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Paper 22
Entered: March 20, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAMAHA CORPORATION OF AMERICA
Petitioner

v.

BLACK HILLS MEDIA, LLC
Patent Owner

Case IPR2013-00593
Patent 8,045,952 B2

Before BRIAN J. McNAMARA, STACEY G. WHITE, and PETER P. CHEN, *Administrative Patent Judges.*

WHITE, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. Background

Yamaha Corporation of America ("Petitioner") filed a petition to institute an *inter partes* review ("Petition") of claims 9, 10, 13, and 14 ("challenged claims") of U.S. Patent No. 8,045,952 B2 (Ex. 1001, the "'952 Patent") pursuant to 35 U.S.C. §§ 311-319. Paper 1 ("Pet."). Black Hills Media, LLC ("Patent Owner") filed a preliminary response. Paper 14 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

> THRESHOLD – The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioner contends the challenged claims are unpatentable under 35 U.S.C. §§ 102 and 103 on the following specific grounds (Pet. 13-14):

Reference	Basis	Claims challenged
Berman[1]	§102	9, 10, 14
Berman	§103	13
Leeke[2]	§102 §103	9, 10, 13, 14

[1] U.S. Patent No. 6,502,194 B1, Dec. 31, 2002, filed Apr. 16, 1999 (Ex. 1012).
[2] U.S. Patent No. 6,587,127 B1, Jul. 1, 2003, filed Nov. 24, 1998 (Ex. 1013).

Reference	Basis	Claims challenged
Wolff[3]	§102	9, 10, 14
Wolff	§103	9, 10, 13, 14
Lansonic DAS-750[4]	§102	9, 10, 14
Lansonic DAS-750	§103	9, 10, 13, 14
Cluts[5]	§102	9, 10, 14

For the reasons described below, we determine that the present record demonstrates a reasonable likelihood that Petitioner will prevail in establishing the unpatentability of all the challenged claims. Accordingly, we grant the Petition for *inter partes* review of the '952 Patent as to claims 9, 10, 13, and 14 based on the authorized grounds, as discussed below.

B. Related Matters

Petitioner indicates that the '952 Patent is at issue in *Black Hills Media, LLC v. Yamaha Corp. of America*, No. 2:13-cv-006054 (C.D. Cal.) Pet. 2-4. In addition, Patent Owner has pending cases concerning the '952 Patent in the United States District Court for the District of Delaware involving Sharp (1:13-cv-00804), Toshiba (1:13-cv-00805), Panasonic (1:13-cv-00806) and LG Electronics Inc. (1:13-cv-00803-RGA); a case in the Eastern District of Texas against Samsung (2:13-cv-00379); cases in the Central District of California involving Pioneer (2:13-cv-05980), Logitech International (2:13-cv-06055), and Sonos, Inc. (2:13-cv-06062); and an

[3] U.S. Patent No. 7,472,353 B1, Dec. 30, 2008, filed July 31, 2000 (Ex. 1014).
[4] Web pages describing the Lansonic DAS-750 (Ex. 1015).
[5] U.S. Patent No. 5,616,876, Apr. 1, 1997, filed Mar. 28, 2000 (Ex. 1016).

investigation before the U.S. International Trade Commission, *Certain Digital Media Devices, Including Televisions, Blu-Ray Disc Players, Home Theater Systems, Tablets and Mobile Phones, Components Thereof and Associated Software*, Inv. No. 337-TA-882 (USITC). Pet. 3-4; Mandatory Notice (Paper 5) 1-2. Also, U.S. Patent No. 8,050,652 B2 is related to the '952 Patent and is the subject of a separate petition for *inter partes* review, which currently is pending before the Board.[6] Pet. 1.

C. Statutory Bar

Patent Owner asserts that the Petition must be denied as untimely. Prelim. Resp. 2. A statutory time bar regarding the institution of an *inter partes* review is set forth in 35 U.S.C. § 315(b), which provides as follows:

> PATENT OWNER'S ACTION - 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. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

The parties acknowledge that on September 19, 2012, Petitioner was served with a complaint alleging infringement of the '952 Patent. *Id*. at 3; Pet. 3. Thus, under the statute, Petitioner must have filed its Petition by September 19, 2013. The filing date accorded to the Petition is September 18, 2013. Notice of Filing Date Accorded (Paper 3).

Patent Owner alleges that this filing date is improper because Petitioner did not effect service until September 20, 2013. Prelim. Resp. 4. In support of this assertion, Patent Owner provides a copy of an express mail

[6] Case IPR2013-00594.

label that shows acceptance of the package containing the service copy of the Petition by the U.S. Post Office on September 20, 2013. Ex. 2003. On January 14, 2014, the Board conducted a teleconference with the parties to discuss this issue. During the conference, Petitioner's counsel maintained that service was effected on September 18, 2013, by depositing the package containing the Petition in a U.S. Postal Service mail slot. Paper 19. On January 16, 2014, Petitioner filed a document certifying that it had served the Petition on September 18, 2013. Paper 20. In support of this certification, Petitioner filed copies of tracking information for the packages containing the Petition and the petition filed in IPR2013-00594,[7] which it alleges was served concurrently with the Petition in this matter. Ex. 1017, Ex. 1018. These exhibits show that the packages were processed by the U.S. Postal Service the afternoon of September 19, 2013, and set for departure from Los Angeles on that date. Ex. 1017, Ex. 1018. The exhibits also show that the Los Angeles Post Office processed the package containing the Petition again on September 20, 2013, while the package containing the petition filed in IPR2013-00594 proceeded to Raleigh, North Carolina. Ex. 1017, Ex. 1018.

Patent Owner cites 35 U.S.C. § 312(a) that states "[a] petition filed under section 311 may be considered only if— . . . (5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner." The statute, however, does not require that the documents be served on the Patent Owner, nor does it specify when the

[7] Patent Owner does not allege that service was late for the petition in IPR2013-00594.

Patent Owner must receive these documents. The statute, instead, requires that the Petitioner "provide[]" copies to the Patent Owner. Patent Owner was provided with, and did receive, copies of the documents in question. *See* Ex. 1017, Ex. 2003. We, therefore, decline to deny this Petition for failure to meet the requirements of 35 U.S.C. § 312.

Patent Owner also relies on 37 C.F.R. § 42.106, which states "[a] petition to institute *inter partes* review will not be accorded a filing date until the petition satisfies [the requirement of] . . . (2) [e]ffect[ing] service of the petition on the correspondence address of record as provided in § 42.105(a)." The evidence submitted in the matter demonstrates that Petitioner made a good faith effort to effect proper service in a timely manner. Based on the facts of this case, we are not persuaded that the accorded filing date is erroneous. Thus, we decline to deny the Petition for failure to meet the requirements of 35 U.S.C. § 315(b).

D. Real Party-in-Interest

Patent Owner alleges that Petitioner fails to identify all real parties-in-interest and thus, the Petition should be dismissed for noncompliance with 35 U.S.C. § 312(a) and 37 C.F.R. § 42.8(b)(1). Prelim. Resp. 5. Patent Owner asserts that Pioneer Corporation and Pioneer Electronics (USA) Inc. (collectively "Pioneer") should have been identified in the Petition as real parties-in-interest. *Id.* at 6. Patent Owner and Pioneer currently are engaged in a patent infringement lawsuit in parallel with the patent infringement lawsuit between Patent Owner and Petitioner. *Id.* at 6-7. AV receivers, networked Blu-Ray players, and home theater systems from Pioneer and Petitioner are alleged to infringe claim 9 of the '952 Patent. *Id.* Thus,

according to Patent Owner, Pioneer and Petitioner are aligned with respect to claim construction and invalidity of the claims asserted in the pending district court litigation. *Id.* at 7. Patent Owner also argues that Petitioner's counsel in this proceeding has spoken on behalf of Petitioner and Pioneer at a district court technology tutorial directed to the '952 Patent. *Id.* Finally, Patent Owner states that Pioneer's counsel agreed to be bound by the outcome of this proceeding if the district court would agree to stay the district court litigation. *Id.* at 7-8; Ex. 2008.

We are not persuaded that Pioneer is a real party-in-interest in this matter. A determination as to whether a non-party to an *inter partes* review is a real party-in-interest is a "highly fact-dependent question," based on factors such as whether the non-party "exercised or could have exercised control over a party's participation in a proceeding" and the degree to which a non-party funds, directs, and controls the proceeding. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759-60 (Aug. 14, 2012). In other words, the question before us is whether there is a non-party "at whose behest the petition has been filed" or a relationship "sufficient to justify applying conventional principles of estoppel and preclusion." *Id.* at 48,759.

On the record currently before us, we are not persuaded that Pioneer is in position to exercise control over Petitioner's involvement in this proceeding. It is common for one lawyer to speak on behalf of multiple parties at a technology tutorial. Often, this is done for efficiency purposes and by itself does not signify control over the various entities in the lawsuit. In addition, while Pioneer and Petitioner both may be interested in the patentability of the '952 Patent claims, this does not mean that the parties have the same interests. Litigation alliances may arise for numerous

reasons, including, but not limited to, parties having a similar perspective on one or more issues in a case. The existence of such alliances alone generally does not rise to the level that would require naming the ally/co-defendant as a real party-in-interest. Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,760. We, therefore, will not deny the petition for failure to comply with 35 U.S.C. § 312(a) and 37 C.F.R. § 42.8(b)(1).

E. The '952 Patent[8] (Ex. 1001)

The '952 Patent is directed to methods and apparatuses that allow users to receive and play audio from various sources and to assign playlists over a network to a network-enabled audio device. Ex. 1001, Abstract. The specification lists several problems with prior art systems such as the cost and technical complexity associated with listening to streaming audio over the Internet and playing songs on a PC. *Id.* at 1:52-2:12. The invention of the '952 Patent was intended to alleviate such issues "by providing a network-enabled audio device for listening to a variety of audio sources with substantially equal convenience." *Id.* at 2:15-19.

The inventive device may be used with a computer. *Id.* at 16:32-35. In that embodiment, software may be used to assign a playlist of songs to a network-enabled audio device. *Id.* This embodiment is illustrated in Figures 15 and 19B of the '952 Patent. Figure 15 is reproduced below:

[8] The '952 Patent shares a specification with the '652 Patent, which is the subject of a separate petition for inter partes review that currently is pending before the Board. *See* IPR2013-00594.

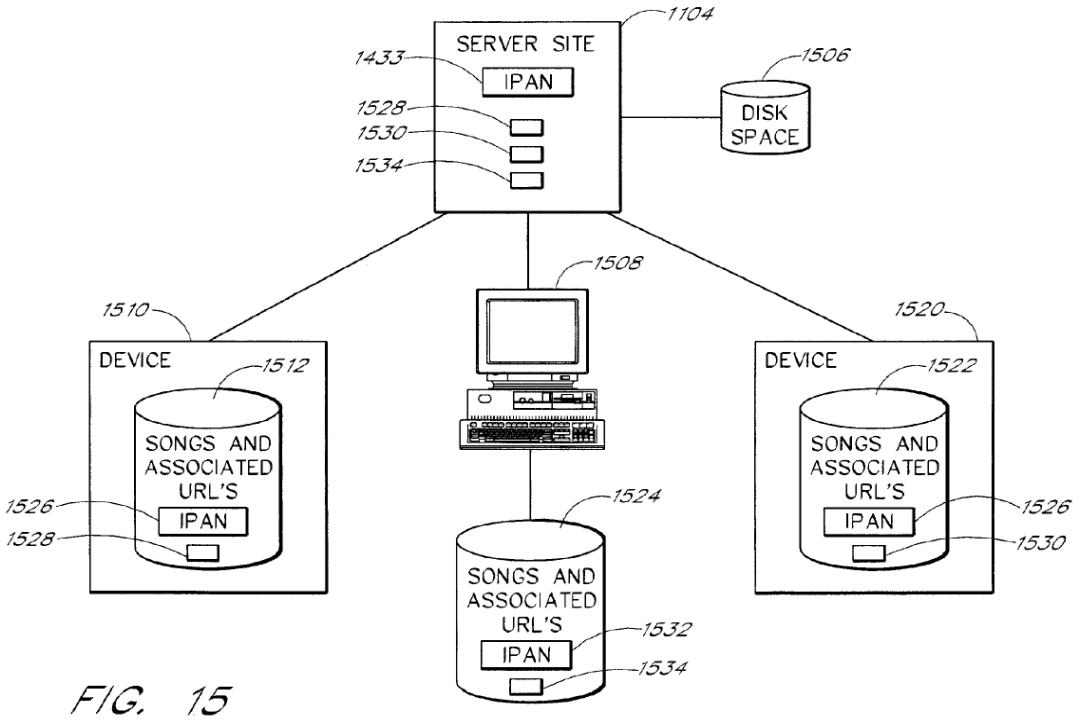

FIG. 15

Figure 15 is a block diagram illustrating the configuration between network-enabled audio devices and a stereo web site. *Id.* at 6:4-6. Figure 15 illustrates two network-enabled audio devices (1510 and 1520) connected to Internet Personal Audio Network ("IPAN") server site 1104. Ex. 1001, 21:40-43. Storage spaces (1512 and 1522) of network-enabled audio devices (1510 and 1520) are used to store IPAN software 1526, playlist (1528 or 1530), and associated URLs and songs within the playlist. *Id.* at 21:43-57. Server site 1104 includes IPAN software 1433 and playlists (1528 and 1530). *Id.* at 21:52-57.

Figure 19B of the '952 Patent is reproduced below:

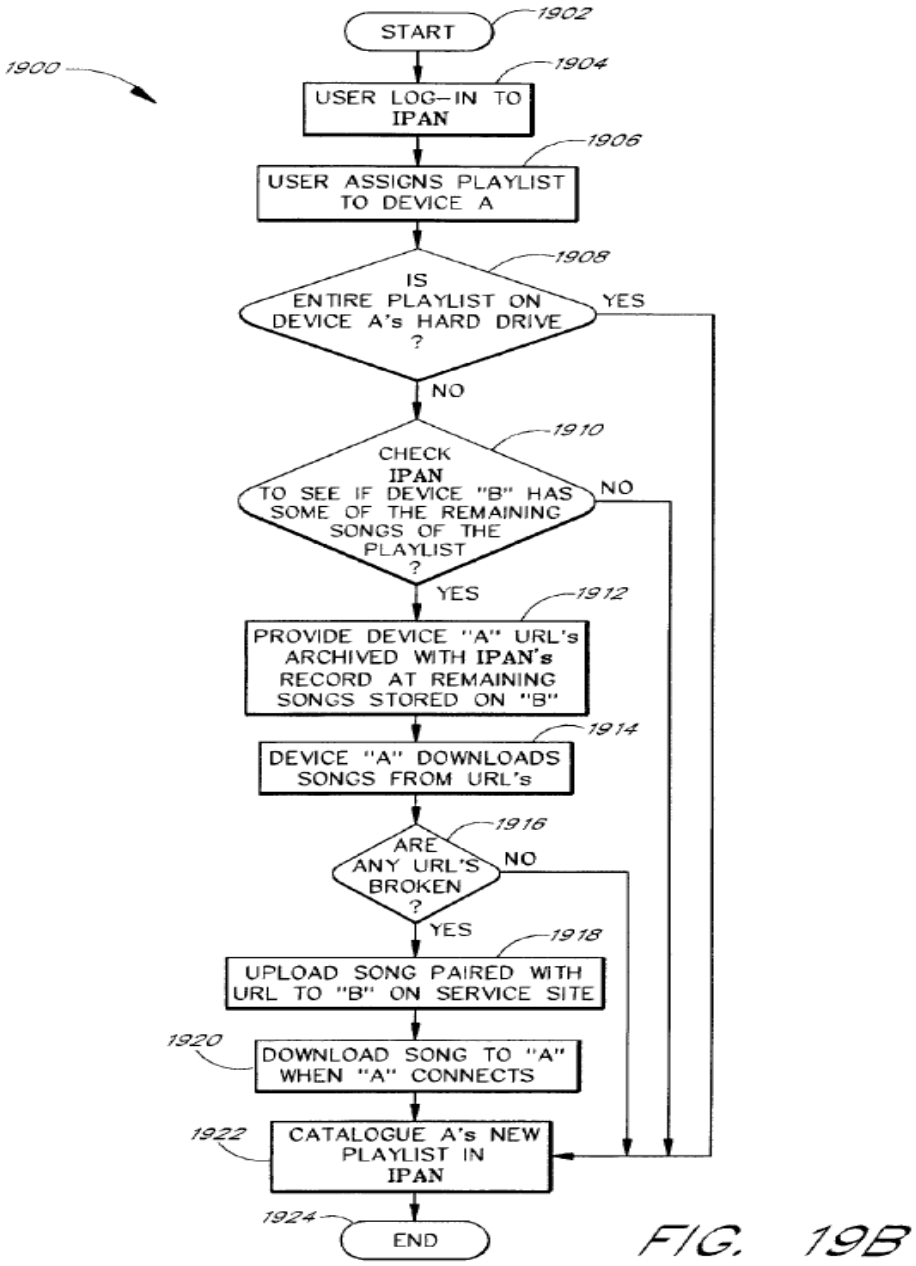

FIG. 19B

Figure 19B shows the process for assigning a playlist to a device. *Id.* at 6:60-61. At step 1908, a user assigns a playlist to first device 1510. *Id.* at 28:14-16. The system then determines whether all of the songs on the playlist are stored on the hard drive of first device 1510. Ex. 1001, 28:20-22. If any of the songs are missing from first device 1510, IPAN 1433 forms a list of remaining songs and checks the hard drive of second device 1520 to

determine whether any of the remaining songs may be found on that device. *Id.* at 28:24-30. If any of the songs is found on second device 1520, then IPAN 1433 will provide first device 1510 with URLs for those songs, and first device 1510 will attempt to download the songs from second device 1520. *Id.* at 28:30-43.

F. Illustrative Claim

Claim 9 of the '952 Patent is the sole independent claim at issue in this Petition and is illustrative of the claims at issue:

> 9. A method comprising:
>
> receiving, at an electronic device, a playlist assigned to the electronic device, the playlist identifying a plurality of songs, wherein ones of the plurality of songs are not stored on the electronic device;
>
> receiving, at the electronic device, information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source; and
>
> obtaining the ones of the plurality of songs from the at least one remote source.

G. Claim Interpretation

We must determine the meaning of the claims before we analyze the proposed grounds of unpatentability. Consistent with the statute and legislative history of the America Invents Act[9], we interpret claims of an unexpired patent using the broadest reasonable construction consistent with the patent specification. 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the

[9] Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA").

broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Petitioner seeks construction of the following terms: (1) "playlist assigned to the electronic device;" and (2) "wherein ones of the plurality of songs are not stored on the electronic device." Pet. 9-12. Patent Owner responds to Petitioner's proposed constructions and proposes a construction for the term "playlist." Prelim. Resp. 17-20.

1. "Playlist"/"Playlist Assigned to the Electronic Device"

Independent claim 9 recites the term "playlist assigned to the electronic device." Petitioner asserts that the term should be construed as "a list of songs that is to be transferred to a particular device selected by the user." Pet. 9 (citing Ex. 1002 ¶¶ 12-14.). Patent Owner argues that "playlist" should be construed separately, and its construction should be "a list referencing media items arranged to be played in a sequence." Prelim. Resp. 17. In addition, Patent Owner asserts that "assigned to the electronic device" requires no further construction, but if the Board decides that a construction is necessary, Patent Owner proposes that the proper construction is "directed to the electronic device." *Id.* at 19.

The specification of the '952 Patent defines "playlist 1528 . . . [as] a list of audio files and associated URLs of where the audio files were retrieved from." Ex. 1001, 21:63-65. Patent Owner argues that the term also includes a requirement that the playlist be "arranged to be played in a sequence." Prelim. Resp. 17-18 (citing Ex. 1001, 24:31-43). In support of

this argument, Patent Owner cites a discussion of Figure 17B. *Id.* This portion of the specification discusses audio player window 1792, which includes shuffle button 1796 and repeat button 1798. Ex. 1001, 24:31-43. These buttons may be used to vary the order of songs to be played and to continue playing songs for what could be an indefinite period of time. *Id.* On the current record, we are not persuaded that this description of audio player window 1792 narrows the previously cited definition of a playlist. Thus, on the record currently before us, we construe playlist to mean "a list of audio files or URLs of where the audio files were retrieved from."

The parties also dispute whether the playlist must be transferred to a device or directed to a device. The specification describes an embodiment that does not have storage space for a playlist. Ex. 1001, 4:4-9. In this embodiment, the playlist is stored on the IPAN Manager or a PC. *Id.* Petitioner's expert, Dr. Bove, opines that, in this embodiment, the playlist is not assigned to the device. Ex. 1002 ¶ 17. His statement, however, does not persuade us. The '952 Patent specifically contemplates a scenario where the playlist is resident on one device and used by another device to play songs. On the current record, we are not persuaded that this term should be narrowed to exclude this embodiment. Thus, based on the record currently before us, we agree with Patent Owner's proposal that the playlist is "directed to" rather than "transferred to" a device.

Finally, the parties dispute whether a user is required to select the device. The specification repeatedly describes assignment of a playlist to a particular device selected by a user. *See e.g.*, Ex. 1001, 4:57-58, 22:39-40, 24:45-48, 28:16, Fig.19B, and Fig. $19C_1$; *see also* Ex. 1002 ¶ 14 (noting that assignments are made to user-selected devices). Patent Owner asserts that

Petitioner is attempting to read an embodiment from the specification into the claim limitations and to exclude other embodiments. Prelim. Resp. 18-19. Patent Owner cites a portion of the specification discussing Figure 17E as an example of an embodiment excluded by Petitioner's proposed construction. *Id.* at 19 (quoting Ex. 1001, 25:3-8). Figure 17E illustrates the screen presented to a user in order to schedule a particular time or day to play a playlist. Ex. 1001, Fig. 17E. It shows the name of the playlist ("Favorites"), and it has a drop down box allowing the user to select the particular device to play this playlist. *Id.* Thus, even in this embodiment, the user selects the particular device. Therefore, on the record currently before us, we construe "playlist assigned to the electronic device" to mean "a list of audio files or URLs of where the audio files were retrieved from directed to a particular device selected by a user."

2. "Wherein Ones of the Plurality of Songs Are Not Stored on the Electronic Device"

Petitioner proposes that the plain meaning of "wherein ones of the plurality of songs are not stored on the electronic device" implies that the electronic device be capable of storing songs. Pet. 10. According to Petitioner, this limitation would have no meaning if no songs could be stored on the device. *Id.* Patent Owner asserts that this proposal "is both illogical and contrary to the teachings of the '952 Patent." Prelim. Resp. 20. As an alternative, Patent Owner proposes that the disputed term should be construed as "wherein *at least one* of the plurality of songs is not stored on the electronic device." *Id.* As both parties acknowledge, the specification describes an embodiment that does not have storage for songs. *See id.*, Pet. 10 (citing Ex. 1001, 3:57-4:9); *see also* Ex. 1001, 4:5-9 ("This embodiment

provides for a low-cost system that can play songs from playlists stored on the IPAN Manager or on the PC's storage space without having to store the audio files locally."). Thus, on the record currently before us, we are persuaded that the broadest reasonable interpretation of the disputed language in light of the specification is "wherein at least one of the plurality of songs is not stored on the electronic device."

3. Remaining Claim Terms

All other terms in the challenged claims are given their ordinary and customary meaning and need no express construction at this time.

II. ANALYSIS

We turn now to Petitioner's asserted grounds of unpatentability and Patent Owner's arguments in its Preliminary Response to determine whether Petitioner has met the threshold standard of 35 U.S.C. § 314(a).

A. Grounds Based on Berman (Ex. 1012)

1. Overview of Berman

Berman is directed to a playback unit that retrieves audio data from a remote server and plays songs that have been selected by the user. Ex. 1012, Abstract. An embodiment of Berman's playback unit is depicted in Figure 1, which is reproduced below.

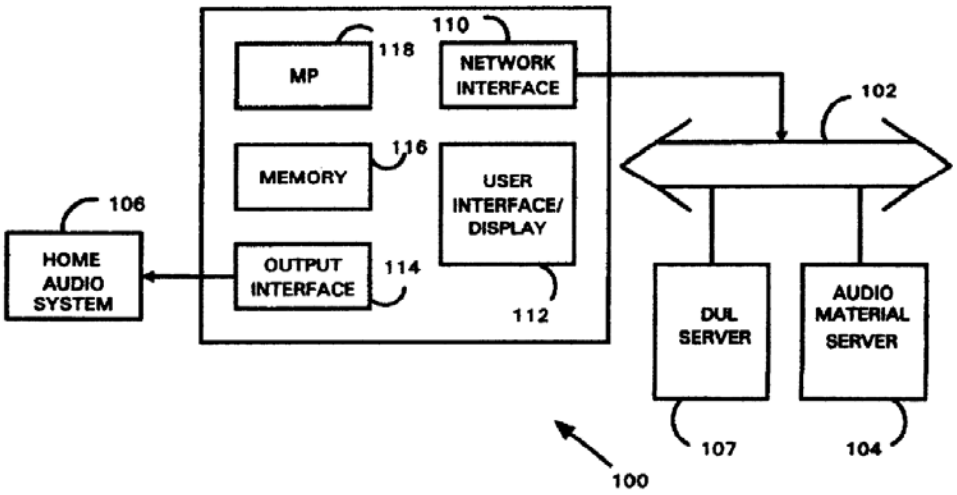

FIG. 1

Figure 1 is a block diagram of Berman's playback unit 100. Ex. 1012, 4:17-19. Playback unit 100 receives audio material from audio material server 104, and access rights to this material are controlled by directory and user list ("DUL") server 107. *Id.* at 4:51-53, 4:63-65. Playback unit 100 includes network interface 110 that facilitates communication with the servers over the Internet. *Id.* at 5:11-14. Memory 116 temporarily stores audio for playback and processing. *Id.* at 6:6-8. In certain embodiments, the user may be permitted to record a song to memory. *Id.* at 8:4-6.

The operation of the playback unit is illustrated in Figures 3 and 4, which are reproduced below:

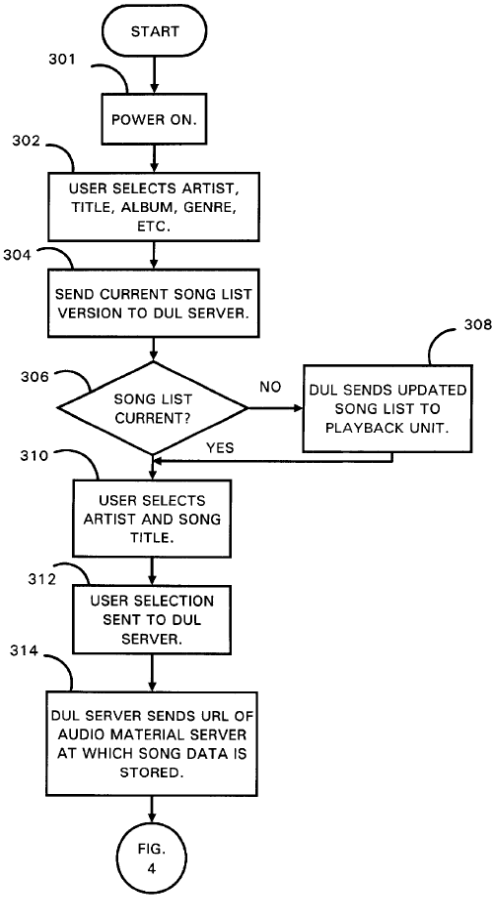

FIG. 3

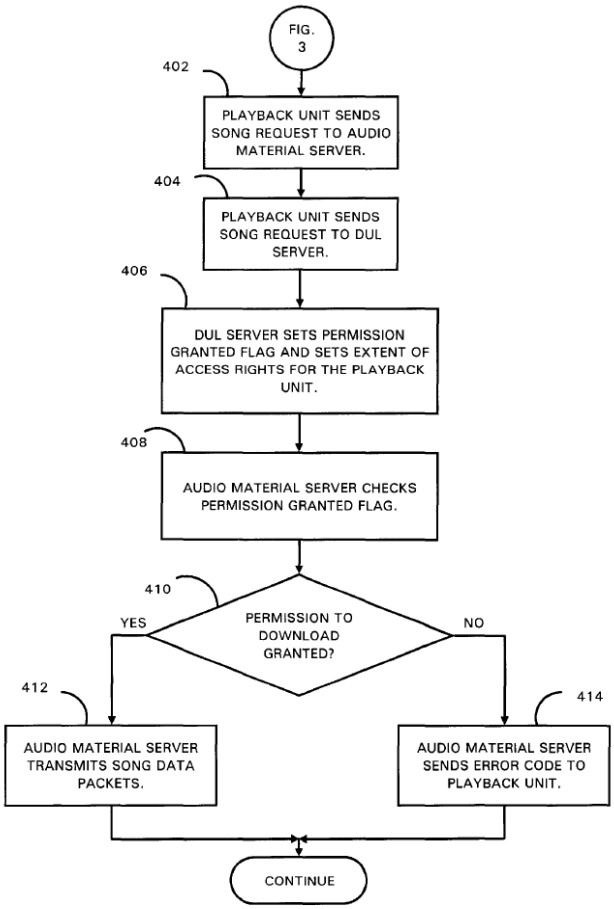

FIG. 4

Figures 3 and 4 are processing flow diagrams depicting the steps executed to request and receive audio material. Ex. 1012, 4:22-25. At step 302, the user selects a music category or type of song. *Id.* at 6:64-7:4. The playback unit then contacts the DUL server to confirm that the playback unit's song list is up to date. *Id.* at 7:4-6, Fig. 3 (step 304). If the song list is not up to date, the DUL server will send an updated song list to the device. *Id.* at 7:14-19, Fig. 3 (steps 306 and 308). The user selects a song from the song list. *Id.* at 7:22-24. The DUL server then sends playback unit 100 the network address or URL for the requested song. *Id.* at 7:30-41. Playback unit 100 then uses that URL to obtain the requested sound file or streaming audio from the

appropriate audio material server. Ex. 1012, 7:41-45, 8:32-34, Fig. 4 (steps 402 and 412).

2. Analysis of Asserted Ground of Anticipation by Berman

a) Independent Claim 9

Independent claim 9, in part, recites

> receiving, at an electronic device, a playlist assigned to the electronic device, the playlist identifying a plurality of songs, wherein ones of the plurality of songs are not stored on the electronic device.

Petitioner argues that Berman discloses a playback unit that receives a song list from the DUL server. Pet. 17 (citing Ex. 1012, Fig. 3 (step 308)); *see also* Ex. 1012, 10:23-28 (describing song list packet sent to playback unit with a user ID "to confirm that the updated song list information was sent to and received by the correct playback unit"). Petitioner also asserts that the songs identified in the song list are stored on audio material server 104, and thus, the songs are not stored on the playback unit. *Id.* at 18 (citing Ex. 1012, 4:51-52).

Patent Owner asserts that Berman's "song list" is not a "playlist" as recited by claim 9 and that the updated song list described in Berman does not disclose receiving a playlist assigned to the electronic device. Prelim. Resp. 21, 22. Patent Owner describes Berman's song list as "a catalog of songs," and thus, it falls within our construction of a playlist as a "list of audio files or URLs of where the audio files were retrieved from." *See id.* at 22. As discussed above in Section I.G.1, for the purposes of this Decision, we construe "playlist assigned to the electronic device" to mean "a list of audio files or URLs of where the audio files were retrieved from directed to

a particular device selected by a user." Patent Owner argues that Berman's disclosure of updating of the song list at device initiation does not disclose this limitation. *Id*. On the current record, we disagree with Patent Owner. As Petitioner has shown, Berman discloses sending a song list to a specific device. *See* Ex. 1012, 10:23-28; *see also* Ex. 1012, Fig. 8 (illustrating the song list packet sent to a playback unit). In addition, Berman discloses an error checking mechanism to confirm that the updated song list was "received by the correct playback unit." *Id.* 10:27. Thus, on this record, we are persuaded that Berman discloses receiving a playlist assigned to the electronic device.

As to the remaining limitations of claim 9, we have reviewed Petitioner's supporting evidence and determine that Petitioner has met the threshold of 35 U.S.C § 314(a). On this record, we are persuaded that there is a reasonable likelihood that Petitioner will prevail in showing that claim 9 is anticipated by Berman.

b) Dependent Claims 10 and 14

Claims 10 and 14 depend from claim 9. Claim 10 recites, in relevant part, that the "electronic device is one of a plurality of associated electronic devices" and that "the at least one remote source is at least one other of the plurality of associated electronic devices." Berman discloses a DUL server that associates a playback unit with a server through the use of a user identification code and a password. Pet. 18-19 (citing Ex. 1012, Figs. 3, 4, 7:55-66). In addition, Berman discloses an error checking mechanism to confirm that the updated song list was "received by *the correct* playback unit." Ex. 1012, 10:27 (emphasis added); *see also id.* at 14:15-18 ("Using the appropriate network protocols, *the correct* server is contacted. For

example, different servers may have different types of musical genres . . . .") (emphasis added). Thus, on this record, we are persuaded that Berman's system includes a plurality of associated electronic devices as recited in claim 10. Therefore, on this record, we are persuaded that Petitioner has shown sufficiently that Berman discloses the limitations of claim 10.

Claim 14 recites, in relevant part, "wherein the personal audio network server enables a user to assign the playlist to the electronic device" and "receiving the information comprises receiving information from the personal audio network server." Petitioner asserts that Berman's DUL server 107 is a personal audio network server. Pet. 19. Petitioner further maintains that "[b]y selection of a song list, the user causes the updated song list to be assigned by the DUL server to the playback unit." *Id.* at 20 (citing Fig. 3 (step 308)). Petitioner also argues that the playback unit receives a URL for the song data stored on the audio material server 104. *Id.* (citing Fig. 3 (step 314)). We are persuaded, on this record, that Petitioner has shown sufficiently that Berman discloses the limitations of claim 14.

Thus, for reasons stated above, on this record, we are persuaded that there is a reasonable likelihood that it will prevail in showing that claims 9, 10, and 14 are anticipated by Berman.

3. Analysis of Asserted Ground of Obviousness over Berman

Petitioner contends that Berman would have rendered obvious claim 13 of the '952 Patent. Pet. 34-35. Petitioner relies on claim charts and the Declaration of Dr. Bove to show how this reference allegedly teaches or suggests the claimed subject matter. *Id.*; Ex. 1002.

Claim 13 depends from claim 9, and recites,

wherein the at least one remote source is at least one web site from which the ones of the plurality of songs had previously been obtained, and obtaining the ones of the plurality of songs comprises:

requesting the ones of the plurality of songs from the at least one web site; and

receiving the ones of the plurality of songs from the at least one web site.

Petitioner asserts that it would have been obvious to one of ordinary skill in the art to use a web site as a remote source in place of Berman's servers. Pet. 20-21. Dr. Bove supports this position by stating that "[i]t would have been well known to one of ordinary skill in the art in 2000 that music files could be provided by a Web server. As one example, the MP3.com music server site launched in 1997." Ex. 1002 ¶ 19. Patent Owner argues that Dr. Bove's statement is conclusory and lacks factual underpinning. Prelim. Resp. 38-40. On the current record, we disagree with Patent Owner. Dr.Bove has stated that one of skill in the art would understand how to obtain music files from a web site, and he provided MP3.com as an exemplar of the web sites that would have been available at the relevant time. Thus, on the record currently before us, we are persuaded that Petitioner has shown sufficiently that Berman would have rendered obvious claim 13 of the '952 Patent.

B. Asserted Anticipation Ground Based on Wolff (Ex. 1014)

1. Overview of Wolff

Wolff is directed to a system and method for organizing and retrieving multimedia objects. Ex. 1014, Abstract. A remote controller is provided

that allows users to retrieve media objects including "Moving Picture Expert Group (MPEG) video[], MPEG audio Layer-3 (MP3), music compact discs (CD), etc." *Id.* at 3:19-25. In one embodiment, the remote controller is a PDA that allows users to select remotely media objects from a network access appliance ("NAA"). *Id.* at 3:25-30. The remote controller sends one or more URLs or media items to the NAA, and the NAA plays each item in order. *Id.* at 3:61-64. The user may create a playlist containing a plurality of songs and upload that playlist from the remote controller to the server and the NAA. *Id.* at 8:16-33. In addition, a remote controller can send a playlist to another remote controller or another user. *Id.* at 8:59-63. The NAA may have memory to store media, but if the media is not stored in memory, the NAA will retrieve the requested selection from a server. *Id.* at 3:34-41, 5:28-32. Wolff's system may include a plurality of NAAs and servers. *Id.* at Fig. 1. Each user of the remote controller has a personalized server to keep track of all services associated with the remote controller. *Id.* at 4:40-43. The personalized server may keep a copy of each media item, or the media objects may be located at different sites in the network. *Id.* at 4:51-53, 4:62-64.

2. Analysis of Asserted Ground of Anticipation by Wolff

Petitioner contends that Wolff anticipates claims 9, 10, and 14 of the '952 Patent. Pet. 29-33. Petitioner relies on claim charts to show how this reference allegedly discloses the claimed subject matter. *Id.*

a) Independent Claim 9

Independent claim 9, in part, recites

> receiving, at an electronic device, a playlist assigned to the electronic device, the playlist identifying a plurality of songs, wherein ones of the plurality of songs are not stored on the electronic device.

Petitioner asserts that Wolff discloses using a remote controller to create a playlist. Pet. 31-32 (citing Ex. 1014, Fig. 1, 4:37-64, 7:62-8:34). The playlist then may be uploaded to the personalized server. *Id.* Petitioner also argues that Wolff discloses a playlist assigned to each NAA. *Id.* at 32 (citing Ex. 1014, 8:31-33). In addition, Petitioner maintains that the songs in the playlist are associated with resource identifiers that enable the NAA to obtain the songs from servers. *Id.* (citing 3:30-41, 4:29-36, 58-64, 8:16-33).

Patent Owner argues that Wolff does not disclose "receiving, at an electronic device, a playlist assigned to the electronic device." Prelim. Resp. 27. First, Patent Owner argues that Wolff's playlist is not a "playlist" as claimed by the '952 Patent because it "is simply a favorites list." *Id.* at 28. Second, Patent Owner asserts that there is no evidence that the NAA ever receives a playlist. *Id.*

We are not persuaded by Patent Owner's arguments. Wolff discloses the creation of a playlist of MP3s or audio files. *Id.* at 3:19-25; 8:16-32. As stated in Section I.G.1 above, for the purposes of this Decision, the term "playlist" is construed to be "a list of audio files or URLs of where the audio files were retrieved from." Wolff discloses sending one or more URLs to the NAA. Ex. 1014, 3:61-64. On this record, we are persuaded that Wolff discloses the claimed playlist.

As to Patent Owner's second argument, Wolff's remote controller sends one or more URLs or media items to the NAA, and the NAA plays the songs associated with those URLs. Ex. 1014, 3:61-64. In addition, Wolff

discloses allowing the "user to easily find and select individual media objects or *entire play lists* on the remote controller and *request an NAA to play them*." *Id.* at 8:29-31 (emphasis added). Further, personalized server 110 contains playlists obtained from the remote controller, and the NAA examines playlists stored on personalized server 110 so that the NAA will be able to play quickly the media indicated by the stored playlist. Ex. 1014, 4:40-44, 8:16-32. In Section I.G.1 above, we construed "playlist assigned to electronic device" to mean "a list of audio files or URLs of where the audio files were retrieved from directed to a particular device selected by a user." Petitioner, on the record currently before us, has persuaded us that Wolff discloses a playlist directed to a particular device. Thus, on this record, Petitioner has shown sufficiently that Wolff discloses the disputed limitation.

As to the remaining limitations of claim 9, we have reviewed Petitioner's supporting evidence and determine that Petitioner has met the threshold of 35 U.S.C § 314(a). On this record, we are persuaded that there is a reasonable likelihood that Petitioner will prevail in showing that claim 9 is anticipated by Wolff.

b) Dependent Claims 10 and 14

Claims 10 and 14 depend from claim 9. Claim 10 recites, in relevant part, that the "electronic device is one of a plurality of associated electronic devices" and that "the at least one remote source is at least one other of the plurality of associated electronic devices." Wolff's system discloses multiple NAAs and servers. Pet. 32; Ex. 1014, Fig. 1, 4:51-53, 8:23-26. We are persuaded, on this record, that Petitioner has shown sufficiently that Wolff discloses the limitations of claim 10.

Claim 14, recites, in relevant part, "wherein the personal audio network server enables a user to assign the playlist to the electronic device" and "receiving the information comprises receiving information from the personal audio network server." Petitioner asserts that the playlist may be "received from personalized server 110, which is part of the personal audio network." Pet. 33. In addition, "[personalized] server 110 enables the user to assign the playlist to the NAA 128, *e.g.*, by selection using the remote controller 130." *Id.* (citing Ex. 1014, 5:22-33). Further, Petitioner asserts that the NAA receives playlists and URLs from personalized server 110 that allow the NAA to obtain songs from the server. *Id.* (citing Ex. 1014, 8:22-33). We are persuaded, on this record, that Petitioner has shown sufficiently that Wolff discloses the limitations of claim 14.

Thus, for reasons stated above, on this record, we are persuaded by Petitioner's assertion that there is a reasonable likelihood that it will prevail in showing that Wolff anticipates claims 9, 10, and 14.

C. Analysis of Asserted Grounds of Unpatentability over Leeke

Petitioner asserts that Leeke anticipates or renders obvious claims 9, 10, 13, and 14 of the '952 Patent. Pet. 21-29. Leeke discloses a content player and server. Ex. 1013, Abstract. Leeke's system is composed of servers 102 and 144, client apparatuses 104 and 106, and electronic network 100. *Id.* at Fig. 1. Patent Owner argues that Leeke does not anticipate or teach the "receiving, at the electronic device, information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source" limitation found in claim 9. Prelim. Resp. 23-25. Petitioner asserts that Leeke's client apparatus 106 receives URLs that

enable the player to obtain the songs from server 102. Pet. 26-27 (citing Ex. 1013, 4:50-52, 5:33-35, 19:59-20:49, 43:14-17). On the current record, we are not persuaded that Leeke discloses or teaches the disputed limitation. The cited portions disclose URLs used to update the database files in content entry subsystem 1600, which is located on the server. *See* Figs. 1 and 58, 43:13-17. Thus, the cited portions of Leeke do not describe sending URLs associated with a playlist to the client apparatus. *See* Prelim. Resp. 25-26. Therefore, we are not persuaded that Leeke anticipates or renders obvious claims 9, 10, 13, and 14 of the '952 Patent.

D. Analysis of Asserted Grounds of Unpatentability over Lansonic DAS-750

Petitioner asserts that Lansonic DAS-750 anticipates or renders obvious claims 9, 10, and 14 of the '952 Patent. Pet. 35-42. Petitioner also asserts that dependent claim 13 would have been obvious over Lansonic DAS-750. *Id.* at 42. Lansonic DAS-750 is a collection of web pages obtained using the Internet Archive Wayback machine. Pet. 35. "For a prior art reference to anticipate a claim, the reference must disclose each claim limitation in a single document." *Apple Inc. v. Int'l Trade Com'n*, 725 F.3d 1356, 1362 (Fed. Cir. 2013) (citing *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000)). Thus, as a threshold matter, we must determine whether Petitioner has shown sufficiently that Lansonic DAS-750 is a single document. Petitioner asserts that these web pages were accessible from a menu on Lansonic's home page. Pet. 35. We note, however, that only one page in Lansonic DAS-750 includes navigation links that could link to the other pages of Lansonic DAS-750. Ex. 1015, at 1. In addition, the pages in evidence show archive dates of June 19, 2000; August

15, 2000; August 17, 2000; and September 18, 2000. *Id.*at 1, 3, 5, 7. We are not persuaded that these web pages with varying archival dates are a single publication for purposes of a 35 U.S.C. § 102 analysis. Thus, we are not persuaded that Lansonic-DAS 750 anticipates claims 9, 10, and 14 of the '952 Patent.

As to the obviousness grounds, Patent Owner argues that Lansonic DAS-750 does not teach the "receiving, at the electronic device, information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source" limitation found in claim 9. Prelim. Resp. 31-32. Petitioner asserts that the Lansonic DAS-750 device as described in the reference can play songs stored on other networked devices and, thus, "the playlist necessarily has information enabling the device to obtain the songs from the remote source." Pet. 39. Dr. Bove concurs and opines that "[i]f such information were not there, the device would not be able to obtain the remotely stored songs." Ex. 1002 ¶ 26. We are not persuaded that the Lansonic DAS-750 device as described by Exhibit 1002 necessarily requires such information as part of its playlist. Dr. Bove's declaration does not contain sufficient technical detail or explanation to persuade us that Lansonic-DAS 750 must have the claimed "information." Therefore, we are not persuaded that Lansonic DAS-750 would have rendered obvious claims 9, 10, 13, and 14 of the '952 Patent.

E. Remaining Grounds

Petitioner asserts that claims 9, 10, and 14 would have been obvious over Wolff and that claims 9, 10, and 14 are anticipated by Cluts. Pet. 33-34, 43-51. Petitioner, however, has not described any relative strengths or

weaknesses of these additional asserted grounds distinguishing them from other grounds asserted. Therefore, the Board deems the remaining proposed grounds redundant, and we do not institute an *inter partes* review on them. *See* 37 C.F.R. § 42.108.

III. CONCLUSION

We conclude that Petitioner has demonstrated a reasonable likelihood of prevailing on the following grounds of unpatentability asserted in the Petition:

Claims 9, 10, and 14 as anticipated by Berman;

Claim 13 as obvious over Berman; and

Claims 9, 10, and 14 as anticipated by Wolff.

The Petition is denied as to all other grounds proposed. The Board has not made a final determination on the patentability of the challenged claims.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is granted as to claims 9, 10, 13, and 14 of the ’952 Patent;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the ’952 Patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial;

FURTHER ORDERED that the trial is limited to the grounds identified above and no other grounds set forth in the Petition as to claims 9, 10, 13, and 14 are authorized; and

FURTHER ORDERED that an initial conference call with the Board is scheduled for 4 PM Eastern Time on April 9, 2014. The parties are directed to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765-66 (Aug. 14, 2012), for guidance in preparing for the initial conference call, and should be prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

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