

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES, INC.,
Petitioner,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2017-01237
Patent 8,914,840 B2

Before JAMESON LEE, KEN B. BARRETT, and JOHN F. HORVATH,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
Grant of Motion for Joinder
37 C.F.R. §§ 42.108, 42.122(b)

I. INTRODUCTION

A. Background

On April 3, 2017, AT&T Services, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute *inter partes* review of claims 1–5, 16, 18–20, 24, 32, 34, 35, 37, 38, 42, 44, 47, 51–56, and 59–62 (“the challenged claims”) of U.S. Patent No. 8,914,840 B2 (Ex. 1031, “the ’840 patent”), together with a Motion for Joinder to join Case IPR2016-01814 (Paper 3, “Mot.”). *See* Mot. 2. We instituted trial in Case IPR2016-01814 on March 3, 2017. *See Netflix, Inc. v. Convergent Media Solutions, LLC*, Case IPR2016-01814, slip op. at 23–24 (PTAB Mar. 3, 2017) (Paper 7). Convergent Media Solutions, LLC, (“Patent Owner”, “CMS”) waived its right to file a Preliminary Response to the Petition (Paper 8), but filed an Opposition to the Motion for Joinder (Paper 9, “Opp.”). AT&T filed a Reply to CMS’ Opposition (Paper 10, “Reply”).

Absent AT&T’s Motion for Joinder, AT&T’s Petition would be barred under 35 U.S.C. § 315(b) because it was filed more than one year after AT&T was served with a complaint alleging infringement of the ’840 patent. *See* Opp. 4; Exs. 2001, 2002 (showing Petitioner was served with a complaint alleging infringement of the ’840 patent on November 10, 2015, and answered the complaint on November 30, 2015). However, as explained in § II.E *infra*, because the time bar does not apply to petitions that are (a) filed with a motion for joinder, and (b) within one month of the institution decision of the *inter partes* review sought to be joined, AT&T’s Petition is not time-barred. *See* 37 C.F.R. §§ 42.101(b), 42.122(b).

Accordingly, upon consideration of the Petition, and in the absence of a preliminary response from Patent Owner, we are persuaded, under

35 U.S.C. § 314(a), that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claims of the '840 patent. Accordingly, we institute an *inter partes* review of these claims.

B. Related Matters

Petitioner identifies the following as matters that could affect, or be affected by, a decision in this proceeding: *Convergent Media Solutions LLC v. AT&T Inc.*, Case No. 3:15-cv-02156 (N.D. Tex.), the latter being a lead case consolidating individual cases brought by Convergent Media Solutions LLC against AT&T Inc., Netflix, Inc., and Roku, Inc. Pet. 2. Patent Owner identifies the same matters, indicating the individual cases brought against Netflix and Roku have been settled, and joint stipulations for their dismissal from the consolidated case have been filed. Paper 5, 2. Patent Owner also identifies the following instituted *inter partes* review as a matter that could affect, or be affected by, a decision in this proceeding: *Netflix, Inc. v. Convergent Media Solutions LLC*, Case IPR2016-01814 (PTAB 2016). *Id.* at 3.

C. Evidence Relied Upon

Reference		Date	Exhibit
Zintel	US 6,910,068 B2	Mar. 16, 2001 (filed)	Ex. 1003
Elabbady	US 7,483,958 B1	Mar. 26, 2002 (filed)	Ex. 1004
Palm	US 2001/0042107 A1	Jan. 8, 2001 (filed)	Ex. 1006
Katz	US 7,103,906 B1	Sept. 29, 2000 (filed)	Ex. 1033

Petitioner also relies on the Declaration of Andrew Wolfe, Ph.D. Ex. 1028.

D. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

References	Basis	Claims Challenged
Elabbady, Palm, and Zintel	§ 103(a)	1–5, 16, 18–20, 24, 32, 34, 35, 37, 38, 44, 47, 51–53, 56, and 59–62
Elabbady, Palm, Zintel, and Katz	§ 103(a)	42, 54, and 55

II. ANALYSIS

A. The '840 Patent

The '840 patent relates to systems and methods for navigating hypermedia using multiple coordinated input/output device sets. Ex. 1031, 3:4–6. The method allows “a user and/or an author to control what resources are presented on which device sets.” *Id.* at 3:6–8. The device sets may include laptops, desktops, tablets, personal digital assistants (PDAs), televisions (TVs), set-top boxes, video cassette recorders (VCRs) and digital video recorders (DVRs). *Id.* at 16:29–36, 18:25–19:40. The term hypermedia refers to “any kind of media that may have the effect of a non-linear structure of associated elements,” and includes “graphics, video, and sound.” *Id.* at 7:4–13. The '840 patent characterizes video and sound as examples of “continuous media,” or a “representation of ‘content’ elements that have an intrinsic duration, that continue (or extend) and may change over time.” *Id.* at 19:65–20:2.

The multiple input/output device sets described in the '840 patent may be coordinated using “a device set management process that performs basic setup and update functions . . . to pre-identify and dynamically discover

device sets.” Ex. 1031, 37:28–35. This management process can “be based on and compatible with related lower-level processes and standards defined for linking such existing devices and systems . . . based on UPnP, HAVi, OSGi, Rendezvous and/or the like.” *Id.* at 37:38–42. The process enables basic communications among the devices in the device set, and “provide[s] discovery, presence, registration, and naming services to recognize and identify devices as they become available to participate in a network, and to characterize their capabilities.” *Id.* at 37:42–47.

Claims 1 and 59–61 of the ’840 patent are independent. Claim 1, reproduced below, is illustrative. Each of the other challenged claims depends from claim 1 or claim 61.

1. A method for use in a second computerized device set which is configured for wireless communication using a wireless communications protocol that enables wireless communication with a first computerized device set, wherein the first and second computerized device sets include respective first and second continuous media players, the method comprising:

receiving discovery information that is obtained at the second computerized device set in accordance with a device management discovery protocol that is implemented at a communication layer above an internet protocol layer, and wherein the discovery information allows a determination to be made at the second computerized device set that the first computerized device set is capable of receiving and playing continuous media content;

enabling navigation of a listing of on-demand continuous media content items, the on-demand

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