

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

INTENT IQ, LLC,
Patent Owner.

IPR2024-00424
Patent 7,861,260 B2

Before NABEEL U. KHAN, SCOTT B. HOWARD, AND DAVID COTTA,
Administrative Patent Judges.

KHAN, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. *Background and Summary*

FreeWheel Media, Inc. filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 10, 11, 13, 14, 23, 24, 26, 29–31, 33–53, 61–74, 89, 90, 92, 93, 102, 103, 105–115, 121, 122, 127–140, 146, and 147 (“the challenged claims”) of U.S. Patent No. 7,861,260 B2 (“the ’260 patent,” Ex. 1101). Intent IQ, LLC¹ (“Patent Owner”) timely filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

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 concurrent filing by Petitioner of petitions in IPR2024-00421 and IPR2024-00422.

B. *Related Proceedings*

The parties identify the following pending matters as involving the ’260 patent: *AlmondNet, Inc. v. Freewheel Media, Inc. et al.*, Case No. 1:23-cv-00220 (D. Del.) (Ex. 1141) (“Corresponding District Court Litigation”); *AlmondNet, Inc. v. Viant Technology Inc. et al.*, 1:23-cv-00174 (D. Del.); *Freewheel Media, Inc. v. Intent IQ, LLC*, IPR2024-00421 (PTAB); *Freewheel Media, Inc. v. Intent IQ, LLC*, IPR2024-00422 (PTAB); and

¹ The caption to Patent Owner’s Preliminary Response identifies AlmondNet, Inc. as Patent Owner. *See* Paper 8. The caption to Patent Owner’s Mandatory Notice, however, identifies Intent IQ, LLC as the Patent Owner and in the Mandatory Notice, Patent Owner identifies Intent IQ, LLC as the real party in interest in this proceeding. Paper 5, 1. The USPTO assignment database includes an assignment that was filed transferring ownership rights from AlmondNet, Inc. to Intent IQ, LLC. Accordingly, we identify Intent IQ, LLC as the Patent Owner in this proceeding.

Freewheel Media, Inc. v. Intent IQ, LLC, IPR2024-00423 (PTAB). Pet. viii-x; Paper 5, 1.

Petitioner also identifies the following pending matters as involving the '260 patent: *AlmondNet, Inc. v. Samsung Electronics Co., Ltd.*, 4:22-cv-07515 (N.D. Cal.); *AlmondNet, Inc. et al. v. Samsung Electronics Co., Ltd. et al.*, 6:21-cv-00891 (W.D. Tex.); *AlmondNet, Inc. v. Meta Platforms, Inc.*, 4:22-cv-08911 (N.D. Cal.); *AlmondNet, Inc. v. Meta Platforms, Inc.*, 6:22-cv-01205 (W.D. Tex.); and *Roku, Inc. v. AlmondNet, Inc.*, 1:21-cv-01035 (D. Del.). Pet. x-xi.

Petitioner also identifies the following terminated matters as involving the '260 patent: *AlmondNet, Inc. v. Amazon.com, Inc.*, 6:22-cv-01204 (W.D. Tex.); *AlmondNet, Inc. v. Microsoft Corp.*, 6:22-cv-01206 (W.D. Tex.); *AlmondNet, Inc. v. Oath Holdings Inc.*, 1:19-cv-00247 (D. Del.); and *AlmondNet, Inc. v. Yahoo! Inc.*, 1:16-cv-01557 (E.D. NY). Pet. xi.

C. The '260 Patent (Ex. 1101)

The '260 patent, titled "Targeted Television Advertisements Based on Online Behavior," relates to a process whereby targeted television advertisements are delivered based on online behavior. Ex. 1101, code (54), (57). IP addresses indicating online access devices and IP addresses indicating television set-top boxes are electronically associated for users, and user profiles are derived from online activities from the online access IP addresses. *Id.* at code (57). Using the user profile, a television advertisement is selected and automatically directed to the set-top box indicated by the set-top IP address associated with the online access IP address. *Id.*

D. Illustrative Claims

Claims 1, 26, 38, and 61 of the '260 patent are independent. Claims 1 and 26 are reproduced below with limitation identifiers in brackets corresponding to claim analysis headings in the Petition. *See, e.g.*, Pet. 9–29, 36–47.

[1pre] A method implemented using a programmed hardware computer system, the method comprising:

[1A] (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

[1B] (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.

Ex. 1101, 23:43–60.

[26pre] A method implemented using computer equipment, the method comprising:

[26A] (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,

[26B] (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,

[26C] (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

[26D] (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.

Ex. 1101, 25:42–63.

E. Evidence

The Petition relies on the following references:

Reference	Exhibit No.
US 8,180,674; filed Oct. 3, 2006; issued May 15, 2012 (“Madhavan”).	1162
US 2006/0039386; filed July 29, 2006; published Feb. 23, 2006 (“Park”)	1163
US 2004/0003292; filed July 1, 2003; published Jan. 1, 2004 (“Kato”)	1164
US 2008/0120178; filed Nov. 22, 2006; published May 22, 2008 (“Martinez”)	1165
US 2005/0096978; filed Nov. 5, 2003; published May 5, 2005 (“Black”)	1134
US 7,376,714; filed Apr. 1, 2004; issued May 20, 2008 (“Gerken”)	1167
US 2005/0096980; filed Dec. 31, 2003; published May 5, 2005 (“Koningstein”)	1124
US 5,740,252; filed Oct. 13, 1995; issued Apr. 14, 1998	1169
US 2008/0201731; filed Feb. 15, 2007; published Aug. 21, 2008 (“Howcroft”)	1116

Reference	Exhibit No.
US 2007/0206773; filed Oct. 2, 2006; published Sep. 6, 2007 (“Branam”)	1170

Petitioner also relies on the Declaration of David B. Lett (Ex. 1102) in support of its arguments. The parties rely on other exhibits as discussed below.

F. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1, 10, 11, 13, 14, 23, 24, 26, 29–31, 33–53, 61–74, 89, 90, 92, 93, 102, 103, 105–115, 121, 122, 127–140, 146, and 147 would have been unpatentable on the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. § ²	Reference(s)/Basis
1	1, 13, 14, 44, 61, 62, 71–74, 92, 93	103(a)	Madhavan, Park
2	1, 13, 14, 44– 48, 52, 61–65, 68, 71–74, 92, 93	103(a)	Madhavan, Park, Kato
3	24, 26, 29, 31, 33–40, 42, 103, 106, 121, 122, 128, 137–140, 146, 147	103(a)	Madhavan, Park, Martinez
4	24, 26, 29, 31, 33–40, 42, 103, 106–110, 114, 121, 122, 128– 131, 134, 137– 140, 146, 147	103(a)	Madhavan, Park, Kato, Martinez

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103 and became effective March 16, 2013. Because the ’260 patent was filed before this date, the pre-AIA versions of §§ 102 and 103 apply.

5	10, 89	103(a)	Madhavan, Park, Black
6	10, 89	103(a)	Madhavan, Park, Kato, Black
7	11, 90	103(a)	Madhavan, Park, Kato, Gerken
8	30, 43	103(a)	Madhavan, Park, Martinez, Koningstein
9	30, 43	103(a)	Madhavan, Park, Kato, Martinez, Koningstein
10	41, 105, 127	103(a)	Madhavan, Park, Martinez, Minor
11	41, 105, 127	103(a)	Madhavan, Park, Kato, Martinez, Minor
12	23, 66, 70, 102	103(a)	Madhavan, Park, Howcroft
13	23, 49, 50, 66, 70, 102	103(a)	Madhavan, Park, Kato, Howcroft
14	132, 136	103(a)	Madhavan, Park, Martinez, Howcroft
15	111, 112, 132, 136	103(a)	Madhavan, Park, Kato, Martinez, Howcroft
16	51, 53, 67, 69	103(a)	Madhavan, Park, Branam
17	51, 53, 67, 69	103(a)	Madhavan, Park, Kato, Branam
18	133, 135	103(a)	Madhavan, Park, Martinez, Branam
19	113, 115, 133, 135	103(a)	Madhavan, Park, Kato, Martinez, Branam

II. ANALYSIS

A. *Discretionary Denial Based on Parallel Petitions*

As identified above, Petitioner has concurrently filed, along with this Petition, three other petitions challenging the claims of the '260 patent. Pet. ix. In total, petitions were filed in the four following proceedings: IPR2024-00421, IPR2024-00422, IPR2024-00423 and IPR2024-00424. Pet. ix.

Patent Owner argues that we should exercise our discretion to deny institution in this proceeding because “Petitioner has not and cannot justify the *four* simultaneously filed parallel petitions directed towards the ’260 patent challenging the same independent claims.” Prelim Resp. 4. For the following reasons, we agree with Patent Owner with respect to two of the proceedings, and we exercise our discretion to deny institution of IPR2024-00423 and IPR2024-00424.

In its Petition Ranking (Paper 3), Petitioner includes the following chart showing Petitioner’s ranking and primary grounds for each of the four concurrently filed proceedings:

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

Paper 3, 1–2.

The chart shows that Petitioner has filed two sets of petitions. The first set of two petitions (in IPR2024-00421 and IPR2024-00422) challenges all 152 claims of the ’260 patent and is based on the Baig reference. Paper 3, 1–2. The second set of two petitions (in IPR2024-00423 and IPR2024-00424) also challenges all 152 claims of the ’260 patent and is based on the Madhavan reference. *Id.*

According to Petitioner, the “four petitions . . . should more appropriately be considered two petitions, each consisting of two parts to cover the enormous number of claims.” Paper 3, 1. Petitioner states that “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).” *Id.* We agree that the large number of claims justifies filing the first set of higher ranked petitions (Petitions 1A and 1B) covering the 152 claims and in separate decisions entered concurrently with this one, we institute *inter partes* review in IPR2024-00421 and in IPR2024-00422. IPR2024-00421, Paper 9; IPR2024-00422, Paper 10.

This proceeding, however, is part of the second set of petitions. The large number of claims alone is not sufficient to justify the filing of the second set of petitions when the first set already covers all 152 claims of the ’260 patent. We therefore turn to Petitioner’s reasons for why it filed the second set of petitions. In this regard, Petitioner identifies three primary “[m]aterial differences between the petition pairs.” Paper 3, 2–5. The first is that the second set of petitions relies on a different set of references, based on Madhavan, rather than Baig. *Id.* at 2. The second material difference relates to possible priority date issues, and the third relates to possible claim construction issues. *Id.*

We determine that none of these “material differences” are sufficient to justify filing the second set of petitions, including this petition. *See* November 2019 Consolidated Trial Practice Guide (“CTPG”) 59, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“[O]ne 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. . . . The Board finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.”).

Regarding the first “material difference,” Petitioner summarizes the history of the assertion of Baig and Madhavan in previous proceedings, noting that Baig was involved in an IPR “filed against a grandchild of the ’260 Patent” and Madhavan was “used in IPRs of various descendants of the ’260 Patent.” Paper 3, 2–3. Petitioner does not explain, however, how this summary supports instituting on both sets of petitions other than the fact that the two sets of petitions rely on two different primary references and that the two references have been used in prior petitions to different effect. As Patent Owner points out, however, “[n]early all parallel petitions involve different proposed prior art” (Prelim. Resp. 6) and, in this case, the differences in how Petitioner applies the art to the challenged claims are not sufficient to justify filing two additional petitions.

Regarding the priority date issues, Petitioner argues that because Baig and Madhavan qualify as prior art under 35 U.S.C. § 102(e), Patent Owner could attempt to antedate the references and that Madhavan’s priority date being one month earlier than Baig’s priority date could be a material difference depending on how Patent Owner attempts to antedate the references. Paper 3, 3–4. Patent Owner, however, responds to these arguments by “expressly stipulat[ing] that it will not ‘attempt to antedate or disqualify’ the prior art relied upon by Petitioner.” Prelim. Resp. 7 (quoting Paper 3, 3–4). We, therefore, do not find Petitioner’s argument persuasive. *See* CTPG, 59–61 (recognizing that while a dispute about priority date may justify more than one petition, Patent Owner’s stipulation that it will not dispute whether references qualify as prior art may help explain why the Board should not exercise its discretion to institute.)

Regarding claim construction, Petitioner argues that Patent Owner may narrowly construe the terms “user” and “television advertisement” and

that Madhavan may address these narrower constructions better than Baig. Paper 3, 4–5. Additionally, Petitioner points out that in prior proceedings, Patent Owner has argued that Madhavan did not teach electronic association of devices based on a common IP address whereas Baig more clearly discloses this element. *Id.* at 5. These arguments, as Patent Owner points out, are mostly speculative. Prelim. Resp. 7. At the institution phase, neither Petitioner nor Patent Owner has offered any specific claim constructions and Petitioner has not provided any specific reason to believe that Patent Owner will take a narrow construction with respect to these terms of the '260 patent. *See* Pet. 6; Prelim. Resp. 7. The only issue identified based on more than mere speculation is Patent Owner's argument in prior proceedings that Madhavan did not teach electronic association of devices based on a common IP address. Paper 3, 5 (citing IPR2022-01420, Paper 9 at 7–19). This argument, however, supports the petitions relying on Baig rather than those relying on Madhavan.

For the aforementioned reasons, we determine that Petitioner has not sufficiently justified filing a second set of petitions challenging the same claims that the first set already covers. Petitioner ranks the two petitions relying on Madhavan lower than the two relying on Baig. Paper 3, 1–2. Because this proceeding is lower ranked, we exercise our discretion to deny institution in this proceeding.

III. CONCLUSION

For the foregoing reasons, in view of the concurrent petitions filed in IPR2024-00421 and IPR2024-00422, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review in this proceeding.

IV. ORDER

For the foregoing reasons, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied and *inter partes* review of the challenged claims of the '260 patent is not instituted.

IPR2024-00424
Patent 7,861,260 B2

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