

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner

v.

SITO MOBILE R&D IP, LLC and SITO MOBILE, LTD.,
Patent Owner

U.S. Patent No. 8,825,887

Title: SYSTEM AND METHOD FOR ROUTING MEDIA

**PATENT OWNER'S SUR-REPLY TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,825,887**

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PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	Complaint, <i>SITO Mobile R&D IP, LLC and SITO Mobile, LTD., v. Hulu, LLC</i> , No. 6:20-cv-00472-ADA
2002	Second Amended Scheduling Order, <i>SITO Mobile R&D IP, LLC and SITO Mobile, LTD., v. Hulu, LLC</i> , No. 6:20-cv-00472-ADA, Dkt. No. 38 (W.D. Tex., Dec. 3, 2020)
2003	Published Interview of Judge Albright, <i>IAM</i> (Apr. 7, 2020)
2004	Docket Order, <i>Kerr Machine Co. d/b/a Kerr Pumps v. Vulcan Industrial Holdings, LLC</i> , No. 6:20-cv-00200 (W.D. Tex. Aug. 2, 2020)
2005	Hulu’s Preliminary Invalidity Contentions, filed in <i>SITO Mobile R&D IP, LLC and SITO Mobile, LTD. v. Hulu LLC</i> , No. 6:20-cv-00472-ADA
2006	Hearing transcript from <i>ParkerVision, Inc. v. Intel Corp.</i> , No. 6:20-cv-00108 (W.D. Tex., Sept. 2, 2020)
2007	Order Resetting Markman Hearing, <i>SITO Mobile R&D IP, LLC and SITO Mobile, LTD., v. Hulu, LLC</i> . No. 6:20-cv-00472-ADA, Dkt. No. 64 (W.D. Tex., Feb. 25, 2021)
2008	Order Denying Defendant’s Motion to Transfer, <i>SITO Mobile R&D IP, LLC and SITO Mobile, LTD., v. Hulu, LLC</i> , No. 6:20-cv-00472-ADA (W.D. Tex., Mar. 24, 2021)
2009	Order Governing Procedures – Patent Case, Version 3.3, (W.D. Tex. Feb. 23, 2021) (Albright, J.)
2010	Claim Construction Order, <i>SITO Mobile R&D IP, LLC and SITO Mobile, LTD., v. Hulu, LLC</i> , No. 6:20-cv-00472-ADA, Dkt. No. 67 (W.D. Tex., Mar. 25, 2021)
2011	Claim Construction Order (WDTX 3-25-2021)
2012	Declaration of Michael Adams
2013	Bate Declaration
2014	Welke Declaration
2015	Bowen Declaration

Exhibit No.	Description
2016	System and Method for Routing Media, draft patent application dated 1/13/2001 (1/13/01 Draft Application)
2017	Priority mapping conception chart Mapping (887 Claims to 1/13/01 Draft Application)
2018	Operational Concept Description (OCD) For Media Routing Algorithm for World Streaming Network dated 1/2/01
2019	Cross-examination Transcript of Henry H. Houh (7-23-2021)
2020	Comparison of '519 Application (U.S. Pat. Pub. 2003/0088686) to 1/13/01 Draft Application
2021	Comparison of '949 Patent/993 App to 1/13/01 Draft Application
2022	Operational Concept Description (OCD) For Media Routing Algorithm for World Streaming Network dated 1/17/2001
2023	App. No. 09/766,519 (U.S. Pat. Pub. No. 2003/0088686)
2024	App. No 09/838,993 (U.S. Pat. No. 7,054,949)
2025	App. No. 09/766,519 as filed 1-19-2001 from PAIR
2026	Curriculum vitae of Michael Adams
2026	Corrected Curriculum vitae of Michael Adams (10-26-2021)
2027	Deposition Transcript of Henry H. Houh (7-27-2021)

I. Hulu ignores the written description and the specific claim language of the '887 Patent.

The '887 Patent claims an improved method for streaming content (e.g., video content) to a communication device (e.g., a mobile device) where, in response to a request for media from the communication device, the video content is streamed by a remote content distribution network to the communication device in portions. This portion-by-portion streaming of the video content is controlled by the communication device (as opposed to the content distribution network) through communications initiated by the communication device and sent to the content distribution network. POR, 10-12. The '887 Patent provides that the communication device uses a three-part playscript that includes information and instructions to control what content is streamed, from what servers it is streamed and how it is streamed.

Hulu, however, overgeneralizes the claims and disregards the claim language of numerous claim limitations in its challenge.

II. SITO correctly characterized the '887 Patent and its claims.

The '887 patent claims streaming video content portion-by-portion. As Hulu concedes, the instituted claims unambiguously recite “at least one portion” and “streaming the at least one portion” of the requested media to the communication device. Ex-1001 ['887Patent], 55:24-25, 39-43. The word “portion” has a plain and

ordinary meaning (i.e., a part that is less than the whole; something that is incomplete), which must be given effect. *Home Semiconductor Corp. v. Samsung Elecs. Co., Ltd.*, 701 Fed.Appx. 1006, 1011 (Fed. Cir. 2017) (reversing the Board where its construction was “contrary to the claim language itself”). This plain and ordinary meaning of “portion” is consistent with the claim language.

The claim language in the dependent claim 117, which depends from independent Claim 98, confirms the correctness of this interpretation because it adds “generating at least one identification of at least *one other portion* of the requested media.” Ex-1001, 65:35-38; POR, 40. A POSITA would understand the plain language as providing for delivering the requested media in portions to the client. A POSITA would understand that this does not allow for the entirety of a requested program to be delivered all at once, as Hulu urges.

Hulu’s provides an example of a “movie trailer followed by a full-length movie,” but concedes these are “*stand-alone pieces of media.*” Reply, 2-3 (emph. added). Stand-alone pieces of media are not portions. A POSITA would not consider a full-length movie a “portion,” and even Hulu does not venture that far. Hulu’s scattershot citations to the specification and out-of-context quotes of the expert are just an attempt to divert from the plain language of the claims.

III. The communication device controls media streaming.

Hulu asserts that the NRP, not the claimed communication device “controls the streaming process.” Reply, 5. Hulu is just trying to distract from the relevant issues in this IPR, namely the significant differences between the prior art Hulu relies on and the claims. Hulu is also wrong. The communication device makes calls to have each media item streamed in segments. The communication device controls streaming because it controls when, how, and to where the communications are made: first to the NRP and second to the MMS to start the streaming of the portion of the requested media. But for the actions and control of the claimed communication device, none of the claimed processes would occur. Ex-1001, 13:19-20, 13:41-43, 17:15-17; Ex-1081, 140:14-22.

IV. The '887 Patent is entitled to the January 13, 2001 invention date that antedates the Madison '273 reference.

A. Patent Owner has established a prior date of invention of January 13, 2001.

The '887 Patent claims priority to application no. 09/766,519 (“the '519 App”) filed on January 19, 2001 and has a prior invention date no later than January 13, 2001. The prior invention date is based on three conception

documents¹ including a January 13, 2001 draft patent application (“the 1/13/01 Draft App”) coupled with diligence leading to the filing of the ’519 App. POR, 26-29. SITO provided three declarations supporting swearing-behind the Madison Reference.

Hulu’s Reply asserts that SITO’s POR did not set forth sufficient facts from the supporting declarations. Reply, 6-7.² But Hulu is wrong. The POR set forth the following facts with specific citations to the declarations:

- Inventor Don Bate exercised diligence from 1/13/01 by working every business day on the 1/13/01 Draft App until its filing on 1/19/01. POR, 27 (citing Ex-2013 at ¶¶ 9-11). Mr. Bate has possession of the three conception documents. *Id.* (citing Ex-2013 at ¶¶ 17-22). There have been

¹ The 1/13/01 Draft App (Ex-2016) alone establishes conception. The other two documents (Ex-2018, 2022) were system design documents and simply provide further corroboration.

² Hulu’s objections to Exhibits 2013-2015 and 2017 are untimely and waived because it failed to do so within five business days of service. 37 CFR § 42.64(b)(1).

no changes to the documents (Ex-2016, 2018, 2022) since their dates of 1/13/01, 1/2/01 and 1/17/01. *Id.* (citing Ex-2013 at ¶¶ 17-22).

- Gene Bowen was a co-worker of Mr. Bate and deceased co-inventor Chuck Jennings. POR, 27, (citing Ex-2015 at ¶¶ 8-14). Mr. Bowen worked with them in documenting the invention in the 1/13/01 Draft App. *Id.* The 1/13/01 Draft App was diligently reduced to practice between 1/13/01 to 1/19/01 with the filing of the '519 App. POR, 27 (citing Ex-2015 at ¶¶ 5-8). Mr. Bowen recognizes and corroborates the three conception documents. *Id.*, (citing Ex-2015 at ¶¶ 8-14).
- Bryce Welke is a computer forensics analyst who examined the metadata in the three conception documents (Ex-2016 [1/13/01 Draft App], Ex-2018 [1/2/01 Operational Concept Document (OCD) for Media Routing Algorithm for World Streaming Network], and Ex-2022 [1/17/01 OCD for Media Routing Algorithm]). POR, 27-28 (citing Ex-2014 at ¶¶ 1-5). Mr. Welke confirmed the dates and integrity of the aforementioned documents. *Id.*, 28 (citing Ex-2014 at ¶¶ 6-12).

Hulu does not challenge the facts set forth above (see Reply, 7-8) or anywhere in the three declarations. Hulu does not challenge the dates and

authenticity of the conception documents. Accordingly, SITO has established a prior invention date of 1/13/01 for the '887 Patent.

B. The conception documents provide support for the claimed invention of the '887 Patent.

Hulu's only challenge to the 1/13/01 effective priority date of the '887 Patent is that the conception documents do not describe the claimed "instructions" on "how the . . . portion of the requested media is to be streamed" to the communication device" in Claim 39. Reply, 7-8.³

The 1/13/01 Draft App supports the claimed "instructions" because the presentation identification instructs the communication device how to communicate with resources in the network such as the NRP and MMS/stream

³ Hulu's retreats from its challenge to the written description in 08/838,993 and the '519 Application (Pet., 6-8) because Patent Owner provided that information in its POR at 28-29. The POR established written description support in the '519 Application and the '993 App (*id.* (citing to Ex-2020, 2021)), including the term "instructions." POR, 32-33; Reply, 6. See Ex-2017, 2020-2022. Also, the '887 Patent and all intervening applications in the chain incorporate the '519 Application by reference. Thus, the showing of written description support in the '519 Application (see Ex-2017, 2020) applies to all applications in the chain.

casters to cause the content to be streamed. For example, the 1/13/01 Draft App describes that a reservation including the presentation ID is transmitted to the viewer which causes the viewer to communicate with a “stream caster 304” to control it so “the media will be streamed to the media player [communication device].” Ex-2016 [1/13/01 Draft App], 20, 31; Ex-2017, 10-11; POR, 28.

Hulu’s Reply asks why the presentation ID might not “more naturally” fit with different claim limitations. Reply, 7. “Naturally fit” is not a legal standard. Hulu argues that the 1/13/01 Draft App does not “say” the presentation ID is an instruction (*id.*), but what matters is the function of the disclosed presentation ID, not its name or label. *See Purdue Pharma LP v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (*in haec verba* support is not required); *Union Paper-Bag Mach. Co. v. Murphy*, 97 U.S. 120, 125 (1877) (inquiry is not based on the “names of things,” but at the “elements in light of what they do, or what . . . function they perform, and how they perform it . . .”). Hulu does not substantively dispute SITO’s showing that the presentation ID in the 1/13/01 Draft App supports the claimed “instructions.” Reply, 7-8.

The claimed “instructions” are also supported in the ’044 Provisional. Ex-2022, 26; POR, 29-31. Hulu’s Reply does not dispute the ’044 Provisional provides support for the claimed “instructions.” Reply 6 n.2.

C. Madison '273 is not prior art based on the priority date of the '887 Patent.

Madison '273 has a prior art effective date no earlier than January 18, 2001 (which Patent Owner does not concede). Ex- 1051, 1 (Cover). Madison is removed as prior art based on Patent Owner's January 13, 2001 date of invention.

V. Eyal/Angles does not render any claim unpatentable (Ground 1).

The combination of Eyal and Angles fails to teach numerous limitations of the claims. POR, 33-46.

A. Eyal/Angles does not disclose “instructions received from the . . . computing device to obtain at least one portion of the requested media” or “instructions as to how the at least one portion of the requested media . . . is to be streamed to the communication device.”

Each of the independent claims recites that the communication device receives (1) instructions to *obtain* the requested media and (2) instructions on *how* the requested media is to be *streamed* to the communication device.

On its first argument, Hulu sets up a strawman that the '887 Patent teaches “order” instructions and that because Eyal allegedly teaches order instructions then Eyal meets the claim limitations. Reply 10-11. But the mere order of URLs in Eyal's playlist is not an instruction at all, much less an instruction on how the communication device *obtains* the requested media or instructions on *how* the requested media is to be *streamed*. POR, 34-35. Hulu's argument on reply fails

because it is based on “ordering instructions” as opposed to the claimed instructions.

On Hulu’s second argument, SITO has already explained that metadata associated with Eyal’s play-list on how media is to be *presented* does not teach instructions on how to *obtain* the media or how the media is to be *streamed*. POR, 35-36. Hulu presents a new argument that dependent claims 84 and 111 cure its defective metadata argument. Reply, 10-11. Not the case. Claims 84/111 provide that the instructions on “how . . . the requested media is to be streamed” *further include* instructions relating to “media format, a media language, a media sequence, and advertisement insertion.” ’887 Patent, 65:5-11 (Claim 111). Hulu attempts to turn the independent claims on their head, but that would mean, for example, that a “media format” or a “media language” is an instruction on *how* the media is to be *streamed*, which cannot be the case. A POSITA would read the dependent claims as reciting additional instructions that can be included with the instructions on how the media is to be streamed. Hulu’s new argument based on dependent claims 84/111 fails.

B. Eyal/Angles does not disclose generating information based on the “capabilities of the communication device” in Claims 39, 45, 68 and 98.

The claims recite that script information with specific components is generated “based on” the “capabilities of the communication device.” *See, e.g.*, ’887 Patent (Claim 39, 55:31-33). SITO explained that Hulu fails to show that script information including *three information parts*— (i) a list identifying at least a portion of requested media, (ii) identification of the resource to facilitate streaming of the requested media, and (iii) instructions on how the media is to be streamed—is generated based on capabilities of the communication device. POR, 36-37.

On reply, Hulu does not dispute that Eyal’s discussion of the protocol *in an existing play-list* is not generating a play-list (allegedly corresponding to the script information in the ’887 Patent claims). Reply, 11-13. The ’887 Patent claims provide for the script information of (i)-(iii) to be generated based on device capabilities. Applied to Hulu’s argument, that would mean that Eyal’s play-list must be generated based on replacing http with pnm. That makes no sense and, of course, Eyal does not disclose that.

Further, Eyal does not disclose modifying protocols in an existing play-list *at all*. Hulu cites Eyal 21:35-46, but that merely describes a “preferable” format of

writing the URL string and the purported benefits of format. Eyal does not teach the system modifying or changing a URL format, least of all modifying the format of a URL to be included in play-lists sent to communication devices *based on* capabilities/attributes of the communication device.

Hulu is unable to provide an evidence-based explanation that its Eyal reference teaches generating script information with (i)-(iii) based on device capabilities. Reply, 12. Hulu's attempt to distract by making a § 112 challenge (Reply, 12-13) is not just improper, but it only serves to highlight that Hulu is on unsteady footing.

Hulu also mischaracterizes SITO's expert. Reply, 12. When Hulu asked whether Eyal would consider the user's media playback component (QuickTime) when generating and returning a playlist to that user, SITO's expert testified Eyal was capable of analyzing the *URL* to "determine its playability, if you like[,] to verify that it was a *good link*." Ex- 1081, 77:8-24. In other words, SITO's expert testified that Eyal could verify the accuracy of the URL links – not that it could detect the media playback component on the user device and responsively generate a play-list. Indeed, SITO's expert testimony is that the URLs of Eyal's play-list do *not* depend on the particular playback component of the user device. Ex-1081, 75:10-76:2.

Eyal/Angles do not generate information based on capabilities or attributes of the communication device making a request for a specific media item.

Eyal/Angles therefore do not render the claims obvious. POR, 36-38; Reply 13.

C. Eyal/Angles does not disclose or suggest delivery of the requested media in “portions” in Claims 39, 45, 68 and 98.

As discussed in Section II above, the '887 Patent discloses and claims that the requested media is delivered in portions (portion-by-portion), not in its entirety. *See* POR, 39-40. Eyal/Angles does not disclose portions of the requested media or portion-by-portion streaming of media. *Id.*

Hulu asserts that the “Eyal/Angles system discloses delivering portions of media in the same manner as the '887 Patent, such as advertisement insertion.” Reply, 14 (citing Ex-1001, 10:8-13). But Hulu’s citation to the '887 Patent undermines its argument. That passage states that “[t]he play script may include the requested media, such as one or more media clips, and additional media, such as one or more advertisements.” '887 Patent, 10:8-13. Thus, the requested media (a movie) is delivered in portions (media clips), while “additional media” (advertisements) is not described as being delivered in portions.

Further, Hulu’s argument incorrectly equates Eyal’s *search request* (Ex-1005 Fig. 4, 1:33-39, 2:19-21, 11:45-48, 19:30-40) with the claimed *media request* (Ex-1001, 9:61-65, 10:1-12, 25:48-51). Reply, 14. These two requests are quite

different. Eyal's search request is a search for *information* and this may or may not return any results. Ex- 1005, 19:30-40. Indeed, zero results will be returned in Eyal when there are no URLs that "match[] the search request." *Id.* Even in situations where Eyal's search is for a predetermined category or genre of media items, when the search is made, it is still uncertain whether any results will be returned to the user. *Id.* Thus, Eyal's search produces either zero results or one or more URLs, each URL being for an *entire media item*.

In contrast, the claimed "request for *media*" is a request for a specific, known media item. Ex-1001, 9:65-67.

Hulu argues a play-list may comprise multiple songs. Reply, 14-15. But even so, the claims still require a "*portion of the requested media.*" Eyal is a "search engine" that queries a database and does not request media as claimed.⁴ Ex- 1081, 70:12-15.

⁴ Mr. Adam's testimony (Ex-1081, 82:21-24) that Eyal's request for a "top jazz hits playlist" was a "request for media" was provided purely in the context of a discussion on Eyal alone. Mr. Adams never testified that Eyal made a request for media as claimed by the '887 patent.

D. Eyal/Angles fails to teach or suggest a “revenue sharing rule” for sharing revenue “generated by streaming . . . the requested media” in Claims 39, 45, 68 and 98.

The claims recite a “revenue sharing rule” for “sharing . . . revenue generated by streaming the at least one portion of the *requested media*.” See, e.g., ’887 Patent, 55:49-52 (Claim 39) (emph. added). Eyal/Angles fail to teach this limitation.

Hulu relies on revenue sharing from advertisements, but advertisements are not “requested media,” per the claims. POR, 44. The POSITA is well aware that the user does not request advertisements. Hulu’s reliance on revenue sharing from advertisements in both Eyal and Angles is misplaced. See Reply, 15-16.

Hulu also fails to show there is a “revenue sharing rule” disclosed in its Ground 1 references. POR, 43-44. Hulu relies solely on Angles for this element, arguing it has an advertising module that “implements a revenue sharing rule.” Pet., 23-24; Reply, 16-17. “Implements a revenue sharing rule” is not a quote from Angles, it is a phrase invented by Hulu. Nowhere does Angles disclose or teach a “revenue sharing rule.” Pet., 24; POR, 41-43; Reply, 16-17 (citations to Angles).

E. There is no motivation to combine Eyal and Angles as proposed.

Hulu points to high-level similarities between Eyal and Angles (Pet., 15-16) as a reason to combine, but the systems are actually quite different. Eyal teaches a

search engine for content on third party websites, while Angles teaches receiving ads on web pages. POR, 61-62. Eyal's open system allows any user to search and receive content, whereas Angles' closed system requires consumer users and content providers to register with a special advertisement content provider system. POR, 62-63 (citing Angles, 3:3-38); Reply, 8. Eyal involves links to content from thousands or millions of third party web sites and has no contractual arrangements with these third party web sites. Eyal, 32:38-42, 33:21-28; Reply, 8-10; POR, 63-64. A POSITA would not have a reason to combine Angles into Eyal because it would require content providers from millions of third party websites to register themselves with Eyal's system. That is totally infeasible.

F. Eyal/Angles do not render the dependent claims unpatentable.

Claim 117 further recites "generating . . . identification of at least one other portion of the requested media in the communication." '887 Patent, 65:35-38. Thus, the script information (i)-(iii) in Claim 98 which includes an "identification of . . . one portion of the requested media" ('887 Patent, 63:43-53) further includes an identification of a second portion of the requested media pursuant to Claim 117. Hulu relies solely on Eyal. However, Eyal does not disclose or suggest delivering a script identifying two separate portions of the *requested media*. Hulu concedes Claim 117 by not addressing the merits of the issue. Reply, 18.

VI. Eyal/Angles/Chang does not render Claim 105 unpatentable (Ground 2).

Claim 105 recites that the script information (i)-(iii) in Claim 98 is “generat[ed] . . . based on *rules* that specify at least one of a frame rate, a bit rate, a sequence associated with the requested media . . . ’887 Patent, 63:43-53 (Claim 98), 64:35-40 (Claim 105) (emph. added).

Hulu argues that the limitation is met because Chang discloses a file *containing* fields specifying frame rate, bit rate and sequence. Pet., 42, 44; POR, 47. Hulu tries to clean up on reply by making the unsupportable argument that Chang’s fields specifying frame rate, bit rate, etc. *are the rules* themselves. Reply, 19. Hulu does not explain or even argue that Chang teaches its file is *generated* based on *rules*. Hulu’s half-hearted argument that Eyal’s protocol header swap (pnm for http) is a rule (Pet., 44) does not show that Eyal teaches that its play-list is generated based on rules. Hulu does not show that Angles teaches a play-list generated based on rules. Hulu’s petition argument effectively ignores the “rules” requirement of Claim 105. Pet., 41-43.

VII. The combination of Madison ’273 and Wolfe does not render any claim unpatentable (Ground 3).

As explained above in Section III and in SITO’s POR, Madison is not prior art.

Its combination with Wolfe still fails to teach numerous limitations from the instituted claims. POR, 47-59.

A. Madison/Wolfe fails to teach or suggest delivery of the requested media in “portions” in Claims 39, 45, 68 and 98.

As discussed in Section II above, the '887 Patent discloses and claims that the requested media is delivered in portions (portion-by-portion). *See* POR, 48-50.

Hulu again contorts the claim language to mean that a portion of a movie can be an entire movie. Reply, 20-21. That is false and should be rejected. Further, Hulu's argument improperly relies on out of context testimony from SITO's expert. The cited testimony was in response to a hypothetical question, divorced from the state of the art at the time of invention, about how the technology could possibly be used—up to today—with ASX, and was not tied to any teaching or disclosure whatsoever in Madison or Wolfe. Accordingly, Hulu's reliance on Mr. Adams' testimony is misplaced.

B. Madison/Wolfe fails to teach or suggest “identifying . . . whether the requested media is available for streaming to the . . . communication device.”

The plain language of the claims provides that the determination of availability is made *in response* to the request for media. *See, e.g.*, '887 Patent, 55:27-30 (Claim 39). POR, 51-52.

Contrary to Hulu's assertion, Madison's disclosure that the content owner can delete files or the system can remove old expired links does not relate to the claim limitation for checking content availability in response to user request for media. POR, 51-52; Reply 21.

Hulu's new argument that the claimed determination of whether the media is available does not occur in response to a request for media (Reply, 21) is just wrong. The claim provides in the second step for determining "whether the requested media is available," with "the requested media" plainly referring back to "receiving . . . a request for media from [a] communication device" in the first step. See, e.g., '887 Patent, 55:20-30.

C. Madison/Wolfe fails to teach or suggest generating information based on a "characteristic associated with a user of the communication device."

Hulu argues that the script information (i)-(iii) in the claims is met by Madison's redirector file. Pet., 56-59. Hulu's first argument is that Madison's "ad tag" meets the user characteristic feature of the claims. However, an ad tag indicating where an advertisement can be inserted has nothing to do with the user. POR, 52.

Hulu argues that Wolfe teaches targeted advertising with ad content selected based on user profile information such as age, sex, etc. Pet., 57; Reply 22. But this

also fails because Hulu is ignoring the language of the claim requiring the *generation of script information (i)-(iii)* based on user characteristics. POR, 53; Reply 22. Hulu’s argument that “Madison teaches that its redirector file should contain *references* to advertisements” (Reply, 22, emph. Added) completely misses the point. Hulu’s argument would require the combination teach that Madison’s redirector file (the alleged script information (i)-(iii) in the claim) is generated *based on* targeted ads/user profiles (the alleged user characteristics). This, of course, is not the case. Madison’s redirector file is generated based on the playlist 328 (Madison, [0062], [0106]-[0108]) such as <http://playlistserver.company.com/makeplaylist.asp?id=12345>. Madison, [0111].

D. Madison/Wolfe fails to teach or suggest “instructions received from the . . . computing device to obtain at least one portion of the requested media” or “instructions as to how the at least one portion of the requested media . . . is to be streamed to the communication device in Claims 39, 45, 68 and 98.

Each of the independent claims recites that the communication device receives (1) instructions to *obtain* the requested media and (2) instructions on *how* the requested media is to be *streamed* to the communication device.

Hulu argues that Madison’s redirector file is a set of instructions for how to obtain the requested media and how the requested media is to be streamed. Pet., 55, 58. But Hulu is unable to make a showing that Madison’s redirector file

includes instructions to *obtain* the requested media and *how* the requested media is to be *streamed* from Madison's streaming media server 120 to the Madison's client 102. *See* Madison '273, Fig. 1.

Hulu also improperly relies on a third reference that is not part of its Ground 3, "All About ASX Files" (Ex- 1017, "AAAF"⁵). In proceedings involving related patents, Hulu properly identified the AAAF reference in its grounds. *See* IPR2021-00298 (Grounds 1-3 include Ex-1017, AAAF); IPR2021-00304 (Grounds 1-3 include Ex-1017, AAAF). Here, Hulu relies on AAAF for its alleged substantive teachings in combination with Madison and Wolfe. Pet., 58-59; POR, 54-55. But Hulu's argument should be disregarded because it constitutes a new ground—Madison in view of Wolfe and further in view of AAAF--not set forth in the Petition in accordance with 35 U.S.C § 42.104(d)(2); *see* POR, 54. Hulu's citation to *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1338 (Fed. Cir. 2020) (Reply, 23-24) is inapposite because the AAAF reference is not being used here to explain the knowledge and skills of a POSITA. Instead, the extra reference is being used to supply the missing limitation. *See, e.g.*, Pet., 59 (AAAF discloses

⁵ In its POR, SITO sometimes referred to "All About ASX Files" as "ASXF."

ASXF and AAAF are the same reference (Ex- 1017).

“instructions on how to where to get the ASF file” to allegedly meet the “instructions” limitation absent from Madison); Pet., 59 (relying on Ex-1003 [Houh Decl.], ¶ 316 (expert finding missing “instructions” solely by reference to AAAF reference)).

Madison’s ASX redirector file (par. [0110] is depicted below:

```
<ASX>
  <ENTRY>
    <REF HREF="mms://mediaserver.company.com/stream1.asf">
    <REF HREF="mms://mediaserver.company.com/stream2.asf">
    <REF HREF="mms://mediaserver.company.com/stream3.asf">
  </ENTRY>
</ASX>
```

The redirector file does not include any instructions in addition to the URLs (e.g., mms://mediaserver.company.com/stream1.asf, etc.). Hulu is now forced to argue that “[a] POSITA *would understand* that ASX files include instructions for obtaining media” and “[a] POSITA *would have understood* ASX files used by Madison to include other information such as instructions to play files . . .” Pet., 58-59 (emph. added); POR, 54-55; Reply 24. This conclusory language cannot fill a missing limitation by adding to Madison some “instructions” supplied by Hulu’s expert. Moreover, the “instructions” Hulu imagines for modifying Madison, such as “to play files in a particular order” or to “insert[] other files” (Reply, 23), still do

not meet the requirement that the claimed “instructions” are for instructing the communication device to *obtain* the requested media and *how* to *stream* the requested media to the communication device, per the claims.

E. Madison/Wolfe fails to teach or suggest a “revenue sharing rule” for sharing revenue “generated by streaming . . . the requested media” in Claims 39, 45, 68 and 98.

Hulu relies on revenue sharing from advertisements, but advertisements are not “requested media.” POR, 56. Therefore, Hulu’s reliance on revenue sharing from advertisements in both Madison and Wolfe is misplaced. *See* Reply, 24-25.

Hulu also states that “none of SITO’s arguments are actually based on the ‘revenue sharing rule’ component of the claims,” but contradicts itself in the same paragraph in noting that “SITO argues that Wolfe lacks a ‘programmed revenue sharing rule’ . . .” Reply, 24. The claims recite the affirmative step of “identifying” the revenue sharing rule. Hulu points to the payment of royalties in Wolfe, but points to nothing disclosing “identifying” a “revenue sharing rule” to govern revenue sharing in a specific case, per the claims. POR, 56-57; Reply, 24-25. Hulu’s references to “settlement record” involve a totally separate limitation of the claims and are a transparent attempt to distract. Reply, 25.

F. There is no motivation to combine Madison '273 and Wolfe as proposed.

Hulu suggests that high-level similarities between the Madison system and the Wolfe system support a motivation to combine. Pet., 52-53. That is not the case because Hulu does not propose combining Madison's system with Wolfe's system-
-Hulu proposes a specific combination which is modifying Madison with two features from Wolfe. *Id.*; Reply, 19-20.

It remains the case that a POSITA would not see a reason to modify Madison because it is focused on sharing content in a community of content owners/consumers without compensation, whereas Wolfe is focused on advertisers paying compensation to content owners. POR, 66.

G. Madison/Wolfe does not render the dependent claims unpatentable.

Regarding Claim 52, Hulu takes the position that the claimed script information (i)-(iii) is Madison's redirector file for Claim 45. Pet., 56. Hulu takes a shotgun approach in asserting that the claimed "rule" could be Madison's alleged storage rules on storing media, or its viewing rules or a "security string" "rule" for securing files. Pet., 64. None of these alleged rules is identified, processed and used as the basis for generating the recited script information (i)-(iii), as required by Claim 52. POR, 58.

Regarding claim 101, Hulu points to the URLs in Madison's redirector file (Madison, [0110]) as being the claimed "unique identifier." Nothing in Madison indicates that the mms URLs for stream1.asp, stream2.asp, etc. are unique. Those file names are based on stream IDs assigned when the content owner is uploading content and it is unlikely that they would be unique in the 2001 timeframe when, for example, an eight bit field for indicating stream IDs would quickly run out of space as a unique identifier.

Claim 117 further recites "generating at least one identification of at least one other portion of the requested media in the communication." Thus, the script information (i)-(iii) in Claim 98 which includes an "identification of . . . one portion of the requested media" further includes an identification of a second portion of the requested media pursuant to Claim 117. Hulu relies solely on Madison's "redirector file." Pet., 71; Reply, 71. However, Madison does not disclose or suggest delivering a script identifying two separate portions of the *requested media*.

VIII. CONCLUSION

For these reasons, the Board should find the instituted claims of the '887 Patent not unpatentable in view of Hulu's cited prior art.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(b), Patent Owner certifies that this Patent Owner's Response includes 5,061 words, as measured by Microsoft Word, exclusive of the table of contents, table of authorities, certificate of service or word count, and appendix of exhibits or claim listing.

Dated: December 13, 2021

By: /s/ Stephen T. Schreiner
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S SUR-REPLY TO PETITION *FOR INTER PARTES* REVIEW OF U.S. PATENT NO. 8,825,887**, together with all exhibits filed therewith was served in its entirety by filing these documents through the PTAB E2E System, as well as by email on the following counsel of record for the Petitioner:

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