

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner,

v.

MONKEYMEDIA, INC.,
Patent Owner.

Case IPR2018-00059
Patent 9,247,226 B2

Before MARC S. HOFF, LYNNE E. PETTIGREW, and
KAMRAN JIVANI, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Unified Patents, Inc. (“Petitioner”) requested an *inter partes* review of claims 1–12 (the “Challenged Claims”) of U.S. Patent No. 9,247,226 B2 (Ex. 1001, “the ’226 patent”). Paper 2 (“Petition” or “Pet.”).

MONKEYmedia, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (confidential version), Paper 12 (redacted version) (“Prelim. Resp.”). Petitioner then filed a Reply to that Preliminary Response. Paper 11 (“Pet. Reply”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless it is determined that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. Based on the information presented in the Petition and Preliminary Response, we are persuaded that there is a reasonable likelihood Petitioner would prevail with respect to claims 1 and 7 on Petitioner’s asserted combination of Lavallee, Gibson, Cohen, and Strickland. We are not persuaded, however, that there is a reasonable likelihood Petitioner would prevail with respect to claims 1–10 on Petitioner’s asserted combination of Davenport and Efrat because Petitioner does not properly account for all the limitations of independent claims 1 and 7 in its analysis of Davenport. Similarly, we are also not persuaded that there is a reasonable likelihood Petitioner would prevail with respect to claims 11 and 12 based on Petitioner’s asserted combination of Davenport, Efrat, and Bartok.

Accordingly, we institute an *inter partes* review of claims 1 and 7 on the ground specified below. We further decline to institute an *inter partes* review of claims 2–6 and 8–12, for the reasons set forth below.

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This is not a final decision as to patentability of claims for which *inter partes* review is instituted.

II. BACKGROUND

A. *The '226 patent (Ex. 1001)*

The '226 patent concerns a method for playing a stored content providing a plurality of segments which collectively contain the stored content. Ex. 1001, 7:31–33. Each of the segments has a first terminus and a second terminus, where the content in each of the segments has a temporal flow from the first terminus to the second terminus. *Id.* at 7:33–36. At least one segment is associated with a plurality of links to a corresponding plurality of other segments. *Id.* at 7:36–38. “The method includes playing at least one segment with the temporal flow, determining whether a content expansion is desired prior to reaching the second terminus. If content expansion is desired, the method links to an expansion segment and playing the expansion segment.” *Id.* at 7:39–43. If content expansion is not desired, the method “links to a continuing segment and playing the continuing segment.” *Id.* at 7:44–45. “The method includes an additional link from the expansion segment to the continuing segment such that the continuing segment is played after the expansion segment has been played.” *Id.* at 7:39–48.

Figure 3B of the '226 patent is reproduced below.

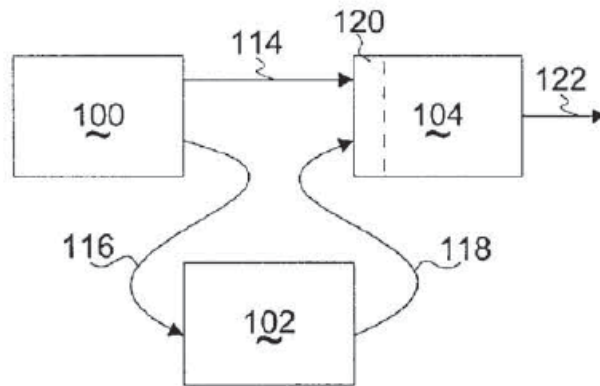


Figure 3B “schematically depicts the segment links between continuous play media segments.” *Id.* at 11:25–26. As described in the '226 patent, Figure 3B illustrates a continuous play media segment 100 having “two links 114 and 116 to other continuous play media segments.” *Id.* at 12:42–43. Continuity link 114 connects to the start 120 of continuous play media segment 104. *Id.* at 12:44–45. The temporal start of a segment or frame sequence is denoted as the first terminus and the temporal end of a segment of frame sequence is denoted as the second terminus. *Id.* at 12:45–48. “Continuous play media segment 100 contains an expansion link 116 to continuous play media segment 102. Continuous play media segment 102 contains a link 118 to continuous play media segment 104.” *Id.* at 12:48–52.

The method of the invention includes playing the stored content segment with temporal flow [e.g., segment 100 in Figure 3B] and determining whether a content expansion is desired prior to reaching the second terminus. *Id.* at 9:42–45. If the content expansion is desired, the method calls for linking to an expansion segment (e.g., segment 102 in

Figure 3B) and playing said expansion segment. *Id.* at 9:45–46. If the content expansion is not desired, the method calls for linking to a continuing segment of stored content (e.g., segment 104 in Figure 3B) and playing said continuing segment. *Id.* at 9:47–49. There is an additional link from the expansion segment of stored content to the continuing segment of stored content, such that the continuing segment of stored content is played after the expansion segment of stored content has been played. *Id.* at 9:45–53.

During prosecution, the claims of the '226 patent were amended to include the phrase “interruption terminus of the first portion” in place of “the second terminus of the first segment.” The claims were further amended to include the phrase “resume-point terminus of a continuing portion” in place of “the first terminus of a continuing segment.” *Compare* Ex. 1002, 51 (Prosecution History of the '226 patent) *with* Ex. 1002, 97. Thus, the claim phrases “interruption terminus of the first portion” and “resume-point terminus of a continuing portion” do not appear in the originally filed Specification or claims.

B. Challenged Claims

Claims 1 and 7 are independent. Claims 2–6 depend from claim 1. Claims 8–12 depend from claim 7. Claim 1 is reproduced below:

1. One or more tangible computer readable storage media (wherein said computer readable storage media is not a propagated signal(s)) storing instructions that when executed by a computer are capable of causing the computer to:
 - a. begin fetching a primary content comprising a primary content continuous play media stream;
 - b. generate a signal to display a first portion of the primary content continuous media stream comprising a first stored audio and/or visual content of the primary content continuous play media stream, wherein an

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