UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FREE STREAM MEDIA CORP.,
D/B/A SAMBA TV,
Petitioner,

v.

GRACENOTE, INC.,
Patent Owner.

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IPR2020-00216
Patent 9,066,114 B2

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Before MICHELLE N. ANKENBRAND, GARTH D. BAER, and
AARON W. MOORE, *Administrative Patent Judges.*

BAER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Free Stream Media Corp. d/b/a Samba TV ("Petitioner") requests an *inter partes* review of claims 1–14 and 16–24 of U.S. Patent No. 9,066,114 B2 ("the '114 patent," Ex. 1001). Paper 1 ("Pet."). Gracenote, Inc. ("Patent Owner") filed a Preliminary Response. Paper 12 ("Prelim. Resp.").

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). We may not institute an *inter partes* review "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

Applying that standard, and upon considering the information presented in the Petition and the Preliminary Response, we determine Petitioner does not show a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claims. Accordingly, we do not institute an *inter partes* review of claims 1–14 and 16–24 of the '114 patent.

II. BACKGROUND

A.   The '114 Patent

The '114 patent, titled "Method and Device for Generating and Detecting a Fingerprint Functioning as a Trigger Marker in a Multimedia Signal," issued on June 23, 2015. Ex. 1001, [45], [54]. The '114 patent relates to a method and device for associating and detecting trigger information with a multimedia signal. *Id*. at 1:14–21.

The written description explains that more interactive television viewing or music listening experiences are created by "'connecting' external actions to a piece of video and/or audio content." *Id.* at 1:22–26. Facilitating this function requires enabling "reliable detection of time points

in a television program, a movie, a music piece, etc. where such additional information is relevant." *Id.* at 1:29–32. Previous methods of marking time points suffered from disadvantages such as relying on broadcaster cooperation to insert time triggers, cooperation of all actors in a broadcast chain to not destroy time marking, or altering the video/audio through watermarking. *Id.* at 1:33–2:35.

The '114 patent purportedly enables "simple, reliable and accurate localisation of a given part of a multimedia signal" and "detection of trigger actions without modifying the multimedia signal." *Id.* at 2:40–45. The '114 patent purportedly achieves this by using a fingerprint as a time marker to trigger actions. *Id.* at 3:7–11. To do this, a fingerprint is generated "on the basis of a part, segment, etc. . . . of the multimedia signal (101), where the segment of the multimedia signal (101) is unambiguously related with the given time point." *Id.* at 4:15–19. The fingerprint is stored for later use in a database, memory, storage, and/or the like. *Id.* at 5:5–10. The fingerprint serves as "an identifier which is computed over that piece of audio or video and which does not change even if the content involved is subsequently transcoded, filtered or otherwise modified." *Id.* at 3:20–24.

According to the '114 patent, detection of the fingerprint occurs during playback of the multimedia signal on a playback device. *Id.* at 5:43–48. During playback, a fingerprint stream is generated from the multimedia signal. *Id.* at 5:48–55. Upon detecting a match between a segment of the fingerprint stream and a fingerprint in the database, the invention determines the time point indicated by the fingerprint and executes the actions associated with that time point. *Id.* at 5:65–6:24.

B. Illustrative Claims

Petitioner challenges claims 1–14 and 16–24 of the '114 patent.
Pet. 1. Of the challenged claims, claims 1, 8, 10, 11, 20, and 21 are independent. Claim 1 is illustrative of the subject matter in claims 1–10 and recites:

> 1. A method comprising:
>
> determining a plurality of trigger fingerprints from content being played back on a playback device, each trigger fingerprint identifying a corresponding trigger time point of a sequence of trigger time points in the content and at which trigger time point at least one corresponding action is to be triggered, the determining being performed by a processor;
>
> accessing a database that includes a plurality of reference fingerprints, previously derived from the content, and a plurality of reference actions, each reference fingerprint identifying at least one corresponding reference action to be performed at a reference time point identified by the reference fingerprint;
>
> identifying the corresponding reference action by obtaining a match in the database between a trigger fingerprint among the plurality of trigger fingerprints and a reference fingerprint among the plurality of reference fingerprints; and
>
> performing a reference action that corresponds to the reference fingerprint on the playback device.

Ex. 1001, 8:6–26.

Claim 11 is illustrative of the subject matter in claims 11–14 and 16–24 and recites:

> 11. A method comprising:
>
> accessing segments of content, a segment among the segments being associated with a corresponding action to be triggered during playback of the segment;

generating a reference fingerprint of the segment associated with the corresponding action, the generating being performed by a processor;

assigning the reference fingerprint of the segment to the corresponding action that is to be triggered during playback of the segment of the content;

providing access to the reference fingerprint of the segment to a playback device configured to match the reference fingerprint to a playback fingerprint derived from the segment by the playback device; and

providing the identifier of the corresponding action to the playback device based on the reference fingerprint matching the playback fingerprint, the provided identifier causing the playback device to trigger the corresponding action during the playback of the segment.

Id. at 9:34–52.

C. The Asserted Ground of Unpatentability

Petitioner challenges the patentability of 1–14 and 16–24 of the '114 patent based on the following ground:

Claims Challenged	35 U.S.C. §[1]	References
1–14, 16–24	103	Murphy[2] and Brunk[3]

Pet. 15–20. Petitioner relies on the Declaration of Ahmed H. Tewfik, Sc.D. (Ex. 1007) to support its asserted grounds of unpatentability. In arguing against the asserted grounds of unpatentability, Patent Owner relies on the Declaration from Dr. Pierre Moulin (Ex. 2001).

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[1] Because the claims at issue have an effective filing date before March 16, 2013, the effective date of the applicable provisions of the Leahy Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) ("AIA"), we apply the pre-AIA version of 35 U.S.C. §§ 102 and 103 in this decision.
[2] GB 2 375 907 A, published Nov. 27, 2002 (Ex. 1011, "Murphy").
[3] US 2002/0126872, published Sept. 12, 2002 (Ex. 1012, "Brunk").

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