

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner,

v.

EQUIL IP HOLDINGS LLC,
Patent Owner.

IPR2023-00330
Patent 8,495,242 B2

Before RICHARD M. LEOVITZ, ROBERT J. WEINSCHENK, and
SHARON FENICK, Administrative Patent Judges.

FENICK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Akamai Technologies, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claim 9 (“the challenged claim”) of U.S. Patent No. 8,495,242 B2 (Ex. 1001, “the ’242 patent”). Equil IP Holdings LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). After authorization (*see* Ex. 1040) to file additional briefing relating to 35 U.S.C. § 325(d) arguments and issues relating to the correction of inventorship in U.S. Patent No. 6,964,009, Petitioner filed a Preliminary Reply (Paper 12, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 13, “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, we decline to exercise our discretion to dismiss under 35 U.S.C. §§ 314(a) or 325(d), and determine that Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claim. Accordingly, we institute an *inter partes* review of the challenged claim on all grounds raised in the Petition.

B. *Real Parties in Interest*

Petitioner and Patent Owner identify only themselves as real parties in interest. Pet. 3; Paper 4 (Patent Owner’s Mandatory Notices), 1.

C. *Related Matters*

Petitioner and Patent Owner each identify as related *Equil IP Holdings LLC v. Akamai Technologies, Inc.*, Case 1-22-cv-00677 (D. Del.) and *inter partes* review petitions IPR2023-00329 and IPR2023-00332. Pet.

3–4; Paper 4, 1. Patent Owner additionally notes that the ’242 patent is related to several patent applications. Paper 4, 1–2.

D. The ’242 Patent

The ’242 patent, titled “Automated Media Delivery System,” describes an automatic graphics delivery system that operates in parallel with an existing Web site infrastructure to provide delivery of media for access by an end user. Ex. 1001, codes (54), (57), 1:18–23. “The system streamlines the post-production process by automating the production of media through content generation procedures controlled by proprietary tags placed within URLs embedded within Web documents. The system automatically processes the URL encoded tags and automatically produces derivative media for the web site from the original media.” *Id.* at 7:8–16.

When a request for the media is received, the client connection, server traffic, content generation procedures, and proprietary tags within the URL are used to generate a version of the media for the client. *Id.* at 7:17–20, 17:27–30. The generated media is cached so that further requests for the same version of the media requires less overhead. *Id.* at 7:22–24, 18:34–40.

In some embodiments, a primary content generation procedure produces a derivative image based on images from an image repository. *Id.* at 18:41–45. A dynamic image content system then may generate a subsequent derivative media from that intermediate derivative image, which may be modified for a specific user browser and then passed to the user. *Id.* at 18:45–51, 18:63–67, 19:48–53. Inputs to the dynamic image content system may be stored in a cache so the intermediate derivative image need not be regenerated. *Id.* at 18:60–63, 19:23–42, 19:66–20:3.

E. Challenged Claim

The sole challenged claim, claim 9, is reproduced below with bracketed identifiers added as used by the Petitioner.

9. A method for accessing dynamically transcoding media content, the method comprising:

[9.a] an act of receiving a request for media content to be delivered to a client presentation system for media content, wherein the requested media content has a limited number of base transcoding profiles associated therewith, each base transcoding profile corresponding to a cached version of the requested media content;

[9.b] at the time of the request, and without input by a network administrator, an act of automatically identifying transcoding parameters to be applied to the requested media content prior to delivery to the client presentation system, wherein identification of transcoding parameters is based on one or more formats of any client presentation system;

[9.c] an act of determining that the transcoding parameters to be applied to the requested media content prior to delivery to the client presentation system are the same as transcoding parameters that are being applied to the requested media content prior to delivery to another client presentation system;

[9.d] an act of transcoding the requested media content in accordance with the identified transcoding parameters, such that the identified transcoding parameters are used to perform additional incremental transcoding on top of the base transcoding profile;

[9.e] wherein the act of act of transcoding the requested media content in accordance with the identified transcoding parameters comprises:

an act of selecting a pre-existing base transcoded version of the requested media content comprising intermediate derivative media that has been transcoded in accordance with only a portion of the identified transcoding parameters; and

[9.f] an act of creating a final version by incrementally performing further transcoding of the pre-existing base transcoded version in accordance with a remaining portion of the identified transcoding parameters; and

[9.g] an act of delivering the transcoded media content to both client presentation systems concurrently.

Ex. 1001, 23:45–24:16.

F. Prior Art and Asserted Grounds

Petitioner raises the following grounds of unpatentability with respect to the challenged claims:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
9	102	Tso ² , Huang ³
9	102	Samaniego ⁴
9	103	Samaniego
9	103	Samaniego, Tso

Pet. 6.

II. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102, 103. Because the filing date for the ’242 patent is before the effective date of the applicable AIA amendment, we refer to the pre-AIA version of these statutes. *See* Ex. 1001, code (22). Our institution determination would not change under the post-AIA version of these statutes.

² Tso et al., US 6,421,733 B1 (iss. July 16, 2002) (Ex. 1004).

³ Huang et al., US 6,438,576 B1 (iss. Aug. 20, 2002) (Ex. 1005).

⁴ Samaniego et al., US 2002/0078093 A1 (pub. June 20, 2002) (Ex. 1007).

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