Paper 10 Date: February 10, 2025

## UNITED STATES PATENT AND TRADEMARK OFFICE

# BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC., Petitioner,

v.

ANONYMOUS MEDIA RESEARCH HOLDINGS, LLC, Patent Owner.

IPR2024-01057 Patent 10,719,848 B2

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Before ELIZABETH M. ROESEL, FREDERICK C. LANEY, and MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, Administrative Patent Judge.

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

### I. INTRODUCTION

## A. Background and Summary

Roku, Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–15 of U.S. Patent No. 8,510,848 B2 (Ex. 1001, "the '848 patent"). Paper 1 ("Pet."). Anonymous Media Research Holdings, LLC ("Patent Owner") filed a Preliminary Response to the Petition. Paper 7 ("Prelim. Resp."). The Petition is supported by a declaration from Dr. Samuel H. Russ. Ex. 1003 ("Russ Declaration"). The Preliminary Response is supported by a declaration by Mr. W. Leo Hoarty. Ex. 2001 ("Hoarty Declaration").

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2023). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons given below, on this record, Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of any one of claims 1–15 of the '848 patent. Accordingly, we do not institute an *inter partes* review of the '848 patent.

#### B. Real Parties in Interest

Petitioner identifies itself as the real party-in-interest. Pet. 78. Patent Owner identifies itself as a real party-in-interest. Paper 9, first unpaginated page.

#### C. Related Matters

## 1. The '848 patent

The parties represent that the '848 patent is involved in *Anonymous Media Research Holdings LLC v. Samsung Electronics Co. Ltd. et al.*, Case No. 2:23-cv-00439 (E.D. Tex. filed September 22, 2023) and *Anonymous Media Research Holdings LLC v. Roku, Inc.*, Case No. 3:24-cv-04171 (N.D. Cal. filed September 22, 2024). Paper 9, first unpaginated page; Pet. 78–79.

Patent Owner represents that the '848 patent is the subject of a Petition to Accept Unintentionally Delayed Benefit claims (denied without prejudice to refile on December 17, 2024) and a Request for Certificate of Correction (currently undecided). Paper 9, second and third unpaginated pages. Patent Owner asserts that the '848 patent is the subject of IPR2024-01350, filed by Samsung Electronics Co, Ltd. *Id.*, second unpaginated page.

## 2. Related patents

Petitioner Roku has also filed IPRs challenging other patents asserted in the district court cases, namely U.S. Patent Nos. 8,296,791 (IPR2024-01053), 8,510,768 (IPR2024-01054), 8,756,622 (IPR2024-01055), 10,572,896 (IPR2024-01056), 10,719,849 (IPR2024-01058). Paper 9, first and second unpaginated pages.

Patent Owner asserts that an IPR has been filed on IPR2024-01349 (USP 10,719,849) by Samsung Electronics Co, Ltd. *Id.*, second unpaginated page. Patent Owner further represents that U.S. Patent 8,510,768 is the subject of *ex parte* reexamination 90/019,375, concluded with the issuance of an *ex parte* reexamination certificate on December 6, 2024, confirming patentability of claims 1–3, 5–7, 9–11, and 13–15. Paper 9, second and third unpaginated pages. Patent Owner further represents that U.S. Patent

8,756,622 is the subject of an *ex parte* reexamination, ordered on October 28, 2024.

#### D. The '848 Patent

The '848 patent is titled "Media Usage Monitoring and Measurement System and Method." Ex. 1001, code (54). The '848 patent issued from Application No. 16/660,615, filed on October 22, 2019, and claims priority through a chain of applications to provisional application 60/574,386, filed on May 27, 2004. *Id.* at codes (60), (62). The '848 patent relates to media monitoring and measurement. *Id.* at code (57). In some embodiments, content identifications are enhanced through audience data, media player log data, or sample sequence data. *Id.* In another embodiment, sample construction and selection parameters are adjusted based upon identification results. *Id.* In yet another embodiment, play-altering activity of an audience member is deduced from content offset values of identifications. *Id.* Still other embodiments provide for reception of an audio signal from a media player. *Id.* 

#### E. Illustrative Claim

Claim 1 is illustrative, and recites as follows:1

- [1.P] A media measurement method comprising:
- [1.1] (a) receiving over a network, at one or more computers, data for a sequence of video data samples, the video data samples comprising representations of video data captured at a media monitoring device, the plurality of video data samples being submitted over the network;
- [1.2] (b) using the one or more computers to query an electronic database of a plurality of video data representations and corresponding content identifiers;

<sup>&</sup>lt;sup>1</sup> Bracketed organization added as per the Petition.

- [1.3] (c) generating a raw play stream, the raw play stream comprising a sequence of content identification results corresponding to the sequence of video data samples;
- [1.4] wherein: the sequence of content identification results is obtained by querying the electronic database to attempt to determine respective likely matches between respective video data samples in the sequence of video data samples and respective video data representations in the electronic database;
- [1.5] a content identification result of the sequence of content identification results comprises either: (i) a content identifier associated in the electronic database with a respective video data representation that is determined to be a respective likely match with a respective one of the video data samples; or (ii) an indication of the absence of a respective likely match between a respective video data sample and a video data representation in the electronic database; and
- [1.6] the raw play stream includes either: at least two different content identifiers obtained from the electronic database; or at least one content identifier obtained from the electronic database and at least one indication of the absence of a respective likely match between a respective video data sample and a video data representation in the electronic database;
- [1.7] (d) scrubbing the raw play stream by analyzing sample sequence data of the raw play stream to determine whether to change a result of the sequence of content of identification results in view of a pattern of the sample sequence data of the raw play stream compared to an expected pattern of sample sequence data; and
- [1.8] (e) generating a clean play stream from the raw play stream by making any changes to the raw play stream that are determined to be made by the scrubbing.

*F. Evidence* Petitioner relies on the following patent document evidence.

Name	Patent Document	Exhibit
Herley et al.	US 2004/0260682 A1	1005
("Herley 682")		
Seet et al.	US 2005/0193016 A1	1006
("Seet")		
Herley et al.	US 7,333,864 B1	1007
("Herley 864")		
Wang et al.	US 2002/0083060 A1	1008
("Wang")		

# G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–15 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1-3, 5-6, 8-11, 13-14	$103(a)^2$	Herley 682, Seet
1–6, 8–14	103(a)	Herley 682, Seet, Herley 684
7, 15	103(a)	Herley 682, Seet, Wang
7 15	103(a)	Herley 682, Seet, Herley 684,
7, 15		Wang

#### II. ANALYSIS

# A. Legal Standards

A claim is unpatentable under 35 U.S.C. § 103(a) 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

<sup>&</sup>lt;sup>2</sup> Petitioner asserts, in view of the uncontested priority claims to application 11/139,330, filed May 26, 2005 and provisional application 60/574,836, filed May 27, 2004, that pre-AIA 35 U.S.C. 103(a) applies to the '848 patent. *See* Pet. 1. Because the amendments to 35 U.S.C. § 103 in Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), have an effective date of March 16, 2013, we agree.

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), if presented, objective evidence of non-obviousness.<sup>3</sup> *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

# B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art ["POSITA"] at the critical time would have had "a bachelor's degree in electrical engineering, computer engineering, computer science, or equivalent degree with at least two years of relevant industry experience, including in digital media content delivery." Pet. 2 (citing Ex. 1003 ¶ 32). Patent Owner argues that the level of ordinary skill should include persons lacking a formal degree but possessing considerable industry experience designing and implementing automated content recognition systems, and that such systems are the relevant industry experience. Prelim. Resp. 6–8. For purposes of this Decision, we adopt Petitioner's proposed level of ordinary skill, modified by the more inclusive standards of Patent Owner, as it appears to be consistent with the specification of the '848 patent and the prior art of record.

<sup>&</sup>lt;sup>3</sup> Neither party presents evidence or arguments regarding objective evidence

#### C. Claim Construction

In an *inter partes* review, we construe a patent claim "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)." 37 C.F.R. § 42.100(b). Under this standard, the words of a claim generally are given their "ordinary and customary meaning," which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Here, neither party sets forth any explicit claim construction. Pet. 14; Prelim. Resp. Although Patent Owner analyzes the term "media monitoring device" in its arguments (Preliminary Response 37–43), our ultimate determination on institution does not turn on that construction. We determine that no need exists to determine a particular construction for purposes of this institution decision, and instead construe the claims pursuant to § 42.100(b).

#### D. Obviousness

All of Petitioner's assertions of unpatentability rely on teachings of Seet. *See supra* § I(G). Patent Owner argues that Seet is not prior art because it has not been shown by Petitioner to be entitled to a priority date that would qualify Seet as prior art. We start by addressing this issue.

# Prior art status of Seet

Petitioner asserts that Seet is prior art as of the February 17, 2004 filing date of provisional application 60/545,681 (hereinafter the "Seet provisional"). Pet. 17–22; Ex. 1006, code (60). Patent Owner disputes that assertion, arguing that Seet is not entitled to its provisional filing date and

does not antedate the May 27, 2004 effective filing date of the '848 patent. Prelim. Resp. 9–10.

Because the pre-AIA patentability statute applies to the '848 patent, *Dynamic Drinkware* applies to determining the applicable date of Seet. *Dynamic Drinkware LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1381–82 (Fed. Cir. 2015). *See supra* § I.G n.2. The parties agree. Pet. 17 (citing *Dynamic Drinkware*, 800 F.3d at 1381–82); Prelim. Resp. 12 n.4 (citing *Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021–01466, Paper 34, 29–35 (March 10, 2023) (precedential as to § II.E.3)). *Dynamic Drinkware* states, "[a] reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112, ¶ 1." *Dynamic Drinkware*, 800 F.3d at 1381–82. The requisite § 112 support must include written description support for the full scope of that claim. *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4<sup>th</sup> 1330, 1337 (Fed. Cir. 2021), 19.

Petitioner retains the burden of persuasion for its obviousness contentions, including that Seet is prior art to the asserted claims. *Dynamic Drinkware*, 800 F.3d at 1378–1380. Petitioner also bears the burden of production of arguments and/or evidence to show that Seet is entitled to the benefit of its provisional filing date. *Id.* at 1380 (stating, "because the PTO does not examine priority claims unless necessary, the Board has no basis to presume that a reference patent is necessarily entitled to the filing date of its provisional application"); *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016) (finding the shifting of the burden of production is not warranted where "patentee's position is that the patent challenger failed to meet *its* burden of proving obviousness"). We further note that in this

proceeding there is no dispute about the effective filing date of the asserted claims of the '848 patent that would shift the burden of production to Patent Owner.<sup>4</sup> *See In re Magnum Oil*, 829 F.3d at 1376.

The parties' dispute centers on whether the Seet provisional provides written description support for claim 9 of Seet, which recites,

[a] method for generating entries for a media content database, the method comprising:

receiving a first media stream;

receiving a second media stream; matching at least some portions of the second media stream to the first media stream to determine repeating content between the streams;

and presenting the repeating content to a reviewer for identification.

Ex. 1006, 6. Pertinent to the parties' dispute is whether "media," as used in claim 9, is supported by the Seet provisional. Petitioner points to the title of the Seet provisional, "Media Content Database Creation and Maintenance Using Time-Delayed Auto-Correlation of Frequency Characteristics." Pet. 18 (citing Ex. 1019, 4, Title). Petitioner further asserts that "media" is supported by the following description in the Seet provisional:

Instead of using a high-quality original master recording (say a CD, or digital video tape, etc), we suggest using the same audio signal that is to be identified, but from a previous period. In the case of radio or television monitoring, we propose that the previous period (i.e. day or dayperiod) for that particular station (or genre, or group of similar stations), be fingerprinted, and inserted into a fingerprint database."

<sup>&</sup>lt;sup>4</sup> Patent Owner argues that the May 27, 2004 effective filing date of the '848 Patent was not contested by Petitioner in this proceeding, and therefore, Patent Owner does not bear any burden to show entitlement to that date. Prelim. Resp. 9, 11 n.3.

*Id.* at 18–19 (citing Ex. 1019, 4). Petitioner further cites to "DB of Previous Day's Samples." *Id.* at 19 (citing Ex. 1019, 5–6, Figs. 1–2).

Patent Owner argues that the Seet provisional is limited to audio, and does not describe the full scope of Seet claim 9, which includes audio and video. Prelim. Resp. 13 (citing Ex. 2001 ¶ 54). Regarding the Seet provisional, Patent Owner points to a definition of media therein, which states, "[m]edia will be defined as any streaming audio source in any form, be it radio, television, cable, satellite, internet stream, or the like." *Id.* at 14 (citing Ex. 1019, 4). Patent Owner asserts that the Seet provisional discusses video and television only in the sense that the audio portion of the signal is being used for matching. *Id.* at 14–15 (quoting Ex. 1019, 4 ("Instead of using a high-quality original master recording (say a CD, or a digital video tape, etc[.]), we suggest using the same audio signal that is to be identified.")). Patent Owner further points to other sections of the Seet provisional as discussing audio "in every single instance." *Id.* at 15–16.

Patent Owner contrasts the audio-only media of the Seet provisional to the audio-and-video media of the Seet specification and claims. *Id.* at 16–19. Regarding Seet, Patent Owner points to a definition of media therein, which states,

As used herein, media items and media data may include information used to represent a media or multimedia content, such as all or part of an audio and/or video file, a data stream having media content, or a transmission of media content. Media content may include one or a combination of audio (including music, radio broadcasts, recordings, advertisements, etc.), video (including movies, video clips, television broadcasts, advertisements, etc.), software (including video games, multimedia programs, graphics software), and pictures; however, this listing is not exhaustive.

Id. at 17 (quoting Ex.  $1006 \, \P \, 50$ ). Patent Owner asserts that "Seet thus expressly teaches analyzing and matching video media streams to identify content, even where no audio is present." Id. at 18 (citing Ex.  $2001 \, \P \, 61$ ). Patent Owner further asserts that Petitioner admits that Seet's media system can be used with a video file. Id. (citing Pet. 27 (citing Ex.  $1006 \, \P \, 26, 50$ )).

Patent Owner asserts that Seet's recitation of media in claim 9 includes video, and is therefore not supported by the audio-only description of media in the Seet provisional. *Id.* at 18-19. Patent Owner asserts that this lack of §  $112 \, \P \, 1$  written description support for claim 9 in the Seet provisional indicates that Seet is not entitled to its provisional filing date. *Id.* 

We agree with Patent Owner that Petitioner has not met its burden to show that Seet is prior art. Seet is not entitled to the benefit of its provisional filing date unless a claim in Seet has written description support in the Seet provisional. *See Dynamic Drinkware*, 800 F.3d at 1381–82. As the "'hallmark' of written description, . . . the disclosure must be considered as a whole, as the person of ordinary skill in the art would read it to determine if it reasonably conveys possession" of the claimed invention. *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4<sup>th</sup> 1358, 1375 (Fed. Cir. 2024) (citation and emphasis omitted).

Moreover, the entire scope of the claim must be supported by adequate written description. *Juno Therapeutics*, 10 F.4<sup>th</sup> at 1337; *see also Pandrol USA, LP v. Airboss Ry. Prod., Inc.*, 424 F.3d 1161, 1165 (Fed. Cir. 2005) ("The written description of the [patent] discloses an 'adhering material,' as claimed, in sufficient detail to show possession of the full scope of the invention."); *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345–46 (Fed.

Cir. 2000) (the purpose of the written description requirement "is to ensure that the scope of the right to exclude . . . does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification").

The requirement that the full scope of the claim be supported by adequate written description applies in the *Dynamic Drinkware* context. *See New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1296 (Fed. Cir. 2002) ("[w]hat is claimed" by a patent "must be the same as what is disclosed in" the provisional application); *Merck Sharp & Dohme Corp. v. Microspherix LLC*, 814 Fed. Appx 575, 580 (Fed. Cir. 2020) (finding a lack of written description support to entitle a reference patent to the filing date of its provisional where a patent claim recited three options but the provisional lacked description of each option).

In determining whether such written description support exists, "claim construction is inherent in any written description analysis." *Atlantic Research Marketing Systems, Inc. v. Troy*, 659 F.3d 1345, 1354 (Fed. Cir. 2011) (quoting *In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1319 (Fed. Cir. 2011)); *see Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326, 1336 (determining that the lower court erred by failing to construe a disputed term in its analysis of written description).

In construing a patent claim, we consider whether the "patentee may have acted as his own lexicographer and imbued the claim terms with a particular meaning or 'disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction." *E-Pass Techs. v.* 3Com Corp., 343 F.3d 1364, 1369. A claim term also may be limited when "consistently, and without exception," the specification provides a narrower

scope. *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1379 (Fed. Cir. 2006); *see also On Demand Mach. Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1340 (Fed. Cir. 2006) ("the claims cannot be of broader scope than the invention that is set forth in the specification").

Petitioner fails to show that the full scope of claim 9 of Seet is described in the Seet provisional. Seet expressly defines the claim term "media," stating that, as it is "used herein," "media" includes audio, video, software, and pictures. Ex. 1006 ¶ 50 ("Media content may include one . . . of audio . . ., video . . ., software . . ., and pictures"). Such a statement provides a clear definition of the term "media" that includes video, software, and pictures, in addition to audio. In addition to the express definition, Seet elsewhere indicates that its media includes video and other non-audio signals and databases. See, e.g., Ex. 1006 ¶¶ 26 ("if the media stream 102 is a video broadcast, each media item may comprise a television show or segment, an advertisement, or any other type of video"), 42–46 (creating databases of "videos," "faces," and "files"), 49 ("any signal that contains repeating content over any broadcast medium can benefit from the procedure described herein."). Accordingly, the use of media in claim 9 for its claimed "media content database" and "media stream[s]" also includes both audio and non-audio media.

The disclosure of the Seet provisional, however, is more limited and defines the term media exclusively as audio. Ex. 1019, 4 ("Media will be defined as any streaming audio source in any form, be it radio, television, cable, satellite, internet stream, or the like."). This definition does not include the full scope of "media" as that term is used in claim 9 of Seet because it does not include video, software, and pictures.

Our determination is further supported by evidence that the description of media in the Seet provisional is consistently limited to audio. *Id.* at 4–6. Consistent with its definition, the Seet provisional discusses its techniques for generating entries for a database used in content identification as being applied only to audio signals. *See, e.g., id.* at 4 (describing that "[o]ne of the biggest challenges for an audio identification or 'audio fingerprinting' company is the development and maintenance of a database of audio against which identifications are attempted," and providing the example of "television ad monitoring" in which the "audio layer" is "extract[ed]," fingerprinted, and stored in a database for subsequent retrieval).

Although the Seet provisional describes television and digital video tape monitoring, the Seet provisional "suggests using the same audio signal that is to be identified, but from a previous period," and not extracting the audio layer from a video-containing signal because of the "many operational issues" that would cause conversion to be "time consuming" and "unreliable." *Id.* at 1. Thus, the Seet provisional describes receiving a priorsent audio signal and not receiving a video-containing signal.

The foregoing review of the Seet provisional as a whole supports our determination that it consistently describes, without exception, that the term "media" refers to audio-only media. The broadening of "media" from the Seet provisional to claim 9 of Seet reflects a change in the scope of the invention possessed by the inventor. *See DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911, 915–17 (Fed. Cir. Dec. 9, 2024)

(addressing a controversy in which the "parties' dispute hinges on the variance between the [at-issue] patent's written description and the provisional application to which the patent claims priority," and determining

that "the deletion made by the patent drafter between the provisional application and the patent specification is highly significant"). Therefore, we determine that the Seet provisional does not reasonably convey possession of non-audio forms of media.

Consequently, the Seet provisional does not support the full breadth of Seet's claim 9 limitations of a "media content database," "receiving a [first and second] media stream" and "matching at least some portions of the second media stream to the first media stream to determine repeating content between the streams." The Seet provisional does not describe comparing portions of video streams that lack an audio component, or a video content database, because it only describes comparing and storing audio signals. Ex. 1019, 4–5. Nor does the Seet provisional describe receiving picture or software streams, or comparing portions of picture or software streams, or a picture or software database, as included in the scope of "media" in claim 9 of Seet.

Because claim 9 of Seet includes within its scope non-audio forms of media, including videos, software, and pictures, it is not fully described by the audio-only description in the Seet provisional. For the foregoing reasons, Petitioner fails to show that claim 9 of Seet is entitled to its provisional filing date. All of Seet's claims include a "media" limitation, because each of Seet's independent claims 1, 9, and 15 recite a "media content database" and receiving or sampling a first and second "media stream." Consequently, no claim in Seet is supported by the description in the Seet provisional.

Without the benefit of its provisional filing date, Seet, filed on February 17, 2005, is not prior art to the '848 patent, having an uncontested benefit to the May 27, 2004 filing date of its provisional. Because each of

Petitioner's unpatentability assertions rely, in part, on Seet's teachings, Petitioner has not shown a reasonable likelihood of prevailing on any of its unpatentability assertions.

# III. CONCLUSION

For the reasons discussed above, we conclude Petitioner has not shown a reasonable likelihood of prevailing with respect to any of claims 1–15. We determine that the record does not support institution. Accordingly, no *inter partes* review is instituted.

# IV. ORDER

For the foregoing reasons, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), no *inter partes* review is instituted for U.S. Patent 10,719,848 B2.

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