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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IPR2020-00218
Patent 9,479,831 B2

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

ANKENBRAND, *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 1–29 of U.S. Patent No. 9,479,831 B2 ("the '831 patent," Ex. 1003). 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 claim. Accordingly, we do not institute an *inter partes* review of claims 1–29 of the '831 patent.

II.   BACKGROUND

A.   The '831 Patent

The '831 patent, titled "Method and Device for Generating and Detecting a Fingerprint Functioning as a Trigger Marker in a Multimedia Signal," issued on October 25, 2016. Ex. 1003, at [45], [54]. The '831 patent relates to a method and device for "detecting one or more trigger actions in a multimedia signal." *Id.* at 2:46–48.

The written description explains that "'connecting' external actions to a piece of video and/or audio content" creates a more interactive television viewing or music listening experience. *Id.* at 1:30–34. 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 1:37–40. 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 1:41–2:43.

The '831 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 2:48–53. The '831 patent purportedly achieves this by using a fingerprint as a time marker to trigger actions. *Id.* at 3:16–20. 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 4:25–29. The fingerprint is stored for later use in a database, memory, storage, and/or the like. *Id.* at 5:18–23. 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 3:29–33.

According to the '831 patent, detection of the fingerprint occurs during playback of the multimedia signal on a playback device. *Id.* at 5:56–61. During playback, a fingerprint stream is generated from the multimedia signal. *Id.* at 5:61–6:1. 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 6:12–6:36.

B.   Illustrative Claim

Petitioner challenges claims 1–29 of the '831 patent. Pet. 1. Of the challenged claims, claims 1, 11, 19, and 24 are independent. Claim 1 is illustrative of the subject matter in claims 1–29 and recites:

1. A method comprising:

playing back multimedia content on a multimedia playback device, including providing at least some of the multimedia content on a display associated with the multimedia playback device;

determining, by a processor of the multimedia playback device, a trigger fingerprint from a segment of the multimedia content being played back on the multimedia playback device;

accessing a plurality of reference fingerprints, each reference fingerprint among the plurality of reference fingerprints having been previously derived from a respective segment of the multimedia content and associated with at least one corresponding reference action;

obtaining a match between the trigger fingerprint and a particular reference fingerprint among the plurality of reference fingerprints;

identifying a particular corresponding reference action associated with the particular reference fingerprint, the particular corresponding reference action being associated with a time point indicating when, in the multimedia content, the particular corresponding reference action is to be performed; and

performing, by the processor of the multimedia playback device, the particular corresponding reference action, wherein performance of the particular reference action causes the multimedia playback device to provide, on the display associated with the multimedia playback device, information related to the segment of the multimedia content.

Ex. 1003, 8:31–60.

C.   *The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–29 of the '831

patent based on the following grounds:

Claims Challenged	35 U.S.C. §[1]	References
1, 2, 5, 8–13, 15, 16, 18–21, 23–29	103(a)	Murphy[2] or Murphy in view of Brunk[3]
3, 4, 14, 17, 22	103(a)	Murphy in view of Brunk
4–7	103(a)	Murphy in view of Brunk and Kate[4]

Pet. 21. Petitioner relies on the Declaration of Ahmed H. Tewfik, Sc.D.

(Ex. 1009) to support its asserted grounds of unpatentability. In arguing

against the asserted grounds of unpatentability, Patent Owner relies on the

Declaration of Pierre Moulin, Sc.D. (Ex. 2001).

III. ANALYSIS

A.   *Level of Ordinary Skill in the Art*

Petitioner asserts that a person of ordinary skill in the art on

July 11, 2003, would have possessed "a bachelor's degree in computer

science, electrical engineering, or a related discipline and two years of

experience in the relevant technical field—multimedia signal processing,

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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).
[3] US 2002/0126872, published Sept. 12, 2002 (Ex. 1012).
[4] W. Kate et al., trigg&link: *A New Dimension in Television Program
Making*, in Lecture Notes in Computer Science 1197, vol. 1242,
Multimedia Applications, Services and Techniques-ECMAST '97 (Second
European Conference Milan, Italy May 21–23, 1997 Proceedings),
(1997) 51–65 (Ex. 1013).

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