

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRIENDFINDER NETWORKS INC., STREAMRAY INC., WMM, LLC,
WMM HOLDINGS, LLC, MULTI MEDIA, LLC, AND
DUODECAD IT SERVICES LUXEMBOURG S.À.R.L.,
Petitioner,

v.

WAG ACQUISITION, LLC,
Patent Owner.

Case IPR2015-01033
Patent 8,327,011

Before GLENN J. PERRY, TREVOR M. JEFFERSON, and
BRIAN J. McNAMARA, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

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

BACKGROUND

Friendfinder Networks Inc., Streamray Inc., WMM, LLC, WMM HOLDINGS, LLC, Multi Media, LLC, and Duodecad IT Services Luxembourg S.À.R.L (collectively, “Petitioner”) filed a petition, Paper 1 (“Pet.”), to institute an *inter partes* review of claims 1–4 (the “challenged claims”) of U.S. Patent No. 8,327,011 B2 (“the ’011 Patent”). 35 U.S.C. § 311. WAG Acquisition (“Patent Owner”) timely filed a Preliminary Response, Paper 6 (“Prelim. Resp.”) contending that the petition should be denied as to all challenged claims. We have jurisdiction under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless 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.”

For the reasons described below, we decline to institute *inter partes* review.

REAL PARTIES IN INTEREST

The Petition identifies the following real parties in interest: FriendFinder Networks Inc., StreamRay Inc., WMM, LLC, WMM Holdings, LLC, Multi Media, LLC, Various, Inc., Interactive Network, Inc., DataTech Global, LLC, DataTech Systems, LLC, Docler USA, LLC, Duodecad IT Services Luxembourg S.à r.l., Docler Holding S.à r.l., Gattyàn Family Irrevocable Trust (including Mr. György Gattyàn in his capacity as Grantor and Investment Advisor), Duodecad IT Services Hungary KFT, and Gattyàn Group S.à r.l.

PENDING LITIGATION

The Petition identifies the following litigation in which the '011 Patent and related U.S. Patent No. 8,122,141 (“the '141 Patent”), related U.S. Patent No. 8,364,839 (“the '839 Patent”) and related U.S. Patent No. 8,185,611 (“the '611 Patent”) have been asserted: *WAG Acquisition, LLC v. Sobonito Investments, Ltd.*, No. 2:14-cv-1661 (D.N.J.) ('141 Patent; '011 Patent; '611 Patent; and '839 Patent); *WAG Acquisition, LLC v. Multi Media, LLC*, No. 2:14-cv-2340 (D.N.J.) ('141 Patent; and '011 Patent); *WAG Acquisition, LLC v. Data Conversions, Inc.*, No. 2:14-cv-2345 (D.N.J.) ('141 Patent; and '011 Patent); *WAG Acquisition, LLC v. Flying Crocodile, Inc.*, 2:14-cv-2674 (D.N.J.) ('141 Patent; '011 Patent; '611 Patent; and '839 Patent); *WAG Acquisition, LLC v. Gattyan Group S.à r.l.*, No. 2:14-cv-2832 (D.N.J.) ('141 Patent; '011 Patent; '611 Patent; and '839 Patent); *WAG Acquisition, LLC v. MFCXY, Inc.*, No. 2:14-cv-03196 (D. N.J.) ('141 Patent; '011 Patent; '611 Patent; and '839 Patent); *WAG Acquisition, LLC v. FriendFinder Networks Inc.*, No. 2:14-cv-3456 (D.N.J.) ('141 Patent; '011 Patent; '611 Patent; and '839 Patent); and *WAG Acquisition, LLC v. Vubeology, Inc.*, No. 2:14-cv-4531 (D.N.J.) ('141 Patent; and '011 Patent).

RELATED MATTERS

The '011 Patent claims to be a continuation of the '141 Patent. Petitioner states that it also has petitioned for *inter partes* review of the '141 Patent (IPR2015–0137), the '611 Patent (IPR2015– 0135); and the '839 Patent (IPR2015–0136).

THE '011 PATENT (EXHIBIT 1001)

The '011 Patent discloses a streaming media buffering system in which a server buffer manager or media source provides for sequentially

numbering media data elements. Ex. 1001, col. 8, ll. 25–28. Using a standard data communications protocol, such as TCP, the user computer transmits a request to a server to send one or more data elements, specifying the serial numbers of the data elements. *Id.* at col. 8, ll. 33–36. A media player buffer manager in a user computer maintains a record of the serial number of the last data element that has been received. *Id.* at col. 8, ll. 30–32. The server responds and the user computer continues with additional data requests, maintaining a record of the highest data element number stored in the user computer buffer, for the duration of the material to be played. *Id.* at col. 8, ll. 39–42.

ILLUSTRATIVE CLAIM

1. A media player for receiving an audio or video program, the program comprising media data elements, from a media source over an Internet protocol network, and playing the program for a user of the media player, wherein each of the media data elements is associated with a serial number, comprising
 - a processor;
 - a memory;
 - a connection to the network; and
 - media player software comprising
 - instructions to cause the media player to request from the media source a predetermined number of media data elements;
 - instructions to cause the media player to receive media data elements sent to the media player by the media source and store the media data elements in the memory;
 - instructions to implement a player buffer manager, for managing a player buffer established in the memory, operable to maintain a record of the serial number of the last media data element that has been received and stored in the player buffer;

instructions to cause the media player to play media data elements sequentially from the player buffer; and
instructions to cause the media player to transmit to the media source a request to send one or more media data elements, each identified by a serial number, and to repeat transmitting the requests to the media source for sequential media data elements so as to maintain the pre-determined number of media data elements in the player buffer until the last media data element comprising the program has been received.

ART CITED IN PETITIONER’S CHALLENGES TO PATENTABILITY

Petitioner cites the following prior art references as grounds for unpatentability:

Reference	Designation	Exhibit
Silvia Hollfelder, Florian Schmidt, Matthias Hemmje, Karl Aberer, Arnd Steinmetz “Transparent Integration of Continuous Media Support into a Multimedia DBMS	Hollfelder	Ex. 1002
Jun Su, “Continuous Media Support for Multimedia Databases”	Su	Ex. 1003
U.S. Patent No. 5,874,986 issued Feb. 23, 1999	’986 Patent	Ex. 1004
European Patent Application Pub. No. EP 0 820 204 A2 to Jaisingh <i>et al.</i> , publ. Jan 21, 1998	Jaisingh	Ex. 1005

BASIS OF PETITION

Petitioner asserts the following challenges to patentability:

Claim[s]	Basis	Challenge
1 and 4	35 U.S.C. § 103	Hollfelder in view of Su
2	35 U.S.C. § 103	Hollfelder in view of Su and '986 Patent
3	35 U.S.C. § 103	Hollfelder in view of Su and Jaisingh

ANALYSIS OF PETITIONER'S PRIOR ART CHALLENGES

Petitioner contends that Hollfelder discloses a media player within a client-server architecture in which the client makes specific requests to a server and receives and stores in a client-side buffer specific continuous object presentation units (COPUs). Pet. 15. Petitioner notes that in Hollfelder's "client-pull" mechanism, the client maintains a record of the COPU retrieved and placed into the buffer, in order to determine which COPUs to request to continue buffering the data stream. *Id.*

As noted above, each of Petitioner's challenges cites Su. Petitioner contends that Su discloses a client-pull system that assigns all of the COPUs disclosed in Hollfelder indexes numbered from 0 to n-1, where n denotes the total number of COPUs. *Id.* at 16. Petitioner argues that Su's indexes are the functional equivalent of serial numbers, as claimed in the '011 Patent. *Id.*

As an initial matter, Patent Owner contends that Petitioner has not demonstrated Su was publicly accessible, so as to constitute printed publication prior art. Prelim. Resp. 2. Petitioner has the initial burden of production of evidence establishing that Su is applicable as prior art.

Dynamic Drinkware LLC v. National Graphics, Inc. No. 2015-1214, 2015 WL 5166366, at *2–3 (Fed. Cir. Sept. 4, 2015). In our August 6, 2015, denial of Petitioner’s request for authorization to submit a response to the Patent Owner Preliminary Response concerning this issue, we noted that during a telephone conference on August 4, 2015, Petitioner acknowledged that it did not seek to introduce new evidence or rebut facts presented in the Patent Owner Preliminary Response and that the question before us is a legal one. Paper 7, 2–3. Where no facts are in dispute, the question of whether a reference represents a “printed publication” is a question of law. *In re Cronyn*, 890 F.2d 1158, 1159 (Fed.Cir.1989).

The Petition states that Su is a thesis submitted to the Department of Computing and Information Science at Queens University, Ontario, Canada in September 1998. Pet. 11. The copy of Su submitted as Exhibit 1003 bears a copyright notice with the year 1998. Ex. 1003, 1. Petitioner further states that Su was published by and available at the National Library of Canada in 1999. Pet. 11. In support of its public availability assertion, Petitioner cites bibliographic information provided in a print-out from Theses Canada. Ex. 1013 (“TH-Su”). TH-Su includes an active PDF link to Su, identifies Su as resident on two microfiches, indicates the publisher is the Ottawa: National Library of Canada [1999], and includes an abstract. *Id.* at 1. TH-Su also includes an AMICUS No. (20672380)¹, an international standard book number (ISBN 0612312569), a Canadian Number (992099080) and the following information “Copies: NL Stacks – Mic. TJ-

¹ We understand AMICUS to be a free searchable catalog listing the holdings of Libraries and Archives Canada (LAC) and other libraries across Canada. Ex. 3001.

31256.” *Id.* However, TH-Su indicates that it is a document created and modified on July 18, 2008. *Id.* at 2.

Patent Owner does not dispute that Su is available today, or even that Su was created in 1998. Prelim. Resp. 4, 10. Patent Owner also acknowledges that TH-Su identifies the location in the library stacks where the two microfiches on which Su is stored may be found. *Id.* at 5. However, Patent Owner contends that Petitioner has not met its burden to show when Su became publicly accessible and, therefore, Su has not been shown to be a prior art printed publication. *Id.* at 4–6, 10–11, 13–14.

Patent Owner argues that the bibliographic information in TH-Su does not identify when the PDF link and abstract rendered in the document were added to the database from which that web page was generated. *Id.* at 10–11. Patent Owner also argues that TH-Su does not establish any date, short of the present, as to when Su was accessible in a searchable or indexed manner, such that it could be located by persons interested and ordinarily skilled in the subject matter or art using reasonable diligence. *Id.* It is not clear if July 18, 2008 is the date Su became available through the Theses Canada service.² The earliest related application identified on the face of the '011 Patent is Provisional Appl. No. 60/231,997, filed on Sep. 12, 2000.

Public accessibility is the touchstone in determining whether a reference is a printed publication. *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986). “A reference is publicly accessible ‘upon a satisfactory showing

² It appears that the Theses Canada service of Library and Archives Canada was launched in 1965 and has been acquiring electronic theses and dissertations since 2003. Ex. 3002, 2. We make note of this information, although we do not rely on it in this Decision because it has not been presented by the parties.

that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)(quoting *SRI Int’l, Inc. v. Internet Sec. Sys. Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). Whether a reference is a printed publication is a legal question based on underlying factual determinations. *Id.* The party seeking to introduce the reference “should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981).

Our inquiry focuses on whether Su, as it was catalogued, indexed, and shelved, was reasonably accessible to the public before the critical date. We consider all the facts and circumstances surrounding the disclosure and determine whether an interested researcher would have been able to find the reference and examine its contents exercising reasonable diligence, prior to the critical date. *In re Lister*, 558 F. 3d 1307, 1314–15, 1317 (Fed. Cir. 2009). Petitioner’s only evidence of public accessibility is TH-Su and Su itself. Thus, we look to other information provided on Su and TH-Su to assess whether Su was accessible to an interested researcher exercising reasonable diligence.

We first consider Su’s copyright notice. When determining the threshold issue of whether a document is a printed publication for purposes of a decision on institution, a copyright notice has been accepted a prima

facie evidence of publication.³ *See Ford Motor Co. v. Cruise Control Technologies LLC*, Case IPR2014-00291, slip op. at 7–8 (PTAB June 29, 2015) (Paper 44) (citing *FLIR Systems, Inc. v. Leak Surveys, Inc.*, Case IPR2014-00411, slip op. at 18–19 (PTAB Sep. 5, 2014) (Paper 9)).

However, in the absence of further evidence, a copyright notice may not be determinative. *Servicenow, Inc. v. Hewlett-Packard Co.*, Case IPR2015-00716, slip op. at 17 (PTAB Aug. 26, 2015), *LG Electronics v. Advanced Micro Devices, Inc.* Case IPR2015-00329, slip op. at 10–13 (PTAB July 10, 2015)(Paper 13). Petitioner acknowledges that Su was not published until at least 1999. Pet. 11. Thus, it is undisputed that Su was not publicly accessible during the year stated in its copyright notice, i.e., 1998.

Therefore, we accord the copyright notice no weight on the issue of public accessibility.

Petitioner offers no evidence from the ISBN, the AMICUS No., or the Canadian No. printed on TH-Su that Su was publicly accessible before the critical date. *See, Square, Inc. v. Unwired Planet LLC*, Case CBM2014-00156, slip op. at 18 (PTAB Dec. 24, 2014)(Paper 11, Decision Instituting Covered Business Method Patent Review)(ISBN found not probative of public accessibility where Petitioner did not provide a description of what the ISBN actually is, how it is generated, or what it purports to show).

Although TH-Su identifies a microfiche and the shelf on which it could be found, Petitioner provides no evidence concerning when or how Su was publicly accessible before July 18, 2008. Patent Owner argues its

³ “[A] notice of copyright . . . may be placed on publicly distributed copies from which the work can be visually perceived” 17 U.S.C. § 401(a) (emphasis added).

additional evidence “shows what the National Library of Canada did in 1999 relative to the Su thesis.” Prelim. Resp. 17.

Patent Owner’s evidence includes a photograph of the microfiche copy of Su, Ex. 2001, and a photograph of an envelope in which the microfiche is stored, Ex. 2002. The photograph of the envelope shows the following information on at the top of the microfiche in the envelope: “Jan–Jul/Aug 1999 ISSN 0225-3216 Index A Authors Titles Series.” Exhibits 2001 and 2002 provide no further information concerning when Su may have become accessible to the public.

Patent Owner represents that Ex. 2003 is a copy of an index microfiche as found in the envelope in Ex. 2002, containing the author, title and other bibliographic information for 1999 Canadian works having titles and author’s names beginning with the letter “C,” but no abstracts. Prelim. Resp. 16. Patent Owner represents that Ex. 2004 is a similar index for the same series of works having titles and authors beginning with the letter “S.” *Id.* Again, there are no abstracts. Exhibits 2005 and 2006 are blowups of the bibliographic entry for the Su thesis corresponding to Exhibits 2003 and 2004, respectively. Patent Owner contends that Exhibits 2001–2006 demonstrate that in 1999 the activities of the National Library of Canada were limited to:

copying the thesis to microfiche, creating a bibliographic entry with the author’s name and title and other identifying information (but importantly not an abstract), putting those bibliographic entries into a publicly accessible physical index, organized and accessible by looking up the author’s last name and the first word of the title in an alphabetical list, and

shelving the two theses microfiches at the library stack location specified in the index.

Prelim. Resp. 17.⁴

A thesis that is uncatalogued and unshelved, notwithstanding its accessibility to a graduate committee, is not a publication within the meaning of 35 U.S.C. § 102(b). *In re Bayer*, 568 F.2d 1357, 1362 (CCPA 1978)(where testimonial evidence indicated that a thesis would not be catalogued or shelved for many months after receipt and that during that time, it would be accessible only to library employees). In contrast, a dissertation shelved in the stacks and indexed in the catalog at the Freiburg University library was found to be a printed publication. *In re Hall*, 781 F. 2d 897– 898 (Fed. Cir. 1986)(finding that, in the absence of rebuttal evidence, an affidavit by the director and manager of the loan department at Freiburg University, stating that a dissertation received on November 4, 1977 would be available for general use toward the beginning of December, 1977, was competent evidence to establish the dissertation was accessible prior to the critical date of Feb. 28, 1978, because, even though a specific access date was not provided, the testimony was based on general library procedure as to indexing, cataloguing and shelving of theses). Thus, an exact date a reference became publicly accessible is not always required.

However, where a reference is not catalogued in a meaningful way, its availability may not be sufficient to make the reference reasonably accessible to the public. *In re Cronyn*, 890 F. 2d at 1161 (“Although the

⁴ Without other evidence, Exhibits 2001–2006 demonstrate only the existence and condition of the microfiche indexes at the time they were obtained in the library. However, given Patent Owner’s acknowledgement in the Preliminary Response, we accept Patent Owner’s inference that the National Library of Canada took these actions in 1999.

titles of the theses were listed on 3 out of 450 cards filed alphabetically by author in a shoebox in the chemistry department library, such “availability” was not sufficient to make them reasonably accessible to the public. Here, the only research aid was the student's name, which, of course, bears no relationship to the subject of the student's thesis.”). Similarly, in *In re Lister*, 558 F. 3d at 1315–16, a book concerning a golf game deposited at the Copyright Office and searchable only by the author’s last name and the first word of the title (“Advanced”) was not considered publicly accessible until sometime later when commercial databases including the full title of the work made the data keyword searchable.

In view of that above, we are persuaded by Patent Owner that the rudimentary indexing of the Su thesis by author name (“Su”) and/or the first word of the title (“Continuous,” which is the only indexing that the evidence suggests may have occurred before the priority date and does not suggest its relevance to the streaming media network transport problem addressed by the ’011 Patent) would not be sufficient to meet the applicable standard for public accessibility. Prelim. Resp. 18–19. As Patent Owner notes, such indexing would not provide a meaningful pathway to a researcher who was not previously aware of the existence of the thesis and was searching by subject matter. *Id.* at 19.

In consideration of the above, we are not persuaded that Petitioner has met its initial burden of production of evidence establishing that Su is applicable as prior art. As Su is cited as prior art in each of Petitioner’s challenges to patentability, we are not persuaded that Petitioner has demonstrated a reasonable likelihood Petitioner would prevail in its challenges to patentability and we decline to institute *inter partes* review.

SUMMARY

Petitioner has not met its initial burden to establish that Su is applicable prior art. Therefore, Petitioner has not demonstrated a reasonable likelihood it would prevail on its challenges to patentability and we decline to institute *inter partes* review.

ORDER

We decline to institute *inter partes* review.

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