

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IKORONGO TECHNOLOGY LLC and IKORONGO TEXAS LLC,
Patent Owner.

IPR2021-00204
Patent 8,874,554 B2

Before BRYAN F. MOORE, SHARON FENICK, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Request on Rehearing
37 C.F.R. § 42.71(d)

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

I. INTRODUCTION

A. *Case Posture*

Google LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–4, 8, 17–20, 24, 33–36, and 38 (“Challenged Claims”) of U.S. Patent No. 8,874,554 B2 (Ex. 1001, “the ’554 patent”). Petitioner identifies itself, along with LG Electronics Inc., LG Electronics U.S.A., Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc., as real parties in interest. Pet. 83. Ikorongo Technology LLC and Ikorongo Texas LLC (collectively, “Patent Owner”) identify themselves as the joint owners of the ’554 patent and real parties in interest for Patent Owner (Paper 4, 1), and timely filed a Preliminary Response to the Petition (Paper 9, “Prelim. Resp.”). In addition, with prior authorization from the Board, the parties filed supplemental briefing relating to arguments made by Patent Owner in the Preliminary Response regarding § 314(a) discretionary denial. Paper 10 (“Reply”); Paper 12 (“Sur-Reply”).

On June 7, 2021, we entered a Decision Denying Institution in which we exercised our discretion to deny institution under 35 U.S.C. § 314(a), in part because the ’554 patent was the subject of a parallel proceeding. Paper 13 (“Decision Denying Institution” or “DDI”).

Petitioner filed a timely Request for Rehearing. Paper 14 (“Request for Rehearing” or “Request”). In its Request for Rehearing, Petitioner asks that we reconsider our Decision Denying Institution because the case schedules of the parallel district court proceedings against Samsung and LG Electronics (“LGE”) would be vacated as a result of the Federal Circuit’s

order granting Samsung and LGE’s writs of mandamus directing the Western District of Texas to transfer the district court cases to the Northern District of California. Request 1–5 (citing Ex. 1023). After considering the Request for Rehearing¹ and for the reasons set forth below, we grant the Request and institute an *inter partes* review as to all of the Challenged Claims of the ’554 patent on the grounds of unpatentability presented in the Petition. We determine that the information presented in the Petition 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).

B. Related Proceedings

The parties indicate that the ’554 patent is involved in two U.S. District Court actions, namely, *Ikorongo Texas LLC v. LG Electronics, Inc.*, No. 6:20-cv-00257 (W.D. Tex.); and *Ikorongo Texas LLC v. Samsung Electronics Co.*, No. 6:20-cv-00259 (W.D. Tex.) (collectively, “WDTX cases”) (transferred to Northern District of California, Case Nos. 21-cv-07429-SI, 21-cv-07424-SI). Pet. 85; Paper 4, 1.

The ’554 patent also is involved in a concurrently filed IPR, *Google LLC v. Ikorongo Technology LLC*, IPR2020-00205 (a decision granting rehearing and instituting this case is being entered concurrently with this Decision). Pet. 84; Paper 4, 1.

¹ Patent Owner has not requested a response to the Request for Rehearing.

C. *The '554 Patent*

The '554 patent is titled "Turnersphere." Ex. 1001, code (54). The '554 patent, through a series of continuation applications, issued October 28, 2014, from an application filed November 1, 2013. *Id.* at codes (22), (45). The '554 patent generally relates to a system for identifying media items associated with a geographic area of interest to a user. *Id.* at code (57), Fig. 1.

System 10 includes media service 12 and devices 14. *Id.* at 3:58–60; Fig. 1. Device 14 provides playback information to media service 12 via network 18. *Id.* at 3:60–62, 4:35–43. The playback information includes information identifying the media item played by device 14 and a current location of device 14 (the location at which the media item is played). *Id.* at 4:35–43, 55–60. Device 14 includes location determination function 38-1 for obtaining the location of the device, where the location of device 14 is included in the playback information provided to media service 12. *Id.* at 7:33–37. Media service 12 tracks playback of media items by users 16 and maintains a play history for each of users 16, including information identifying the media item played by the user and locations at which the media items were played. *Id.* at 4:1–19.

Device 14 may receive a media request from user 16 selecting one or more geographic areas of interest. *Id.* at 5:12–15, 5:21–22, 8:35–37. Device 14 sends the media request to media service 12. *Id.* at 5:19–25, 8:43–45. In response, media service 12 identifies media items based on the geographic areas, such as media items that were played at locations within the geographic areas of interest, and provides the identified media items to device 14. *Id.* at 5:25–32, 8:45–63.

D. Illustrative Claim

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A user device comprising:
 - a media player component adapted to interact with a media item;
 - a communication interface component adapted to provide media item information identifying the media item, the communication interface component adapted to provide location information identifying a geographic location associated with the user device at which the media item was interacted with;
 - a location determination component adapted to receive an identification of a geographic area;
 - the communication interface component adapted to receive information that identifies a second media item, wherein location information associated with the second media item is associated with the identified geographic area; and
 - a user interface component adapted to present, via the user device, the information that identifies the second media item, wherein at least one of the preceding components includes at least one electronic hardware component.

Ex. 1001, 26:30–51.

E. Applied References

Petitioner relies upon the following references:

Horowitz, U.S. Publication No. 2009/0049051 A1 (Ex. 1005, “Horowitz”), filed August 16, 2007, published February 19, 2009.

Kalasapur, U.S. Patent No. 8,156,118 B1 (Ex. 1006, “Kalasapur”), filed August 20, 2007, issued April 10, 2012.

Rosenberg, U.S. Publication No. 2007/0233743 A1 (Ex. 1007, “Rosenberg”), filed June 12, 2007, published October 4, 2007.

Landschaft, U.S. Publication No. 2008/0064351 A1
(Ex. 1009, “Landschaft”), filed September 8, 2006, published
March 13, 2008.

Pet. 1.

F. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–4, 8, 17–20, 24, 33–36, and 38 of the ’554 patent based on the following grounds.

Claims Challenged	35 U.S.C. §	Reference(s)
1–4, 8, 17–20, 24, 33–36, 38	103(a) ²	Horowitz, Kalasapur
1–4, 17–20, 33–36	103(a)	Rosenberg, Landschaft

Pet. 2. Petitioner relies upon the Declaration of David Hilliard Williams (Ex. 1003, “Williams Declaration,” “Williams Decl.”).

II. DISCRETIONARY DENIAL UNDER § 314(a)

A. Parallel Proceedings

Institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); 35 U.S.C. § 314(a) (2018). The Board has held that the advanced state of a parallel proceeding is a factor that may weigh in favor of denying a petition under § 314(a). *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); Patent Trial and Appeal Board, Consolidated Trial Practice Guide, 58 & n.2 (Nov. 2019) (*available*

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the ’554 patent is a continuation of an Application filed before March 16, 2013, the effective date of the relevant amendment, the pre-AIA version of § 103 applies.

at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>). In its Preliminary Response, Patent Owner contended we should exercise our discretion to deny the Petition under § 314(a), “because institution would be an inefficient duplication of parallel litigations . . . [i.e.] two district court cases pending before Judge Albright in U.S. District Court, Western District of Texas – both of which are set for trial prior to the due date for a final written decision should this IPR be instituted.” Prelim. Resp. 6.

In our Decision Denying Institution, we evaluated the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential), and determined that discretionary denial was appropriate in view of the WDTX cases involving the ’554 patent. *See generally* DDI.³

As of the entry of this Decision, the parallel proceedings that served as our basis for exercising our discretion to deny institution are no longer in the Western District of Texas. Ex. 1023, 16; Ex. 3003. In the Request for Rehearing, Petitioner argues that (at that time), “[b]ecause the Federal Circuit directed the WDTX to transfer the district court cases to the NDCA [Northern District of California] (Ex-1023 at 16) . . . the cases against LGE and Samsung will be given a new case schedule in the NDCA, delaying not

³ In assessing whether to exercise such discretion, the Board weighs the following factors: 1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; 2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision; 3. investment in the parallel proceeding by the court and the parties; 4. overlap between issues raised in the petition and in the parallel proceeding; 5. whether the petitioner and the defendant in the parallel proceeding are the same party; and 6. other circumstances that impact the Board’s exercise of discretion, including the merits. *Fintiv*, Paper 11 at 6.

only the trial date but the overall investment in the case by both the parties and the court.” Request 5. We agree. In fact, the cases in NDCA are currently stayed pending an appeal of the Federal Circuit’s Decision. Ex. 3003. In weighing the *Fintiv* factors, we relied on the involvement of the ’554 patent in the WDTX cases as the basis for our weighing four of six factors and for our holistic assessment of the factors in favor of our exercising our discretion to deny institution. DDI 7–13. However, the WDTX cases no longer provide any basis for exercising our discretion to deny institution.

In the Request for Rehearing, Petitioner also contends “[t]he Board’s analysis of Factor 5, whether the parties are the same, overlooks Petitioner’s non-party status.” Request 6. We disagree for the same reasons explained in our Decision Denying Institution, but regardless, find this contention moot, because we agree that the present posture of the parallel proceedings does not support our Decision Denying Institution. DDI 12. In sum, factors 1–3 have changed to not favoring exercising our discretion such that only factor 5 may still favor exercising our discretion,⁴ i.e.: factor 1 now favors

⁴ We note that other panels have found Factor 5 generally follows factor 2 where the petitioner or an RPI is also a defendant in the parallel litigation referenced in factor 2. For example, in *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, the panel agreed with the petitioner that “this factor favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true.” Paper 11 at 14 (PTAB. June 14, 2021) (internal quotation marks omitted). Similarly, in *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, the panel wrote, “Here, . . . Petitioner is the defendant in the parallel proceeding. This fact could weigh either in favor of, or against, exercising discretion to deny institution, depending on which tribunal was likely to address the challenged patent first.” Paper 9 at 21 (PTAB. Oct. 21, 2020).

not exercising our discretion as the NDCA case is stayed; factors 2 and 3 now favor not exercising our discretion because there is no trial date or indication of investment in the NDCA; factor 4 remains unchanged (as far as we know the claims challenged has not changed in the transferred cases) and thus still “weighs marginally in favor of not exercising discretion”; factor 5 remains unchanged and thus still favors exercising discretion; and factor 6 remains unchanged as is still neutral. DDI 6–13. In light of the changed facts, we modify our earlier decision that exercised our discretion to deny institution.

We possess the inherent authority to reconsider our Decision Denying Institution. *See GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1313 (Fed. Cir. 2015). In light of the transfer of the WDTX cases, we now decline to exercise our discretion under 35 U.S.C. § 314(a) to deny *inter partes* review.

B. Multiple Petitions

In its Preliminary Response, Patent Owner also argues “[t]he Board should exercise its discretion under § 314(a) to deny at least one of Petitioner’s two overlapping petitions. Petitioner concurrently filed two petitions against the ’554 patent: IPR2021-00204 (Petition 1) and IPR2021-00205 (Petition 2).” Prelim. Resp. 17. Petitioner contends “Petition 2 challenges only claims with an admitted later priority date . . . [and n]one of the claims challenged in Petition 2 are addressed in Petition 1. The two petitions therefore differ materially both in substance and in the defenses Patent Owner may potentially raise, and were needed to comply with the word limits.” Paper 3, 3. Patent Owner argues this reason is moot because Patent Owner “has opted to not raise a priority dispute at the pre-institution stage.” Prelim Resp. 18–20. We determine that Patent Owner may raise a

priority challenge post-institution so Petitioner's reason for two petitions is still valid. Thus, we determine that denial of one of the two petitions is not appropriate in this case.

III. ANALYSIS OF GROUNDS OF UNPATENTABILITY

Petitioner challenges the patentability of claims 1–4, 8, 17–20, 24, 33–36, and 38 of the '554 patent on the grounds that the claims would have been obvious under 35 U.S.C. § 103 in light of various references including: Horowitz, Kalasapur, Rosenberg, and Landschaft. Because we no longer exercise our discretion under 35 U.S.C. § 314(a) to deny institution, we analyze Patent Owner's argument that we should deny institution upon consideration of the merits of Petitioner's challenges. *See generally* Prelim. Resp.

A. Legal Standards

A patent claim is unpatentable as obvious if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of non-obviousness.⁵ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

⁵ In its Preliminary Response, Patent Owner does not present objective evidence of non-obviousness. *See generally* Prelim. Resp.

“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 petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Claim Construction

Claim construction in this proceeding is governed by 37 C.F.R. § 42.100 (b), which provides:

In an *inter partes* review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.121, shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

Under the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–19 (Fed. Cir. 2005) (en banc), claim terms are given their ordinary and customary meaning, as would have been understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history of record. *See Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365–66 (Fed. Cir. 2012). There is a “heavy presumption,” however, that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*,

288 F.3d 1359, 1366 (Fed. Cir. 2002) (citation omitted).

We are also guided by the principle that we need only construe claim terms if, and to the extent that, it is necessary for the purpose of the proceeding. *See, e.g., Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

The Petition states, “[n]o claim terms need to be construed by the Board at this time.” Pet. 6. Patent Owner “does not propose any claim constructions.” Prelim. Resp. 21. Petitioner does present an implied construction of “location information” which we discuss below, in Section III.E.1.d., in association with Petitioner’s contentions regarding that claim term. Nevertheless, in this Decision, we give the claim terms their ordinary and customary meanings.

C. *Level of Ordinary Skill in the Art*

With regard to the level of ordinary skill in the art, Petitioner contends:

A person of ordinary skill in the art (“POSA”) at the time of the purported invention would have at least a bachelor’s degree in Computer or Electrical Engineering, or equivalent engineering discipline, and approximately three years’ experience in media data management, mobile location, and data networking technologies. Williams, ¶47. Additional education could have substituted for professional experience, and significant work experience could have substituted for formal education. Williams, ¶47.

Pet. 5–6. (citing Ex. 1003 ¶ 47). Patent Owner “does not presently offer a competing definition for a person of ordinary skill in the art at this

preliminary stage.” Prelim. Resp. 20.

Petitioner’s proposal is consistent with the technology described in the Specification and the cited prior art. In order to determine whether Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of at least one of the Challenged Claims, we adopt Petitioner’s proposed level of skill in the art.

D. Cited References

1. Horowitz (Ex. 1005)

Horowitz discloses a system for presenting media items associated with a selected geographic area and the locations at which the media items were interacted with. Ex. 1005, code (57), ¶¶ 50–52. Figure 1 of Horowitz is reproduced below.

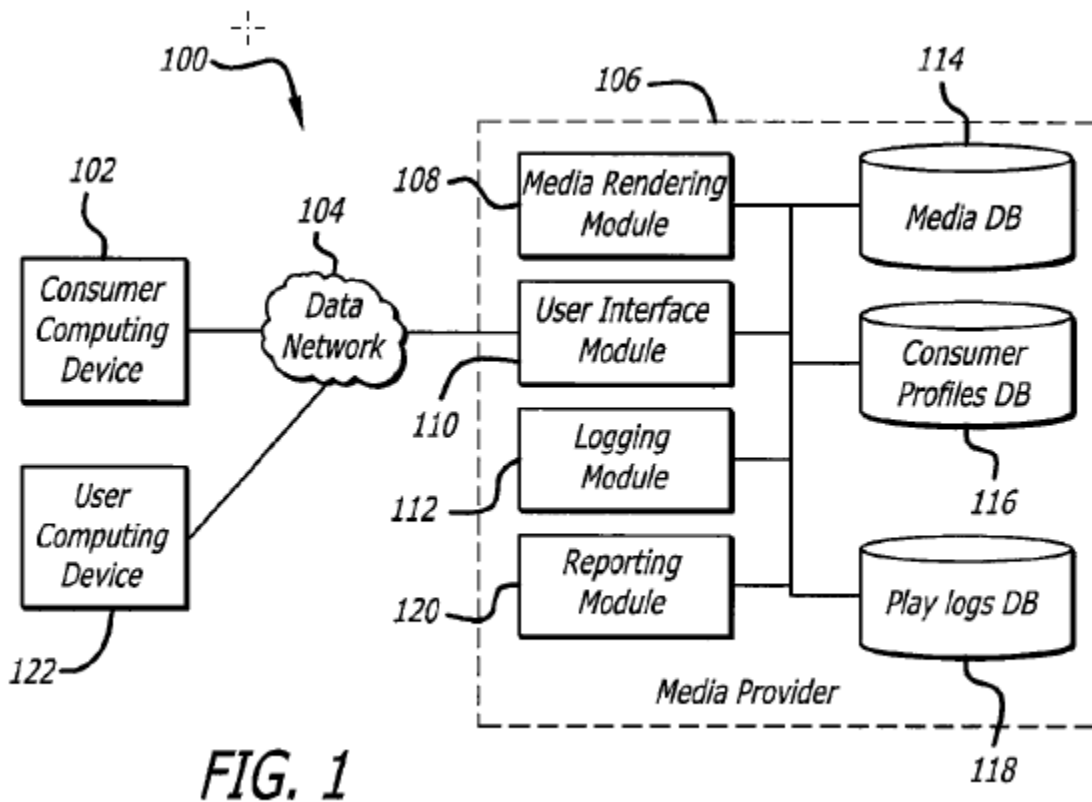
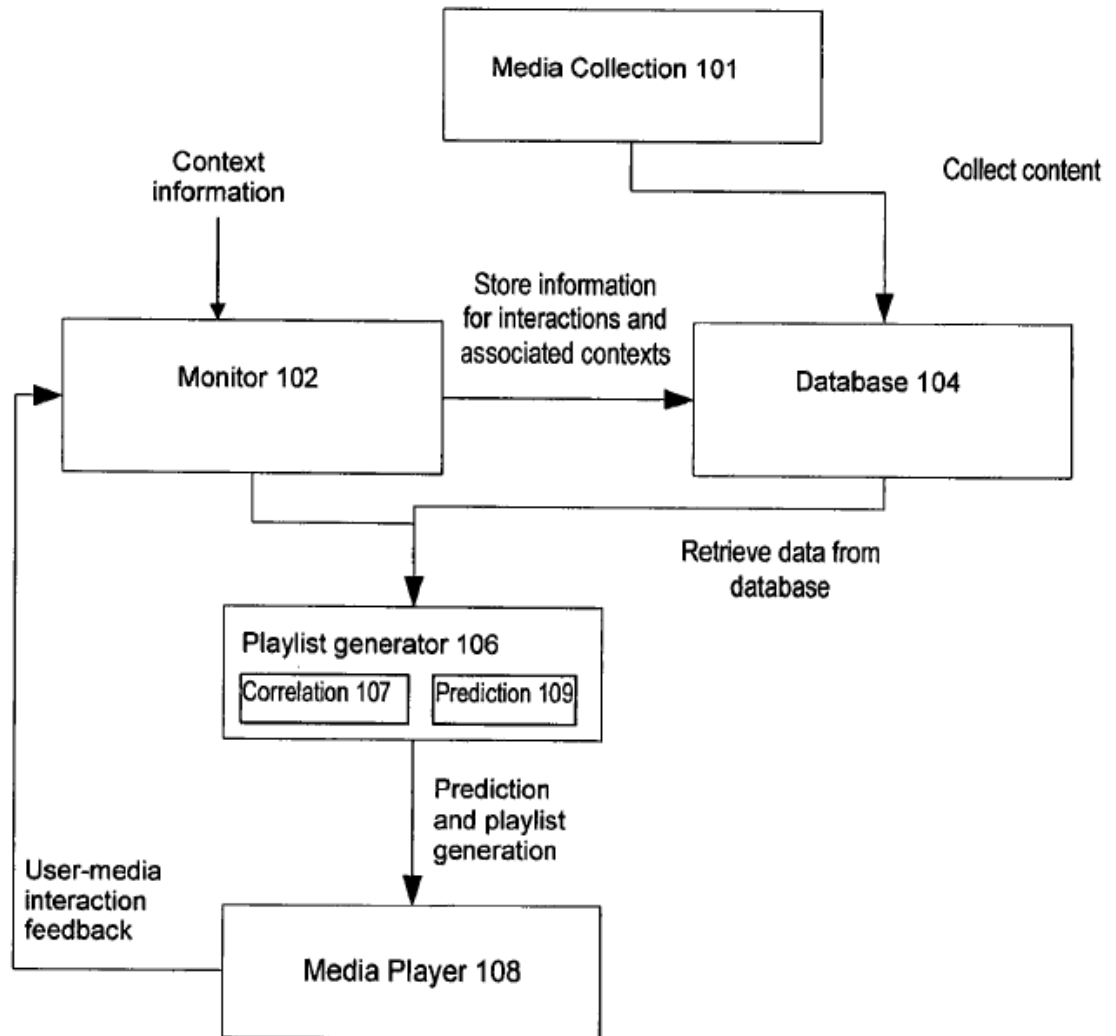


Figure 1 of Horowitz, above, shows consumer computing device 102 and user computing device 122 connected to media provider 106 via data network 104. *Id.* at Fig. 1. A media consumer can request a media file from the media provider 106 using consumer computing device 102 to access data network 104. *Id.* ¶ 29. The media provider determines the “geographic location of the consumer making the request” using the IP address of consumer computing device 102. *Id.* ¶ 32. The media provider stores “information of the requested media as well as geographic information associated with each media request.” *Id.* ¶ 33.

A user at user computing device 122 can “request a report on consumer media access patterns in a specific geographic area.” *Id.* ¶ 34. In response, the media provider communicates to the user a list of media items accessed by consumers located in the specific geographic area, e.g., a top ten list in the geographic area selected by the user. *Id.* ¶¶ 35, 52. The user receiving the list of media items can also “turn into a consumer and request similar media from the media provider.” *Id.* ¶ 26.

2. *Kalasapur (Ex. 1006)*

Kalasapur discloses a system for generating playlists of media items based on user-content interactions and the context of those interactions. Ex. 1006, code (57), 1:48–55, 2:11–24. Figure 1 of Kalasapur is reproduced below.



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FIG. 1

In Figure 1, above, Kalasapur discloses that context information is input to a monitor 102 that “[s]tore[s] information for interactions and associated contexts” in database 104. *Id.* at 2:29–33, 2:37–38, 3:9–18,

Fig. 1. Database 104 receives input from media collection 101. *Id.* Playlist generator 106 “[r]etrieve[s] data from [the] database [104],” receives input from monitor 102, and sends “Prediction and playlist generation” to media player 108, which provides “[u]ser-media interaction feedback” to monitor 102. *Id.*

The user-media interaction context includes “the location(s) of interaction.” *Id.* at 3:51–52, 2:18–19, 4:11–13. For example, a device including media player 108 may be “equipped with a GPS” to obtain the location of interaction with the media items. *Id.* at 4:18–19, 6:42–44. Monitor 102 monitors the user interactions and associated context, and the monitored information is stored in database 104. *Id.* at 3:9–18. Media player 108 may send “a request to the playlist generator 106 for a personalized playlist.” *Id.* at 3:25–26.

The current context, such as the current location of media player 108, is provided to playlist generator 106. *Id.* at 3:32–35. Playlist generator 106 generates a set of recommended media items “using the current context(s) and the monitored information stored in the database 104.” *Id.* at 3:36–40. Kalasapur discloses that monitor 102, playlist generator 106, and database 104 may reside on a same computer separate from the device having media player 108. *Id.* at 6:42–47.

E. Obviousness Analysis

We determine that Petitioner has shown a reasonable likelihood of establishing the obviousness of claim 1 and, on that basis, institute *inter partes* review of all the Challenged Claims. *See* 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims.”).

1. Claim 1

Petitioner presents a detailed analysis of the obviousness of claim 1 supported by citations to the asserted art, the Williams Declaration, and other evidence. *See* Pet. 10–30. Our element-by-element consideration of whether Petitioner has shown a reasonable likelihood of establishing the obviousness of claim 1 is provided below.⁶

a. A user device comprising:

Petitioner relies on Horowitz’s consumer computing device 102 and user computing device 122 as the claimed user device, contending that “Horowitz discloses the same user device can act as user computing device 102 at one time (to request media access patterns) and act as consumer computing device 122 at another time (to request media items).” Pet. 12 (citing Ex. 1005 ¶¶ 29, 34, 50; Ex. 1003 ¶¶ 62–64).⁷

Patent Owner does not argue the preamble. *See generally* Prelim. Resp. Petitioner establishes a reasonable likelihood of showing Horowitz teaches this limitation.

b. a media player component adapted to interact with a media item,

Petitioner cites Horowitz for this limitation. Pet. 12–13. Horowitz discloses that a user device (which Petitioner associates with consumer computing device 102 and user computing device 122) includes a media

⁶ For convenience, our analysis of claim 1 follows the structure of the Petitioner’s presentation.

⁷ We do not need to determine whether the preamble of claim 1 is limiting because we also agree with Petitioner, for the purpose of this decision, that Horowitz discloses the preamble.

player adapted to interact with a media item such that “a media player such as iTunes, Windows Media Player or Yahoo! Music Jukebox” is used “to request media content,” and subsequently “the media content is rendered.” *Id.* at 12 (quoting Ex. 1005 ¶¶ 23, 47, 60, 83; citing Ex. 1003 ¶ 66).

Petitioner contends “[a] POSA would have understood that *Horowitz*’s consumer computing device 102 and user computing device 122 include a media player adapted to interact with a media item, such as requesting access to (e.g., downloading, streaming) a media item or playing a media item.” *Id.* at 12–13 (citing Ex. 1003 ¶ 66).

Patent Owner does not argue this limitation. *See generally* Prelim. Resp. Petitioner establishes a reasonable likelihood of showing *Horowitz* teaches this limitation.

c. a communication interface component adapted to provide media item information identifying the media item;

Petitioner contends *Horowitz* discloses that the computing device includes “network connection 214” that enables the communication between computing devices 102 and 122 and media provider 106 via data network 104. Pet. 13–14 (citing Ex. 1005 ¶¶ 29, 42, 50; Ex. 1003 ¶ 68).

Petitioner further contends network connection 214 (communication interface component) can be used to “request a music file from the media provider 106.” *Id.* at 15 (quoting Ex. 1005 ¶ 29; citing Ex. 1003 ¶ 69).

Petitioner further contends that, upon receiving the “request,” media provider 106 “searches the media database 114 and retrieves the correct media files corresponding to the request” and “stores a collection of user requests of media and corresponding information of the requested media.”

Id. (quoting Ex. 1005 ¶ 29, 30, 33; citing Ex. 1003 ¶ 69).

Patent Owner does not argue this limitation. *See generally* Prelim. Resp. Petitioner establishes a reasonable likelihood of showing Horowitz teaches this limitation.

d. the communication interface component adapted to provide location information identifying a geographic location associated with the user device at which the media item was interacted with;

Petitioner relies on both Horowitz and Kalasapur for this limitation. Pet. 15–18. Petitioner contends Horowitz discloses that consumer computing device 102 provides “the dynamic IP address associated with the consumer computing device 102 at which the consumer making the request was located” to media provider 106 via network connection 214 (communication interface component). *Id.* at 16 (quoting Ex. 1005 ¶ 48; citing Ex. 1003 ¶ 71). Petitioner further contends that media provider 106 is configured to “map IP addresses to geographic locations [] to determine the geographic location of the consumer making the request” using “[k]nown lookup tables and/or software.” *Id.* (quoting Ex. 1005 ¶ 32; citing Ex. 1003 ¶ 71) (alterations in original). Petitioner relies on parent application No. 11/963,050 (“the ’050 Application”), to which the ’554 patent claims priority, to contend that determining a location from an IP address is disclosed as one way to “identify[] a geographic location associated with the user device at which the media item was interacted with.” *Id.* The ’050 Application describes a means for determining a location of the device, which Petitioner contends includes “software on the central server 32 capable of determining an Internet protocol (IP) address of the device 12 and for then determining a location from the IP address.” *Id.* (quoting Ex. 1012

¶ 27; citing Ex. 1003 ¶ 72).

Petitioner alternatively relies on Kalasapur. Petitioner contends Kalasapur discloses a consumer electronics device (e.g., a cell phone) having a GPS sensor to provide GPS-based geographic location information of the device to a monitoring module (e.g., a computer) over a network. Pet. 17 (citing Ex. 1006, 2:19–33, 6:42–47, Fig. 4; Ex. 1003 ¶ 74).

Petitioner further contends Kalasapur discloses monitoring module 102 monitoring user-media interaction and associated user context “every time the user interacts with a media item via the media player.” *Id.* (quoting Ex. 1006, 3:44–48; citing Ex. 1003 ¶ 74). Petitioner also contends the monitored user context includes “the location(s) of interaction” obtained by “utilizing a location sensor (e.g., a global positioning system (GPS)).” *Id.* (quoting Ex. 1006, 3:51–52, 2:25–28; citing Ex. 1006, 4:1–23; Ex. 1003 ¶ 74). Thus, according to Petitioner, Kalasapur expressly discloses providing the “location information” to monitoring module 102. *Id.* (citing Ex. 1003 ¶ 74).

Patent Owner argues that Horowitz does not disclose “location information identifying a geographic location associated with the user device” because the IP address provided by Horowitz does not identify a geographic location but, rather, provides information that may be used to derive location information. Prelim. Resp. 25–26. On the present record and for the purpose of this Decision, we agree with this argument regarding Horowitz. As to Petitioner’s implied construction of “location information” based on the ’050 Application, we recognize when examining patents from the same family, “we must interpret the claims consistently across” all patents. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed.

Cir. 2005) (citation omitted). Nevertheless, although the description in the '050 Application mentions *determining* location based on an IP address, the '050 Application's reference to IP address is not tied to the claim term "location information identifying a geographic location associated with the user device," as recited in the challenged patent. *See* Prelim. Resp. 25–26. Thus, we decline to find that "location information" encompasses IP address information based on the '050 Application as urged by Petitioner. Thus, we are not persuaded by Petitioner's contention as to this limitation based on Horowitz alone.⁸

We rely on Petitioner's combination with Kalasapur, which explicitly discloses determining the location of user interactions with media. For example, as Petitioner states, "*Kalasapur* describe[s] monitoring and storing geographic location information associated with the user device each time a media item is interacted with." Pet. 19 (citing, e.g., Ex. 1006, 3:11–18, 3:44–52; Ex. 1003 ¶ 76).

Patent Owner argues Kalasapur does not have a user device with GPS for determining a location. Prelim. Resp. 28–29. Patent Owner argues Kalasapur recites "a monitoring module monitors (obtains) user context such as user activity, time/date, and the current location of the user by utilizing a

⁸ Patent Owner also argues that the use of the past tense in the limitation of "location information identifying a geographic location associated with the user device at which the media item was interacted with," excludes Horowitz, which determines an IP address for a "request for accessing" media in the future, not an actual access of media that occurred in the past. *Id.* at 27 (citing Pet. 16; Ex. 1005 ¶ 32). Because we are persuaded by Patent Owner's other argument regarding Horowitz alone we do not reach this argument.

location sensor (e.g., a global positioning system (GPS)), or querying the user, etc.” *Id.* at 28 (quoting Ex. 1006, 2:25–28) (emphasis omitted). According to Patent Owner, the monitor and a playlist generator are described in Kalasapur as running on a home personal computer 123, distinct from a cell phone 131 (i.e., user device). *Id.* at 29 (citing Ex. 1006, 6:26–47).

We determine that even if Kalasapur does not explicitly disclose that the monitor receives a GPS location of user media interaction determined by GPS on a user device, Kalasapur states the monitor “utilizes” a “GPS” to determine the location of the user device while the user is at different locations, “e.g., working, walking, exercising, driving, etc.” Ex. 1006, 2:60–61, 4:19–23; Pet. 17 (citing Ex. 1006, 4:1–23). We do not find that it is likely that Kalasapur intended to disclose using a GPS residing on home personal computer 123 to determine those locations when it also describes a device such as cell phone 131 with the ability to determine those locations. For example, Petitioner states a person of ordinary skill in the art “would have been motivated to incorporate *Kalasapur*’s GPS sensor into *Horowitz*’s user device (which *Kalasapur* also provides) to improve the accuracy of the location information identifying the geographic location at which the user interacted with the media item.” Pet. 19.

The skilled artisan would “be able to fit the teachings of multiple patents together like pieces of a puzzle” because the skilled artisan is “a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420–21 (2007); *see also Bos. Sci. Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009) (“Combining two embodiments disclosed adjacent to each other in a prior art patent does not require

a leap of inventiveness.”). Here, Patent Owner has not demonstrated that the Petitioner’s proffered combination in support of the conclusion of obviousness would have been “uniquely challenging or difficult for one of ordinary skill in the art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 419–21). Thus, we do not find that Patent Owner’s argument undermines Petitioner’s showing.

Petitioner establishes a reasonable likelihood of showing the cited art teaches this limitation.

e. a location determination component adapted to receive an identification of a geographic area;

Petitioner relies on both Horowitz and Kalasapur for this limitation. Pet. 22–26. Petitioner contends Horowitz discloses receiving “a geographic indicator corresponding to a geographic area” via a user interface. *Id.* at 22 (quoting Ex. 1005 ¶ 51; citing Ex. 1005, Fig. 4). As noted above, Kalasapur at least suggests a user device including a GPS sensor for determining the current location of the user device. *See id.* at 25 (citing Ex. 1006, 2:25–28, 4:18–19).

Patent Owner does not argue this limitation. *See generally* Prelim. Resp. Petitioner establishes a reasonable likelihood of showing the cited art teaches this limitation.

f. the communication interface component adapted to receive information that identifies a second media item, wherein location information associated with the second media item is associated with the identified geographic area; and

Petitioner relies on Horowitz as teaching this limitation. Pet. 26–28. Petitioner contends Horowitz discloses that the communication interface component (e.g., network connection 214) in the user device (e.g., user computing device 122) receives information that identifies a second media item (e.g., a top ten list in the geographic area selected by the user), where location information associated with the second media item is associated with the identified geographic area. *Id.* at 26–28 (citing Ex. 1005 ¶¶ 34, 35, 52, 67, 84; Ex. 1003 ¶ 85).

Patent Owner does not argue this limitation. *See generally* Prelim. Resp. Petitioner establishes a reasonable likelihood of showing the cited art teaches this limitation.

g. a user interface component adapted to present, via the user device, the information that identifies the second media item

Petitioner relies on Horowitz as teaching this limitation. Pet. 28–29. Petitioner contends Horowitz discloses that the user device (e.g., user computing device 122) includes a user interface component (e.g., user interface 1100) adapted to present, via the user device, the information that identifies the second media item. *Id.* (citing Ex. 1005 ¶¶ 66, 67, 91, Fig. 11; Ex. 1003 ¶ 87).

Patent Owner does not argue this limitation. *See generally* Prelim. Resp. Petitioner establishes a reasonable likelihood of showing Horowitz teaches this limitation.

h. wherein at least one of the preceding components includes at least one electronic hardware component.

The Petition states, “Horowitz discloses that the user interface component includes ‘a display,’ which is an electronic hardware component for displaying the user interface.” Pet. 30 (citing Ex. 1005 ¶¶ 40, 41, 91; Ex. 1003 ¶¶ 89, 90). Patent Owner does not argue this limitation. *See generally* Prelim. Resp. Petitioner establishes a reasonable likelihood of showing Horowitz teaches this limitation.

i. Motivation to Combine the Relevant Teachings of Horowitz and Kalasapur

Petitioner provides detailed and well-supported reasoning for combining the relevant teachings of Horowitz and Kalasapur. *See* Pet. 19–26. With specific regard to combining the teachings of these references, the Petition provides:

Both *Horowitz* and *Kalasapur* are directed to providing recommendations of media items to a user based on the locations at which the user interacted with media items. Ex-1005, [0005], [0050]-[0052]; Ex-1006, 2:11-33; Williams, ¶76. Both *Horowitz* and *Kalasapur* describe monitoring and storing geographic location information associated with the user device each time a media item is interacted with. Ex-1005, [0032]-[0033]; Ex-1006, 3:11-18, 44-52; Williams, ¶76. *Horowitz* describes providing an IP address of the user device to determine the location of the user device, and *Kalasapur* describes using a GPS sensor in the user device to determine the location of the user device. Ex-1005, [0032], [0048]; Ex-1006, 2:25-28; Williams, ¶76.

A POSA would have been motivated to incorporate *Kalasapur*’s GPS sensor into *Horowitz*’s user device (which *Kalasapur* also provides) to improve the accuracy of the location information identifying the geographic location at which the user interacted with the media item. Williams, ¶77. GPS is a well-known positioning technology that was commonly implemented

in user devices at the time of the '554 patent. *See, e.g.*, Ex-1007, *Rosenberg*, [0028] (describing a portable media player having “a Global Positioning System (‘GPS’) 120 for use in tracking the location of portable media player in real time.”); Ex-1009, *Landschaft*, [0014] (describing “a laptop computer, a PDA or a mobile phone having media players as well as an independent media player wherein all have GPS capability.”); Williams, ¶77.

It was also known that GPS technology provides a more refined location than the location mechanisms based on a network identifier, such as a cell identifier or an IP address. *See, e.g.*, Ex-1007, [0028] (describing GPS technology, which achieves “an accuracy of approximately 100 feet” and “an accuracy of better than 3 feet may be achieved” for differential GPS which is “well known in the art”); Ex-1009, [0020] (explaining GPS technology provides “a more defined or refined location than the one achievable employing Cell-IDs in a communication system”); Ex-1013, 3 (describing the GPS system provides “an accuracy of 10 meters or less”); Ex-1014, 2 (comparing various techniques for determining the geographic location of an Internet host from its IP address, where the best performing technique provides “a median error of 28 km”); Williams, ¶78. Incorporating *Kalasapur*’s GPS sensor into *Horowitz*’s user device would improve the accuracy of the location determination beyond using the IP address, as disclosed by *Horowitz*. Williams, ¶78. Although the addition of a GPS sensor for location determination could increase the overall device costs, for certain applications the improved accuracy would result in an overall better user experience. For example, the improved location accuracy would allow *Horowitz*’s media provider to provide media items associated with a more refined geographic area (e.g., particular parks, supermarkets, neighborhoods). Williams, ¶78. A POSA would have been motivated to incorporate *Kalasapur*’s GPS sensor into *Horowitz*’s user device to allow users to receive a list of recommended media items that were requested in a refined geographic area (e.g., particular parks, supermarkets, neighborhoods). Williams, ¶78.

Id. at 19–21. We determine that Petitioner has provided a showing sufficient to support institution as to why a skilled artisan would have been motivated at the time of the invention to look to GPS location capability of Kalasapur to implement the user device of Horowitz, with a reasonable expectation of success in meeting the limitations of the claimed invention. *See id.* at 19–21 (Petitioner’s contention regarding motivation to combine), 21–22 (Petitioner’s contention regarding reasonable expectation of success).

2. *Summary as to Claim 1*

Petitioner has shown a reasonable likelihood of showing that claim 1 of the ’554 patent would have been obvious in view of the combined teachings of Horowitz and Kalasapur.

3. *Claims 2–4, 8, 17–20, 24, 33–36, and 38*

Petitioner also contends that independent claims 17 and 33 and dependent claims 2–4, 8, 18–20, 24, 34–36, and 38 would have been obvious in view of a combination of the asserted references. *See* Pet. 30–41. Patent Owner relies on its arguments discussed above as to those claims. We have reviewed Petitioner’s arguments and evidence concerning claims 2–4, 8, 17–20, 24, 33–36, and 38 and are persuaded that Petitioner also has shown a reasonable likelihood of success in proving that claims 2–4, 8, 17–20, 24, 33–36, and 38 would have been also unpatentable over Horowitz and Kalasapur.

4. *Rosenberg/Landschaft Ground*

Petitioner also contends that claims 1–4, 17–20, and 33–36 (a subset of the claims in the *Horowitz/Kalasapur* Ground) would have been obvious in view of a combination of Rosenberg and Landschaft. *See* Pet. 42–80.

Petitioner asserts that “because Patent Owner may potentially attempt to antedate *Horowitz* and *Kalasapur* for these claims, Petitioner presents a second, separate ground for claims 1-4, 17-20 and 33-36 based on *Rosenberg* and *Landschaft* which were filed before the alleged invention date.” Paper 3, 2. Because, at least at this stage of the proceeding, Patent Owner has not challenged the priority date,⁹ and because, as explained above, we have determined Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of those claims as obvious over Horowitz and Kalasapur, we do not reach this alternative ground at this time. Because Petitioner has demonstrated a reasonable likelihood of success that at least one claim of the ’554 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348, 1358 (2018); 37 C.F.R. §42.108 (a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

IV. Conclusion

We determine that Petitioner has demonstrated a reasonable likelihood of showing at least one of the claims challenged in the Petition would have been obvious.

⁹ “Patent Owner has opted to not raise a priority dispute at the pre-institution stage.” Prelim. Resp. 19.

V. Order

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–4, 8, 17–20, 24, 33–36, and 38 of U.S. Patent No. 8,874,554 B2 is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 8,874,554 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2021-00204
Patent 8,874,554 B2

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