

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIDEOAMP INC.,

Petitioner,

v.

THE NIELSEN COMPANY (US), LLC,

Patent Owner

Case IPR2025-00556
Patent No. 11,871,058

PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL

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I. INTRODUCTION

Patent Owner The Nielsen Company (US), LLC (“Patent Owner”) requests the Director exercise its discretion and deny institution of VideoAmp Inc.’s (“Petitioner”) IPR in accordance with the Director’s March 26, 2025, Memorandum regarding the “Interim Processes for PTAB Workload Management” (“Memo”).

II. DISCRETIONARY DENIAL FACTORS

On March 26, 2025, Acting Director of the USPTO, Coke Morgan Stewart, published the Memo, detailing the PTAB’s interim procedure for “determin[ing] whether discretionary denial of institution is appropriate.” *Memo*, 1. “[C]onsistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics**) and the Consolidated Trial Practice Guide (2019), the parties are permitted to address all relevant considerations[.]” *Memo*, 2. Among the considerations set forth in the Memo, “[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims” and “[t]he strength of the unpatentability challenge” are relevant here. *Id.* “The Director will also consider the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs.” *Id.* at 3 (citing 35 U.S.C. § 316(b)).

III. THE DIRECTOR SHOULD EXERCISE ITS DISCRETION AND DENY INSTITUTION OF THIS *INTER PARTES* REVIEW

A. The '058 Patent Has Already Been Found Unpatentable Under 35 U.S.C. § 101 by the District Court in the Parallel Litigation

The Director should exercise her discretion and deny Petitioner's IPR for a simple reason: On March 31, 2025, the district court in Patent Owner's related litigation against Petitioner granted Petitioner's motion to dismiss and held the '058 Patent to be directed to patent-ineligible subject matter under 35 U.S.C. § 101. Ex. 2001, *Memorandum Opinion*, at 13. The procedural posture here is similar to a recent decision in which the Director reversed the institution of an IPR challenging a patent that had already been found invalid under § 101 in concurrent litigation. *Hulu, LLC v. Piranha Media Dist., LLC*, IPR2024-01252, Paper 27 (PTAB Apr. 17, 2025). As the Director explained in *Hulu*, "where a district court already has found the challenged claims invalid, the efficiency and integrity of the patent system is best served by denying institution." *Hulu, LLC v. Piranha Media Dist., LLC*, IPR2024-01252, Paper 27, at 3 (PTAB Apr. 17, 2025). Thus, the district court's decision in the parallel litigation holding the '058 Patent invalid moots Petitioner's *Fintiv* analysis, which was advanced prior to the district court's decision, and *Fintiv* favors denial of institution. *Id.*

Patent Owner currently intends to appeal the district court's ruling. But that does not mean Petitioner's IPR should be allowed to proceed. "In the event the

Federal Circuit reverses...Petitioner may raise such invalidity arguments in the district court on remand.” *Id.* at 2–3. Moreover, Patent Owner’s appeal of the district court’s order will likely still be pending by the July 30, 2026, deadline for the PTAB to issue its Final Written Decision in this IPR, making a decision by the Board an impermissible advisory opinion. Ex. 2002, *Sterne Kessler Report*, at 13 (noting the median pendency for appeal to the Federal Circuit of district court decisions was approximately 20 months).

Additionally, as the Federal Circuit has observed, one of the “salutary effects” of resolving patent eligibility at the pleadings stage is that “it will conserve scarce judicial resources.” *Ultramercial*, 772 F.3d at 718. Indeed, in its motion to dismiss, Petitioner expressly argued *against* wasting “judicial and party resources unnecessarily litigating” the ’058 Patent. Ex. 2003, *Motion to Dismiss*, at 2. In petitioning for this IPR *after* making that representation, Petitioner requests that the Board waste the very resources Petitioner did not believe the district court should waste—presumably because, in this instance, the waste can potentially benefit Petitioner. And because any § 101 appeal likely would not be resolved until after the Board is required to issue its decision in this proceeding, the parties and Board will not know whether this entire proceeding was a waste of resources until after the resources have already been spent.

The Director’s reversal of institution in *Hulu* also aligns with the statutory obligation for tribunals to resolve matters of § 101 before reaching novelty or obviousness. As the Supreme Court has stated, “[t]he obligation to determine what type of discovery is sought to be patented **must** precede the determination of whether that discovery is, in fact, new or obvious.” *Parker v. Flook*, 437 U.S. 584, 593 (1978); *see also Bilski v. Kappos*, 561 U.S. 593, 621 (2010) (Stevens, J., concurring) (“Section 101 imposes a threshold condition.”); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 718 (Fed. Cir. 2014) (Mayer, J., concurring) (explaining that “[j]ust as a court must assure itself of its own jurisdiction before resolving the merits of a dispute,...it must likewise first assess whether claimed subject matter is even *eligible* for patent protection before addressing questions of invalidity or infringement”).

As it stands today, the threshold eligibility inquiry has been answered in the negative by the district court. Thus, there is no reason to move to “the determination of whether [the claimed invention] is, in fact, new or obvious.” *Parker*, 437 U.S. at 593. “Indeed, if claimed subject matter does not fall within the ambit of section 101, any determination on validity...constitutes an impermissible advisory opinion.” *Ultramercial*, 772 F.3d at 718 (citing *Oil, Chem. & Atomic Workers Int’l Union v. Missouri*, 361 U.S. 363, 367 (1960)).

Thus, because the ’058 Patent is currently held unpatentable and because Petitioner has argued it would be a waste of resources to litigate the ’058 Patent, in

furtherance of the Memo’s “aim to improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, [and] reduce pendency in *ex parte* appeals,” the Director should exercise her discretion and deny institution. *Memo*, 3.

B. The Unpatentability Challenges in the Petition Are Weak.

The Director should also exercise its discretion and deny institution because, as will be more fully explained in Patent Owner’s Preliminary Response, Petitioner’s unpatentability challenge is weak.

The claimed invention of the ’058 Patent relates to systems and methods for determining the duration that media is presented on one device in a first location using that device’s tuning data by relying on additional data from a second device at a second location. Ex. 1001, ’058 *Patent*, Abstract. Figure 1 depicts an example environment employing the claimed invention:

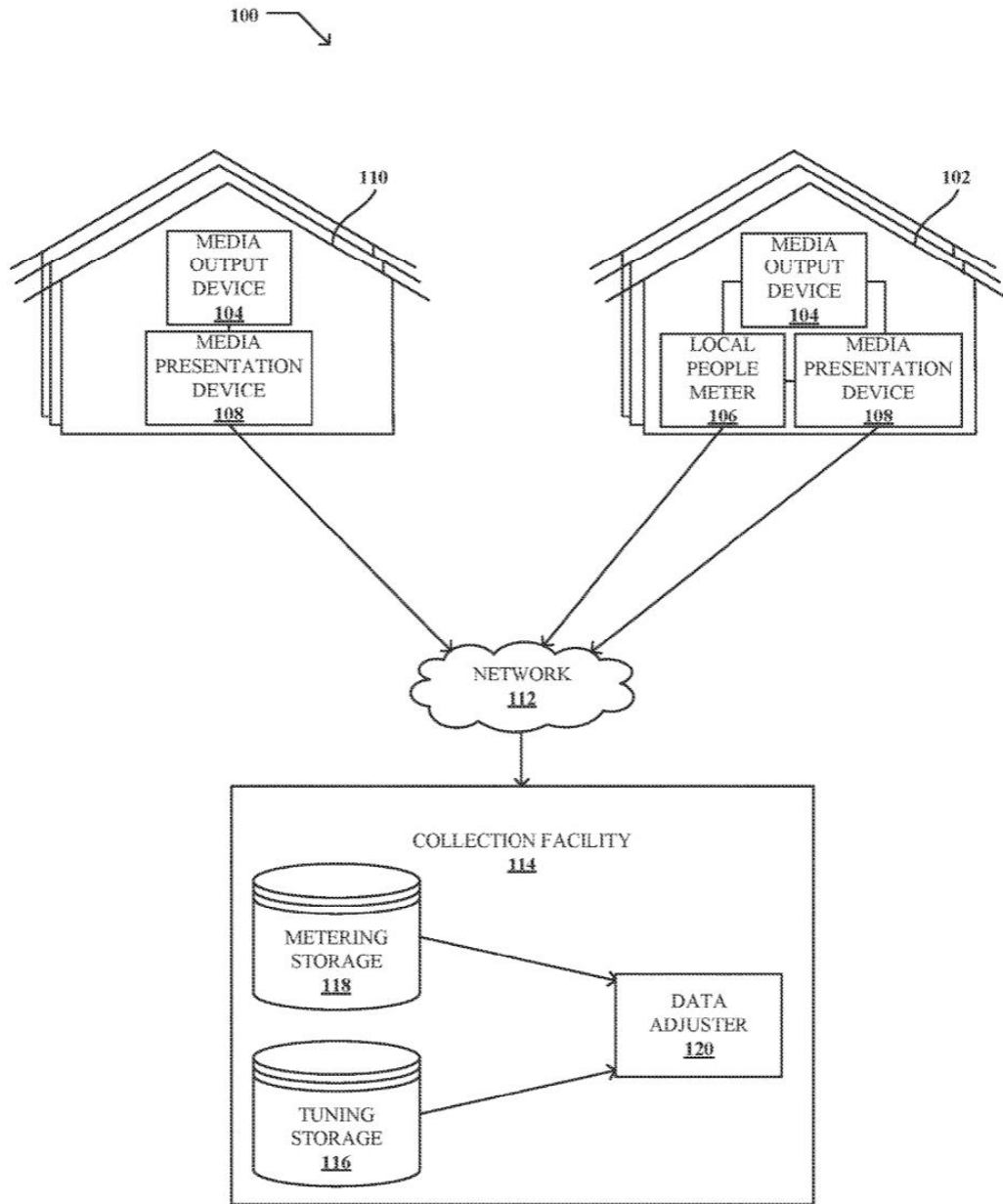


FIG. 1

Id., FIG. 1. As shown, environment 100 includes a first example media presentation location 102, having a local people meter (“LPM”) 106 that collects metering data like media exposure timestamps and on/off status, among others, and a second example media presentation location 110 lacking an LPM. *Id.*, 4:30–37, 7:38–48.

Both locations include media output devices 104, e.g., a television, and media presentation devices 108, e.g., a set top box. *Id.*, FIG. 1, 4:65–5:1, 5:54–55. Media presentation devices 108 “transmit[] tuning data related to tuned channels while the media presentation 108 is on” to a collection facility 114. *Id.*, 5:66–6:2. Thus, the collection facility collects tuning data from both locations, but only collects metering data like media exposure timestamps and on/off status from the first location. Then, a “data adjuster 120 creates model(s) based on the collected metering data” from the first location 102 and uses the models to estimate presentation sessions for tuning sessions received from the media presentation device of the second location 110 (that lacks an LPM). *Id.*, 4:26–50, 7:57–8:5, 8:24–27.

Essentially, the claimed invention relies on devices that collect *both* tuning data and presentation session durations (claims 1 and 11) or on/off durations (claim 15) to determine presentation session durations (claim 1 and 11) or on/off durations (claim 15) for devices at locations where *only* tuning session durations are collected.

Essentially, the claimed invention uses devices with *both* presentation session durations (claim 1) or on/off durations (claim 15) and tuning session durations to determine presentation session durations for devices where *only* tuning session durations are available.

Petitioner argues that U.S. Pat. Pub. No. 2016/0249098 to Pecjak, et al. (“Pecjak”) in view of U.S. Patent No. 9,204,188 to Mirisola, et al. (“Mirisola”) renders obvious independent claims 1 and 15 of the ’058 Patent, along with some of the dependent claims. *Pet.*, at 1. For independent claim 1, Petitioner relies on Pecjak for the limitations relevant to the ’058 Patent’s system/method described above. *Pet.*, 13–20, 27–31, 34–39. For independent claim 15, Petitioner relies on Pecjak for the *accessing tuning session data* limitation and argues a POSITA would have understood Pecjak also provides on/off durations, but also advances an alternative mapping that further relies on Mirisola to teach the claimed on/off data. *Id.* at 67–71, 72–75.

The fundamental weakness in Petitioner’s challenges stems from the fact that Pecjak is directed to a fundamentally different goal than the ’058 Patent: attempting to *allocate tuning data* among different demographics rather than attempting to *estimate actual viewing time* from tuning data. As shown in Figure 1, Pecjak’s system collects entirely different data sets from two distinct groups—tuning data from non-panelist household STBs 112 and viewing data from panelist household viewing monitors 132:

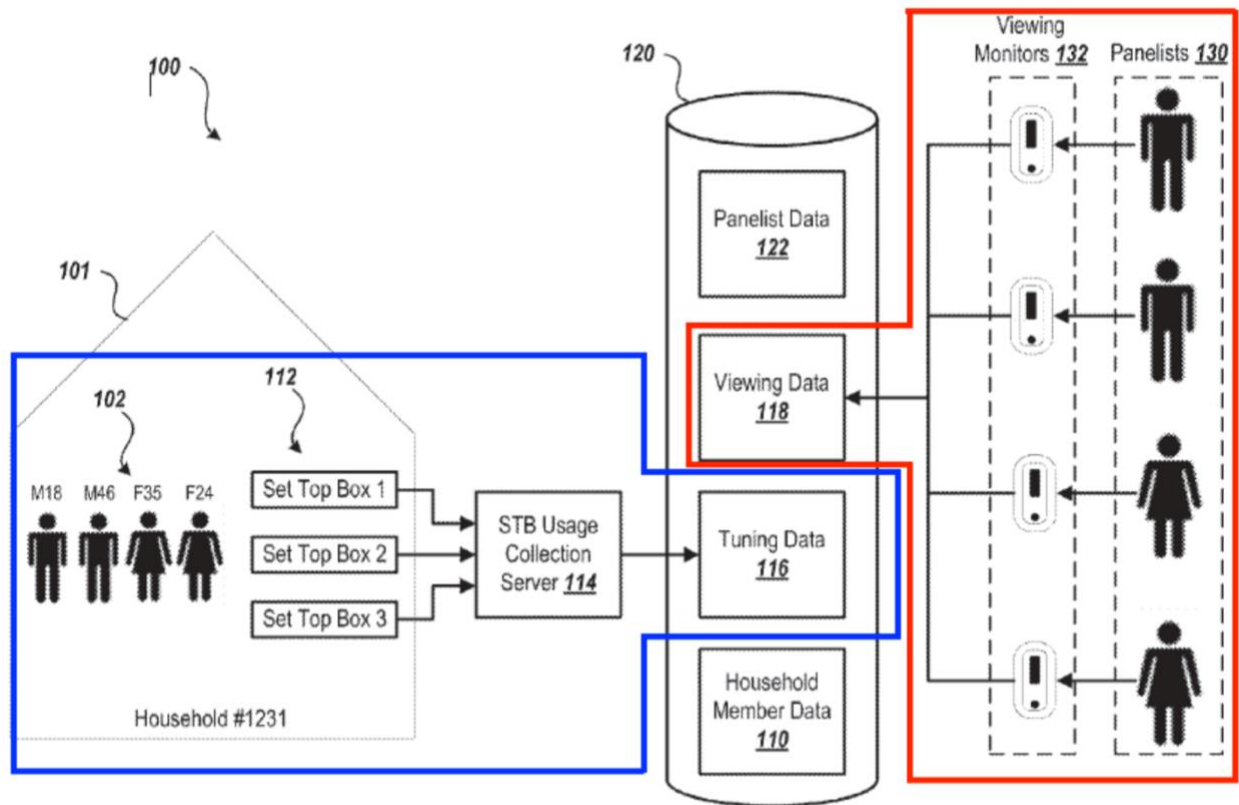


FIG. 1

Ex. 1005, FIG. 1 (annotated). Thus, on its face Pecjak alone *cannot* satisfy the requirements of claim 1 because neither the data collected from the non-panelist households nor the data collected from the panelist households amounts to the proper combination of data needed to create the claimed model, namely, tuning data and presentation data for a single household. Moreover, for at least the reason that Pecjak's system does not collect the data needed to create the claimed model, it follows that Pecjak's system also fails to teach or suggest utilizing a properly created model as claimed.

Turning to claim 15, Petitioner relies on Pecjak or, alternatively, Mirisola as purportedly teaching how television on/off data can be collected concurrently with tuning data by an STB connected to the television. Pet., 68–70. But as just explained, in Pecjak’s system, panelist households only rely on viewing monitors, not STBs, so even if Pecjak’s STB’s were modified to collect on/off data, Petitioner’s mapping for claim 15 suffers from one of the fatal flaws affecting claim 1—no tuning data is collected from the panelist households. Nor can Petitioner cure that flaw by attempting to rely solely on non-panelist households, as such a system would become useless for estimating demographic data—the very problem that Pecjak sets out to solve. These defects demonstrate substantial weakness in Petitioner’s unpatentability challenges, further supporting the Director’s exercise of her discretion to deny institution

IV. CONCLUSION

For the reasons provided herein, the Director should exercise its discretion and deny institution of Petitioner’s *inter partes* review.

Respectfully submitted,

/Jennifer C. Bailey/

Jennifer C. Bailey, Reg. No. 52,583

Robin Snader, Reg. No. 66,085

Virginia Brown, Reg. No. 80,538

ERISE IP, P.A.

7015 College Boulevard, Suite 700

Overland Park, Kansas 66211

Telephone: (913) 777-5600

Facsimile: (913) 777-5601
Jennifer.Bailey@eriseip.com
Robin.Snader@eriseip.com
Virginia.Brown@eriseip.com
PTAB@eriseip.com

ATTORNEYS FOR PATENT OWNER

APPENDIX OF EXHIBITS

Exhibit 2001	The Nielsen Company (US), LLC v. VideoAmp, Inc., No. 24-123-RGA, Dkt. 21 (D. Del. Mar. 31, 2025) (“ <i>Memorandum Opinion</i> ”)
Exhibit 2002	2024 Federal Circuit IP Appeals Summaries of Key 2024 Decisions, Sterne Kessler (“ <i>Sterne Kessler Report</i> ”)
Exhibit 2003	The Nielsen Company (US), LLC v. VideoAmp, Inc., No. 24-123-RGA, Dkt. 9 (D. Del. April 22, 2024) (“ <i>Motion to Dismiss</i> ”)

CERTIFICATION OF WORD COUNT

The undersigned certifies pursuant to 37 C.F.R. § 42.24 that the foregoing Patent Owner's Brief in Support of Discretionary Denial, excluding any table of contents, mandatory notices under 37 C.F.R. § 42.8, certificates of service or word count, or appendix of exhibits, contains 2,160 words according to the word-processing program used to prepare this document (Microsoft Word).

Dated: April 23, 2025

Respectfully submitted,

/Jennifer C. Bailey/

Jennifer C. Bailey, Reg. No. 52,583

Robin Snader, Reg. No. 66,085

Virginia Brown, Reg. No. 80,538

ERISE IP, P.A.

7015 College Boulevard, Suite 700

Overland Park, Kansas 66211

Telephone: (913) 777-5600

Facsimile: (913) 777-5601

Jennifer.Bailey@eriseip.com

Robin.Snader@eriseip.com

Virginia.Brown@eriseip.com

PTAB@eriseip.com

ATTORNEYS FOR PATENT OWNER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL was served on April 23, 2025, by email on the following counsel of record for Petitioner:

Fish & Richardson P.C.

Usman A. Khan

Aamir Kazi

W. Karl Renner

60 South Sixth Street, Suite 3200

Minneapolis, MN 55402

IPR57824-0002IP1@fr.com

PTABInbound@fr.com

Dated: April 23, 2025

Respectfully submitted,

/Jennifer C. Bailey/

Jennifer C. Bailey, Reg. No. 52,583

jennifer.bailey@eriseip.com

ATTORNEY FOR PATENT OWNER