

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner,

v.

DIVX, LLC,
Patent Owner.

IPR2021-01419
Patent 10,257,443 B2

Before BART A. GERSTENBLITH, MONICA S. ULLAGADDI, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Hulu, LLC (“Petitioner”) filed a Petition (Paper 4, “Pet.”) requesting institution of *inter partes* review of claims 1, 2, 4, 7, 8, 10, and 13–16 (“the Challenged Claims”) of U.S. Patent No. 10,257,443 B2 (Ex. 1101, “the ’443 patent”).¹ DivX, LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

At Petitioner’s request, a conference call was held on January 7, 2022, a transcript of which is included in the record. *See* Ex. 1132 (Transcript of Proceedings, Jan. 7, 2022). During the conference call, the parties were authorized to file additional briefing pertaining to two issues—(1) the application of 35 U.S.C. § 325(d) and (2) prosecution history disclaimer. *See id.* at 27:9–31:22. Thereafter, Petitioner filed a Preliminary Reply (Paper 10, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 12, “Prelim. Sur-reply”).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that 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) (2018). For the reasons below, Petitioner has not established a reasonable

¹ This Petition is Petitioner’s second petition challenging claims 1, 2, 4, 7, 8, 10, and 13–16 of the ’443 patent. As noted below, Petitioner also filed a petition challenging the same claims of the ’443 patent in IPR2021-01418. Petitioner filed a Ranking and Explanation of Material Differences Between Petitions (Paper 3), where Petitioner discusses the two petitions. Because of the determination we reach on the merits, we do not address the parties’ arguments as to whether two petitions are necessary.

IPR2021-01419
Patent 10,257,443 B2

likelihood that it would prevail in showing the unpatentability of at least one of the Challenged Claims. Accordingly, we do not institute an *inter partes* review of the Challenged Claims.

B. Related Proceedings

The parties indicate that the '443 patent is asserted in *DivX, LLC v. Hulu, LLC*, 2-21-cv-01615 (C.D. Cal.). Pet. 2; Paper 6 (Patent Owner's Mandatory Notices), 1. Petitioner indicates that the '443 patent is related to U.S. Patent No. 8,472,792 ("the '792 patent"), which is asserted in *DivX, LLC v. Hulu, LLC*, 2-19-cv-01606 (C.D. Cal.), and *DivX, LLC v. Netflix, Inc.*, 2-19-cv-01602 (C.D. Cal.). Pet. 2. Additionally, Petitioner explains that Netflix and Hulu filed a petition challenging claims of the '792 patent in IPR2020-00646. *Id.* Further, Patent Owner notes that Petitioner also challenges claims of the '443 patent in IPR2021-01418. Paper 6, 1.

C. Real Parties in Interest

Petitioner identifies Hulu, LLC and The Walt Disney Company as real parties in interest. Pet. 2. Patent Owner identifies DivX, LLC and DivX CF Investors LLC as real parties in interest. Paper 6, 1.

D. The Asserted Grounds of Unpatentability and Declaration Evidence

Petitioner challenges the patentability of claims 1, 2, 4, 7, 8, 10, and 13–16 of the '443 patent on the following grounds:

Claim(s) Challenged	35 U.S.C. §²	Reference(s)/Basis
1, 2, 4, 7, 8, 10, 13–16	103(a)	Notoya, ³ Matsui, ⁴ Candelore-I, ⁵ Candelore-II ⁶
4, 10, 16	103(a)	Notoya, Matsui, Candelore-I, Candelore-II, Mowry ⁷

Pet. 4–5. Petitioner supports its challenge with a Declaration of Dr. James A. Storer (Ex. 1102) and a Declaration of Dr. Sylvia Hall-Ellis (Ex. 1127). Patent Owner supports its arguments with a Declaration of Professor Chandrajit Bajaj, Ph.D. (Ex. 2002).

² The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '443 patent has an effective filing date before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability.

³ WO 03/092285 A1, published Nov. 6, 2003 (Ex. 1104, “Notoya”). Exhibit 1104 includes a translator certification, an English-language translation of the reference, and the original Japanese-language version of the reference. Citations herein are to the English-language translation.

⁴ WO 03/101114 A1, published Dec. 4, 2003 (Ex. 1107, “Matsui”).

⁵ U.S. Patent Application Publication No. 2003/0133570 A1, published July 17, 2003 (Ex. 1105, “Candelore-I”).

⁶ U.S. Patent Application Publication No. 2004/0049694 A1, published Mar. 11, 2004 (Ex. 1106, “Candelore-II”).

⁷ U.S. Patent Application Publication No. 2004/0253942 A1, published Dec. 16, 2004 (Ex. 1108, “Mowry”).

E. The '443 Patent

The '443 patent is directed to a “multimedia distribution system for multimedia files with interleaved media chunks of varying types.” Ex. 1101, code (54) (capitalization altered). The '443 patent explains that the described multimedia files include “a series of encoded video frames and encoded meta data about the multimedia file.” *Id.* at 7:64–65. The multimedia files also “can include digital rights management” that “can be used in video on demand applications.” *Id.* at 27:19–22. “Multimedia files that are protected by digital rights management can only be played back correctly on a player that has been granted the specific right of playback.” *Id.* at 27:22–24.

The '443 patent explains that “[m]ultimedia files in accordance with embodiments of the present invention can be structured to be compliant with the Resource Interchange File Format (‘RIFF file format’) RIFF is a file format for storing multimedia data and associated information.” Ex. 1101, 12:57–63. “A RIFF file typically has an 8-byte RIFF header, which identifies the file and provides the residual length of the file after the header (i.e. file_length-8). The entire remainder of the RIFF file comprises ‘chunks’ and ‘lists.’” *Id.* at 12:63–67.

The '443 patent states that “[a] ‘movi’ list chunk of a multimedia file” can include “information enabling digital rights management.” Ex. 1101, 27:32–36. A “‘movi’ list chunk” can include “a ‘DRM’ chunk” prior to each video chunk, where “[t]he ‘DRM chunks’ . . . are ‘data’ chunks that contain digital rights management information” *Id.* at 27:36–41. “A device attempting to play the digital rights management protected video track uses the information in the ‘DRM’ chunk to decode the video

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