

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,  
Petitioner,

v.

HBAC MATCHMAKER MEDIA, INC.,  
Patent Owner.

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Case CBM2016-00097  
Patent 6,002,393

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Before TRENTON A. WARD, GEORGIANNA W. BRADEN, and  
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* BRADEN.

Dissenting opinion filed by *Administrative Patent Judge* PAULRAJ.

DECISION

Denying Institution of Covered Business Method Patent Review  
*37 C.F.R. § 42.208*

## I. INTRODUCTION

Google Inc., (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute a covered business method patent review of claims 1–70 of U.S. Patent No. 6,002,393 (Ex. 1001, “the ’393 patent”). HBAC Matchmaker Media, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

After filing its Petition, but before Patent Owner filed its Preliminary Response, the U.S. Court of Appeals for the Federal Circuit issued a decision in *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 1376 (Fed. Cir. 2016) (“*Unwired Planet*”), which provided guidance regarding the financial prong of the covered business method patent eligibility test. *Id.* at 1379, 1382. Given this case law, we afforded Petitioner an opportunity to file a supplemental brief to explain how the Federal Circuit’s guidance in *Unwired* impacts this proceeding.<sup>1</sup> Petitioner filed a Supplemental Brief that was tailored narrowly to address this issue. Paper 12 (“Pet. Suppl. Brief”). Patent Owner then filed a Reply to Petitioner’s Supplemental Brief. Paper 13 (“PO Reply”).

We have statutory authority under 35 U.S.C. § 324. Pursuant to 35 U.S.C. § 324(a), the Director may not authorize a covered business method patent review unless the information in the petition, if unrebutted, “would demonstrate that it is more likely than not that at least 1 of the claims

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<sup>1</sup> Shortly before this Decision issued, the Federal Circuit issued its decision in *Secure Access v. PNC Bank et al.*, case no. 2016-01353 (Fed. Cir. Feb. 21, 2017). The parties did not have the opportunity to address the holding in *Secure Access* or any possible bearing it may have had on the present case. The Court in *Secure Access* reached a similar outcome as that in *Unwire Planet*, and we find that its holding does not alter the outcome or analysis presented in this Decision.

challenged in the petition is unpatentable.” *See also* 37 C.F.R § 42.4(a) (delegating authority to the Board).

Taking into account the arguments presented in Patent Owner’s Preliminary Response and Petitioner’s Supplemental Brief, we determine that the information presented in the Petition does not establish that the ’393 patent qualifies as a covered business method patent, as defined by § 18(d)(1) of the AIA.<sup>2</sup> Accordingly, we decline to institute a covered business method patent review of claims 1–70 of the ’393 patent.

## II. BACKGROUND

### A. *Related Proceedings*

The parties inform us that the ’393 patent is the subject of district court case *HBAC Matchmaker Media, Inc. v. Google Inc. et al.*, Case No. 1:13-cv-00429 (D. Del. Mar. 15, 2013). Pet. 3 (citing Ex. 1003); *see* Paper 4, 2 (Patent Owner’s Mandatory Notices). The parties further inform us that the ’393 patent is the subject of several related district court cases. Pet. 4; Paper 4, 2–3.

### B. *The ’393 Patent*

The ’393 patent is titled “System and Method for Delivering Targeted Advertisements to Consumers Using Direct Commands,” and discloses systems and methods for providing video delivery system operators

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<sup>2</sup> *See* Section 18(a)(1) of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284, 329–31 (2011) (“AIA”), which provides that the transitional program for covered business method patents will be regarded as a post-grant review under Chapter 32 of Title 35 of the United States Code, and will employ the standards and procedures of a post-grant review, subject to certain exceptions.

processes to increase the effectiveness of delivering specific video signals to specific users. Ex. 1001, Title, Abst., 2:1–4. One embodiment of the '393 patent provides a system that analyzes and categorizes customers, commercials, and television programs with the results stored in databases. *Id.* at 6:40–44. According to the '393 patent, the information in the databases is used to construct instruction governing the display of commercials that will be transmitted to display sites. *Id.* at 6:44–47. Figure 1, reproduced below, illustrates an exemplary architecture for such a system.

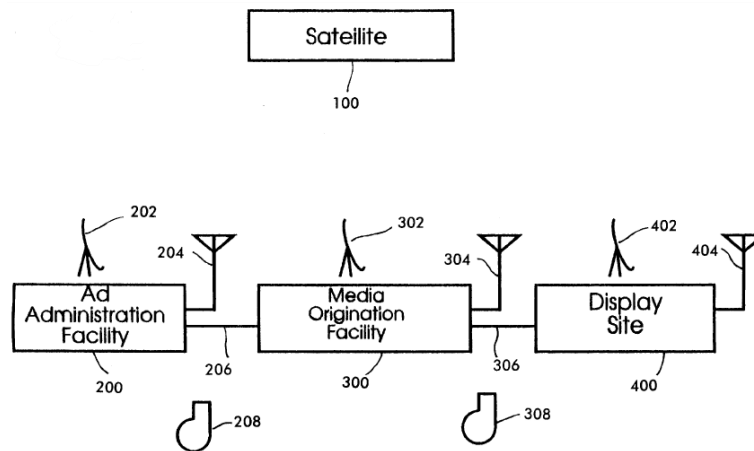
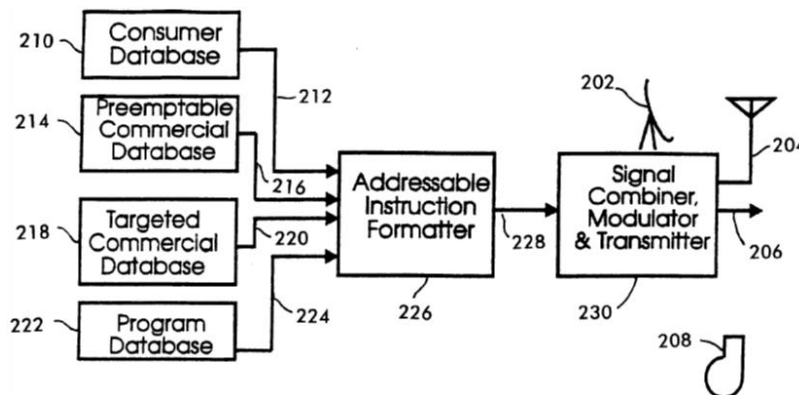


Figure 1, above, shows certain components of one embodiment of the '393 patent, including Ad Administration Facility 200, Media Origination Facilities 300, display or reception site 400, and satellite 100. Ex. 1001, 6:22, Fig. 1. Ad Administration Facility 200 distributes the targeted commercial display instructions to a plurality of Media Origination Facilities 300 via satellite 100 using uplink antenna 202 and downlink antennas 302. *Id.* at 6:48–51. Alternatively, the '393 patent discloses that for Media Origination Facilities 300 in close proximity, antenna 204 can be used to transmit some or all of the targeted commercial display instructions to antennas 304 at Media Origination Facilities 300. *Id.* at 6:52–55. The

'393 patent contemplates that electrical and/or optical link 206 could be used as well as physical conveyance of the targeted commercial display instructions by physical means 208, such as optical or magnetic tapes or disks or other suitable means. *Id.* at 6:55–59. According to the '393 patent, Media Origination Facility 300 also receives programming and commercials from other sources and creates some programming and commercials in its own facilities. *Id.* at 6:59–62.

The '393 patent further discloses that the package of programming and processed commercials and targeted commercial display instructions is conveyed to display site 400 (reception site) via electrical and/or optical links 306, or radio transmission via antenna 304 and 404, or via satellite 100 and antennas 304 and 404, or even via physical means 308 such as optical or magnetic tapes or disks or other suitable means. *Id.* at 6:63–7:2.

Another embodiment of the '393 patent provides for details of Ad Administration Facility 200, shown in Figure 2a, reproduced below.



According to the '393 patent, Ad Administration Facility 200, shown above in Figure 2a, is where the characteristics of those viewing or hearing the commercials are analyzed and categorized and the results stored in Consumer Database 210. *Id.* at 7:8–11. Data in Consumer Database 210 is conveyed by connection 212 to Addressable Instruction Formatter 226. *Id.*

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