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EXAMINER

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ART UNIT

PAPER NUMBER

3992

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/019,699.

PATENT UNDER REEXAMINATION 11463768.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

|                                                              |                                      |                                               |                                 |
|--------------------------------------------------------------|--------------------------------------|-----------------------------------------------|---------------------------------|
| <b>Order Granting Request For<br/>Ex Parte Reexamination</b> | <b>Control No.</b><br>90/019,699     | <b>Patent Under Reexamination</b><br>11463768 |                                 |
|                                                              | <b>Examiner</b><br>C. Michelle Tarae | <b>Art Unit</b><br>3992                       | <b>AIA (FITF) Status</b><br>Yes |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--*

The request for *ex parte* reexamination filed 10/11/2024 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892,      b) ☐ PTO/SB/08,      c) ☒ Other: IDS

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

|                                                                |  |  |
|----------------------------------------------------------------|--|--|
| /C. Michelle Tarae/<br>Reexamination Specialist, Art Unit 3992 |  |  |
| cc:Requester ( if third party requester )                      |  |  |

### **DECISION ON REQUEST FOR *EX PARTE* REEXAMINATION**

A substantial new question (SNQ) of patentability affecting claims 1, 10, 19, and 27 U.S. Pat. No. 11,463,768 to Donian et al. (“the ‘768 Patent”) is raised by the Request for *Ex Parte* reexamination filed October 11, 2024 (“Request”) by the Requester.

Reexamination is granted for claims 1, 10, 19, and 27.

### ***Related Proceedings and Litigation***

Requestor has identified the following litigation beginning on p. 2 of the Request as pending:

- *Piranha Media Distribution LLC v. Hulu LLC*, No. 2:24-v-00498 (C.D. Cal.)
- IPR2024-01252, *Hulu, LLC v. Piranha Media Distribution, LLC*
- IPR2024-01253, *Hulu, LLC v. Piranha Media Distribution, LLC*

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the ‘768 Patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceedings throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282, and 2286.

### ***References Asserted by PO Requester as Raising SNQs of Patentability***

- U.S. Pat. No. 7,877,766 to Wu et al. (“Wu”)
- U.S. Pat. Pub. No. 2002/0090198 to Rosenberg et al. (“Rosenberg”)
- U.S. Pat. No. 7,292,773 to Angel (“Angel”)

- U.S. Pat. Pub. 2002/0083439 to Eldering (“Eldering”)

Other considerations:

- Declaration of Anthony J. Wechselberger (“Wechselberger Dec.”)

### ***Prosecution History of the ‘768 Patent***

Application 17/234,498 (“the ‘498 Application”) that matured into the ‘768 Patent was originally filed April 19, 2021 with claims 1-2.

A preliminary amendment was filed June 21, 2021 amending claim 1, cancelling claim 2, and adding claims 3-21.

A first office action was mailed August 18, 2021 rejecting claims 1 and 3-21 under 35 USC 102(a)(2) with U.S. Pat. Pub. No. 2007/0204310 to Hua.

Applicant filed a response on November 4, 2021 arguing that Hua was not a prior art reference. No claims were amended.

A second office action was mailed February 17, 2022 objecting to claims 3, 4, 9-11, 13, 14, and 19-21 for being dependent upon a rejected base claim, would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The second office action also issued a double patenting rejection of claims 1, 5-8, 12 and 15-18 over claim 1 of U.S. Pat. No. 10,986,403.

On March 28, 2022 Applicant filed claim amendments. Claim 1 was amended to include *based on an advertisement requirement that applies to the digital media system; modify the adapted insertion point of digital advertising content based on the*

*advertisement requirement.* Claim 12 was amended to include *based on one or more advertisement requirements.* Claims 9 and 19 were canceled.

A Notice of Allowance was issued July 25, 2022 indicating claims 1, 3-8, 10-18 and 20-37 allowed. The reasons for allowance indicated the prior art did not disclose, *change a predetermined advertisement insertion point in the digital media content to an adapted advertisement insertion point in the content, in response to receiving a user input to update a current play position in the content to a new play position in the content, the adapted advertisement insertion point determined by an adaptive preference rule based on an advertisement requirement that applies to the digital media system, modify the adapted insertion point based on the advertisement requirement.*

Thus, based on the Examiner's reasons for allowance statements, teachings related to:

- *changing a predetermined advertisement insertion point in the digital media content to an adapted advertisement insertion point in the content, in response to receiving a user input to update a current play position in the content to a new play position in the content,*
- *the adapted advertisement insertion point determined by an adaptive preference rule based on an advertisement requirement that applies to the digital media system, and*
- *modify the adapted insertion point based on the advertisement requirement*

would be deemed important to a reasonable examiner in determining the patentability of the claims in this *ex parte* reexamination.

***Substantial New Question of Patentability Requirement***

For a substantial new question of patentability (SNQ) to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim. MPEP 2242 I. Additionally, it must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. MPEP 2216.

***Proposed SNQs Raised in the Request***

SNQ 1: Wu, Rosenberg, Eldering, and Angel raise an SNQ for claim 1

SNQ 2: Wu, Rosenberg, and Angel raise an SNQ for claims 10, 19, and 27

### ***Analysis of SNQs***

#### **SNQ 1: Wu, Rosenberg, Eldering, and Angel raise an SNQ for claim 1**

Wu discloses “[a] method and system of providing a non-skippable sub-advertisement stream... when a user of an electronic digital recording/play back device causes it to fast forward through or skip over a recorded television advertisement, an overlay screen corresponding to the skipped advertisement is displayed on a portion of a television screen once the user resumes watching the recorded television show in normal play back mode... In this manner, the user of the electronic digital recording/play back device is unable to easily avoid viewing content corresponding to the skipped advertisement.” (Wu, abstract) Wu teaches that each advertisement has a specified time interval relative to a corresponding segment of video content (i.e., advertisement insertion point). (*Id.*, Figs. 4A and 4B) Wu also teaches that the advertisement insertion point may be updated in response to receiving a user input to update a current play position in the content to a new play position in the content because an overlay screen corresponding to the skipped advertisement is displayed on a portion of a television screen once the user resumes watching the recorded television show in normal play back mode. (*Id.*, abstract)

Rosenberg discloses ad placement in a digital video stream. (Rosenberg, abstract) Rosenberg teaches changing a predetermined advertisement insertion point in the digital media content to an adapted advertisement insertion point in response to user input in its quick-skip ad placement. (*Id.*, Fig. 3C and ¶0061)

Angel discloses techniques for enforcing mandatory segments (i.e., advertisements) in multimedia content, while at the same time providing a large amount

of flexibility.” (Angel, 1:37-39) With reference to Fig. 2, Angel teaches that mandatory segments (i.e., advertisements) have requirements for being displayed: “[d]escription 245 comprises a timestamp 246, a duration 247, a segment lifetime 248, and a mandatory level 249.” (*Id.*, 4:39-59) The mandatory level is an adaptive preference rule because it “indicates to what extent a mandatory segment is allowed to be skipped. In one embodiment, mandatory level 249 may be ‘hard’ or ‘soft,’ where “hard” indicates that the mandatory segment cannot be skipped and “soft” indicates that the mandatory segment can be skipped if certain conditions are met.” (*Id.*, 5:32-43) Angel further teaches advertisement requirement that applies to the digital media system in its discussion of activation distances: “[i]f the activation distance 160 is too long, then the mandatory segment 140 might not be enforced. For example, if a user jumps one hour of a two hour video, there could be quite a few mandatory segments 140 in this one hour. In this situation, the mandatory segments within the one hour might not be played.” (*Id.*, 3:28-35; Fig. 1)

Eldering is directed to “[a] system for inserting advertisement into channels of media programming... for improving effectiveness in targeted advertising.” (Eldering, abstract) Eldering’s object is “to provide a method and system for inserting targeted advertisements into television program channels according to ad insertion schedule.” (*Id.*, ¶0011) With reference to Fig. 2, Eldering illustrates the different software modules associated with the functions for managing the ad insertion schedule. (*Id.*, ¶¶0042, 0045, 0046) Eldering is used by Requester “to show that it was known to implement different functions performed by the software of a user’s set top box or digital video

recorder in separate modules, where each module performs a specific function of the software.” (Request, p. 50)

Accordingly, it appears the combination of Wu, Rosenberg, Eldering, and Angel discloses the technological teachings of

- *changing a predetermined advertisement insertion point in the digital media content to an adapted advertisement insertion point in the content, in response to receiving a user input to update a current play position in the content to a new play position in the content,*
- *the adapted advertisement insertion point determined by an adaptive preference rule based on an advertisement requirement that applies to the digital media system, and*
- *modify the adapted insertion point based on the advertisement requirement*

Therefore, such teachings are deemed important to a reasonable examiner in determining the patentability of at least independent claim 1.

Wu, Rosenberg, Eldering, and Angel were not previously cited in the prosecution history of the ‘768 Patent. The issues are not the subject of a final holding by a Federal Court. The teachings are also not cumulative to the teachings previously residing in the prior art cited by the ‘768 Patent. Therefore, the Examiner agrees that Wu, Rosenberg, Eldering, and Angel raise a SNQ of patentability with respect to at least claim 1.

SNQ 2: Wu, Rosenberg, and Angel raise an SNQ for claims 10, 19, and 27

Similar reasons are used in SNQ 2 as were used in SNQ 1. The limitation in claim 1 that Eldering was relied upon for is not recited in claims 10, 19, and 27; therefore, Eldering is not relied upon for SNQ 2. Since the combination of Wu, Rosenberg, and Angel are considered to raise a SNQ for claim 1, they would also be considered to raise a SNQ with respect to claims 10, 19, and 27 since the claims recite similar limitations.

### **325(d) Analysis**

35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Thus, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments that previously were presented to the Office.

A review of the post grant history of the ‘768 patent indicates that the patent was the subject of a two prior AIA petitions.

On August 22, 2024, petitioner Hulu, LLC, filed a petition seeking *inter partes* review of claims 1-3, 5-12, 14-21, 23-25, 27-29 and 31-33 of the ‘768 patent (IPR2024-01252). In the petition, petitioner asserted the following grounds as raising a reasonable likelihood in prevailing (RLP) in showing the unpatentability of the claims:

**IPR2024-01252**

| <b>RLP #</b> | <b>Claims Challenged</b>              | <b>35 USC §</b> | <b>References</b> |
|--------------|---------------------------------------|-----------------|-------------------|
| 1            | 1-3, 5-12, 14-21, 23-25, 27-29, 31-33 | 103             | Wu, Doherty       |

Also on August 22, 2024, petitioner Hulu, LLC, filed a second petition seeking *inter partes* review of claims 1-3, 5-12, 14-21, 23-25, 27-29 and 31-33 of the '768 patent (IPR2024-01253). In the petition, petitioner asserted the following grounds as raising a reasonable likelihood in prevailing (RLP) in showing the unpatentability of the claims:

**IPR2024-01253**

| <b>RLP #</b> | <b>Claims Challenged</b>              | <b>35 USC §</b> | <b>References</b>       |
|--------------|---------------------------------------|-----------------|-------------------------|
| 1            | 1-3, 5-12, 14-21, 23-25, 27-29, 31-33 | 103             | Eldering I, Eldering II |

The Patent Trial and Appeal Board (PTAB) has not yet issued a decision on the institution of *inter partes* review in either IPR2024-01252 or IPR2024-01253.

Accordingly, the merits of the newly presented references of Wu, Doherty, Eldering I and Eldering II have not been addressed by the PTAB.

A comparison between the prior art and arguments presented in the current *ex parte* reexamination Request (90/019,699) and the prior *inter partes* review petitions (IPR2024-01252 and IPR2024-01253) indicates that the instant request is not based on the same or substantially the same prior art or arguments as were previously presented to the Office.

As stated above, the instant request asserts the following grounds as raising an SNQ to claims 1, 10, 19 and 27 of the '768 patent:

| SNQ # |  | Claims<br>Challenged | Basis | References                       |
|-------|--|----------------------|-------|----------------------------------|
| 1     |  | 1                    | 103   | Wu, Rosenberg, Eldering I, Angel |
| 2     |  | 10, 19, 27           | 103   | Wu, Rosenberg, Angel             |

As an initial matter, none of the grounds asserted as raising an SNQ in the current *ex parte* reexamination Request (90/019,699) are based on identical grounds asserted in the prior IPR petition and the arguments in the Request relate to these prior art combinations. Thus, the Request is not based on the same prior art or arguments previously presented to the Office.

In addition, the Request is also not based on substantially the same prior art or arguments as were previously presented to the Office. As noted above, the newly presented Rosenberg and Angel references are materially different references than those presented in the prior IPR petitions (IPR2024-01252 and IPR2024-01253). Furthermore, Rosenberg and Angel are cited in the Request in combination with the Wu (SNQ 1 and SNQ 2) and the Eldering I reference (SNQ1). Rosenberg is argued as teaching changing a predetermined advertisement insertion point in the digital media content to an adapted advertisement insertion point in response to user input in its quick-skip ad placement. (*Id.*, Fig. 3C and ¶0061) and Angel is argued as teaching techniques for enforcing mandatory segments (i.e., advertisements) in multimedia content, while at the same time providing a large amount of flexibility.” (Angel, 1:37-39). Thus, neither the prior art nor arguments presented in the current request of the ‘768 patent are substantially the same as the art and arguments previously presented to the Office.

However, to the extent that the references of Rosenberg and Angel presented in the current *ex parte* reexamination Request (90/019,699) are considered to be substantially similar to the references of presented in the prior IPR petitions (IPR2024-01252 and IPR2024-01253), the Examiner as delegated by the Director declines to exercise her discretion to reject this request in view of the following facts:

- 1.) The fact that there has been no finding of serial abusive Office challenges to the '768 patent by Third Party Requester;
- 2.) The fact that the PTAB has not yet issued a decision on the institution of *inter partes* review in the IPR2024-01252 and IPR2024-01253 petitions and therefore has not yet considered the merits of references presented in the IPR petitions;
- 3.) The fact that there is minimal additional burden on the Office in examining the claims of the '768 patent in view of the grounds determined to raise an SNQ; and
- 4.) The fact that there is a strong public interest that the prior art references of Wu, Rosenberg, Eldering I and Angel, which are determined to raise an SNQ over claims 1, 10, 19 and 27 of the '768 patent, be fully considered by the Office to fully address the patentability of the challenged claims.

Accordingly, *Ex Parte* Reexamination is Ordered based on the determination that cited references raise an SNQ to the '768 patent for the reasons set forth above.

### ***Conclusion***

Thus, the Request to reexamine claims 1, 10, 19, and 27 of the '768 Patent is GRANTED in view of the determination above that the Request raises a SNQ as to at least one of the requested claims.

### ***Extension of Time***

Extensions of time under 37 C.F.R. § 1.136(a) will not be permitted in these proceedings because the provisions of 37 C.F.R. § 1.136 apply only to "an applicant" and not to parties in a reexaminations proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

### ***Amendment in Reexamination Proceedings***

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 C.F.R. § 1.530(d)-(j), must be formally presented pursuant to 37 C.F.R. § 1.52(a) and (b), and must contain any fees required by 37 C.F.R. § 1.20(c). See MPEP § 2250 IV. for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

### ***Service of Papers***

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 C.F.R. § 1.248. See 37 C.F.R. § 1.550.

### ***Future Correspondence***

If attempts to reach Examiner C. Michelle Tarae by telephone at 571-272-6727 are unsuccessful, the examiner's supervisor, Andrew J. Fischer, can be reached on 571-272-6779.

Information regarding the status of published reexamination applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.  
Signed:

/C. Michelle Tarae/  
Reexamination Specialist, Art Unit 3992

#### **Conferees:**

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