

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HULU, LLC,  
Petitioner,

v.

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

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IPR2021-00265 (Patent 9,591,360 B2)  
IPR2021-00308 (Patent 8,825,887 B2)1

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Record of Oral Hearing  
Held Virtually: Monday, February 7, 2022

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Before JONI Y. CHANG, THOMAS L. GIANNETTI,  
KEVIN W. CHERRY, and MICHAEL T. CYGAN,  
*Administrative Patent Judges.*

IPR2021-00265 (Patent 9,591,360 B2)

IPR2021-00308 (Patent 8,825,887 B2)

APPEARANCES:

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The above-entitled matter came on for hearing on Monday, February 7, 2022, commencing at 1:00 p.m. EST, by video/by telephone.

1 PROCEEDINGS

2 Good afternoon. I'm Joni  
3 Chang, Administrative Patent Judge. With me are Judges Thomas  
4 Giannetti, Kevin Cherry and Michael Cygan.

5 This is a consolidated oral hearing for IPR 2021-  
6 00265 and IPR 2021-800308, involving U.S. Patent 9,591,360  
7 and 8,825,887, respectively. This is not an expanded panel of  
8 the Board. We are the judges on the panels of these two IPR  
9 proceedings.

10 This hearing is open to the public. The transcript  
11 of this hearing will be entered into the records of both  
12 cases. At this time counsel, you may introduce yourselves and  
13 your colleagues starting with Petitioner.

14 MR. WESTIN: Yes, Your Honor. Good afternoon. My  
15 name is Cameron Westin with O'Melveny & Myers, and I am  
16 counsel for Petitioner Hulu, LLC.

17 JUDGE CHANG: Okay. Thank you. Counsel for Patent  
18 Owner.

19 MR. SCHREINER: Good afternoon, Your Honor. My name  
20 is Steve Schreiner. I'm from Carmichael IP, on behalf of  
21 Patent Owner, SITO, and I'm joined by my colleague and lead  
22 counsel James Carmichael.

23 JUDGE CHANG: Thank you. Welcome. During this oral  
24 hearing, please mute yourself unless you're speaking and  
25 please identify yourself each time you speak for clarity of

1 the record. Each presenter must clearly identify the specific  
2 slide number during the presentation. We do have your  
3 demonstratives. When you refer to other papers and exhibits,  
4 please identify the paper number and exhibit number and the  
5 page number.

6 The panel will have access to all the papers and  
7 exhibits of the record of these proceedings. So consistent  
8 with our prior order, each party will have 75 minutes of  
9 total time to present its argument. You don't have to use the  
10 entire time. Petitioner has the burden of proof will proceed  
11 first. Thereafter, the Patent Owner will present its  
12 response.

13 Petitioner may reserve a small portion of its time  
14 for rebuttal and Patent Owner may reserve a small portion of  
15 its time for sur-rebuttal. Is there any questions at this  
16 time?

17 MR. WESTIN: Not from Petitioner, Your Honor.

18 JUDGE CHANG: Okay.

19 MR. SCHREINER: Not from Patent Owner, Your Honor.

20 JUDGE CHANG: Thank you. Counsel for Petitioner, you  
21 may proceed any time when you're ready, and please let me  
22 know if you want to reserve any rebuttal time.

23 MR. WESTIN: Thank you, Your Honor. Yes, I'd like to  
24 reserve 25 of my 75 minutes for rebuttal.

25 JUDGE CHANG: Okay. You may start any time.

26 MR. WESTIN: Thank you, Your Honor. As I mentioned,

1 my name is Cameron Westin. I am counsel for the Petitioner  
2 Hulu LLC, and I'll be arguing today for the Petitioner on the  
3 instituted *inter partes* review proceedings for U.S. Patent  
4 Numbers 8,825,887 and 9,591,360.

5 Now, these two challenged patents are related and  
6 many of the -- many of the disputes are similar to those that  
7 were raised in this morning's hearing as well as on the  
8 hearing on January 13th, involving the related 673 Patent.

9 In addition, the Board has already heard argument  
10 regarding the '887 Patent in connection with the instituted  
11 covered business method proceeding.

12 I will try not to cover too much of the same ground  
13 as I think the Board is familiar with a number of the issues  
14 that we're going to address here. I will also be referring to  
15 Petitioner's Exhibits 1085, which is Petitioner's set of  
16 Demonstratives that was filed in both proceedings.

17 Turning to slide two, I'm sorry, was there a  
18 question? Okay. Turning to slide number two of Petitioner's  
19 Demonstratives, the '887 Patent is titled System and Method  
20 for Routing Media.

21 The application that led to the '887 Patent was filed  
22 on March 15th, 2013 and the Patent issued September 2nd,  
23 2014. The challenge claims of the '887 Patent are directed to  
24 managing distribution of audio and video content based on  
25 characteristics of a consumer.

26 Skipping ahead to slide number four of Petitioner's

1        Demonstratives, the 360 Patent is also titled System and  
2        Method for Routing Media.

3            The application that led to the 360 Patent was filed  
4        on September 16th, 2016. The challenge claims in the 360  
5        Patent are directed to providing a file that identifies the  
6        locations of streaming content in advertisements on a content  
7        distribution network or CDN.

8            Now, the 360 Patent is the first patent in this  
9        series of patents that added disclosure regarding segments  
10       and content distribution networks, which is found in the  
11       Summary of the Invention section, that is column two, line 47  
12       through column three, line 53 of the 360 Patent.

13           And that's addressed in the Petition at pages 14 to  
14       15. I'm going to skip ahead now to slide number nine of  
15       Petitioner's Demonstratives.

16           And before I move into the specific grounds, I just  
17       want to briefly address claim construction. As shown on slide  
18       nine, Hulu proposed constructions for one term in the 887  
19       Patent and for four terms in the challenge claims of the 360  
20       Patent. Hulu's constructions are addressed in the briefing as  
21       well as some disputes between the parties.

22           But unless the Board has specific questions about  
23       the constructions, I will not address them here today and  
24       that is because any disputes between the parties over claim  
25       constructions do not matter for purposes of resolving the  
26       grounds in the Petition. And that is shown on slide 10 of

1       Petitioner's Demonstratives.

2           The parties both agree that while they disagree on  
3       some of the constructions, neither side's construction is  
4       dispositive on the issue of whether the prior art invalidates  
5       these claims. And therefore, under the Federal Circuit's GPNE  
6       vs. Apple precedent that's cited on page six of Petitioner's  
7       Reply, the Board need not determine the correct disputed  
8       construction between those disputed terms.

9           With that, I'll skip ahead to slide number 12 on the  
10       Petitioner's Demonstratives and this addresses specifically  
11       the grounds for the '887 Patent. Hulu's first ground for the  
12       challenge claims under the '887 Patent is Eyal in combination  
13       with Angles.

14          There is no dispute that both Eyal and Angles are  
15       prior art to the '887 Patent's claims. Turning to slide 13,  
16       Eyal is U.S. Patent Number 6,389,467. Eyal's Figure 19 as  
17       shown here on slide 13 with some annotation that's found on  
18       page 13 of Hulu's Petition.

19          And as shown on this slide, streaming content from  
20       multiple media servers, which are the green 1722 servers on  
21       top are routed through a network server module 1770, and  
22       provided to streaming media playback components 1710 in a  
23       user device. Eyal discloses in response to receiving a  
24       request for media from a user generating a playlist to send  
25       back to the requesting device.

26          The playlist includes links that locate a media file

1 on the network. A user terminal then accesses the URL and  
2 loads the web resource associated with each media link into  
3 the streaming media playback component.

4 Turning to slide 14, the Angles reference is U.S.  
5 Patent Number 6,385,592. Angles also describes delivering  
6 media and also describes delivering customized electronic  
7 advertisements in an interactive communication system,  
8 particularly relevant here as highlighted on slide 14 in the  
9 abstract of Angles.

10 Angles teaches that the communication system also  
11 credits accounts each time a consumer views a custom  
12 advertisement. That includes crediting a consumer account, a  
13 content provider account, and an internet provider account.

14 Turning to slide 15, the Petition describes in  
15 detail why a person skilled in the art would have been  
16 motivated to combine Eyal's streaming media system, with  
17 Angles's more explicit disclosure of targeted advertising.

18 Both Eyal and Angles describe providing targeted  
19 advertisements to viewers and also as shown here in slide 15,  
20 Eyal discloses that streaming media commercials can be  
21 inserted into playlists. Accordingly, a person of ordinary  
22 skill in the art would have been motivated to combine  
23 Angles's teachings to increase the efficiency of targeting  
24 this advertising and for allocating payments and credits for  
25 revenue derived from the delivery of advertisements.

26 Turning to slide 16 of Petitioner's Demonstratives,



1 the Petition addresses in detail how Eyal in view of Angels  
2 renders all of the challenge claims obvious. I'll briefly  
3 address SITO's arguments attempting to distinguish this prior  
4 art using Claim 98 as an exemplary claim. As shown here in  
5 slide 16, SITO's arguments are directed to four separate  
6 limitations that are highlighted here in Claim 98.

7 Turning to slide 17, the first of these limitations  
8 is that the communication that is sent to the device is  
9 generated based on one or more capabilities of the  
10 communication device, and at least one characteristic  
11 associated with a user of the communication device. Eyal  
12 discloses both of those features. Let's start with  
13 capabilities of the communication device.

14 Eyal does disclose generating the playlist based on  
15 capabilities of the communication device. When it is creating  
16 the playlist, Eyal's playlist generator modifies the network  
17 protocol that is used for the URLs based on the media  
18 playback component's capabilities. That is shown here on the  
19 right-hand side of slide 17.

20 As this quote shows, this adjustment changing the  
21 HTTP to the PNM prevents playback component 211 from failing  
22 as a result of a bug in the media playback component,  
23 particularly, if the playback component is a real network's  
24 player. In other words, a person of ordinary skill would  
25 understand that the URLs within the playlist are modified  
26 based on a capability of the user's player.

1           Now in its Sur-reply, SITO attempts to distinguish  
2           by arguing some limitations that I don't think  
3           are found in the claims.

4           First, SITO argues that all three aspects of the  
5           communication, X 1, 2 and 3 in Claim 98, that all of those  
6           need to be generated based on one or more communication  
7           capabilities of the communication device.

8           That is not a limitation in the claim. It's also not  
9           supported by the Patent, which does not disclose generating  
10          all of those limitations or excuse me, all of those pieces of  
11          information based on the capabilities of the communication  
12          device.

13          Now, SITO also argues that Eyal discloses modifying  
14          protocols in an existing playlist, not modifying those in  
15          connection with generating the playlist.

16          And that just isn't the case. SITO does not point to  
17          anything saying the playlist is created before this change is  
18          made and that wouldn't make sense in an Eyal system, because  
19          that Eyal is retrieving these URLs and associated metadata  
20          from a database and is generating the playlist depending on  
21          the media playback component of the player.

22          Turning to slide 18, Eyal also discloses generating  
23          the playlist based on the characteristics of the user. And I  
24          think that's very clear from what's shown on slide 18, which  
25          is from column 33 lines 9 through 20 of Eyal, and in  
26          particular as shown here on slide 18, Eyal discloses the

1 playlist may be personalized for the user of the end terminal  
2 1710.

3 For example, playlists may be generated for  
4 preferences and profiles specified by the user of user  
5 terminal 1710.

6 Turning to slide 19 of Petitioner's Demonstratives,  
7 SITO's next argument is that Eyal does not teach that the  
8 communication includes at least one identification of the at  
9 least one portion of the requested media.

10 This argument is part and parcel of the same  
11 mischaracterization of the '887 Patent that my colleague  
12 discussed in this morning's presentation, in particular that  
13 the portions or segments of the claims require -- cannot be  
14 met by a media file and instead must be some portion of that  
15 file.

16 This argument fails for the reasons that we  
17 discussed this morning. I also simply wanted to point out  
18 that it fails in light of the claim language specifically in  
19 this term or in this claim, which recites "at least one  
20 identification of the at least one portion of the requested  
21 media." Accordingly, if multiple portions of the requested  
22 media were to be provided, it would still meet the  
23 limitations in this claim.

24 Turning to slide 20, SITO's next argument is that  
25 Eyal does not disclose that the communication includes "one or  
26 more instructions as to how the at least one portion of the

1 requested media is to be streamed to the communication  
2 device.” Eyal discloses a playlist that contains a number of  
3 instructions of how the media is to be streamed to the  
4 communication device.

5 We've identified in the Petition, the URL. We've  
6 also identified the sequencing information contained in the  
7 playlist, and we've also identified the metadata.

8 I think what's helpful here is that the dependent  
9 claims of the '887 Patent provides some guidance on what an  
10 instruction as to how the at least one portion of the  
11 requested media is to be streamed.

12 Dependent Claim 111 of the '887 Patent depends from  
13 Claim 98 and recites “generating the one or more instructions  
14 as to how the at least one portion of the requested media is  
15 to be streamed to the communication device to include one or  
16 more instructions relating to at least one of a media format,  
17 a media language, media sequence, and an advertisement  
18 insertion.”

19 Now as shown on the right-hand side of slide 20,  
20 Eyal's playlist contains all of the information. It contains  
21 orders of the URLs to be streamed, which is a media sequence,  
22 and it contains metadata associated with the URLs that  
23 specify the media format, things like broadcast quality and  
24 image size.

25 Turning to slide 21, SITO's last argument under  
26 ground one for the Claim 98 of the '887 Patent is that the

1 combined system of Eyal and Angles does not teach the  
2 revenue sharing limitations of Claim 98.

3 These are discussed in detail in Hulu's Petition,  
4 including at pages 23 through 26, and the Reply brief at  
5 pages 10 to 11, but I did want to focus on one argument in  
6 SITO's Sur-reply.

7 And that is on page 14 of its Sur-reply, SITO argues  
8 that because Angles only discloses revenue-sharing for  
9 advertisements, that is not revenue generated by streaming  
10 the at least one portion of the requested media.

11 In other words, SITO is saying that because Angles  
12 teaches payments for the advertisements inserted into that  
13 requested media, that the revenue is not generated by  
14 streaming the at least one portion of the requested media.

15 Now, as discussed earlier today, Eyal discloses that  
16 the requested media can be something a file or, excuse me, an  
17 album containing multiple songs or a playlist, containing  
18 multiple pieces of media.

19 Eyal also discloses inserting the advertising within  
20 those multiple pieces of media. Accordingly, any revenue from  
21 those advertisements is going to be revenue generated by  
22 streaming the at least one portion of the requested media.

23 And based on the argument that we've detailed in our  
24 brief, that one of skill in the art would have been  
25 motivated to modify Eyal system to add Angle's teaching of  
26 revenue crediting and sharing for the advertising in that

1 media. When that revenue is generated, when the playlist --  
2 the requested media is played for the user, it meets this  
3 limitation.

4 Turning to Petitioner's slide 22, Hulu's second  
5 ground for the '887 Patent is the Eyal and Angles combination  
6 from ground one further combined with Chang.

7 This second ground is only asserted against a single  
8 dependent claim, Claim 105. For the sake of time unless  
9 there are specific questions about this claim, I will move on  
10 to the third ground which covers a number of the challenge  
11 claims.

12 Turning to Petitioner's slide 27, Hulu's third and  
13 final ground for the '887 Patent is Madison '273 combined with  
14 Wolfe. These references and this specific combination were  
15 discussed in this morning's hearing. I will not repeat the  
16 same discussion we had there but instead will try to focus on  
17 how these references apply specifically to the '887 Patent's  
18 claims.

19 So with that, skipping to slide 31 of Petitioner's  
20 Demonstratives, for Claim 98, SITO disputes the same four  
21 limitations with regard to the Madison '273/Wolfe combination  
22 that it did for the Eyal/Angles combination.

23 Turning to slide 32, there's an additional argument  
24 that SITO makes for Independent Claim 39 of the 87 Patent.  
25 And that is that the Madison '273/Wolfe combination does not  
26 disclose identifying whether the requested media is available

1 for streaming.

2 So, taking these distinctions or these arguments in  
3 order, turning to slide 33, Madison '273 clearly disclosed the  
4 playlist is based on the capabilities of the user device.

5 As shown here, quoted on slide 33 from Madison '273,  
6 the playlist meta file is generated dynamically, and its  
7 format can be specified, depending on the end users media  
8 player. If the request by the media player is for RealMedia content, the  
9 playlist meta file is generated with the RAM  
10 format.

11 If the media player is requesting content for  
12 Windows Media Player, the playlist meta file is generated  
13 with an ASX format. And again, Petitioner's or Patent Owner's  
14 argument here seems to be that each of these also  
15 need to be generated, all need to be generated based on the  
16 capabilities of the communication device. And for the reasons  
17 discussed earlier that, that is simply not what's required by  
18 the claims.

19 Turning to Petitioner's slide 34, the combination of  
20 Madison '273 and Wolfe also discloses that the playlist is  
21 generated based on at least one characteristic of the user.  
22 As discussed this morning, Madison '273 discloses inserting  
23 and ad tag into the file where advertisements would be  
24 inserted.

25 That's shown at the top of slide 34 here. Now as  
26 shown at the bottom right-hand side of slide 34, Wolfe

1 teaches providing programmed media content via the Internet  
2 to subscribers and bundling that programming with  
3 advertisements tailored to the individual.

4 Wolfe accomplishes this targeted advertising using  
5 databases and subscriber profiles and advertiser preferences.

6 Importantly, in the Madison '273 system combined with  
7 the targeted advertising taught by Wolfe, when the file in  
8 Madison '273 is generated, that ad tag that is inserted would  
9 be specifically tailored to the individual user. That meets  
10 this limitation of generating the communication based on at  
11 least one characteristic associated with a user of the  
12 communication device.

13 Turning to Petitioner's slide 35, Madison '273 also  
14 discloses that the redirector file includes at least one  
15 identification of the at least one portion of the requested  
16 media and that's shown here on slide 35, where the ASX file,  
17 that's shown as an example in Madison '273, lists URLs that  
18 each show individual portions of the requested media  
19 including individual streams within the playlist redirector  
20 file.

21 Turning to Petitioner's slide 36, Madison '273 also  
22 discloses one or more instructions as to how the at least one  
23 portion of the requested media is to be streamed to the  
24 communication device.

25 As shown here on slide 36, Madison '273's playlist  
26 server 122 dynamically generates a playlist redirector file



1       which can be an ASX file, and Madison '273 specifies the type  
2       of information provided with each stream, which includes  
3       instructions on the order to play the media, as well as an ad  
4       tag instructing when and where advertisements should be  
5       streamed.

6             Now, turning to slide 37, pages 58 and 59 of the  
7       Petition detail the knowledge one of skill in the art would  
8       have possessed about these ASX files that are explicitly  
9       disclosed in Madison '273, including that those files contain  
10      numerous other instructions.

11            Now, this is an addition to the explicit  
12      instructions that are in Madison '273, but I did want to  
13      address SITO's argument that it is somehow improper for the  
14      Board to consider SITO's understanding of the capabilities  
15      and functionality of ASX files through reference to a  
16      contemporary needs document. SITO doesn't cite any authority  
17      for that position.

18            And it is, in fact, legally incorrect. On page 24 of  
19      Hulu's Reply brief, Hulu cited the Federal Circuit's holding  
20      in *Phillips NV versus Google LLC*. The citation for that is  
21      948 F.3d. 1330, and again that's on page 24 of Hulu's Reply  
22      brief.

23            In that case, the petitioner contended that even if  
24      a standard that was asserted in the primary reference, the  
25      SMIL 1.0 standard did not explicitly anticipate every  
26      limitation of the claim that other limitations would,

1       nevertheless, have been obvious over that standard in light of  
2       the general knowledge of the skilled artisan regarding  
3       distributed multimedia presentation systems as of the  
4       priority date.

5             The Federal Circuit agreed and held, "although the  
6       prior," excuse me, this is a quote. "Although the prior art  
7       that can be considered an *inter partes* reviews is limited to  
8       patents and printed publications, it does not follow that we  
9       ignore the skilled artisans knowledge when determining  
10      whether it would have been obvious to modify the prior art."

11            Thus, even if this standard did not disclose each  
12      and every element of the claimed invention, it's proper for  
13      the Petitioner to argue that the differences would have been  
14      obvious in light of the standard and in light of the  
15      knowledge of one of skill in the art. And that is -- that  
16      general knowledge of is what is relied on here  
17      and what's reflected in the all about ASX files article.

18            Turning to Petitioner's slide 38, a person of  
19      ordinary skill in the art would have been motivated to  
20      combine Madison system with Wolfe's teachings of a program  
21      that determines billing data for advertisers.

22            That modification meets the limitations in the 878  
23      Patent's claims related to the revenue sharing rules. Now  
24      SITO contends that Wolfe only discloses revenue-sharing for  
25      advertisements, not the requested media.

26            That is incorrect as shown here on slide 38. Wolfe

1 discloses tallying billing data, including royalty fees,  
2 payable to owners of the music. In other words, not just for  
3 advertisements, but for the specific media files themselves.  
4 That is in addition to preparing billing data for  
5 advertisers.

6 And like with the Eyal/Wiser combination, because  
7 Madison's redirector file contains both the media clips and  
8 the advertisements, the Madison '273/Wolfe combination also  
9 discloses the requested media is associated with a revenue-  
10 sharing rule, even when it's specific to advertising.

11 Turning to slide 39, this argument is unique only to  
12 the Madison '273/Wolfe combination, and to Claim 39, and it's  
13 Dependent Claims in the '887 Patent. And that argument that  
14 SITO makes is that Madison '273 does not identify whether the  
15 requested media is available for streaming.

16 As detailed in the Petition and the Reply brief,  
17 that is not correct. As shown here on slide 39, Madison '273  
18 discloses a script that periodically evaluates whether the  
19 content is available for streaming or whether it has expired  
20 and should be deleted.

21 I wanted to address this because in its Sur-reply,  
22 SITO raised the argument that the plain language of the  
23 claims provides that the determination of availability is  
24 made in response to the request for media.

25 It does not point to any specific claim language to  
26 support that argument. But even if that were the case, the

1 very same portion of Madison '273 that's shown here on slide  
2 39 explains that the stream's actual file name when it is  
3 expired is replaced with the file name of a default message  
4 indicating that the requested content is not available.

5 A person of skill in the art would still understand  
6 that the system would therefore identify whether the  
7 requested media is available for streaming at the time the  
8 request is made. Unless there are any further questions on  
9 the '887 Patent, I will skip to the '360 Patent and address the  
10 arguments there. Skipping ahead -- skipping ahead to  
11 Petitioner's slide 41, the '360 Patent was filed in September  
12 of 2016.

13 And while it claims priority to the earlier  
14 applications, including the '887 Patent, it contains different  
15 disclosure and that's discussed in our Petition, the addition  
16 of the --in the Summary of the Invention section. The  
17 addition of the, in the Summary of the Invention section. I  
18 only wanted to point it out because it explains for our  
19 purposes today why some of the claim language is different.

20 Turning to slide 42, the first ground asserted  
21 against the '360 Patent is the Eyal Patent which we discussed  
22 earlier in combination with Wiser, U.S. Patent Number  
23 6,385,596. There's no dispute that Eyal and Wiser are prior art,  
24 and the specific combination of Eyal and Wiser was previously  
25 discussed at the January 13th hearing related to the '673  
26 Patent that's related to these patents.

1 I'll briefly discuss Wiser now because we did not  
2 discuss it this morning. Turning to slide 43, Wiser teaches a  
3 method for online distribution of digital media data over the  
4 internet. And turning to slide 44, the content manager in  
5 Wiser creates and provides a media voucher, which is shown  
6 here in Wiser's Figure 3.

7 This media voucher is delivered to the user device  
8 to the media player. And the media voucher includes a unique  
9 voucher ID shown here in box 302 which limits the use of  
10 media voucher 300 to a single purchase or preview  
11 transaction. I'm going to skip ahead to slide 46 and discuss  
12 the arguments that SITO makes against the Independent Claims  
13 of the '360 Patent.

14 So, Hulu's Petition describes in detail how these  
15 limitations are met. I'm going to address the disputes that I  
16 believe have been raised with these three limitations  
17 starting with a unique identifier. And that's shown on slide  
18 47. The limitation is "generating an identifier uniquely  
19 associated with the client device and a viewing session for  
20 the video content."

21 Wiser's voucher ID is an identifier uniquely  
22 associated with the client device and a viewing session.  
23 Wiser discloses that the media voucher which contains the  
24 unique voucher ID is created for each purchase or preview of  
25 a media data file and is "provided to the media player 116 of  
26 the user."

1           So, as shown here on slide 47, that unique voucher  
2       ID "limits the use of the media voucher 300 to a single  
3       purchase or preview transaction." That means that this media  
4       voucher which is sent to the media player is uniquely  
5       associated with that media player of the user and not any  
6       other media device. It only valid for that one session. Now  
7       SITO asserts a different interpretation of this claim.

8           It argues that the claim requires that the voucher  
9       ID uniquely identify the specific client device. That  
10      argument is found at Pages 11 to 12 of SITO's Sur-reply. But  
11      that's not what the claim says again.

12          Claim 15 says that the identifier is uniquely  
13      associated with the client device and a viewing session for  
14      the video. That's exactly what Wiser discloses here that the  
15      unique voucher ID is sent to the player device and it is only  
16      associated with that device going forward.

17          Turning to Petitioner's slide 48, SITO also argues  
18      that Eyal does not disclose that the one or more files  
19      transmitted to the media player include an indication of the  
20      one or more segments of that video content.

21          Eyal does disclose an indication of one or more  
22      segments of the requested video content that's discussed in  
23      detail, including identifying individual media clips within  
24      the playlist. I won't go back into that argument unless there  
25      are any questions on it.

26          JUDGE CYGAN: This is Judge Cygan.

1 MR. WESTIN: Sure, Your Honor.

2 JUDGE CYGAN: Can you draw the line for me from  
3 single purchase to client device?

4 MR. WESTIN: I'm sorry, Your Honor. I'm not certain  
5 I understand the question here.

6 JUDGE CYGAN: So you're arguing that Wiser limits  
7 the use of a media voucher to a single purchase.

8 MR. WESTIN: Yes, Your Honor.

9 JUDGE CYGAN: How is that limited to a single-use  
10 purchase I guess. Is that your argument a single purchase, it  
11 has to be viewed on one client device and therefore, it  
12 couldn't be viewed on two client devices? Is that your  
13 argument?

14 MR. WESTIN: Yes, Your Honor. That is the correct  
15 interpretation of Wiser. That view is only allowed for either  
16 one preview transaction, or for a single delivery. And I think  
17 what's important is looking at the language uniquely  
18 associated with the client device in the claim.

19 But we know that that voucher ID, that specific  
20 voucher ID is -- once generated is provided to the client  
21 device. That's -- in Wiser at column eight, lines 20 through  
22 23. Did that answer your question, Your Honor?

23 JUDGE CYGAN: What does it say at that section that  
24 you just quoted 20 through 23?

25 MR. WESTIN: Yes, Your Honor. I'm sorry. Let me  
26 bring it up. I didn't have it on my slide here.

1           Beginning at column eight, line -- and it's actually  
2           line 19 where I'll start, "the media voucher is an object  
3           that is used to control the purchase and preview of media  
4           data files 200. For each purchase or preview of a media data  
5           file 200, a new media voucher is created by the content  
6           manager 112 and is provided to the media player 116 of the  
7           user.

8           The media voucher is used by the media player to  
9           identify both the specific media data file to be acquired and  
10          the delivery server to provide the information."

11          So in other words, Your Honor, the -- once that  
12          unique voucher ID is created, it's then provided to the  
13          device that requested it making it uniquely associated with  
14          that device.

15          JUDGE CYGAN: Is that kind of an argument that if  
16          you get a receipt for a transaction that you -- your ID,  
17          you're uniquely identified because you have that receipt now?

18          MR. WESTIN: I don't think that's right because the  
19          receipt and perhaps I'm misunderstanding what you're actually  
20          proposing, but I think the receipt would be reflecting that  
21          the transaction has already happened; whereas for the voucher  
22          ID that is required to obtain the video from the network  
23          server according to Wiser.

24          JUDGE CYGAN: If I understand the section you  
25          quoted, that mentioned that the voucher ID tells the media  
26          player information about what it's going to receive but I



1        didn't hear you mention anything about how it mentions  
2        anything about the identity of the media player or anything  
3        associated with the identity of the media player.

4            MR. WESTIN: Well, I'm sorry, Your Honor. The  
5        voucher ID does not have the identity of the media player.  
6        That is how -- that is how SITO is reading the claims but  
7        that's not what is required by the claims. Instead the claims  
8        require an identifier uniquely associated with the client  
9        device. And that voucher ID, which allows for only one play  
10       and is provided to the client device after its generated,  
11       meets that limitation.

12           JUDGE CYGAN: And the single play part of that was -  
13       - was in the earlier cited section?

14           MR. WESTIN: Yes, Your Honor. I believe that's also  
15       shown up here as well on slide 47, which is the that the  
16       voucher ID limits the use of the media voucher to a single  
17       purchase or preview transaction.

18           JUDGE CYGAN: Wouldn't there be a difference between  
19       a single purchase and a single play? Couldn't you have a  
20       purchase of a media and then play it numerous times in  
21       different media players?

22           MR. WESTIN: No, Your Honor. I don't think that's --  
23       well, hypothetically, you could but Wiser also discloses that  
24       it could be a preview transaction. And in that case, it's  
25       only a single preview transaction that discloses uniquely  
26       associating that identifier with the media player that it's

1 delivered to because there's not going to be a another  
2 preview transaction as a result.

3 JUDGE CYGAN: But it could be a purchase or  
4 transaction, right? So the preview transaction by itself  
5 doesn't help you because it's just an alternative.

6 MR. WESTIN: I'm sorry. I accidentally spoke over  
7 you. I couldn't -- I didn't hear what you said at the end  
8 there, Your Honor.

9 JUDGE CYGAN: Oh, my question was, if let's say a  
10 preview transaction would limit it to a single use, the fact  
11 that Wiser also disclosed a single purchase, if that's not  
12 limited to a single use, it really doesn't matter if a  
13 preview transaction limits you to a single-use, correct?

14 MR. WESTIN: I disagree with that, Your Honor. I  
15 think that that would still disclose generating an identifier  
16 in this case, an identifier for a preview transaction that's  
17 uniquely associated with the client device.

18 So, it is still disclosed by the prior art and  
19 taught by the prior art. I'd also argue that a person of  
20 ordinary skill in the art would look at this and understand  
21 that this this clearly teaches -- the point of Wiser is to  
22 limit to a single transaction.

23 And while there could be ways that perhaps a  
24 transaction could be viewed more than once, that's really the  
25 teaching of Wiser is to limit the view that you are  
26 purchasing to this unique voucher ID.

1 JUDGE CYGAN: So, in a sense if the preview  
2 transaction uses the same voucher ID as a single purchase  
3 transaction, the fact that the preview transaction can only  
4 be used by a single -- in a single use, that is what's  
5 limiting it to a unique association. That's nothing with the  
6 you're talking about the context of it?

7 MR. WESTIN: Yes, Your Honor. I would say it's two  
8 separate points that we've made in our briefing and in the  
9 Reply. The first being, yes, a preview transaction is going  
10 to be an identifier uniquely associated with the client  
11 device because that preview transaction only occurs once.

12 And there's no question that it -- that voucher ID  
13 is only going to be associated with that client device that  
14 obtained the preview. So, that is one example of Wiser  
15 disclosing this limitation.

16 Another is that frankly, the teaching -- I think the  
17 most natural read of Wiser is that these media vouchers are  
18 only meant to be used once for a single purchase or preview  
19 transaction.

20 As Your Honor noted, it doesn't exclusively say  
21 there will never be an additional play of one of these  
22 videos, but if we're looking at how one of skill in the art  
23 would interpret this and apply it to the Eyal system, I think  
24 that is the correct rating and the correct teaching.

25 JUDGE CYGAN: Okay. Thank you.

26 MR. WESTIN: Thank you, Your Honor. I'd like to,

1 unless there are any further questions on the Eyal/Wiser  
2 combination, I'll turn to slide 50 of Petitioner's  
3 Demonstratives and address the second ground asserted against  
4 the '360 Patent, which is a combination of Madison '273, and  
5 Wiser. Now, both of these references have already been  
6 discussed today. So, I'll try to move quickly through them.

7 Turning to Petitioner's slide 52, SITO disputes the  
8 same three limitations with regard to the Madison/ Wiser  
9 combination as for the Eyal/ Wiser combination. And for the  
10 first limitation highlighted here related to the unique  
11 identifier, it is the exact same argument because Hulu is  
12 again relying on Wiser for that limitation.

13 Turning to slide 53, as we previously discussed,  
14 Madison discloses an indication of one or more segments of  
15 the video content. And the example of that is what shown here  
16 in slide 53, which is individual media items stream one,  
17 stream two, and stream three with the Madison '273's  
18 redirector file.

19 Turning to Petitioner's slide 54, SITO also contends  
20 that Madison does not disclose information instructing the  
21 client device how to communicate with one or more resources  
22 of the content distribution network to cause the plurality of  
23 segments to be streamed to the client device by the content  
24 distribution network.

25 Madison does teach this limitation specifically for  
26 the reasons we've discussed before. Madison teaches that the

1       redirector file can be an ASX file and as detailed in the  
2       Petition, a person of ordinary skill would have understood  
3       that an ASX file contains instructions as shown here in the  
4       top box on where to get the ASF file.

5           Moreover, a person of ordinary skill in the art  
6       would have understood that the ASX file contains instructions  
7       on scheduling order, including scheduling content to play in  
8       succession or in a particular order. That's shown in the  
9       bottom box here on Petitioner slide 54. And with that, if --  
10      unless the Board has any further questions, I'll reserve the  
11      rest of my time for rebuttal.

12           JUDGE CHANG: I don't have any questions. Okay.  
13      Thank you. Patent Owner, counsel? You may start anytime and  
14      let me know if you want to reserve any sur-rebuttal time.

15           MR. SCHREINER: Thank you, Your Honor. We will  
16      reserve 20 minutes of sur-rebuttal time.

17           JUDGE CHANG: Okay. Thank you. You may start  
18      anytime.

19           MR. SCHREINER: I'd like to direct the Board to  
20      slide two of Patent Owner's Demonstrative. And what I'd like  
21      to do is provide an overview of the invention before we dive  
22      into the numerous distinctions between the grounds asserted  
23      and the clients.

24           The video streaming system disclosed and claimed and  
25      the '360 Patent is a highly orchestrated network that includes  
26      client devices that engage in a very specific series of

1       signaling requests and response operations.

2           These signaling -- specific signaling requests or  
3       responses from the client device cause the back end of a  
4       client of the content distribution network to locate  
5       requested media content and deliver it in a manner that  
6       ensures that it's available.

7           And that the resources for delivery are available.

8       I'll now turn to slide three and I just want to touch briefly  
9       on some terminology issues. Hulu has mentioned or referred in  
10      its slides to independent demonstrative and some of its  
11      arguments in the papers about distinctions between “program”  
12      versus “request for media.”

13           And this is really a red herring. The term “program”  
14      is not used in any of the claims of the '360 Patent or the '887  
15      Patent, except for one mention of the word “program” in Claim  
16      39 of the '887 Patent.

17           But focusing on the right hand side of the table  
18      shown on slide three and just to orient us before I show some  
19      illustrations, you can see we have requests for media or  
20      signaling for media. So, these are requests for media content  
21      submitted by a viewer client device.

22           And in the next passage on the right hand side of  
23      slide 3, you can see that we have a response from the back  
24      end of the CDN, content distribute network, to the client  
25      device request states the RTSMS 106 then generates a  
26      customized play script for the requested program to the

1 viewer.

2 Now, just to add as a footnote that the play script  
3 does not have to be customized and copied. That's a preferred  
4 embodiment.

5 Now, turning to slide four, let's discuss the  
6 operation of the system. We have -- so we client device  
7 viewer 120 sends a signal, that is a first request. And it's  
8 a request for media or a request for video content.

9 Video content in the case of the '360 Patent,  
10 requests for media in the case of the '887 Patent. In any  
11 event, there's a request for media from the client device to  
12 the backend of the CDN. And this is shown by the red arrow  
13 from the viewer 120 to the RTSMS reservation system 106.

14 Now, I'd like to direct Your Honors to slide five.  
15 Turning to slide five, it refers to a request from the client  
16 device that we just discussed causes the RTSMS 106, this is  
17 the reservation system to create a play script or if you want  
18 to call it a list of media items that is sent to -- by the  
19 blue arrow back to the viewer client device.

20 Now the RTSMS 106 reservation system applies various  
21 media rules in preparing that play script, media rules such  
22 as who can watch the media, when, what geographies, et  
23 cetera.

24 I'm not going to go into those details. The  
25 important point is that there was a first request by the  
26 client for media. We saw on slide five, and the back end of

1 the CDN, the reservation system sends back a response with a  
2 play script of items.

3 In '360 Patent, Claim 15, you can see on slide five, there's  
4 items one, two and three or I'm sorry, one through five.

5 In Claim 39 of the '887 Patent, you can see that  
6 there's -- the transmission of three items, in response to  
7 the original first client request. Now turning to slide six,  
8 besides slide 6, we have a second request signal from the  
9 client device.

10 That's viewer 120 shown by the red arrow. And it's  
11 made to the backend CDN system shown in the red box. It  
12 contains switches and streaming servers such as MMS 112 as  
13 you can see on slide six.

14 This second request signal is a different request  
15 signal from the first request signal that we discussed in  
16 slide four. The second request signal corresponds to the  
17 client device having received a play script or list of items  
18 in the prior slide. Now, sending those items or some of those  
19 items in a request to the backend of the CDN in order to have  
20 those items streamed to the client device.

21 I'd like to direct the Board's attention now to  
22 slide seven. So, now with slide seven you can see that we  
23 have the blue arrow showing the backend CDN response to this  
24 second request from the client device 120. And that response  
25 comes from the switches and streaming servers shown in the  
26 red box on slide seven.



1           So, viewed in the context of the claims, here are  
2           the client devices controlling the CDM back end by sending  
3           the second request that has a place for it or list of items  
4           one through five for the '360 Patent or items one through  
5           three for the '887 Patent.

6           So, what we've attempted to do here is provide an  
7           overview of the operation of the invention as disclosed and  
8           linked to the claims showing number one, a first request from  
9           the client device for media content. Then the back end of the  
10          CDN processes that client request and responds with a  
11          playlist or a list of items sent back to the client device.

12          The client device then submits a second request with  
13          the play script or list of items, which is sent to the back  
14          end of the CDM, having the switches and streaming servers.  
15          And finally, the back end of the CDN is controlled to deliver  
16          those content items in response to that second client  
17          request.

18          Do any of the Board members have any questions  
19          regarding this overview? As you'll note in the slides, we've  
20          linked the illustrations to the language of the claims that  
21          we're dealing with here in the '360 Patent and the '887 Patent.  
22          With that, it's convenient -- Petitioner addressed the '887 Patent  
23          and then the '360 Patent. Patent Owner's Demonstrative starts with  
24          the '360 Patent and then with the -- then goes to the '887 Patent.

25          Since the Petitioner ended with the '360 Patent, it actually  
26          I believe turns out to be convenient that we are starting

1 with '360 Patent and I'd like to direct the Board to slide 16  
2 at this time. So, the claim limitation at issue is the  
3 identifier, the unique identifier associated with a client  
4 device and a viewing session.

5 Now, Hulu admits that Eyal does not teach generating  
6 an identifier, a uniquely identifying a client device and  
7 viewing session. Hulu's argument is basically that Wiser's  
8 voucher ID 302 is the claim's unique identifier.

9 And Hulu points to Wiser's teaching that the voucher  
10 ID has two functions. This is -- these are citations by Hulu  
11 in their papers. Number one, the voucher ID identifies the  
12 specific purchase transaction.

13 And number two, the voucher ID limits the use of the  
14 media voucher to a single purchase or preview transaction.  
15 Those are both quotations from Wiser. So Wiser's voucher ID  
16 identifies "the specific purchase transaction," and secondly,  
17 it "limits the use of the media voucher 300 to a single  
18 purchase or preview transaction."

19 SITO's response is that the voucher ID 302, which is  
20 the only basis for Hulu's argument on this ground for the '360  
21 Patent, Hulu's response is, yes, it's correct. The voucher ID  
22 identifies the specific purchase transaction and the voucher  
23 ID limits the use of the media voucher to a single purchase  
24 or preview transaction.

25 So, in essence, the voucher ID creates an electronic  
26 receipt for the purchase transaction and it limits the use of

1       the media voucher to one viewing of the purchase content.

2               Wiser's system allows the user to view the purchase  
3       content one time only. How do we know that? We know that from  
4       Wiser. Wiser, column two, lines 27 through 33 again, voucher  
5       ID 302 limits the use of the media voucher to a single  
6       purchase or preview transaction.

7               Stated affirmatively, Wiser does not teach or  
8       suggest that voucher ID 302 meets the limitation of uniquely  
9       identifying a client device as required by Claim 15 of the  
10       360 Patent.

11              Furthermore, Wiser specifically teaches that its  
12       system should "allow a consumer to playback purchased content  
13       not merely on a single computer but on any platform equipped  
14       with the appropriately licensed playback device."

15              That's at Wiser column two, lines 35 through 40. So,  
16       that stated objective of Wiser confirms that the voucher ID  
17       does not uniquely identify a client device because that  
18       voucher ID needs to be capable of allowing playback on any  
19       suitable playback device of the purchaser.

20              So, what happens in Wiser is that a purchaser makes  
21       a purchase for some content and the purchaser receives a  
22       voucher ID 302, and at that time, or at a later time, the  
23       purchaser can use that voucher ID to playback that content on  
24       any client device of the purchaser. So, that shows us that  
25       the voucher ID 302 is not tied or it does not identify a  
26       specific client device.

1 JUDGE CYGAN: Counsel, this is Judge Cygan.

2 MR. SCHREINER: Yes, Your Honor.

3 JUDGE CYGAN: The fact that a consumer could later  
4 playback the content on something else, how does that take  
5 away from the fact that the identifier could still uniquely  
6 associate it with the client device, assuming we went with  
7 Petitioner's sort of context based association? Does the  
8 claim really matter when it's played back?

9 MR. SCHREINER: When the voucher ID is -- when the  
10 voucher ID is issued, it is not identified or linked to any  
11 specific client device.

12 JUDGE CYGAN: Yes, but does the playback get  
13 involved with it at all? You're making a playback argument?  
14 How does that correspond to the claim limitation?

15 MR. SCHREINER: The claim limitation states that in  
16 response to the user request, an identifier uniquely  
17 associated with the client device and a viewing session is  
18 generated.

19 So, applying that to Wiser in response to the  
20 purchaser making a purchase request, in other words, a  
21 request for a media, then that purchaser receives something  
22 that uniquely identifies the client device.

23 In the case -- that doesn't occur in Wiser. In the  
24 case of Wiser, the purchaser makes the purchase, receives the  
25 voucher ID. But that voucher ID, I apologize, my volume was  
26 turned down, I'm having some difficulty with my phone here.

1 But in response to the purchaser request in Wiser,  
2 it returns a voucher that is not linked, it does not identify  
3 a specific client device and that's in contrast to the claim  
4 language of Claim 15 of the '360 Patent which states that in  
5 response to the received sibling, which is the client  
6 requests for media, generating an identifier uniquely  
7 identified with the client device.

8 And a fair reading, a reading by a POSITA, would  
9 understand that to mean that at the time that identifier is  
10 returned to the client device, it is associated -- uniquely  
11 associated with that client device.

12 That doesn't occur in Wiser. The scenario your  
13 author refers to is well, a purchase could purchase some  
14 content and receive a voucher ID 302. And then, at some later  
15 time that voucher ID might be played back on a different  
16 client device.

17 JUDGE GIANNETTI: Mr. Schreiner, it's Judge  
18 Giannetti. Have the parties agreed that uniquely associated  
19 equates to uniquely identifies because I see a difference in  
20 those terms.

21 MR. SCHREINER: I'm not sure that the parties  
22 actually or no, let me put it this way. The issue -- that  
23 particular question was not raised by Hulu in its papers.

24 JUDGE GIANNETTI: You've consistently in your  
25 presentation said that the identifier has to be uniquely  
26 identified with the client device. So obviously, in your

1 presentation, you have equated those terms and I'm wondering  
2 whether that's something that's in dispute.

3 MR. SCHREINER: And no, it's not in dispute because  
4 Hulu has taken the same position. Hulu has--

5 JUDGE GIANNETTI: You don't see a difference --

6 MR. SCHREINER: Your Honor, if you --

7 JUDGE GIANNETTI: Yes, go ahead.

8 MR. SCHREINER: Hulu has stated that the voucher ID  
9 302 in Wiser uniquely identifies the client device. They have  
10 not hinged anything on the difference between -- any alleged  
11 difference between that and associated with. So, that is not  
12 an issue that's been raised in this proceeding.

13 And I respectfully submit that a fair proceeding  
14 would understand the language of Claim 15, that particular  
15 language as meaning that the identifier does uniquely  
16 identify the client device. There is specification support  
17 and the specification support is consistent with that. I can  
18 provide that if that would be helpful to Your Honor.

19 JUDGE GIANNETTI: I'll accept your explanation for  
20 now.

21 MR. SCHREINER: Hulu cites to Wiser at column 14:65  
22 through 15:18. This is in the Petition at page 32, as  
23 disclosing "the content manager generates a media voucher to  
24 reserve a delivery system resources."

25 This passage doesn't even mention the voucher ID  
26 that Hulu relies on or relates to an identifier that

1 identifies a specific client device as called for in Claim 15  
2 of the Patent. That passage just discusses how loads on  
3 delivery servers 118 in Wiser are managed by the content  
4 manager 112.

5 I'd like to now proceed to slide 19. So, we just  
6 addressed Hulu's first argument on Wiser for ground one on  
7 the '360 Patent. Hulu's second argument is that "an HTTP  
8 response embedding the media voucher data" sent from the  
9 content manager in Wiser to the web browser to invoke the  
10 media player, would include the media voucher and the voucher  
11 ID 302. And that somehow that meets the limitation of the  
12 claimed identifier that in response to the user requests for  
13 media identifies the client device.

14 That -- Wiser does disclose the passage I just read  
15 and that Hulu cited. But the voucher ID 302 and the HTTP  
16 response does not uniquely identify the client device. To the  
17 contrary, any requesting client device would receive the HTTP  
18 response, including the voucher ID 302 that would identify  
19 the transaction limit, the media voucher into a single  
20 purchase or preview transaction.

21 Notably, Hulu fails to explain how the voucher ID in  
22 an HTTP response in Wiser would uniquely identify that  
23 particular client device.

24 JUDGE CYGAN: Counsel, this is Judge Cygan.

25 MR. SCHREINER: Yes, Your Honor.

26 JUDGE CYGAN: You seem to be adding on an additional

1        limitation here. So, we have the claim language with -- it  
2        says “associated with a client device.”

3            And you've taken that and said that it has to  
4        identify the client device. And now you seem to say that it  
5        has to limit the client device. So that only that client  
6        device can play back the media.

7            Why would that identifier -- I don't understand how  
8        there needs to be a limitation on playback here when all the  
9        claim requires is that there be an identifier associated with  
10       the client device.

11           MR. SCHREINER: I apologize Your Honor if I gave the  
12       impression that the -- let me respond to it this way. The  
13       claim language recites “generating an identifier uniquely  
14       associated with the client device.”

15           So, we have a unique -- we have an identifier that  
16       is uniquely associated with a client device. In Wiser, the  
17       voucher ID 302 is not uniquely associated with any client  
18       device, and the reason is number one, Wiser doesn't disclose  
19       that it is uniquely associated with a specific client device.

20           And number two, because Wiser teaches us that it  
21       shouldn't be uniquely associated with a specific client  
22       device because in Wiser, the goal is to allow the content  
23       once purchased to be played on any client device of that  
24       user.

25           So, not only does Wiser not disclose that the  
26       voucher ID is uniquely associated with a client device, but



1       Wiser tells us that that's how it should be because the  
2       objective of Wiser is not to restrict play back to a single  
3       platform but to allow play back on any suitable platform of  
4       that user.

5           JUDGE CYGAN: And so let me repeat my question. What  
6       does the identifier, which is sort of the receipt have to do  
7       with later playback?

8           MR. SCHREINER: The voucher ID is used in the later  
9       playback to ensure that playback only occurs one time. Wiser  
10      is a one-time playback system. The user makes a purchase of  
11      some content and that content can be played back by the user  
12      a single time.

13          JUDGE CYGAN: So you seem to be supporting  
14      Petitioner's argument here that if it always has to be a  
15      single use, then the voucher ID is only going to be received  
16      by a single media player. Therefore, it's only going to be  
17      associated with that media player because you can't play it  
18      anywhere else or do I have it backwards here?

19          MR. SCHREINER: With all due respect, I believe you  
20      do. The media content is purchased by the user can be played  
21      back on any suitable media device.

22          So if a client has -- if the purchaser has five  
23      different alternative client devices, the purchaser can  
24      purchase the content, is inclined to device one, and the  
25      purchaser will then have a voucher ID that is basically a  
26      receipt for that purchase as you described, but the purchaser

1       can play back that content on client device one, client  
2       device two, three or five, and that's because the new voucher  
3       ID is not limited to or tied to a specific client device.

4           JUDGE CYGAN: Let me restate my question here. If in  
5       the system of Wiser, there's originally a voucher that's  
6       generated --

7           MR. SCHREINER: Yes.

8           JUDGE CYGAN: -- does it matter that downstream,  
9       there is playback? If that voucher, we determine was uniquely  
10      associated with the client device that originally received  
11      it, what does it matter if later on it's played back on  
12      different devices because that would meet the claim  
13      limitation? The claim limitation doesn't say anything about  
14      restricting play back later.

15          MR. SCHREINER: But the voucher ID in Wiser, the  
16      voucher ID 302 is not described as being uniquely associated  
17      with any specific client device. No one -- the voucher ID is  
18      described as having two functions in Wiser.

19          One is to memorialize the purchase transaction and  
20      two is to ensure that the playback only occurs once. Nowhere  
21      in Wiser does it disclose or suggest that that voucher ID  
22      uniquely identifies or is uniquely associated with the  
23      purchasing client device, which is what I think Your Honor is  
24      suggesting.

25          JUDGE CYGAN: I'm not sure where your playback  
26      argument comes into that. That seems to be completely

1       separate from what happens downstream during the playback,  
2       but I don't want to belabor that point.

3             MR. SCHREINER: The --

4             JUDGE CYGAN: Please go forward.

5             MR. SCHREINER: The point of the playback argument  
6       is that Wiser allows you to playback the purchase content  
7       using the voucher ID on any number of client devices. And  
8       that firms the point that the voucher ID is not in the first  
9       instance when it is created at purchase, it's not restricted  
10      or associated with a single client device.

11            If it were, if the voucher ID were associated with a  
12      single -- uniquely associated with a single client device,  
13      then that would restrict or impede the ability of the  
14      purchaser to playback that content on any number of other  
15      client devices that the purchaser has, and that is one of the  
16      primary objectives of Wiser. And again, a reminder to all of  
17      us that the voucher ID 302 is usable only once.

18            In the HTTP response, it functions as a one-time  
19      only permit to access the content or a one-time ticket if you  
20      will. And I'd like to direct Your Honors to slide 20. In  
21      slide 20, we have Hulu's third argument on this limitation of  
22      an identifier uniquely associated with the client device and  
23      the viewing session.

24            In the third argument, Hulu claims that because the  
25      voucher ID limits the use of the media voucher to a single  
26      preview transaction, it follows that it "would have been

1 obvious that the voucher ID limits the transaction to the  
2 device initiating the transaction," in other words, the  
3 device making the purchase. Without saying it, SITO's  
4 position is that Hulu's proposing a modification to Wiser's  
5 voucher ID to have it uniquely identify the client device in  
6 the case of preview transactions.

7 Hulu is really conflating the voucher IDs function  
8 of limiting the media voucher for a single purchase or  
9 preview transaction for viewing with limiting the viewing of  
10 the media to a single specific client device. And we know  
11 that's not the case in Wiser. Wiser states at column two,  
12 lines 34 through 39, playback is not limited to "a single  
13 computer, but on any platform equipped with an appropriate  
14 playback device."

15 And with that, I will turn to slide 22. Slide 22  
16 involves the limitation of transmitting information  
17 instructing the client device how to communicate with  
18 resources of the content distribute network to cause a  
19 plurality of segments to be streamed. The highlighted items  
20 on slide 22 indicate that we have two separate limitations  
21 here.

22 Limitation two a URL indicating --including an  
23 identification of one or more resources to facilitate  
24 streaming and then separately information instructing the  
25 client device how to communicate with one or more resources.

26 So we have two separate limitations. And I'd like to

1       now direct Your Honors to slide 25, review of the parties'  
2       arguments on this issue. I'm not going to read Counsel for Hulu has  
3       already provided that.

4             Hulu's first argument is that in Eyal, the control  
5       information sent from Eyal's web server to the client device  
6       discloses the claimed instructions on how the client device  
7       is to cause the communication of the requested content.

8             And, this is and Hulu points to -- I'm sorry. This  
9       is not the case because the control instructions and Hulu  
10      points to the control information 207 sent from Eyal's web  
11      server to the client device.

12            If I can go back -- let me just go back two slides  
13      or one slide, I'm sorry, to slide 24, we can see on slide 24,  
14      Eyal's Figure 4, we have annotated the client surf  
15      request, that's number 203, and then in response Eyal looks  
16      up in a database of URLs 247 and the web server module then  
17      provides the list of URLs.

18            That's line 209 in green and separate from that,  
19      Eyal provides control information and that's control  
20      information 207 indicated by the pink arrow.

21            So returning back to slide 25, Hulu's first argument  
22      is that that separate line of control information corresponds  
23      to the claimed instructions in Claim 15 of the 360 Patent.  
24      But this is not the case because the control instructions  
25      control the operation of the media player on Eyal's client  
26      device.

1           They don't control the media player on how to  
2       communicate with the network resources to cause the segments  
3       to be streamed as recited in limitation number three of Claim  
4       15.

5           Hulu's second argument is that the sequence of URLs  
6       in the playlist returned to the client device disclose the  
7       instructions on how the client device is to cause the  
8       streaming of the content. But a mere sequence of URLs in  
9       Eyal's playlist is not an instruction instructing the client  
10      device how to communicate with resources to cause streaming.

11          Indeed, the mere sequence of URLs in the playlist is  
12      not an instruction. It's just a sequence of URLs that are  
13      played one after another. Hulu's third argument is really  
14      enveloped by its sequence argument.

15          Hulu argues that URLs -- Hulu argues that -- Eyal  
16      states that URLs for commercials inserted in Eyal's playlist  
17      can be played along with other URLs for medial items.

18          And thus the URLs for the commercials are doing just  
19      that. They're URLs that link to commercials to be inserted  
20      during the playback of the list of URLs in Eyal, but they're  
21      not instructions to the client device on how to contact  
22      resources to cause streaming of the plurality of segments to  
23      the client device.

24          Hulu cites to Eyal that --

25          JUDGE GIANNETTI: Counsel, before you move on, is  
26      there a construction on what an "instruction" is? You said

1       rather obviously boldly that these are not “instructions,” this  
2       list of URLs not instruction.

3             And my question is -- is there a claim  
4       construction or not for “instruction?” Is there a claim construction on  
5       what an “instruction” is and if not, what is your view on what an  
6       “instruction” is? It seems to me it's a rather broad -- it's a  
7       rather broad term.

8             MR. SCHREINER: What I stated, Your Honor, was that  
9       the sequence of URLs in a list of URLs is not itself an  
10      “instruction.”

11            JUDGE GIANNETTI: And why is that?

12            MR. SCHREINER: Because it's just a sequence of URLs  
13      in a list, and instruction is the ordinary meaning of  
14      “instruction” as understood in this claim is something separate  
15      from the URLs themselves.

16            JUDGE GIANNETTI: Well, the ordering is -- the  
17      ordering though is what's important here, isn't it? The URL  
18      itself may not be an instruction but the ordering of URLs may  
19      be an instruction.

20            MR. SCHREINER: I respectfully disagree. Hulu has  
21      already pointed to the URLs in the list as meeting limitation  
22      ii in Eyal. So, they have to point to something different to  
23      meet this separate limitation of instructions on how to cause  
24      the client to communicate with resources.

25            And, so, pointing to the URLs is not pointing -- is  
26      not disclosing the separate limitation, this limitation three

1 in Claim 15.

2 And an “instruction” -- the term was not construed by  
3 the parties. There was claim constructions proposed. But a  
4 person of ordinary skill in the art would understand an  
5 “instruction” as being a command signal or information that  
6 instructs a recipient including device to do something.

7 JUDGE GIANNETTI: I don't see how you can rely on  
8 the argument that it's not an “instruction” when you haven't  
9 asked for a construction of that. You know --

10 MR. SCHREINER: It's a --

11 JUDGE GIANNETTI: It sounds like you're making up  
12 these constructions as you go along.

13 MR. SCHREINER: That's incorrect. We're applying the  
14 plain and ordinary meaning of “instruction.”

15 JUDGE GIANNETTI: I hear your argument on that but I  
16 don't agree with you. I think you're imposing a construction  
17 on the term and you didn't ask for a construction. And I  
18 think that says a lot about what's going on. And you really  
19 have not come to grips with what the meaning of an  
20 instruction is.

21 MR. SCHREINER: Your Honor, there's a parallel  
22 district court case and the term instruction, this was not  
23 submitted for construction in the parallel district court  
24 case.

25 Neither -- Your Honor, neither party in this case  
26 submitted a construction for the term “instruction.” And so,



1 I'll just leave it at that. Still on slide 25, I'd like to  
2 move this along, Your Honor, so that I can cover the material  
3 we hope to cover.

4 Hulu has a fourth argument which is that the meta  
5 data in Eyal's playlist on how to present the downloaded  
6 media meets this limitation that the instructions on how a  
7 client device contacts Hulu resources.

8 But metadata determining how content is displayed on  
9 the user device does not disclose instructions telling the  
10 client device how to have the media streamed from the CDN  
11 network resources to the client device.

12 Still on slide 25, Hulu has a fifth argument which  
13 is that the intermediary web server module in Eyal that its  
14 replacement of HTTP by another prefix like PNM in the URLS  
15 returned to the client device meets the claim instructions.  
16 But these prefixes, HTTP or PNM, they're a part of the URLs  
17 in Eyal's playlist that Hulu already alleges meets limitation  
18 two of Claim 15 of the 360 Patent.

19 Those same URLs cannot be used to meet the  
20 separately recited limitation three that we're discussing  
21 here. And with that, I'd like to move to slide 32. Slide 32  
22 deals with the issue of priority and the position taken by  
23 SITO is that Madison '273 is not entitled -- is not prior art  
24 because it is annotated by the '360 Patent.

25 This is based on the priority assertion under  
26 Section 120 from the '360 Patent back to the Application

1       Number 09/766,519 filed January 19th, coupled with a prior date  
2       of invention of January 13, 2001 with demonstrated diligence  
3       from that -- the date of that document to the constructive  
4       reduction to practice in filing the '519 application. If I  
5       could turn Your Honors to slide 33.

6             SITO submitted a claim chart in its Patent Owner's  
7       response as Exhibit 2017 and it shows support in the January  
8       13th, 2001 draft application for everyone of the challenged  
9       claims in the '360 Patent.

10            This is Exhibit 17, I'm sorry; Exhibit 2017  
11       submitted in Patent Owner's Response. SITO also submitted a  
12       document comparing the disclosure of the '519 application to  
13       the support from the January 13th draft application to show  
14       that the common support in those documents supported the  
15       claims.

16            SITO also submitted two other conception documents  
17       in addition to the January 13th draft application, and they  
18       both show the data conception and they are Exhibit 2018, a  
19       January 2nd, 2001 operational concept document and a January  
20       17th version of the operational concept document. So, there's  
21       three documents that support prior conception, although I  
22       want to make it clear that the Board need only rely on the  
23       single January 13th draft application to establish prior  
24       invention.

25            And I would like to point out that Hulu has not  
26       disputed the authenticity or the dates of any of these three

1       conception documents. I'd like to turn to slide 34 now. SITO  
2       also submitted three Declarations supporting the prior  
3       invention to January 13th, 2001.

4             There was a Declaration of a co-inventor Bate that  
5       he has all three conception documents, no changes were made  
6       to them and that there was diligence from January 13th, until  
7       six days later with the filing of the '519 application on  
8       January 19th.

9             There was also a Declaration from co-worker Bowen  
10       and he also testified to diligence in the construction  
11       reduction to practice. He confirmed the authenticity of the  
12       three conception documents.

13            Finally, a Declaration was submitted by a forensic  
14       expert who confirmed the dates and authenticity of the three  
15       conception documents. Hulu did not dispute any of the facts  
16       of the three Declarations on prior invention, nor did Hulu  
17       dispute or object to the authenticity and dates of the three  
18       conception documents.

19            Hulu argues that the Declarations from the three  
20       gentlemen I just mentioned and the one claim with the firm,  
21       the dates and authenticity of the three consecutive there  
22       three conception documents the who did not dispute  
23       any of the facts of the three Declarations on prior  
24       invention.

25            Nor did Hulu dispute object to the authenticity. And  
26       date of the three conception documents little argues that the

1       Declarations from the three gentlemen. I just mentioned and  
2       one claim chart, Exhibit 2017, are documents and properly  
3       incorporated by reference seeking to avoid. But  
4       that's not the case.

5             SITO's Patent Owner's Response at pages 24 through  
6       31 and it's Sur-reply, pages three through 11 provide  
7       detailed explanation of the content of the three Declarations  
8       and the one claim chart of which Hulu complains.

9             Ultimately Hulu's objections to the evidence rings  
10       hollow for three reasons. Number one, Hulu does not dispute  
11       at any of the facts in the three Declarations.

12            Number two on the claim chart, Hulu only challenges  
13       support for three claim terms. And number three, Hulu has  
14       never objected to any of this evidence under Rule  
15       42.64(b)(1).

16            SITO has demonstrated support in the January 13th,  
17       2001 conception document for the three terms that Hulu  
18       disputes and I'm going to discuss that now as we turn to  
19       slide 35.

20            JUDGE CYGAN: Counsel, this is Judge Cygan.

21            MR. SCHREINER: Yes, Your Honor?

22            JUDGE CYGAN: For your evidence on diligence, do you  
23       just have the inventor's own declaration?

24            MR. SCHREINER: No. We have the declaration of one  
25       of the co-inventors, as well co-worker Bowen. That's number  
26       three on slide 34. So, he was a co-worker and he worked with

1       them on finalizing this application and so he corroborates  
2       diligence.

3           JUDGE CYGAN: And what manner did he corroborate  
4       diligence?

5           MR. SCHREINER: He stated that he in essence that he  
6       watched -- that he saw the two inventors, the late Mr.  
7       Jennings, and inventor Bate work on the draft application  
8       from January 13th, diligently until January 19th with the  
9       filing of the '519 application.

10          JUDGE CYGAN: Thank you.

11          MR. SCHREINER: Turning to slide 34, Hulu disputes  
12       support for three terms from the January 13th, 2001 draft  
13       application. The first is "information instructing the client  
14       device" on how to have the -- how to communicate with the  
15       resources and the network to cause streaming. SITO  
16       provides ample support for this that the "presentation ID" in  
17       the January 13th draft application supports this  
18       limitation.

19          And I can provide that support - I can provide  
20       citations to that support if that would be helpful at this  
21       time, or I can move on to the next term. Okay. With that,  
22       I'll move on to the next term.

23          The next disputed term, Hulu claims that the term  
24       "content distribution network" is not disclosed in January  
25       13th, 2001 draft application. Of course we know, support is not required  
26       in the prior application to support a

1 term in a later application.

2 And just referring to the January, 13th application,  
3 Exhibit 2016, I'll just read a passage. This is from page  
4 five, lines 14 through 20 and it's cited in SITO's Sur-reply.

5 The draft application states "the streaming system  
6 one and two in figure one complies as an enhanced service  
7 routing process 104," and it goes on to say, "and a managed  
8 media switch, MMS 110, each communicating to a packet network  
9 112," and it goes on to refer to communicating with one or  
10 more viewers 116 to 118, who may communicate with the MMS  
11 110, which is a switch for streaming media and/or the  
12 reservation server 114.

13 That's in the draft application and -- but that  
14 perfectly describes a content distribution network. And it's  
15 very similar and supports Figure 1 in the '360 Patent. Hulu  
16 also challenges the support for advertising server in the  
17 January 13th, 2001 draft application.

18 The draft application refers to, for example, the  
19 playlist may include the requested media and additional  
20 media, such as one or more advertisements, and the  
21 "presentation ID" I referred to earlier describes how it is  
22 used to control the receipt of content from MMS stream  
23 casters.

24 So, the January 13th, 2001 draft application  
25 discloses the concept of delivery advertisements and using  
26 stream casters to deliver various types of content including

1 requested content as well as advertising.

2 JUDGE CHANG: I have a question. This is Judge  
3 Chang.

4 MR. SCHREINER: Yes, Your Honor.

5 JUDGE CHANG: So you mentioned that you submitted  
6 three documents, right? So, the other documents you mention  
7 we don't have to look at? We just have to look at the January  
8 13, 2001 conception document. Is that true?

9 MR. SCHREINER: No, Your Honor, I would -- I would  
10 submit that it's -- it would be very help for the Board to  
11 look at the other two conception -- conception documents, the  
12 January 2nd and the January 17th conception documents.

13 JUDGE CHANG: So, if we find that the January 13,  
14 2001 conception document does not fully support the claims,  
15 then we have to look at the January 2nd, 2001 OCD and also  
16 January 17th, 2001 OCD. Do you have the argument on those two  
17 support documents?

18 MR. SCHREINER: I understand your question, Your  
19 Honor. We're relying on the January 13th draft application  
20 that's providing the support for a prior invention as of that  
21 date.

22 We provide the other conception documents just to  
23 provide additional context to show that the invention was  
24 being conceived at that time and it also supports diligence,  
25 I believe. But ultimately we are relying on the January 13th  
26 draft application, submitted as Exhibit 2016.

1 JUDGE CHANG: Okay. Well, thanks for that  
2 clarification because, you know, I've just wanted to make sure  
3 that how those three documents are related. And what is your  
4 position on the -- on the conception and diligence. Thank  
5 you.

6 JUDGE CYGAN: Counsel, this is Judge Cygan.

7 MR. SCHREINER: Yes, Judge Cygan.

8 JUDGE CYGAN: How does the existence of a separate  
9 January 17th document speak to the diligence of working on  
10 the '519 application if this exhibit 22 was issued in the  
11 middle of it?

12 MR. SCHREINER: For diligence, we're relying on the  
13 Declarations that were submitted. We submitted the additional  
14 conception documents just to paint -- just to show a more  
15 broad picture of what was taking place between the time of  
16 the January 13, 2001 application and the filing of the '519  
17 application on January 19th. It's a little bit belt and  
18 suspenders, granted.

19 JUDGE CYGAN: My question is that if the idea for  
20 diligence is that the inventors don't do anything else except  
21 work diligently in filing an application we seem to have this  
22 piece of evidence which says on the 17th they have this other  
23 technical document that they submitted. How should that  
24 impact our consideration of whether or not they were  
25 diligently working on that '519 application?

26 MR. SCHREINER: The January 17th, document is just



1 an update of the January 2nd document. The inventor and his  
2 coworker testified that the inventors were diligent, working  
3 continuously between January 13th, and January 19th to file  
4 the '519 application. But obviously doesn't -- diligence  
5 doesn't require that the inventor work 24 hours a day on the  
6 application that's being reduced to practice.

7 An inventor can work one hour a day on some other  
8 matter. But the -- so the question is that did the inventors work  
9 diligently on reducing the invention practice with a filing  
10 of the 519 application? And we have unrebutted declaration  
11 testimony that they were diligent.

12 JUDGE CYGAN: Is the existence of this January 17th  
13 document explained in the testimony as to how they  
14 apportioned their time or is it not mentioned at all in the  
15 diligence testimony?

16 MR. SCHREINER: I do not believe it's mentioned in  
17 the diligence testimony, but I'm going on recollection, Your  
18 Honor. I'm not where -- I'm not aware of any case law that  
19 states that an inventor is not diligent if he worked  
20 essentially -- if he worked every day between the conception  
21 document and the filing of the application.

22 If he worked every day on that, but also took time  
23 for lunch, for example, or took time to update a different  
24 document. With that, I'd like to turn to the '887 Patent and  
25 slide 49. And the issue here is the limitation of generating  
26 based on one or more capabilities of the communication device

1 specific information.

2 In other words, a script, a list of items, including  
3 three specific -- three specific items that are enumerated on  
4 slide 49.

5 Turning now to slide 50, Hulu takes the position and  
6 again, we're now talking about the '887 Patent, we've  
7 transitioned from the '360 Patent and this is ground one based  
8 on Eyal and Angles. Hulu takes the position that replacing  
9 the URL prefixes in the playlist from HTTP to PNM somehow  
10 meets this limitation.

11 But Eyal's modification of the URL protocol from  
12 HTTP to PNM in its playlist does not correspond to generating  
13 the script of three items based on the capabilities of the  
14 communication device.

15 And I have something further I'd like to add to  
16 that. It is correct that the replacement of HTTP -- HTTP with  
17 PNM in Eyal is just modifying an existing or already created  
18 playlist, not generating the playlist based on the device  
19 capabilities.

20 Hulu cites to Eyal at column 21, lines 34 through 46  
21 but that doesn't support Hulu's argument. Again, the  
22 replacement of the HTTP prefixes with PNM means the playlist  
23 already exists because those prefixes are being replaced.

24 That doesn't correspond to generating a play script  
25 or a play list based on the device capabilities as called for  
26 in this limitation of Claim 39, excuse me, yes, Claim 39 of

1 the '887 Patent.

2 I'd like to now turn to slide 58. Slide 58 deals  
3 with the claim limitation in Claims 39, 45 and 68 of "identifying . . .  
4 whether the requested media is available for streaming to the  
5 communication device."

6 Hulu's argument is that Madison '273 streams to table  
7 stores media items that are assigned expiration dates.

8 And that Madison '273 says that those media items are  
9 expired -- that are expired are deleted as part of the normal  
10 maintenance of the CM database 118, which is Figure 1 of  
11 Madison '273.

12 JUDGE CHANG: Counsel?

13 MR. SCHREINER: Yes, Your Honor.

14 JUDGE CHANG: Sorry to interrupt. You have two  
15 minutes.

16 MR. SCHREINER: Oh, I'm going to make it.

17 JUDGE CHANG: Okay.

18 MR. SCHREINER: SITO's answer is that the general  
19 maintenance of files based on whether their dates have  
20 expired and the removal of those expired links in Madison '273  
21 does not correspond.

22 It does not teach or suggest checking whether the  
23 requested media is available for streaming in response to a  
24 request for that media. That's what the plain language says in  
25 the '887 Patent.

26 It recites that in response to that request, there

1 is a step -- I'm referring to Claim 39 identifying that at  
2 least one computing device whether the requested media is  
3 available for streaming.

4 The requested media refers to the client submitted  
5 requests for media in the very first limitation of Claim 39.  
6 And with that, Your Honor, I will rest our response to lose  
7 opening argument.

8 JUDGE CHANG: Thank you.

9 MR. SCHREINER: Thank you.

10 JUDGE CHANG: Counsel for Petitioner, you may start  
11 your rebuttal anytime. You have 30 minutes.

12 MR. WESTIN: Thank you, Your Honor, and I only have  
13 one very narrow point I want to make on rebuttal. I believe  
14 the panel understands this but it was suggested in or stated  
15 in Patent Owner's Response.

16 So, I wanted to make sure that it was clear. Hulu  
17 has never agreed that the claim language of Claim 15 of the  
18 '360 Patent equates uniquely associated with, and uniquely  
19 identifying.

20 I direct the Board to Hulu's arguments, for example,  
21 at page 32 of, its Petition and page 14 of its Reply in the  
22 '360 Patent proceeding. Hulu's position has been that the  
23 claim language controls.

24 And with that, that is all I have on rebuttal, Your  
25 Honor.

26 JUDGE CHANG: Thank you.

IPR2021-00265 (Patent 9,591,360 B2)

IPR2021-00308 (Patent 8,825,887 B2)

1           MR. SCHREINER: Your Honor, this is Patent Owner. We  
2           have no further statements to make and we want to thank the Board for  
3           its attention and courtesy this  
4           afternoon.

5           JUDGE CHANG: Thank you very much for your time, and  
6           this concludes this oral hearing. Thank you.

7           MR. WESTIN: Thank you.

8           (Off the record at 2:57 p.m.)

IPR2021-00265 (Patent 9,591,360 B2)

IPR2021-00308 (Patent 8,825,887 B2)

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