

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIAUT TECHNOLOGY LLC,
Petitioner,

v.

INTENT IQ, LLC,
Patent Owner.

IPR2024-00422
Patent 7,861,260¹

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

¹ Viant Technology LLC was joined as a party to this proceeding via a Motion for Joinder in IPR2025-00129.

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I. Introduction

Petitioner’s invalidity theory required Petitioner to establish the obviousness of the controller of a set-top box at some public establishment (such as a coffee shop) *using* that set-top box *to display a social media website to customers*. The Board erred in adopting Petitioner’s theory, because no substantial evidence supports the obviousness of using a television at a public hotspot to display a social media website to customers in the manner proposed by Petitioner.

Indeed, the Board acknowledged that Petitioner’s expert, Mr. Lett, was “*unqualified*” “to opine about economic reasons why a coffee shop owner would or not want to do something.” FWD at 38 & n.24 (emphasis added). Despite acknowledging that Mr. Lett was “unqualified” to opine regarding economic benefits of the Petition’s “social-media-website on a television at a public establishment” modification, the Board’s decision inexplicably credited Mr. Lett’s testimony on exactly this point in concluding that it would be beneficial to “share [the social media website’s] music, video games, and advertisements with customers at a public establishment” via a set-top box. FWD at 42 (citing Ex. 1002, ¶160); *id.* at 44 (“fully credit[ing]” Mr. Lett’s testimony regarding alleged economic advantages of navigating a STB at a public establishment to a social media website).

Because the Board found that Petitioner’s expert was unqualified to testify regarding the economic benefits of navigating a public establishment’s set-top box

to a social media website, that testimony *could not* have supported the obviousness of Petitioner’s proposed modification. And Petitioner provided no *other* evidence that navigating a public set-top box to a social media website to a social media website would have been obvious. Indeed, despite claiming to be familiar with how set-top boxes are used in public establishments,”² Petitioner’s expert was unable to identify *any* examples of a STB being used in this allegedly obvious manner. *E.g.*, Ex. 2005, 65:2-14.³

The Board’s reliance on testimony from an admittedly unqualified expert to arrive at an unpatentability determination is particularly inappropriate given the purposes of the America Invents Act to evaluate patentability based on “patents and printed publications” rather than uncorroborated expert testimony. *See generally*, July 31, 2025 Memorandum Regarding 37 C.F.R. §42.104(B)(4), *available at* https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf.

Accordingly, Patent Owner respectfully requests that the Director reverse the FWD and find all challenged claims not unpatentable.

² Ex. 2005, 45:6–8.

³ *See also* Ex. 2005, 62:15–20 (Mr. Lett testifying he did not “have an opinion on” whether he was “aware of any public establishment that has *ever* included a TV that used that TV to display a social media website”) (emphasis added).

II. Overview of the Proceedings

A. The Petition

The Petition proposed that the challenged claims, which require *inter alia* directing advertisements to a set-top box (“STB”) based on a common IP address, were obvious based on a combination of Baig (Ex. 1007) and Costa (Ex. 1011).

At a high level, Baig discloses a social media website (*see* Ex. 1007 ¶¶37–38 (comparing Baig’s website which provides “vicinity-based user groups” to “social networking sites, such as ‘MySpace.com’, ‘Facebook.com’ and the like”)) which groups users together based on which public WiFi hotspot they are using. *See* Pet. 9–10 (providing overview of Baig).

Although Baig’s website is designed to provide the social media services to users’ mobile devices (such as laptops or mobile phones—*see* Ex. 1007 at [0002] (“Field of the Invention” pertaining to “providing various services for mobile devices which are in communication with local area network wireless access points”)), the Petition proposed that it would be obvious to add a television and STB to a public WiFi hotspot. *See* Pet. 10–12 (arguments regarding “Modifying Baig to include Costa’s STB”). In doing so, the Petition relied on a combination with Costa, which taught in relevant part the simple fact that it is possible for wireless networks “such as a public hotspot” to include a STB. *See id.* (discussing Costa).

Merely adding a STB to a public hotspot, however, does not satisfy the claim

requirements under the Petition’s theory, because the STB needed to be used to display advertisements delivered from Baig’s social media website. *See, e.g.*, Pet. 24 (Petition’s claim mapping relying on delivering Baig’s social media “advertisements to... a STB”). Thus, in order to show unpatentability, the Petition had to show not only (1) the obviousness of adding a STB to a WiFi hotspot of a public establishment, **but also** (2) the obviousness of **using** that STB to navigate to Baig’s social media site to display to customers. *See* POR 5–6 (expanding on this point).

The Petition presented argument on the first requirement, regarding why adding a STB to a public hotspot would allegedly have been obvious. *See* Pet. 10–12 (section heading titled “Modifying Baig to include Costa’s STB,” wherein the Petition alleged “[i]t would have been obvious to include a STB at Baig’s hotspot”). For instance, it alleged that a “POSA would be motivated to include Costa’s STB [at a public hotspot] because it beneficially allows customers at a public establishment to watch television or other information on an associated display.” Pet. 12.

Petitioner also provided a *KSR* rationale for adding a STB to a public hotspot—that it represented the mere combination of known elements according to known methods to yield predictable results. Pet. 11. But the Petition’s allegedly “known method” was “connecting the STB to an AP” (*id.*), and said nothing about how ***navigating a STB at a public hotspot to Baig’s social media site*** was a known method. (Petitioner’s expert later admitted that he was not aware of anyone having

ever navigated a public STB to a social media or equivalent website—*see* Sur-Reply at 9–10, citing Ex. 2005,⁴ 62:15–65:14.).

Regarding the second requirement, the Petition provided a single sentence alleging a benefit of *using* the STB to display Baig’s site to customers. Specifically, the Petition alleged “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.

In doing so, the Petition relied on two sources of evidence: Baig itself and the opinions of Petitioner’s expert, Mr. Lett. *Id.* The cited portions of Baig make *no mention* of a STB or a television, or any purported benefits of displaying Baig’s social media website via a STB. *See generally* Ex. 1007, ¶¶54, 62, 94–95, 103, 107–108. Instead, Baig makes clear that it is directed to providing the website content to “users having [their own] mobile devices, such as laptops, PDA, mobile phones and the like” (Ex. 1007 ¶¶2–5) to provide services “for wireless mobile devices of end-users” (*id.* ¶38). In other words, because Baig teaches that its website is designed to be directed to Baig makes clear that the benefits of providing Baig’s social media content via a display occurs *regardless* of whether or not any STB is navigated to the social media website (and Baig does not even contemplate the use of an STB at

⁴ The Sur-Reply’s citations to Ex. 2005 are incorrectly noted as Ex. 2004.

any public hotspot).

The cited testimony of Mr. Lett attempts to fill this gap in Baig’s teachings by relying on alleged economic benefits to navigating the STB to Baig’s social media website. First, Mr. Lett opined that a “POSA would have recognized that entertainment in a public venue such as a retail business is often beneficial to engage the user’s interest and maintain their presence at that location.” Ex. 1002, ¶160. Next, Mr. Lett testified that Baig’s social media website “is content that could be beneficially provided by a set-top box serving as a gateway for the music, games, television programming, and/or advertisements from content servers to a display device (e.g., a television).” Ex. 1002, ¶163. Mr. Lett identified only the same citations to Baig discussed above in support of this assertion, which discuss display via users’ individual *mobile devices*, not a communal “television” as Mr. Lett proposes. *See id.* Mr. Lett also alleged that “Costa’s technique [of adding a STB to a public hotspot] would have improved Baig’s similar wireless hotspot system by providing access to television content at the hotspot.” *Id.*

Other than citations to Baig (which did not discuss a STB or television), Mr. Lett provided no evidence for his opinions regarding any purported benefits of *navigating a STB at a public establishment to Baig’s social media website.*

B. Patent Owner’s Response

Patent Owner made clear that Petitioner’s argument required *both* adding a

STB *and* directing the STB to Baig’s website. POR 1 (“*Displaying Baig’s website 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.”) (emphasis added); POR at 5–6 (noting that both (1) adding a STB to a public hotspot *and* (2) directing the public STB to Baig’s website are required); *id.* at 11–13 (addressing the Petition’s failure to show obviousness of using the STB *to display Baig’s website to customers*).

Regarding the first aspect of the combination (adding a STB to Baig’s public hotspot), Patent Owner addressed the *KSR* rationale regarding the alleged known method of “connecting the STB to an [access point],” explaining that *KSR* requires “a reason” a POSITA would have made the proposed modification, and the Petition failed to establish “a reason to add a STB to Baig’s coffee shop” or other public establishment. POR, 10–11.

Regarding the second aspect of the combination (using the STB *to display Baig’s website to customers*), in order to rebut Petitioner’s own economic arguments, Patent Owner presented numerous economic reasons why the modification would *not* have made sense. For example, Baig’s social media website does not “provide television service or streaming service” (POR 11), the types of content that would typically be shown on a public television. Patent Owner further

noted that the Petition provided no “analysis of whether [directing the STB to a social media website] would have been beneficial *in the context of an STB at a coffee shop*” (or any other public establishment⁵). POR 11–12 (emphasis in original). Patent Owner also explained Petitioner’s proposed combination raised privacy concerns and failed to explain *how* the STB would be controlled. *Id.* 12–13.

C. Petitioner’s Reply

In Reply, Petitioner separately addressed the alleged obviousness of both (1) adding a STB to a public hotspot (Reply at 7–11, providing reasons it “would have been obvious to include a STB at Baig’s hotspot”), and (2) using the “television to display [Baig’s] web content” (Reply at 15–17).

In addressing the second obviousness issue of using the public hotspot “television to display [Baig’s] website content,” the Petition did not cite to *KSR* or provide any *KSR* rationale. *See* Reply at 15–17. Instead, Petitioner addressed only *economic* concerns such the alleged economic motivation for an advertiser to “reach

⁵ The POR focused on the Petition’s coffee shop example, because “the Petition’s sole example” of its proposed implementation was “a coffee shop.” POR 1. The Petition’s failures to show the obviousness of the proposed combination in the context of a coffee shop thus are necessarily failures to show the obviousness in the context of any other public establishment.

the widest possible audience at the hotspot.”⁶

Petitioner also cited numerous exhibits that purport to show that “it was common to use televisions (displays) for more than just ‘television service.’” *See* Pet. 15–16 (citing Exs. 1064–1068).

Finally, Petitioner argued that Patent Owner’s expert testimony regarding economic undesirability of the proposed combination was unsupported by corroborating evidence. *See* Reply 18–19.

D. Patent Owner’s Sur-Reply

In Sur-Reply, Patent Owner made clear that the most glaring deficiency of the Petition, which the Reply did not cure, was a failure to show obviousness of “displaying ***Baig’s website*** on a TV at a public hotspot” to customers (as opposed to the merely adding a STB to a public hotspot and using it to display *other* content, such as sports or news). POR at 3-4 (emphasis in original). Patent Owner noted that

⁶ As Patent Owner explained in Sur-Reply, the proprietor of an STB is different than the advertiser, such that the desires of the advertiser are irrelevant. *See* Sur-Reply at 6–8 (“the ***advertiser*** to Baig’s VCSP website is not the proprietor of the establishment” the STB is located within) (emphasis in original). Petitioner never alleged that the ***advertiser*** would be able to control whether the STB is tuned to Baig’s social media site.

the new evidence submitted with the Reply did not cure the deficiency of the Petition, because none of it addressed the obviousness of displaying *a social media website* like Baig’s using a STB at a public establishment. *See* Sur-Reply at 5–6 (citing Mr. Lett’s failure to provide any opinions regarding the obviousness of displaying the type of content *Baig’s website* includes, such as social media and auction content, at a coffee shop or other public establishment).

Patent Owner also reiterated that Petitioner’s *KSR* rationale (which was presented in the context of *adding* a STB to a public hotspot, not directing the STB to Baig’s website) does not even arguably address the entirety of the Petition’s combination, which requires “adding a STB to a *public hotspot* for public display, and then navigating that STB to a social media website providing auction and file-sharing content.” Sur-Reply at 12. Petitioner failed, *e.g.*, to allege that this latter aspect constituted a “known method,” which was underscored “by the fact that Mr. Lett was unable to identify *any* instances of when *any* website (much less a website similar to Baig’s... social media website) was ever displayed at a public establishment using a public WiFi hotspot.” Sur-Reply at 12–13.

Finally, Patent Owner made clear that, if Petitioner’s own argument regarding conclusory testimony was adopted, Petitioner’s expert testimony regarding economic benefits should likewise be rejected as conclusory. Sur-Reply 17–18.

III. The Board’s Final Written Decision erred in finding the challenged

claims unpatentable.

The Board’s Final Written Decision erred for at least two reasons, discussed in the following sections. First, the Board erred in relying on the testimony of Mr. Lett regarding the economic benefits of directing a public STB to a social media website, because Mr. Lett was unqualified to offer such testimony. Second, the Board erred by relying on Petitioner’s *KSR* rationale, even though that rationale did not pertain to the obviousness of *using the STB to display Baig’s social media content to customers of a public establishment via a TV*.

A. The Board erred by relying on Mr. Lett’s economic testimony.

The Board’s final written decision acknowledged that Petitioner’s expert Mr. Lett was “unqualified” to opine about economic reasons the proprietor of a coffee shop (or any other public establishment) “would or would not do something,” such as navigating a STB to a social media website. FWD at 38 & n.24. Nevertheless, the Board inexplicably credited Mr. Lett’s testimony in his opening declaration as supposedly not relating to such economic considerations. *See id.* (“[W]e focus on the reasons given in the Petition and Mr. Lett’s original testimony, which focus on reasons given in *KSR* and not the economics of a coffee shop.”).

As noted above in Section II.A, Mr. Lett’s testimony (as it pertains to the purported obviousness of directing a STB at a public establishment to Baig’s social media site) alleges *only* the benefits of displaying particular content to customers in

order to retain them at the establishment.

The fact that Mr. Lett’s declaration relied exclusively on *economic* benefits of navigating the STB to Baig’s social media website is unsurprising, because choosing what type of content to display on a television is purely an *economic* concern. For example, it *would* presumably be obvious for a sports bar to display NFL, MLB, and NBA games on its televisions. However, this is not obvious for any specific *technical* benefit—it is *economically* obvious, because that is part of the business model of a sports bar. Likewise, it would presumably *not be* obvious to display children’s cartoons at a 21+ sports bar, not because there is some *technical* reason to avoid doing so, but because that is not the type of content that is typically shown at a 21+ sports bar based on the business model of the establishment.

Whether *other* types of content (such as a social media website, such as Facebook, eBay, or Baig’s website⁷) would be obvious to display on a TV at any particular establishment likewise pertains to the economic business model of that

⁷ See Ex. 1007 ¶¶37–38 (Baig comparing its “vicinity-based community” website to social media content from Facebook and MySpace).

establishment, not to any *technical* benefits of displaying that content.⁸

Despite acknowledging that Mr. Lett was unqualified to offer economic opinions, the Board inexplicably “fully credited” his declaration testimony as it pertained to the economic benefits of navigating a STB to Baig’s social media site at a public establishment. FWD, 44. And the Board relied on exactly this “unqualified” testimony regarding economic benefits in finding that the proposed navigation of the STB to Baig’s social media website would be economically beneficial to “share music, video games, and advertisements with customers at a public establishment.” FWD, 42 (citing Ex. 1002, ¶¶160, 163).

The Board further disregarded “Patent Owner’s argument focusing on the economics of a coffee shop as opposed to technical problems” (FWD at 39, 41–42), but such a focus was appropriate because Petitioner identified *only* economic issues

⁸ The Board stated that the definition of a POSITA does not require a POSITA to be the proprietor of a public establishment. FWD 39. But Petitioner presented no evidence that anyone *other than* the proprietor of the establishment in which a STB is located would be capable of allowing the proposed navigation of the STB to Baig’s social media site. For example, Petitioner made no allegation that the entity controlling Baig’s website, or an advertiser entity, would be able to hack into a public establishment’s STB and cause the STB to navigate to Baig’s website.

as motivating displaying a social media website on a TV a public establishment.

And given that the Board held *Petitioner's expert* was unqualified to offer evidence regarding such economic considerations, there was insufficient evidence to support a finding of unpatentability *even if* Patent Owner's countervailing arguments were not considered. As noted above, the obviousness of displaying social media website content at a public establishment via a STB (as opposed to displaying some other type of content) is *exclusively* a concern of economics (e.g., what type of content would benefit the individual deciding what content to display), because there is no alleged *technical* improvement from the proposed action.

B. The Board further erred in relying on a *KSR* rationale not articulated by Petitioner.

The Board also relied on Petition's *KSR* rationale that the "combination of Baig and Costa would have been obvious because the combination merely combines known prior art elements according to known methods to yield predictable results." FWD, 28. But the Petition's *KSR* rationale relied on the "known method" of "*connecting the STB to an AP*" (Pet. 11 (emphasis added)), and the Board identified no allegation by Petitioner that *navigating an STB at a public establishment to a social media website* was a known method or otherwise justified by *KSR*.

The Board disregarded Patent Owner's argument that navigating a public STB to a social media website was not a "known technique." *See* Sur-Reply at 12

(“[W]hat was not well-known was adding a STB to a public hotspot for public display, and then navigating that STB to a social media website...,” as supported by “Mr. Lett [being] unable to identify” any even remotely analogous instances); FWD at 42–43 (disregarding this argument because Petitioner relied on *KSR* rationales in the Petition, even though the alleged “known methods” in the Petition were “connecting the STB to an AP” rather than navigating the STB to a social media website in a public establishment). But *even ignoring* the evidence from Petitioner’s own expert that displaying social media content to coffee shop customers was not a known technique, the Board still erred because the Petition never alleged (and the Board made no finding) that *navigating a STB at a public establishment* (e.g., coffee shop) *to a social media website to display social media content to customers* was a known technique.

In sum, neither the Petition nor the Board’s decision articulated why any *KSR* rationale supports the obviousness of displaying a social media website to customers of a public establishment via a TV.

IV. Conclusion

For the foregoing reasons, Patent Owner respectfully requests that the Director reverse the Board’s finding of unpatentability, which findings relied on (1) uncorroborated expert testimony that the Board itself found the expert was “unqualified” to offer, and (2) a *KSR* rationale Petition did not advance.

Date: November 13, 2025

Respectfully submitted,

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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 November 13, 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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