim 1 of the ’260 patent recites:

> 1. A method implemented using a programmed hardware computer system, the method comprising:
> (a) for each of a multitude of users, with the computer system, electronically associating an online access IP address of the user and a set-top box IP address of that user based on a common IP address, wherein network traffic is routed via the common IP address to both an online user interface device and a set-top box of that user; and
> (b) using user profile information derived from online activity from a first online user interface device via a first one of the online access IP addresses of the multitude of users, with the computer system automatically causing a first television advertisement to be directed to a set-top box for presentation via that set-top box, selectively, wherein the set-top box is indicated by the set-top box IP address associated with the first online access IP address.

For both Grounds A-B as applied to claim 1, the Petition proposes combining Baig with Costa such that for a multitude of public hotspots (in the Petition's example of coffee shop hotspots), a set-top box ("STBs") would have been added to the hotspots and used to target ads based on profile information of other users of devices at the same hotspot via Baig's website using Baig's ad-targeting system. *See* Pet. 10-12. In adding STBs to Baig's system, neither the Petition nor the corresponding expert declaration propose any changes to Baig's content server (which provides the VCSP website). *See* Ex. 2003 at 26:10-20 ("Q. If you are modifying Baig in view of Costa, for example, in your ground A modification, what changes are you proposing being made to Baig's content server? A. I don't think I rendered an opinion on any changes that were needed in the content server."); *see also* Ex. 1002, ¶164 ("Adding a well-known device such as a set-top box to Baig[]… would require only minimal changes if any…."); Ex. 2003 at 17:3-10 ("Q. What are you referring to by 'minimal changes if any'? A. So I didn't really, I don't think, go into the details of that in my declaration. You know, I think that I really haven't spent much time thinking about all of the minimal changes, if any.").

The Petition's combination of Baig with Costa depends on two assumptions that would ***both*** need to be true in order for it to be obvious for Baig's computer system to "automatically caus[e] a first television advertisement to be directed to a set-top box" in the claimed manner (e.g., by "using user profile information derived

from online activity from a first online user interface device" that has used an IP address associated with the set-top box's IP address) as required by claim 1.

The **first** assumption is that it would have been obvious to install a set-top box at a public Wi-Fi hotspot (to which Baig directs vicinity-based community services), such as a coffee shop's hotspot, such that it "would have allowed individuals operating other devices (e.g., phones, laptops, etc.) to view multimedia content, such as television content, via a television connected to the set-top box." Ex. 2001, ¶¶30-33. (A coffee shop is the only specific example of a location to which the Petition or the corresponding expert declaration allege it would have been obvious to add a STB.)

The **second** assumption is that that after the STB is configured at the public Wi-Fi hotspot (coffee shop), the STB would be used to visit Baig's VCSP website using the coffee shop's hotspot, which does ***not*** provide television service. *See* Ex. 1002 ¶663 ("A POSA would recognize that the systems of Baig would operate independently of a television service provider, as no details of such as television service provider are described in Baig."); *see also* Ex. 1003 (not discussing television service or streaming service); Ex. 2001 ¶34.

If ***either*** of these assumptions is not true for a multitude of hotspots,[1] then Baig's VCSP content server(s) (i.e., the alleged "computer system"—Pet. 8) would not be able to "automatically caus[e] a first television advertisement to be directed to a set-top box" based on an association of the STB's IP address with another device's IP address at the same public Wi-Fi hotspot as alleged. For example, if it would not have been obvious to include the STB within the Wi-Fi hotspot in the first place, there would be no STB for Baig's content server to direct the ad to. And likewise, if it would not have been obvious to use the STB to navigate to Baig's VCSP website at a public Wi-Fi hotspot in the manner alleged, then Baig would also not be able to direct an ad to the STB, because Baig's content server only displays ads on the VCSP website. Ex. 2001, ¶35. The Petition fails to support ***either*** of these assumptions. Ex. 2001 ¶¶35-48.

Regarding the Petition's first assumption (the purported obviousness of adding a set-top box to a public hotspot), somebody would actually need to make that modification, and whoever that person is would need to be motivated to do so. Ex. 2001 ¶36. However, Petitioner's expert Mr. Lett did not provide any opinion regarding ***who*** would have been responsible for making the proposed modification

[1] These assumptions would have to be true for a "multitude of" hotspots, because the claim requires that the method be performed "for each of a multitude of users," and under the Petition's theory "each of the vicinity-based communities in Baig is a separate 'user.'" Pet. 15.

(i.e., the person who would have been motivated to make the proposed modification). Ex. 2003 at 15:19-16:1 ("Q. So who is responsible to making this modification to Baig's system? Is it the [Baig website] or is it the coffee shop owner in the example that you provided? A. I don't think I provided an opinion on that.") The fact that Petitioner's expert was unable to provide an opinion on ***who*** would have been motivated to make the specific modification he is proposing (providing a set-top box at the public Wi-Fi access point) is evidence that he did not fully consider the obviousness of making this modification, because if the combination would have been obvious he would have had an opinion on who would have implemented it.

Further evidence against Mr. Lett's opinion on the obviousness of adding a set-top box to a public wireless hotspot is Mr. Lett's inability to recall any public wireless hotspots that included a set-top box as of the priority date of the '260 patent. Ex. 2003 at 25:15-18. Patent Owner's expert Mr. de la Iglesia is also not aware of any "indication or evidence of any coffee shops that displayed television content via a set-top box in the manner Mr. Lett suggests before the priority date of the '260 patent." Ex. 2001, ¶37. Of course, that is not dispositive as to the question of obviousness, but if a set-top box truly would have obvious to include at a multitude of coffee shops' wireless hotspots in the relevant timeframe as Petitioner alleges, more than likely there would be some evidence of some coffee shop having actually done it.

Mr. de la Iglesia further explains several reasons why a POSITA would have ***avoided*** adding a STB to a coffee shop's wireless hotspot in the manner the Petition alleges. Ex. 2001, ¶38. For instance, TV is distracting, and people who would prefer to visit a coffee shop to talk with friends or read a book (common coffee shop behaviors) would prefer ***not*** to be distracted with television content. *Id.* In addition, adding a STB to a coffee shop is costly, because it requires purchase and installation of a television / STB, and television service costs additional money beyond that. *Id.* Accordingly, a POSITA would have avoided making the modification suggested by the Petition (which is presumably why there is no evidence of this modification having been done in the relevant timeframe).

The Petition also does not provide any plausible motivation to adding a STB to a public hotspot. *See* Ex. 2001, ¶¶39-44. The Petition first alleges that "Costa teaches public wireless hotspots (similar to Baig's coffee shop) having networked STBs and televisions." Pet. 10. First, even if true, that would not itself a motivation to modify Baig in the proposed manner. Additionally, Costa does ***not*** teach any public wireless hotspots having networked STBs and televisions as the Petition alleges. Instead, as explained by Mr. de la Iglesia, the cited portions of Costa teach that an STB is one type of device that can be connected to a "UPnP network," and Costa further discloses that UPnP networks are typically home or office networks, but can optionally be "public wireless hotspots." Ex. 2001, ¶44. In other words,

Costa at most teaches that a public wireless hotspot ***could*** potentially include a STB, but does not actually disclose a public wireless hotspot including an STB, or any advantages to such a configuration.

The Petition further alleges:

> A POSA would be motivated to include Costa's STB because it beneficially allows customers at a public establishment to watch television or other information on an associated display. Baig shares music, video games, and advertisements at hotspots, and a POSA would have realized a STB would beneficially provide that content for display via a television or other display.

Pet. 12 (internal citation omitted).

However, as explained by Mr. de la Iglesia, displaying television content at a coffee shop would not be seen as desirable by the coffee shop owner, who would want to offset the costs of providing the STB in the first place, and who would recognize that patrons do not go to coffee shops to watch a television screen. Ex. 2001, ¶¶38-39. And if users ***did*** end up watching the TV, that may actually harm the coffee shop because they may stay at their seats / tables longer, thus providing less seating for customers who have just arrived at the coffee shop and who want a place to sit after getting their order. Ex. 2001 ¶40.

The Petition also alleges that adding a STB to the hotspot "represents the mere combination of known elements (Baig's VCSP and Costa's STB) according to known methods (connecting the STB to an AP) to yield predictable results (an STB connected to VCSP hotspot AP 106 along with other devices 102 to participate in VCSP services)." Pet. 11. But *KSR* itself makes clear that a combination which involves "two known [elements] according to their established functions" does not necessarily render that combination obvious, absent "a ***reason*** that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does":

> Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, *it can be important to identify a* ***reason*** *that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does*. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 417–18 (2007) (emphasis added). And as explained by Mr. de la Iglesia, a POSITA would ***not*** have had a reason to add a STB to Baig's coffee shop in the manner the Petition proposes. Ex. 2001, ¶¶42-43.

Regarding the Petition's second assumption, the Petition also fails to show the obviousness of using the STB to access Baig's website at the Wi-Fi hotspot in the manner the Petition proposes. Ex. 2001, ¶¶45-48. Even assuming that a coffee shop ***did*** include a television / STB, there is no reason why the controller of that STB (presumably, the coffee shop itself) would navigate to Baig's VCSP ***website*** which does not provide television service or streaming service. *See* Ex. 1002, ¶663 ("A POSA would recognize that the systems of Baig would operate independently of a television service provider, as no details of such as television service provider are described in Baig."); Ex. 2001, ¶45.

To the extent a POSITA would have seen a benefit to installing a television on a coffee shop's public hotspot, the purpose would presumably be to provide ***television*** service to visitors to the coffee shop. Ex. 2001, ¶45. Having the television set displaying a website such as Baig's would have been a very strange decision that the Petition provides no reasoning would have been obvious (other than the conclusory allegation that the content is "beneficial[]," without any analysis of whether it would have been beneficial ***in the context of an STB at a coffee shop***). *See* Pet. 12.

Moreover, if Baig's services ***were*** displayed over a STB, those services would require that someone be controlling the use of the website to the exclusion of others. Ex. 2001, ¶46. As an example, if coffee shop patron "John" is controlling the set-top

box via a remote control, then "Nancy" (and all other coffee shop patrons) would be unable to control it at that time. This scenario would not have been desirable, particularly in the context of a display at a public hotspot where the use of the website would be visible to those not actually using the website, causing privacy concerns. *Id.*

For example, if one person wanted to search for particular "goods and services" (Ex. 1007 ¶59) on Baig's website via a STB at a coffee shop, other coffee shop patrons viewing the television would be able to see what goods and services the searching person was looking at. Thus, as explained by Mr. de la Iglesia, assuming a STB ***were*** somehow in a coffee shop, it would presumably be used to provide television service (since that is typically the type of content that is displayed on TVs in public locations, not content from a website similar to Baig's VCSP website). Ex. 2001, ¶46. And notably, this would not prevent customers of the coffee shop from accessing Baig's VCSP website, because they could simply use their own devices to access that content if they actually wanted to see it while visiting the coffee shop. *Id.*

Because the Petition does not establish either the obviousness of adding a STB to Baig's coffee shop, or the obviousness of having the STB display showing Baig's VCSP website, claim 1 would not have been obvious under the Petition's theory. Ex. 2001, ¶¶29-49.

B. Independent Claim 61

Claim 61 recites:

> 61. A method implemented using a programmed hardware computer system, the method comprising:
>
> (a) for each of a multitude of users, with the computer system, electronically associating an online user interface device identifier, which indicates an online user interface device of the user, and a set-top box identifier, which indicates a set-top box of that user, which electronic association is based on a common IP address, wherein network traffic is routed via the common IP address to both the online user interface device and the set-top box of that user; and
>
> (b) using user profile information derived from online activity from the online user interface device of a first user of the multitude of users via a first online access IP address, with the computer system automatically causing a first television advertisement to be directed to a set-top box for presentation via that set-top box, selectively, wherein the set-top box is indicated by the set-top box identifier associated with the online user interface device identifier of the first user's online user interface device.

The Petition acknowledges that "claim 61 is largely identical to claim 1," and the Petition relies almost exclusively on its claim 1 analysis in alleging the

obviousness of claim 61. Pet. 28-29. Claim 61 is not obvious for the same reasons discussed above with respect to claim 1. Ex. 2001, ¶¶50-51.

C. Independent Claim 26

Claim 26 recites:

> 26. A method implemented using computer equipment, the method comprising:
>
> (a) with the computer equipment, automatically electronically delivering electronic user profile information to a computer system that includes a server that electronically associates, for each of a multitude of users, an online access IP address of the user and a set-top box IP address of that user based on a common IP address,
>
> (b) wherein network traffic is routed via the common IP address for both an online user interface device and a set-top box of that user,
>
> (c) wherein delivered user profile information of a first user of the multitude of users (i) is derived from online activity of the first user from a first online user interface device via a first online access IP address and (ii) includes identification of the first online access IP address and the time and date of the online activity, and
>
> (d) as a result of which delivery, a first television advertisement can be directed to a set-top box for presentation via that set-top box, selectively, wherein the

> set-top box is indicated by the set-top box IP address that the server associates with the first online access IP address.

The Petition alleges that claim 26 "is largely identical to claim 1," with two additional requirements not present in claim 1. Pet. 29. Claim 26 is not obvious for the same reasons discussed above with respect to claim 1. In particular, without evidence that a POSITA would have found it obvious to include a set-top box in a public hotspot in the manner the Petition alleges, and further obvious to navigate to Baig's VCSP website using the STB, there would be no possibility for "a first television advertisement [to] be directed to a set-top box" as a result of delivered profile information as claim 26 requires. Ex. 2001, ¶¶52-53.

D. Independent Claim 38

Claim 38 recites:

> 38. A method implemented using computer equipment, the method comprising:
>
> (a) with the computer equipment, automatically electronically delivering electronic user profile information to a computer system that includes a server that electronically associates, for each of a multitude of users, an online user interface device identifier, which indicates an online user interface device of the user, and a set top box identifier, which indicates a set-top box of that user, which electronic association is based on a common IP address,

> (b) wherein network traffic is routed via the common IP address for both the online user interface device and the set-top box of that user,
>
> (c) wherein delivered user profile information of a first user of the multitude of users (i) is derived from online activity of the first user from the first user's online user interface device via a first online access IP address and (ii) includes identification of the first online IP address and the time and date of the online activity, and
>
> (d) as a result of which delivery, a first television advertisement can be directed to a set-top box for presentation via that set-top box, selectively, wherein the set-top box is indicated by the set-top box identifier that the server associates with the online user interface device identifier of a first user's online user interface device.

The Petition acknowledges that "Claim 38 is largely identical to claim 26, except that claim 38 recites identifier-based associations, whereas claim 26 recites IP address-based associations." Pet. 37. Claim 38 is not obvious for the same reasons claim 26 is not obvious, as discussed above. Ex. 2001, ¶¶54-55.

IV. Conclusion

For the reasons set forth above, Patent Owner respectfully requests that the Board find all challenged claims not unpatentable.

Date: January 7, 2025

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this **PATENT OWNER'S RESPONSE**, that the amount of words in this paper is 3,809. Pursuant to 37 C.F.R. § 42.24, this word count is in compliance with the word limit set forth in 37 C.F.R. § 42.24(b)(2) excluding the portions exempted under 37 C.F.R. § 42.24(a)(1).

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on January 7, 2025, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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