

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON WEB SERVICES, INC., AND
AMAZON.COM SERVICES LLC,
Petitioner,

v.

ALMONDNET, INC and INTENT IQ, LLC,
Patent Owner.

IPR2023-00227
Patent 8,677,398 B2

Before KRISTEN L. DROESCH, THOMAS L. GIANNETTI, and
STACEY G. WHITE, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314

Denying Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

Amazon.com Inc., Amazon Web Services, Inc., and Amazon.com Services LLC (collectively “Petitioner”) filed a Petition requesting *inter partes* review of claims 36 and 37 of U.S. Patent No. 8,677,398 B2 (Ex. 1001, “’398 Patent”). Paper 2 (“Pet.”). AlmondNet Inc. and Intent IQ, LLC (collectively “Patent Owner”) filed a Preliminary Response. Paper 7. Petitioner also filed a Motion for Joinder (Paper 3, “Mot.” or “Motion”) requesting that Petitioner be joined as a party to *Meta Platforms, Inc., v. Almondnet, Inc. and Intent IQ, LLC*, IPR2022-00773 (“the Meta IPR”), which involves the same claims of the ’398 Patent, and for which an *inter partes* review was instituted on October 21, 2022. *See* Motion; *see also* IPR2022-00773, Paper 6. Pursuant to our authorization, Petitioner filed a Reply to the Preliminary Response (Paper 8), and Patent Owner filed a Sur-reply (Paper 9).

On April 14, 2023, the parties involved in the Meta IPR filed a Joint Motion to Terminate the proceeding. *See* IPR2022-00773, Paper 15. At the request of Petitioner, on April 17, 2022 the Board held a conference call with counsel for the parties, as well as counsel for Meta Platforms, Inc., the petitioner in the Meta IPR. During the conference call, Petitioner requested that the Board delay termination of IPR2022-00773 so that the Board could issue a decision on the Petition and Motion for Joinder.

For the reasons below, the Motion for Joinder is denied as moot, and the Petition is denied because it is time-barred under 35 U.S.C. § 315(b).

B. Related Matters

Petitioner indicates the '398 Patent is the subject of *Meta Platforms, Inc., v. AlmondNet, Inc. and. Intent IQ, LLC*, No. IPR2022-00773 in which institution was granted. Pet. 6; Paper 5, 1. Petitioner also indicates the '398 Patent was the subject of *Yahoo! Inc. v. Intent IQ, LLC*, No. IPR2017-01299 (institution denied), *Roku, Inc. v. AlmondNet, Inc.* No. IPR2022-01236 (institution denied), and *Microsoft Corp. and Samsung Electronics Co. Ltd., v Intent IQ, LLC*, No. IPR2022-01420 (institution denied). See Pet. 6–7; Paper 5, 1.

The parties indicate the '398 Patent is or was the subject of the following proceedings:

AlmondNet, Inc., v. Oath Holdings Inc., 1–19-cv-00247 (D. Del.);
Roku, Inc. v. AlmondNet, Inc., 1:21-cv-01035 (D. Del.);
AlmondNet, Inc., v. Roku, Inc., 6:21-cv-00731 (W.D. Tex.);
AlmondNet, Inc., v. Samsung Elecs. Co., 6:21-cv-00891 (W.D. Tex.);
AlmondNet, Inc., v. Facebook, Inc., 6:21-cv-00896 (W.D. Tex.);
AlmondNet, Inc., v. Microsoft Corp., 6:21-cv-00897 (W.D. Tex.);
AlmondNet, Inc., v. Amazon.com, Inc., 6:21-cv-00898 (W.D. Tex.);
Pet. 7; Paper 5, 1–2.

C. The '398 Patent (Ex. 1001)

The '398 Patent discloses a method for delivering targeted television advertisements based on online behavior. See Ex. 1001, Abstract.

Figure 7 of the '398 Patent is reproduced below:

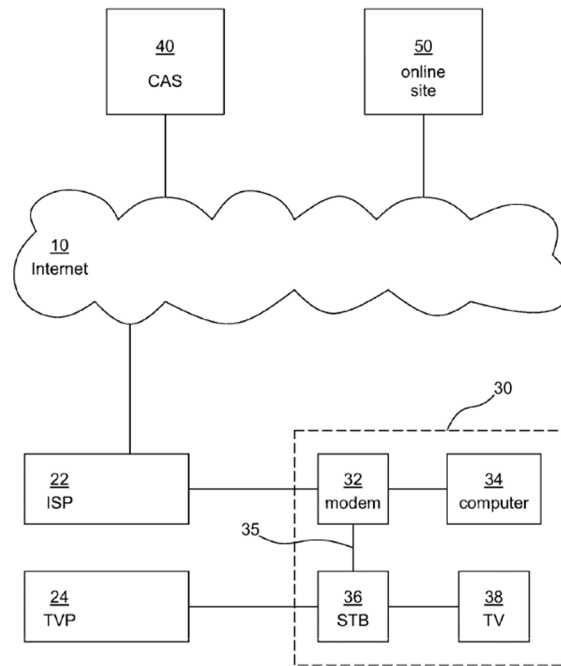


Figure 7 depicts central ad server (CAS) 40 and online site 50 connected to Internet 10, modem 32 connected to Internet service provider (ISP), computer 34 and set-top box (STB) 36, and TV 38 connected to STB 36 and television provider (TVP) 24. *See* Ex. 1001, 12:47–13:21. An identifier can be assigned to STB 36, such as an equipment serial number, a device MAC address, a username, a pseudonym, a tag, or other identifying code or data element, and may include the IP address STB 36 is using when in contact with CAS 40. *See id.* at 15:1–14.

Once a STB is confirmed to have been using a certain IP address at a certain date and time (for example by having a uniquely tagged STB consecutively communicate with the CAS using the same IP address . . .), the CAS database can be searched to find all computers, mobile devices, and other STBs that used the same IP address at the same date and time, and those will be assumed to be devices that are part of the same household and same LAN. Then, an association or link is created among the devices, by linking the device identifiers or tags with the STB's identifier in the CAS database

Once the association is created, profile information (both behavioral and demographic) collected about the computers and mobile devices before and after the association was created could be used to target ads to the STB, regardless of the IP addresses used by the computers and mobile devices (such as cell phones) to access the web at the time the profiles were collected.

Ex. 1001, 18:24–50.

D. Illustrative Claim

Claim 36 is independent, and claim 37 depends therefrom. *See* Ex. 1001, 26:57–27:15. Claim 36 is illustrative and reproduced below.

An article comprising a non-transitory tangible medium encoding computer-readable instructions that, when applied to one or more computers, instruct the one or more computers to perform a method comprising:

- (a) receiving at one or more of the computers an electronic identifier of a first device;
- (b) automatically generating and storing electronic indicia of an association between the first device identifier and an electronic identifier of a second device based on automatically recognizing that each of the first and second devices was connected, independently of the other, to a common local area network, wherein the computer system is connected to the local area network through the Internet but is not in the local area network; and
- (c) based on the electronic indicia of the association between the first and second device identifiers, automatically sending an electronic transmission that causes another programmed hardware computer system to take an action, based on first electronic profile data associated with the first device identifier, with respect to the second device, which is indicated at the time of the action by the second device identifier.

Ex. 1001, 26:57–27:11.

E. Asserted Challenges to Patentability and Asserted Prior Art

Petitioner asserts that claims 36 and 37 would have been unpatentable based on the following grounds (Pet. 9):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
36, 37	103(a) ¹	Baig ² , Zwicky ³ , Satapati ⁴ , Hahn ⁵
36, 37	103(a)	Baig, Zwicky, Satapati, Hahn, Appelman ⁶
36, 37	103(a)	Baal-Haness ⁷ and Appelman
36, 37	103(a)	Baal-Haness, Appelman, Zwicky, Satapati

II. ANALYSIS

Under 35 U.S.C. § 315(b), an *inter partes* review “may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” Patent Owner served Petitioner with a complaint alleging infringement of the ’398 Patent in September 2021. Ex. 1016. Petitioner filed the Petition more than one year later on November 18, 2022. Pet. 80. Petitioner relies on its request to join the Meta IPR to avoid the time bar of 35 U.S.C. § 315(b). Pet. 9 (“Because Petitioner files an accompanying motion for

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Because the ’398 Patent has a filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA versions of §§ 102 and 103.

² US 2008/0113674 A1, published May 15, 2008 (Ex. 1003).

³ Building Internet Firewalls, Elizabeth D. Zwicky et al., 2000 (Ex. 1006).

⁴ US 7,356,045 B2, issued Apr. 8, 2008 (Ex. 1007).

⁵ Internet Complete Reference, Harley Hahn, 1996 (Ex. 1008).

⁶ US 7,899,862 B2, issued Mar. 1, 2011 (Ex. 1009).

⁷ US 2007/0067459 A1, published March 22, 2007 (Ex. 1010).

joinder within one month of institution in IPR2022-00773, this petition is timely under 35 U.S.C. §315(c) and 37 C.F.R. §42.122”). The Meta IPR, however, has been terminated. IPR2022-00773, Paper 16 (PTAB June 2, 2023). Thus, there no longer is a pending proceeding in the Meta IPR for Petitioner to join. Accordingly, Petitioner’s request to join the Meta IPR is moot, and the Petition is not timely under 35 U.S.C. § 315(b).

In any event, in addition to the mootness of Petitioner’s Motion for Joinder due to termination of the Meta IPR, we are not persuaded that joinder would have been appropriate. More specifically, we are not persuaded by Petitioner’s arguments that “joinder will have little, if any impact on the Meta IPR because . . . the schedule would be unaffected.” Mot. 3; *see also* Mot. 4 (“Joinder will not affect the schedule in the Meta IPR.”). We note that stipulated Due Date 2 for filing a reply in the Meta IPR was May 2, 2023. *See* IPR2022-00773, Paper 14. In view of the fact that stipulated Due Date 2 in the Meta IPR has passed, and no reply has been filed in the Meta IPR, Petitioner does not sufficiently address how “the requested joinder will not create any additional burden for the Patent Owner or the Board and will not require any additional time or resources.” Pet. Prelim. Reply 1. As pointed out by Patent Owner, “even if this proceeding went forward by essentially ‘picking up’ where the Meta . . . IPR left off, the existing schedule [of the Meta IPR] would need to be pushed back significantly, to allow time after institution for Petitioner[] to depose Patent Owner’s expert and prepare a reply.” PO Prelim. Sur-Reply 2. Because Petitioner does not meaningfully address the impact joinder would have had on the Meta IPR schedule, joinder also would not have been appropriate.

III. CONCLUSION

The Motion for Joinder is denied as moot because the Meta IPR has been terminated, and the Petition is denied because it was not filed within the time period set forth in 35 U.S.C. § 315(b).

IV. ORDER

Accordingly, it is
ORDERED that the Motion for Joinder is denied as moot; and
FURTHER ORDERED that that the Petition is denied, and no trial is
instituted.

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