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Paper 8
Entered: January 5, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner,

v.

BROADBAND iTV, INC.,
Patent Owner.

Case IPR2014-01222
Patent 7,631,336 B2

Before JUSTIN T. ARBES, MICHELLE R. OSINSKI, and TINA E. HULSE, *Administrative Patent Judges.*

OSINSKI, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Unified Patents, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–4 and 7–11 of U.S. Patent No. 7,631,336 B2 (Ex. 1001, "the '336 patent"). Broadband iTV, Inc. ("Patent Owner") filed a Preliminary Response (Paper 7, "Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314, 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." 35 U.S.C. § 314(a).

Upon consideration of the Petition and Preliminary Response, we determine that Petitioner has not shown that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims of the '336 patent. For the reasons described below, we do not institute an *inter partes* review of claims 1–4 and 7–11 of the '336 patent based on the asserted grounds.

B. Related Proceedings

The parties represent that the '336 patent is the subject of the following district court proceeding: *Broadband iTV, Inc. v. Hawaiian Telecom, Inc.*, Case No. 1:14-cv-00169 (D. Haw.). Pet. 4; Paper 5, 2–3.

C. The '336 Patent

The '336 patent relates to a method for enabling the converting, navigating, and displaying of video content from a video content provider on an open online network to a discrete digital TV service provider network.

Ex. 1001, 21:15–18 (claim 1). One example of such a method outlined in the '336 patent broadly relates to the "uploading [of] wide ranging content via [the] Internet for viewing on the VOD [video-on-demand] platforms of any type of digital TV system." *Id*. at 14:36–38. Figure 4 of the '336 patent is reproduced below.

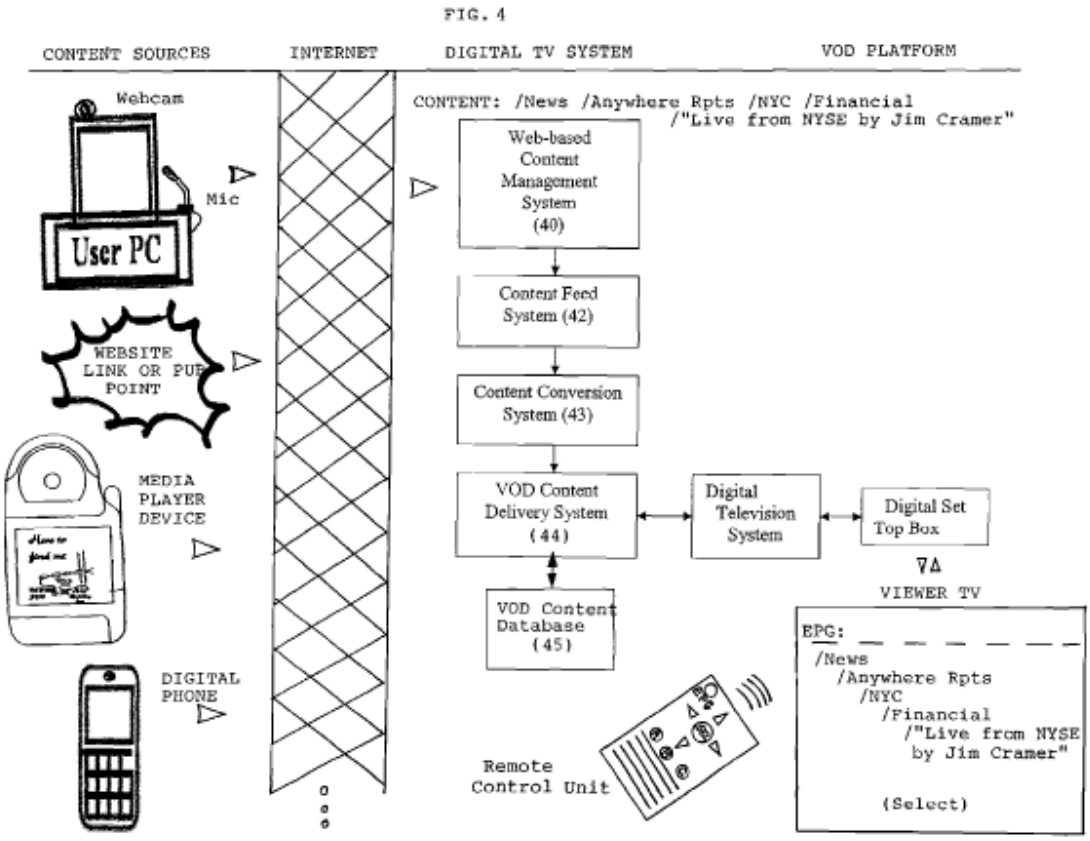

Figure 4 depicts "a diagram illustrating a process flow for enabling content publishers on the Internet to upload video content to digital television service providers for viewing on the home TV." *Id*. at 4:24–27. Referring to Figure 4, an author or publisher can upload content from his or her computer, for example, to Web-based Content Management System 40. *Id*. at 14:45–46. "[H]ierarchical addressing metadata is associated with or tagged to the content when uploaded to the Web-based Content Management

System 40." *Id*. at 16:55–57. "[T]he author or publisher selects the category term, subcategory term(s) and title by which it is desired to find the program title in the TV EPG [electronic program guide] display hierarchy." *Id*. at 16:46–50. In this way, "the addressing metadata identifying content uploaded on the Internet" is the same as the "EPG hierarchical addressing scheme used for the VOD program guide." *Id*. at 16:42–46.

Content Feed System 42 transfers the uploaded content to Content Conversion System 43. *Id*. at 14:45–47. Content Conversion System 43 converts the uploaded content "from standard digital data formats to TV video format." *Id*. at 14:45–49. The converted content is then sent to VOD Content Delivery System 44 where a "local instance" of the converted content is stored at an assigned VID [video ID] address in Video Content Database 45 for retrieval upon viewer request. *Id*. at 14:49–51, 17:3–6. "The VID address is linked to the metadata title for the video content listed in the EPG." *Id*. at 17:6–8.

"Uploaded [content is] offered to viewers by listing them on the EPG, and upon viewer selection via the Set Top Box, are delivered via the Digital TV System infrastructure." *Id*. at 14:51–54. The content is "automatically listed in the EPG under the common addressing scheme to enable viewers to find any program of interest." *Id*. at 16:60–62. "Upon the subscriber selecting . . . the title of the video content from the hierarchically-arranged categories and subcategories in the EPG, a return request for the selected title is transmitted to the VOD platform for retrieving the video content at the linked VID address in the Video Content Database." *Id*. at 17:12–18.

D. Illustrative Claim

Claim 1 is illustrative of the claimed subject matter and is reproduced below.

> 1. A method for automatically enabling the converting, navigating and displaying of video content from a video content provider on an open online network to a discrete digital TV service provider network which is of the type employing a closed system of pre-screened and pre-programmed video content selectable for viewing by TV service subscribers inputting keypresses on their TV remote control units to set-top boxes connected to their TV equipment, which predetermined video content is listed by title for selection from an electronic program guide for a video-on-demand (VOD) platform of [] the discrete digital TV service provider comprising:
>
> (a) enabling the uploading of video content in a digital video format via an online network to a Web-based content management server that is connected to the VOD platform of the discrete digital TV service provider network, along with a title and a hierarchical address of hierarchically-arranged categories and subcategories as metadata for categorizing a hierarchical ordering for the title for the video content;
>
> (b) converting the content uploaded to the Web-based content management server into a standard TV digital format used by the discrete digital TV service provider network and storing a "local instance" thereof at a video ID (VID) address in a video content database of the VOD platform, wherein the VID address is linked to the title for the video content;
>
> (c) listing the title of the video content in an electronic program guide for the VOD platform of the discrete digital TV service provider using the same hierarchically-arranged categories and subcategories as used in the uploaded metadata for the hierarchical address for the video content in the electronic program guide of the VOD platform;
>
> (d) providing a TV service subscriber, having a TV-equipment-connected set-top box connected to the VOD platform of the discrete digital TV service provider network, with access to the electronic program guide for the VOD

> platform for navigating through the hierarchically-arranged titles of video content by categories and subcategories therein in order to find the title of the video content desired for viewing on their TV equipment; and
>
> (e) upon the TV service subscriber selecting, via their TV remote control unit in communication with the set-top box, the title for the video content from the hierarchically-arranged categories and subcategories of the electronic program guide, and the set-top box transmitting a request for the selected title to the VOD platform, then enabling retrieval of the selected video content stored at the VID address in the video content database of the VOD platform linked thereto, and transmission of the selected video content to the TV service subscriber's set-top box for display on the TV service subscriber's TV equipment.

E. The Asserted Ground of Unpatentability

Petitioner contends that claims 1–4 and 7–11 of the '336 patent are unpatentable under 35 U.S.C. § 103(a) because the claims would have been obvious over White,[1] Samaan,[2] Dunn,[3] and Shoff.[4]

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, the Board interprets claim terms in an unexpired patent using the broadest reasonable construction. 37 C.F.R.

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[1] White et al., U.S. Patent No. 6,804,825 B1 (filed Nov. 30, 1998, issued Oct. 12, 2004) ("White," Ex. 1002).
[2] Samaan et al., U.S. Patent Application Publication No. 2002/0138843 A1 (published Sept. 26, 2002) ("Samaan," Ex. 1003).
[3] Dunn et al., U.S. Patent No. 5,648,824 (issued July 15, 1997) ("Dunn," Ex. 1004).
[4] Shoff et al., U.S. Patent No. 5,758,258 (issued May 26, 1998) ("Shoff," Ex. 1005).

§ 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Although Petitioner submits constructions for several terms (*see* Pet. 14-16), we determine that construction of these terms is not necessary to our determination of whether to institute trial.

B. Obviousness of Claims 1–4 and 7–11 over White (Ex. 1002), Samaan (Ex. 1003), Dunn (Ex. 1004), and Shoff (Ex. 1005)

1. Overview of White

White teaches entertainment head-end 12 that provides broadcast programming, video on demand services, and HTML-based interactive programming. Ex. 1002, Abstr. White discloses "[p]roviding a television-like interaction [not only] for on-demand video," but for "HTML-based video services" as well. *Id*. at 6:23–28. One technique for enhancing the television-like appearance of HTML-based video services is to list the services "in the system's electronic program guide simply as additional channels, amidst the other channels familiar to viewers." *Id*. at 6:59–64. An electronic program guide can be selectively displayed on screen to facilitate selection by users. *Id*. at 5:66–6:1.

White teaches that entertainment head-end 12 includes fast digital disk arrays and/or optical storage 28 for storage of MPEG-encoded digital video for on demand delivery, as well as one or more interactive services servers 30, which output HTML-based programming (i.e., customized news, celebrity chat, interactive jukebox, and interactive games). *Id*. at 2:27–33.

The content for HTML-based programming comprising customized news may be downloaded and stored in local client disk storage. *Id*. at 7:64–66. The content for HTML-based programming comprising a celebrity chat channel may include streaming audio/video. *Id*. at 8:28–30.

2. Overview of Samaan

Samaan relates to systems and methods for distributing video over a computer network. Ex. 1003 ¶ 1. Samaan is concerned with "combining the user-friendly visual experience of television with the vast information resources of the Internet while removing the seemingly complex intricacies of the Internet." *Id*. ¶ 5. Samaan teaches that its methods and systems "allow any consumer with access to a video camera and the Internet the ability to archive, post, distribute, and view any video content they desire . . . on the Internet." *Id*. ¶ 55.

Samaan's systems and methods include users uploading video clips to server computer 12 from their respective personal computers 16 via the Internet, and server computer 12 then selectively transmitting the uploaded video clips to personal computers 18 of recipients designated by the users. *Id*. ¶ 72. Server computer 12 includes Web site manager 26 operatively connected to Internet 14 for generating personal web pages and transmitting them to user computers 16 and recipient computers 18. *Id*. ¶ 76. Users' video clips are stored in database 28, and processor 30 receives raw uploaded video clips and converts them into a common predetermined format. *Id*.

Server computer 12 further includes Web page database 32 operatively connected to Web site manager 26 for storing identification information pertaining to users and recipients. *Id*. ¶ 77. "Web page data

store 32 also contains . . . memory locations of the . . . video clips in video database 28, . . . *names or identifiers of categories defined by the various users for organizing their uploaded video clips*, . . . the identities of the video clips in the selected categories," as well as other identifying information. *Id*. (emphasis added). Web site manager 26 additionally includes Web page generator 44 that can assist users in defining video clip categories, as well as selecting a background image and positioning video clip category names on the background image. *Id*. ¶¶ 82–83.

Samaan also teaches the use of video clip categorizer 48 operatively connected at an output to video clip processor 30. *Id*. ¶ 84. Video clip categorizer 48 "serves to place incoming or previously uploaded video clips in respective groupings defined by the respective user." *Id*. "[A]ddresses of . . . video clips in video database 28 are associated with their respective group names and stored therewith in Web page data store 32 by video clip categorizer 48." *Id*. Video clip categorizer 48 "may impose several levels of organization on a collection uploaded by the respective user." *Id*. ¶ 85. Samaan teaches that each video clip may be one of a set called an "event" (e.g., "Jerry's third birthday, Ellie's fifth birthday, Gary's eleventh birthday"), and that several "events" may be grouped into a "category" (e.g., birthdays). *Id*. Although there are default category names for video clips, Samaan further describes a customization process in which the default listing of video clip categories can be changed or video clip events can be recategorized. *Id*. ¶¶ 104–108. For example, users may add or modify categories, copy categories, delete categories, and/or reclassify events in the categories, etc. *Id*. ¶ 104.

3. Overview of Dunn

Dunn teaches systems and methods for controlling viewing of video movies on a television. Ex. 1004, 1:11–15. Interactive television system 30 includes centralized head-end server 32 that provides movies on demand and an electronic programming guide. *Id*. at 3:55–56, 4:22–23. Head-end server 32 includes continuous media server 50 and database server 52. *Id*. at 4:24–25. "Continuous media server 50 stores the video data streams for selected movies that are to be provided on demand to an individual household." *Id*. at 4:26–28. Video data streams "can be accessed through pointers to the particular memory location" of the respective stream. *Id*. at 4:34–36. "Database server 52 stores program descriptive information [e.g., program title, actor information, program category, description text] used by the electronic programming guide (EPG) or other menus, such as a movie-on-demand menu." *Id*. at 4:47–55. "Database server 52 also holds pointers to memory locations within . . . continuous media server 50." *Id*. at 4:56–57.

Viewers can select the programming of their choice from a menu, and head-end server 32 retrieves the digital video data stream from continuous media server 50 using pointers from database server 52 and transmits the digital video data stream to the requesting set top box for display on the television. *Id*. at 4:60–65.

4. Overview of Shoff

Shoff teaches systems and methods of providing selective levels of programming for designated viewers. Ex. 1005, 1:7–11. Predetermined characteristics of programming may include content-based and class-based characterizations corresponding to those assigned to designated viewers. *Id*. at 6:53–55. These characteristics are stored as programming data and

"preferably are included in an electronic programming guide (EPG) database at central control node 12." *Id*. at 6:56–58. In some embodiments, viewers can request information about the content or class of a specific program, or could request a specific time listing for programming of a specific content or class. *Id*. at 9:16–25.

5. Obviousness of claims 1–4 and 7–11

Petitioner argues that the combination of White, Dunn, Shoff, and Samaan renders claims 1–4 and 7–11 unpatentable as obvious. Pet. 16. Petitioner argues that White teaches a system providing both video-on-demand and HTML-based video services in which users select from an electronic program guide that is organized by categories. *Id*. (citing the declaration of Sheila S. Hemami, Ph.D., Ex. 1006 ¶¶ 31–32).[5] Petitioner argues specifically that the HTML-based video services are included in the electronic program guide of the video on-demand system. *Id*. at 17 (citing Ex. 1006 ¶ 33).

Petitioner further points out that Samaan teaches that users can share content via the Internet by uploading content "to a central location where it is converted into a common format, stored, and indexed into categories, such that they can share the content with other users ('recipients')." *Id*. Petitioner reasons that:

> the video content in the Internet library of Samaan would provide relevant and appropriate HTML content for delivery to end-users in the video-on-demand system of White. Such an inclusion would broadly increase the available programming to

[5] Dr. Hemami's declaration largely repeats portions of the Petition, including Petitioner's claim chart. *See* Pet. 24–59; Ex. 1006 at 26–60.

> viewers, and would also provide a rich source of new content because of the inclusion of uploaded content in Samaan. One of ordinary skill would strive to provide greater and richer content, because a system with greater content would be seen as one of higher value. The added functionality of supporting uploaded content would thus be seen as a strong benefit to the system of White.

Id. at 20–21. Petitioner further argues that even though the combination of White and Samaan might have "one storage entity in which the converted uploaded videos reside and a separate storage entity in which the non-user uploaded videos in the VOD system reside," it would be a mere "matter of design choice" for one of ordinary skill in the art to use a single database to house both types of content. *Id*. at 21–22.

Although Petitioner arguably has explained how the combination of White and Samaan arrives at the uploading of video content via an online network to a server connected to the video on-demand platform of a discrete digital TV service provider, we are not persuaded that Petitioner has explained adequately how the combination of prior art arrives at (i) the inclusion of "a title and a hierarchical address of hierarchically-arranged categories and subcategories as metadata" for the content uploaded through the Internet; and (ii) listing the content uploaded through the Internet "in an electronic program guide . . . using the same hierarchically-arranged categories and subcategories as used in the uploaded metadata for the hierarchical address for the video content in the electronic program guide." *See* Ex. 1001, 21:27–34, 42–48 (claim 1).

Petitioner explains that White teaches an "electronic program guide" including video content categories (Pet. 28, 40–41 (citing Ex. 1002, 5:66–6:9, Fig. 4)) and also teaches channels, such as a news service channel, for

example, organized into a small number of categories, such as headlines, sports, weather, traffic, and financial, for example (Pet. 29–30 (citing Ex. 1002, 7:44–59). Patent Owner argues that "White contains no teaching that the video content is arranged in the appropriate categories based on metadata . . . with the video content." Prelim. Resp. 21. We agree with Patent Owner that Petitioner has failed to explain adequately how White teaches listing content in hierarchically-arranged categories and subcategories in an electronic program guide where the hierarchically-arranged categories and subcategories of the electronic program guide are the same as those used in the metadata associated with the content.

Although Petitioner also explains that Samaan teaches (i) uploading a particular "subject matter category" with uploaded content (Pet. 33), (ii) that categories can be assigned to content and stored in a database (*id*. at 37), and (iii) that uploaded content is presented to a user via a web page (*id*. at 43–44 (citing Ex. 1002 ¶¶ 37–38)), Petitioner still fails to explain adequately how a person of ordinary skill in the art would have combined the teachings of Samaan with those of White in such a manner that content uploaded through the Internet would be listed in hierarchically-arranged categories and subcategories in an electronic program guide, where the hierarchically-arranged categories and subcategories of the electronic program guide are the same as those used in the metadata associated with the content uploaded from the Internet.

Patent Owner argues that Samaan teaches that "the categories are established and stored in the Web page data store 32, and the video clips are then assigned to various ones of those categories." Prelim. Resp. 22. We agree. Even if Samaan allows for customization of categories, Petitioner has

not provided sufficient reasoning that would support why one of ordinary skill in the art would select categories that are the same as those used in the electronic program guide of a VOD platform of a discrete digital TV service provider.

Patent Owner also argues that "Samaan *never* uses the term 'metadata.'" *Id*. at 21. Patent Owner explains that "where a category is 'assigned' to video content . . . through metadata associated with the video content . . . , the category information becomes portable and can travel with the video content from location to location." *Id*. at 22–23. Samaan, however, relies on "a list of video clips associated with [a] chosen category" in which "a single category [can] contain[] identifiers for any number of video clips." *Id*. at 22. Patent Owner further argues that Samaan merely teaches "the user *manually* placing the video clips into the categories provided on the web site" and "[i]f title-ordering metadata had been uploaded to the server computer 12 along with the video clips, . . . the user would not have had to perform a manual categorization step to place the video clips in the appropriate locations on the web site." *Id*. at 23. We agree with Patent Owner that Petitioner has not explained adequately how Samaan remedies the deficiencies of White so as to provide hierarchically-arranged categories and subcategories as metadata for the title for the video content uploaded from an online network. Consequently, Petitioner has failed to show that the combination of references teaches or suggests all of the limitations of claim 1.

Although Petitioner also explains that Dunn teaches an electronic programming guide (Pet. 41 (citing Ex. 1004, 4:21–22)) and that Shoff teaches the presentation of category and sub-category information in

electronic programming guides to facilitate selection of content by subscribers (Pet. 41–43 (citing Ex. 1005, 5:56–6:3, 6:50–58, 9:16–26)), Petitioner fails to explain adequately how a person of ordinary skill in the art would have combined the teachings of Dunn and/or Shoff with those of White and/or Samaan so that content uploaded through the Internet would be listed in hierarchically-arranged categories and subcategories in an electronic program guide, where the hierarchically-arranged categories and subcategories of the electronic program guide are the same as those used in the metadata associated with the content uploaded from the Internet. *See also* Prelim. Resp. 23–24 (explaining that Shoff only teaches that electronic programs guides may contain categories and subcategories, not that metadata is uploaded along with video content such that the electronic program guide uses the same hierarchically-arranged categories and subcategories as the metadata).

Finally, Petitioner fails to articulate a rational evidentiary underpinning explaining why an ordinary artisan would have had a reason to combine the teachings of White, Samaan, Dunn, and Shoff so as to arrive at the claimed subject matter. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (stating "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine elements in the way the claimed new invention does"). Specifically, claim 1 recites that the content uploaded through the Internet is uploaded "along with a title and a hierarchical address of hierarchically-arranged categories and subcategories as metadata" and the title of the uploaded content is listed "in an electronic program guide . . . using the same hierarchically-arranged categories and subcategories as used in the uploaded metadata for the

hierarchical address for the video content in the electronic program guide." Ex. 1001, 21:27–34, 43–49 (claim 1). The claims of the '336 patent are directed toward "migrating content to a discrete, closed cable television system using the Internet." Prelim. Resp. 1. The use of the same hierarchically-arranged categories and subcategories in both metadata of the uploaded content itself and in the electronic program guide help facilitate the migration of the content into cable television systems. *Id*. at 2. But Petitioner has failed to explain sufficiently why one of ordinary skill in the art would use the same hierarchically-arranged categories and subcategories in both metadata of the uploaded content itself and in the electronic program guide based on the combination of White, Samaan, Dunn, and Shoff.

Consequently, we are not persuaded that Petitioner has demonstrated a reasonable likelihood that independent claim 1 is unpatentable as obvious over White, Samaan, Dunn, and Shoff. For the same reasons, we are not persuaded that Petitioner has demonstrated a reasonable likelihood that dependent claims 2–4 and 7–11 are unpatentable as obvious over White, Samaan, Dunn, and Shoff.

III. CONCLUSION

For the foregoing reasons, based on the present record, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on the asserted grounds of unpatentability.

IV. ORDER

For the reasons given, it is

ORDERED that institution of *inter partes* review is *denied*.

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