

By: Thomas Engellenner
Pepper Hamilton LLP
125 High Street
19th Floor, High Street Tower
Boston, MA 02110
(617) 204-5100 (telephone)
(617) 204-5150 (facsimile)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC,
and
LG ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC., and LG
ELECTRONICS MOBILECOMM U.S.A., INC.
Petitioners

v.

BLACK HILLS MEDIA, LLC
Patent Owner

Case No. IPR2014-00740
Case No. IPR2015-00340
U.S. Patent 8,045,952

PATENT OWNER RESPONSE

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF AUTHORITIES	iii
UPDATED TABLE OF EXHIBITS.....	vi
I. INTRODUCTION	1
II. PETITIONER’S BURDEN OF PROOF	2
III. BACKGROUND OF THE ‘952 PATENT	8
A. Summary Of The ‘952 Patent	8
B. Summary Of The Claimed Subject Matter	13
IV. CLAIM CONSTRUCTION AND ORDINARY SKILL IN THE ART	16
A. Legal Standard	17
B. A Person Having Ordinary Skill In The Art	18
C. Construction Of “Playlist”	19
1. Plain and ordinary meaning of “playlist” in the media file sharing arts.....	20
2. The specification of the ‘952 Patent uses “playlist” consistent with its plain and ordinary meaning	25
D. Construction Of “Assigned To The Electronic Device”	30
V. BERMAN DOES NOT ANTICIPATE CLAIMS 9, 10, AND 14.....	31
A. Neither The Petition Nor The Jeffay Report Apply A Proper Claim Construction To The Anticipation Analysis.....	31
B. Legal Standard Of Anticipation	32
C. Summary Of Berman.....	32
D. Berman Does Not Anticipate Claim 9, 10, Or 14	37

Page

VI.	BERMAN DOES NOT RENDER OBVIOUS CLAIMS 1-3	41
A.	Neither The Petition Nor The Jeffay Report Apply A Proper Claim Construction To The Obviousness Analysis Over Berman.....	41
B.	Legal Standard Of Obviousness	42
C.	Berman Does Not Render Obvious Claims 1-3	45
VII.	LOGAN DOES NOT RENDER OBVIOUS THE CHALLENGED CLAIMS	46
A.	Neither The Petition Nor The Jeffay Report Apply A Proper Claim Construction To The Obviousness Analysis Over Logan	47
B.	Summary Of Logan.....	47
C.	Logan Does Not Render Obvious Claims 1-3, 9-11, Or 14.....	51
1.	Logan’s ProgramID does not identify a song.....	51
2.	One cannot conclude that Logan’s “music selection” program segments are songs.....	54
3.	The Jeffay Report fails to demonstrate that a person of ordinary skill in the art would modify Logan as suggested	56
VIII.	CONCLUSION	59

TABLE OF AUTHORITIES

	<u>Page(s)</u>
CASES	
<i>CallCopy, Inc. v. Verint Americas, Inc.</i> , IPR2013-00486, Paper No. 11 (PTAB, Feb. 5, 2014).....	7, 42, 47
<i>CCS Fitness, Inc. v. Brunswick Corp.</i> , 288 F.3d 1359 (Fed. Cir. 2002)	17
<i>Endo Pharmaceutical, Inc. v. Depomed, Inc.</i> , IPR2014-00656, Paper 12 (PTAB, September 29, 2014)	17, 18
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	42, 43
<i>Grain Processing Corp. v. American-Maize Prods. Co.</i> , 840 F.2d 902 (Fed. Cir. 1988)	43
<i>In Heart Failure Techs., LLC v. CardioKinetix, Inc.</i> , IPR2013-00183, Paper No. 12 (PTAB, July 31, 2013)	44
<i>In re Cortright</i> , 165 F.3d 1353 (Fed. Cir. 1999).....	16
<i>In re Kubin</i> , 561 F.3d 1351 (Fed. Cir. 2009)	43
<i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011)	43
<i>In re Oetiker</i> , 977 F.2d 1443 (Fed. Cir. 1992).....	2
<i>In re Paulsen</i> , 30 F.3d 1475 (Fed. Cir. 1994).....	18
<i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Fed. Cir. 2007)	17
<i>InTouch Tech., Inc. v. VGO Comm's, Inc.</i> , 2014 U.S. App. LEXIS 8745, *5	44
<i>Key Pharms. v. Hercon Labs. Corp.</i> , 161 F.3d 709 (Fed.Cir.1998).....	3
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	42-44
<i>Medichem, S.A. v. Rolabo, S.L.</i> , 353 F.3d 928 (Fed. Cir. 2003).....	3, 31, 41
<i>Microsoft Corp. v. Proxyconn, Inc.</i> , IPR2012-00026, Paper No. 17 (PTAB, December 21, 2012)	4, 31

Page(s)

<i>Motorola, Inc. v. Interdigital Tech. Corp.</i> , 121 F.3d 1461 (Fed. Cir. 1997).....	32
<i>Motorola Mobility LLC, et al. v. Arendi S.A.R.L.</i> , IPR2014-00203, Paper No. 10 (PTAB, June 5, 2014)	34
<i>Oakley, Inc. v. Sunglass Hut Int'l</i> , 316 F.3d 1331 (Fed.Cir.2003)	3
<i>Scripps Clinic & Res. Found. v. Genentech, Inc.</i> , 927 F.2d 1565 (Fed.Cir.1991).....	32
<i>Universal Remote Control, Inc. v. Universal Electronics, Inc.</i> , IPR2013- 00152, Paper No. 8 (PTAB, Aug. 19, 2013)	17
<i>Thorner v. Sony Computer Entm't Am., LLC</i> , 669 F.3d 1362 (Fed. Cir. 2012)	17
<i>Unigene Labs., Inc. v. Apotex, Inc.</i> , 655 F.3d 1352 (Fed. Cir. 2011).....	43
<i>Wowza Media Systems, LLC v. Adobe Systems Inc.</i> , IPR2013-00054, Paper No. 12 (PTAB, April 8, 2013)	44
<i>ZTE Corporation v. ContenGuard Holdings, Inc.</i> , IPR2013-00139, Paper No. 15 (July 9, 2013)	4, 31, 32

STATUTES

35 U.S.C. § 102	1
35 U.S.C. § 103(a)	1
35 U.S.C. § 312(a)(3).....	2, 7
35 U.S.C. § 316(e)	2, 3

OTHER AUTHORITIES

37 C.F.R. § 42.20(c).....	7
37 C.F.R. § 42.22(a)(2).....	7
37 C.F.R. § 42.100(b)	17
37 C.F.R. § 42.104	2, 7, 27, 40, 46

	<u>Page(s)</u>
37 C.F.R. § 42.120	1
77 Fed. Reg. 48756 (Aug. 14, 2012)	7, 17
MPEP § 2111	16
MPEP § 2131	32
MPEP § 2141	18, 43
MPEP § 2142	2

UPDATED TABLE OF EXHIBITS

Previously filed

Exhibit Description	Exhibit #
Mobile Application Distribution Agreement between Samsung and Google	2001
Relevant Pages from Joint Submission of Corrected Exhibit List, Doc. 293 filed on 4/15/2012, in the matter of <i>Oracle America, Inc. v. Google Inc.</i> , Case No. CV 10-03561 WHA (N.D. Ca)	2002
Google's Motion to Intervene filed in ITC Inv. No. 337-TA-882	2003
Initial Determination in ITC Inv. No. 337-TA-882, Order No. 17, Granting Google Inc.'s Motion to Intervene	2004
Claim Chart filed in ITC Inv. No. 337-TA-882 as Exhibit 97 to Original Complaint	2005
Redacted Claim Chart supplied in ITC Inv. No. 337-TA-882	2006
Declaration of Ivan Zatkovich (filed in IPR2013-00593 as Exhibit 2012)	2007
TerraTec M3PO High Quality Audio Decoder Manual (May 18, 2000)	2008
Siren Juken Operating Manual (2000)	2009
Microsoft Windows Media Player 7 Handbook, Ch. 2 (October 4, 2000)	2010
Public Version of Initial Determination in ITC Inv. No. 337-TA-882, issued July 7, 2014	2011
Declaration of Ivan Zatkovich (filed in ITC Proceeding 337-TA-882)	2012

UPDATED TABLE OF EXHIBITS (CONTINUED)

New

Exhibit Description	Exhibit #
Declaration of Ivan Zatkovich	2013
Jeffay Deposition Transcript, January 15, 2015	2014

**PATENT OWNER RESPONSE
PURSUANT TO 37 C.F.R. § 42.120**

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.120, Patent Owner, Black Hills Media, LLC, (“Patent Owner”) hereby submits this Response to the Petition for *Inter Partes* Review (Paper 1, “Petition”) of U.S. Patent No. 8,045,952 (the ‘952 Patent) as to the grounds for which a trial was instituted in the Decision Institution of *Inter Partes* Review dated November 4, 2014 (Paper 7, “Institution Decision”).

The Patent Trial and Appeals Board (“the Board”) instituted a trial only with respect to the following grounds:

- 1) Claims 9, 10, and 14 as anticipated under 35 U.S.C. § 102 by U.S. Patent No. 6,502,194 of Berman (Ex. 1003, “Berman”);
- 2) Claims 1-3 as obvious under 35 U.S.C. § 103(a) over Berman; and
- 3) Claims 1-3, 9-11, and 14 as obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 6,199,076 of Logan (Ex. 1004, “Logan”).

As detailed below, none of the claims at issue in this proceeding are unpatentable over Berman or Logan as the asserted prior art fails to teach the claimed inventions, and the Petitioner has failed to demonstrate by a preponderance of the evidence that it would have been obvious to modify Berman or Logan to arrive at the claimed inventions.

II. PETITIONER'S BURDEN OF PROOF

“[T]he petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. § 316(e). The legal standard of “a preponderance of evidence” requires the evidence to be more convincing than the evidence which is offered in opposition to it. MPEP § 2142. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of the arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

To prove unpatentability, a petitioner is required to file a petition that must identify with particularity: 1) the statutory grounds on which the challenge to each claim is based, and 2) evidence that supports the grounds for the challenge to each claim, including “such other information as the Director may require by regulation.” 35 U.S.C. § 312(a)(3). Consistent with these statutory requirements, Rule 42.104(b) requires that the petition must: 1) identify “[h]ow the challenged claim is to be construed”; 2) identify “[h]ow the construed claim is unpatentable under the statutory grounds identified” and “specify where each element of the claim is found in the prior art patents or printed publications relied upon”; and 3) provide “the relevance of the evidence to the challenge raised.”

“Both anticipation under § 102 and obviousness under § 103 are two-step

inquiries. *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1339 (Fed.Cir.2003); *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed.Cir.1998). The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art. *Oakley*, 316 F.3d at 1339.” *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (emphasis added).

Because the totality of the Petition’s analysis¹ and evidence² with regard to anticipation and obviousness is premised on an improper (and necessarily broader)

¹ The Petition provides no analysis regarding the proper construction of “playlist,” merely indicating that “for the reasons provided by the Board in IPR2013-00593, these constructions should apply to the meaning of these terms in the present proceeding as well.” (Paper 1, pp. 5-6.)

² The Declaration of Kevin Jeffay, Ph.D. was submitted with the Petition as Exhibit 1011 (“the Jeffay Report”). The Jeffay Report noted the Board’s preliminary construction of “playlist” in IPR2013-00593 and indicated that “[f]or the purposes of the present proceeding, I have assumed that these constructions should continue to apply to the meanings of these terms,” though the Jeffay Report further alleged the construction should be further broadened to also include URLs that “indicate the location from which the audio files associated with the playlist *can be* downloaded.” (Ex. 1011, ¶¶28-29).

claim construction that was not preliminarily adopted by the Board in the Institution Decision, the Petitioner cannot meet its burden of proving unpatentability of the challenged claims in its Petition. *See Microsoft Corp. v. Proxyconn, Inc.*, IPR2012-00026, Paper No. 17 at 21, 24 (December 21, 2012) (the Board disagreed with Petitioner’s claim construction and held that “[a]s this argument is premised on Petitioner’s *erroneous claim construction* we are not persuaded of a reasonable likelihood of prevailing.”) (emphasis added) and *ZTE Corporation v. ContenGuard Holdings, Inc.*, IPR2013-00139, Paper No. 15 at 27 (July 9, 2013) (“Because ZTE’s analysis of what is covered by the six means-plus-function elements recited in independent claim 1 within the ‘repository’ is incorrect, *ZTE has not properly applied those elements onto the disclosure of EP ’139*. Accordingly, *for that reason alone*, ZTE has not demonstrated a reasonable likelihood that it would prevail with respect to claims 1-4, 8-11, and 14-17.”). Moreover, the Petition and the Jeffay Report failed to allege any alternative plain-language meaning of the term “playlist” or to cite to any evidence of how a person of ordinary skill in the art would have understood the term in light of the specification of the ‘952 Patent. Rather, Dr. Jeffay confirmed during his deposition that the entirety of his analysis was based upon an improper construction, and that he did not consider any other meaning of the term “playlist” in applying the claims to the cited art:

Q. Do you have any opinion as to the opinion [*sic*] of playlist?

MS. REISTER: Objection. Scope. Relevance.

A. I mean, for purposes of this matter, I just was using the definition of playlist that was presented by the board in the previous Yamaha IPR proceedings, and beyond that, I haven't offered an independent opinion.

...

Q. So, again, what is your definition of the term playlist in the context of these patents?

MS. REISTER: Objection. Scope. Relevance. Vague.

A. I was never asked to come up with my own independent definition. In both the ITC case and the PTO matters -- well, it's slightly different. So one case, as I say, these constructions were just provided to me, and I was asked to opine on these existing constructions, in -- and then do an analysis, and I believe I did an analysis under each of them, but I don't recall for certain. And in the case of these -- this IPR, again, I was not asked to opine on the appropriateness of the construction or playlist, but rather to use a construction that I understood came from a -- related IPR.

BY MR. ENGELLENER:

Q. Do you have any personal opinion as to what the meaning of playlist is?

MS. REISTER: Objection. Scope. Relevance.

A. I haven't done a sufficient analysis to come up with at this point of an independent conclusion as to a construction for playlist.

BY MR. ENGELLENER:

Q. So if the board were to ultimately conclude that playlist had a different meaning than was -- than the way the term was construed in each of these proceedings at the time that you prepared your declarations, would that affect your conclusions?

MS. REISTER: Objection. Scope. Hypothetical.

A. I don't think I can answer that. I mean, clearly it's going to depend on what the actual construction is.

Q. Is there a plain and ordinary meaning for the term playlist?

MS. REISTER: Objection. Scope.

A. I haven't done that analysis to determine that.

(Jeffay Tr. Ex. 2014, at 56:21-62:24 (emphasis added)).

The Petition (and the evidence that it relies upon) is therefore incurably flawed, as the Petitioner cannot now change course at this late stage of the proceedings and submit with its Reply new evidence or arguments to supplant that which was required to be presented in the Petition.³ To allow the Petitioner to

³ Despite Petitioner's knowledge of the Board's preliminary construction in the Institution Decision, Petitioner also failed to submit any supplemental information as contemplated under 37 C.F.R. §42.123(a).

submit such evidence or arguments in the Reply would be contrary to the regulatory and statutory mandates of efficacy, economy, and timely completion of proceedings, and would require Patent Owner to anticipate and respond to the arguments that could be set forth in a Reply, as Patent Owner will have no further opportunity to respond to Petitioner's arguments beyond oral argument. This *de facto* shifting of the burden to Patent Owner to both fill in the gaps in Petitioner's arguments as well as deconstruct these straw-man invalidity contentions is legally impermissible as the burden of proof lies on a petitioner to fully set forth its case and all material facts in its petition. 37 C.F.R. §§ 42.20(c) and 42.22(a)(2); *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012).

Without the required "comparison of the properly construed claim to the prior art" in the Petition, the Board cannot determine that Petitioner satisfies its burden without impermissibly substituting its own analysis for the Petitioner's. *See CallCopy, Inc. v. Verint Americas, Inc.*, IPR2013-00486, Paper No. 11 at 10 (Feb. 5, 2014). Rather, it is Petitioner's burden by statute to provide in its Petition clear and detailed analysis in support of its proposed grounds of unpatentability. *See* 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4). Thus, if the Board ultimately finds that the Petition applied the wrong claim construction, the Board's only option is to find the claims not unpatentable, as the Petitioner will have provided

no analysis or evidence in its Petition to show by a preponderance of the evidence that the claims are anticipated or obvious under the proper claim construction.

III. BACKGROUND OF THE '952 PATENT

The '952 Patent was filed on November 27, 2006, as U.S. Application No. 11/563,227, and issued on October 25, 2011. The '952 Patent claims priority as a continuation of U.S. Application No. 09/805,470, filed on March 12, 2001, which in part claims priority to U.S. Provisional Application No. 60/246,842, filed on November 8, 2000.

A. Summary Of The '952 Patent

In 2000, when the provisional application disclosing the subject matter that was ultimately claimed in the '952 Patent was filed, the industry was primarily focused on the significance of audio content in digital content distribution systems. By way of example, audio player devices were developed to have large amounts of storage (e.g., personal digital assistants (PDAs)) that enabled a user to aggregate personal content on their own local player device. Other products at the time were instead focused on aggregating audio content centrally such that a user's player device could receive for playback centrally-stored audio content selected by a user on that user's player device. (Zatkovich Decl. Ex. 2013, ¶¶ 30-31).

The '952 Patent is generally directed to methods and systems that provide a user with access to audio content from a variety of remote sources, e.g., networked

remote sources or web sites (Ex. 1001, Abstract and 2:15-21, 57-62), and one of the more significant innovations described and claimed in the '952 Patent is the role of the playlist in the management of audio content (as opposed to the audio content itself). (Zatkovich Decl. Ex. 2013, ¶31). Specifically, the '952 Patent provides that the receipt of an assigned playlist by a network-enabled electronic device allows the playlist-receiving device to obtain and play the audio content indicated by the playlist, for example, to “provide[] people who are or are not comfortable with computers a way of taking music from various sources and putting it into one place for listening pleasure.” (Ex. 1001, 3:19-23). For example, the '952 Patent describes a process that allows a user logged into a central server (which may authorize the user based on a password) to assign a centrally-managed playlist, which identifies a plurality of songs aggregated from one or more remote sources, to a local electronic device. (Ex. 1001, 23:35-45 and 24:8-12). The centrally-managed playlists can be controlled by the user, for example, to add songs to and delete songs from the playlist. (Ex. 1001, 23:35-45 and 24:8-12). (*See also* Zatkovich Decl. Ex. 2013, ¶31).

A copy of the playlist can then be transmitted from the server to the device, such that the receiving device takes control to obtain audio content of the songs indicated in the playlist from the one or more remote sources and to sequentially play the songs identified by the playlist. (*See* Ex. 1001, Figures 19B-19C and

27:47-30:18). For example, when an electronic device obtains and plays back the audio content corresponding to a song within a playlist, the audio content can be streamed to, or downloaded by, the electronic device. (Ex. 1001, 21:65-22:4). (See also Zatkovich Decl. Ex. 2013, ¶52).

The '952 Patent describes various computing environments that enable the network-enabled audio devices to store files, play standard audio CDs and MP3 encoded CDs, record songs from CDs, receive digitized radio broadcasts over the World Wide Web, and/or receive assignments of playlists of songs from other network-enabled audio devices. (Ex. 1001, 2:57-62). Figure 11 of the '952 Patent, which is reproduced below, shows one exemplary embodiment of such a computing environment. The network includes network-enabled electronic

'Device A' (1108), network-enabled electronic 'Device B' (1110), and personal computer (1106). These electronic devices interact with a server (1104) "through the network 1102 (such as the Internet)." (Ex. 1001, 16:56-60). (See also Zatkovich Decl. Ex. 2013, ¶¶41-42).

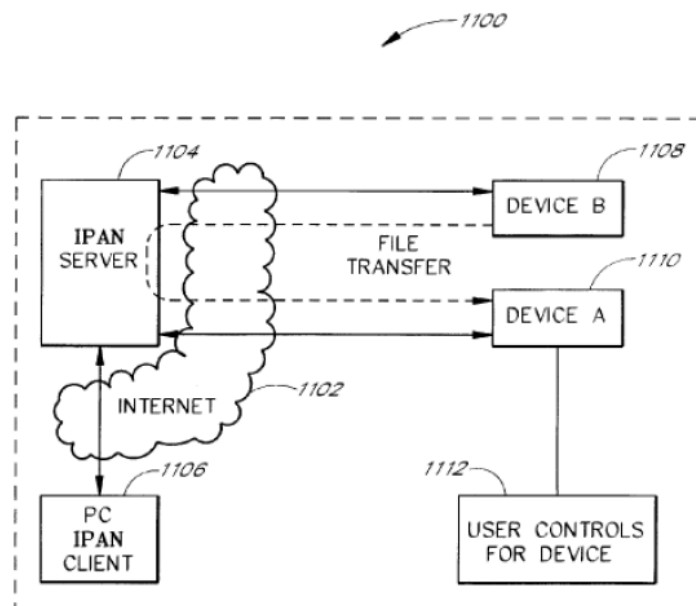


FIG. 11

The electronic devices (e.g., devices (1108) and (1110)) are assigned, and can receive, playlists and content over a network (e.g., the Internet or a local home network), and can retrieve content indicated by the playlists through the network connection. (Ex. 1001, 2:37-39, 22:47-48, and 30:19-26). For example, the '952 Patent describes a process that allows a user logged into a central server (which may authorize the user based on a password) to assign a centrally-managed playlist, which identifies a plurality of songs aggregated from one or more remote sources, to a local electronic device. (Ex. 1001, 23:35-45 and 24:8-12; Zatkovich Decl. Ex. 2013, ¶31). Alternatively, the '652 Patent provides that playlists can be assigned to one or more playback devices when those devices connect to the IPAN Server, for example. (Ex. 1001, 25:53-58; Zatkovich Decl. Ex. 2013, ¶47). A copy of the playlist can then be transmitted from the server to the device, such that the playlist-receiving device takes control to obtain audio content indicated by the playlist from the one or more remote sources and can play the songs identified by the playlist. (Ex. 1001, Figures 19B-19C and 27:47-30:18; Zatkovich Decl. Ex. 2013, ¶31). When an electronic device obtains and plays back the audio content corresponding to a song within a playlist, the audio content can be streamed to, or downloaded by, the electronic device. (Zatkovich Decl. Ex. 2011, ¶52; Ex. 1001, 21:65-22:4). In some embodiments, the electronic device does not include local storage and therefore can only stream the audio content corresponding to the songs

of a playlist from a remote source. (Ex. 1001, 3:57-58; Zatkovich Decl. Ex. 2013, ¶¶52-53).

In another aspect, the '652 Patent provides that a user can select between various modes of operation. For example, as an alternative to the playlist mode of operation described above, the '652 Patent additionally discloses that the network-enabled device can select an "Internet Radio" option in order to receive and play Internet radio broadcasts. (Ex. 1001, FIG. 18A ("option 1814") and 26:20-25; Zatkovich Decl. Ex. 2013, ¶57). For example, "in the Web Radio mode, the intelligent radio 100 uses the modem 206 to connect to the ISP 232. The ISP 232 provides a list of available Web broadcasts, and access to the Internet 234, so that the various Web broadcasts can be received by the intelligent radio 100. In the Web Radio mode, the display device 112 is used to select a Web broadcast and to provide information about the selected Web broadcast." (Ex. 1001, 10:50-57). The Web Radio mode "allows the user to select a preferred type of program material (e.g., Sports, Weather, News, All, etc.). The display 330 includes a list 332 of program types and a scroll bar 331. The user uses the cursor control 116 or the tuning control 114 to highlight a desired program type from the list 332, and then the user presses the select button 118 to select the highlighted program type." (Ex. 1001, 11:45-52; Zatkovich Decl. Ex. 2013, ¶59).

After selecting the type of program material, the list of available programs corresponding to the selected program type can be displayed to allow the user to select a particular Web broadcast for playback. (Ex. 1001, 11:53-54 and 12:62-13:1; Zatkovich Decl. Ex. 2013, ¶¶59-60).

B. Summary Of The Claimed Subject Matter

Independent claim 1 recites a method comprising:

“assigning a playlist to an electronic device, the playlist identifying a plurality of songs;

identifying ones of the plurality of songs in the playlist that are not stored on the electronic device;

providing the playlist to the electronic device; and

providing information to the electronic device enabling the electronic device to obtain the ones of the plurality of songs that are not stored on the electronic device from at least one remote source.”

Each of challenged claims 2-4 depends directly from independent claim 1 and recites additional limitations of the method of claim 1.

Independent claim 9 recites 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.”

Each of challenged claims 10-12 and 14 depends directly from independent claim 9 and recites additional limitations of the method of claim 9.

In every method and system described in the ‘952 Patent, three distinct pieces of information are received or obtained by the electronic device in order to play the songs indicated by a playlist assigned thereto: i) a playlist identifying a plurality of media items (e.g., by song title) (*see, e.g.*, Ex. 1001, 4:29-30, “The playlists include ***titles of audio*** from a variety of audio sources.”); ii) information enabling the electronic device to obtain the media items (e.g., a location or source from which a song identified in a playlist may be obtained, *see, e.g.*, Ex. 1001, 4:30-31, “The assignments provide information about the location of other web sites containing the audio sources.”); and iii) the media items themselves (*see, e.g.*, Ex. 1001, 4:32-33, “The software module is configured to connect through the ISP to the web sites to download the audio files.”). (Zatkovich Decl. Ex. 2013, ¶32, 86).

The '952 Patent distinguishes between the information for identifying a song (e.g., a song title), the information for obtaining a song (e.g., a location or source from which a song identified in a playlist may be obtained), and the song itself (e.g., an audio file to be streamed or downloaded). (Zatkovich Decl. Ex. 2013, ¶32). Though these three pieces of information are distinct and can be received independently from one another (*see, e.g.*, Ex. 1001, 4:50-5:3, Zatkovich Decl. Ex. 2013, ¶33), the '952 Patent also describes embodiments in which the information enabling the electronic device to obtain the song is received *together with* the information identifying the songs (*see, e.g.*, Ex. 1001, 21:62-65, and 22:48-50, Zatkovich Decl. Ex. 2013, ¶34).

The '952 Patent makes clear that, regardless of their association in the playlist, the information identifying a song is different from the information used to obtain a song. (*see, e.g.*, Ex. 1001, 21:62-65, and 22:48-50, Zatkovich Decl. Ex. 2013, ¶35). For example, in every portion of the '652 Patent that depicts the contents of a playlist, the song title is identified. (*See e.g.*, Ex. 1001, 4:29-30 ("The play lists include titles of audio from a variety of audio sources.") and 22:48-50 ("Within the playlist, the URL's indicate the location from which the audio files associated with the song titles in the playlist can be downloaded."); Zatkovich Decl. Ex. 2013, ¶¶35-39). Indeed, it is key that a playlist *identify* the songs (e.g., by title) such that the user can assign, compose, and/or manipulate the playlists and

the songs contained therein. (Zatkovich Decl. Ex. 2013, ¶36). Thus, the ‘952 Patent makes clear that while the “information enabling a song to be obtained” can be *associated* with the “information identifying the song,” the information enabling the electronic device to obtain a song in and of itself is not sufficient to identify the song within the meaning of the ‘952 Patent. (Zatkovich Decl. Ex. 2013, ¶35).

IV. CLAIM CONSTRUCTION AND ORDINARY SKILL IN THE ART

As noted above, independent claims 1 and 9 respectively recite a method involving a “playlist” assigned to an electronic device, “the playlist identifying a plurality of songs.” Patent Owner submits that the proper construction for the term “playlist” is “a list referencing media items arranged to be played in a sequence.”

The Board preliminarily construed the term “playlist” to mean “a list of audio files.” Institution Decision, p. 10. It is respectfully submitted that this preliminary construction neglected substantial evidence of record as to the complete ordinary and customary meaning of the term “playlist.” The Board’s determination that its preliminary construction of “playlist” is “consistent with” the specification and that “[a]ny other aspects of ‘playlist’ need not be construed expressly for purposes of this decision” is erroneous as a matter of law. Rather, “the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach,” Manual of Patent Examining Procedure (MPEP) § 2111 (citing *In re Cortright*, 165 F.3d 1353 (Fed.

Cir. 1999)), including the fundamental “aspect” that media items referenced by a playlist are arranged to be *played as a group* (i.e., in succession one after another), as discussed in detail below.

A. Legal Standard

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). “Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).” *Endo Pharmaceutical, Inc. v. Depomed, Inc.*, IPR2014-00656 (Paper 12 at 6, September 29, 2014).

Indeed, “[t]here is a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning,” *Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2013-00152 (Paper 8, Aug. 19, 2013) (quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366. (Fed. Cir. 2002)), and “there are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony*

Computer Entm't Am., LLC, 669 F.3d 1362, 1365 (Fed. Cir. 2012). “Any special definitions for claim terms must be set forth with reasonable clarity, deliberateness, and precision.” *Endo Pharmaceutical, Inc.*, IPR2014-00656 (Paper 12 at 6) (citing *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)).

B. A Person Having Ordinary Skill In The Art

Patent Owner submits that a person having ordinary skill in the art (also referred to as “PHOSITA”) at the time of the invention of the ‘952 Patent would have had a Bachelor’s degree in computer science or electrical engineering or its equivalent and 1-2 years of practical experience with media file sharing. (Zatkovich Decl. Ex. 2013, ¶26). Patent Owner’s proposed definition is supported by the declaration of Ivan Zatkovich, which takes into account various factors to be considered in determining this hypothetical person such as the type of problems encountered in the art at the time of the invention, the sophistication of the technology, and the education level and professional capabilities of active workers in the field. MPEP §2141(II)(C); (Zatkovich Decl. Ex. 2013, ¶27).

The ‘740 Petition, on the other hand, has proposed an open-ended definition for a person having ordinary skill in the art (also referred to as “PHOSITA”) as having “at least a B.S. degree in electrical engineering, computer engineering or computer science and approximately two years of professional experience with computer networking and multimedia technologies, or the equivalent.” (Paper 1, p.

7; Jeffay Decl. Ex. 1011, ¶4, emphasis added). Though there appears to be no material difference exists between the fields of study and experience between Patent Owner’s proposed definition and that of Petitioner (Zatkovich Decl. Ex. 2013, ¶29), Patent Owner’s proposed definition more accurately reflects the education level of a person of ordinary skill in the art in that it specifically excludes persons having a PhD that would exceed the level of “ordinary” skill.⁴

Accordingly, Patent Owner respectfully requests that the Board adopt the Patent Owner’s proposed definition because it would exclude persons who are overqualified to be considered of “ordinary skill in the art.”

C. Construction Of “Playlist”

In its Institution Decision, the Board provided a preliminary construction that the term “playlist” means “a list of audio files” that does “not require items arranged to be played in a sequence.” Institution Decision, p. 10.

Patent Owner respectfully disagrees and submits that the broadest reasonable interpretation of “playlist” from the vantage point of one of ordinary skill in the art at the time of the invention of the ’952 Patent is “a list referencing media items

⁴ During his deposition, Dr. Jeffay acknowledged that the analysis contained within the Jeffay Report “focus[ed] on someone who has a BS degree and approximately two years of experience, and for purposes of doing it specifically, I would say I was basically doing it with two years of experience.” (Ex. 2014, p. 113, ll. 4-8).

arranged to be played in a sequence.” The Patent Owner’s construction of “playlist” is supported by the intrinsic evidence provided by the specification and claims, by numerous exemplary contemporaneous, and by the declaration testimony of Ivan Zatkovich, who testifies as to the plain and ordinary meaning of the claim terms from the vantage point of one of ordinary skill in the art at the time of the invention in light of the ‘952 Patent. Neither the Petition nor the Jeffay Report contest Patent Owner’s proposed construction, though Patent Owner’s construction is affirmatively supported by the various documents cited in the Jeffay Report to characterize the state of the art at the time of the invention.

1. Plain and ordinary meaning of “playlist” in the media file sharing arts

“Playlist” is a term that was generally understood in the media file sharing arts at the time of the invention of the ‘952 Patent to mean a list referencing media items arranged to be played in a sequence. (Zatkovich Decl. Ex. 2013, ¶¶63). That is, the media items referenced by the playlist are arranged to be played one after another as a group, without having to select individual songs for playback. (Zatkovich Decl. Ex. 2013, ¶¶65-66). This customary meaning is exemplified in the publications cited as Exhibits 2008-2010, which were published around the time of the invention of the ‘952 Patent. (Zatkovich Decl. Ex. 2013, ¶¶63-65, 80-82).

The *TerraTec M3PO High Quality Audio Decoder Manual* dated May 18, 2000 (Ex. 2008, “*TerraTec Manual*”), for example, provides that “[t]he playlist is a pre-selected *sequence of titles* you wish the m3po to play.” (Zatkovich Decl. Ex. 2013, ¶ 63; Ex. 2008, p. 10). “In DJ mode, you can pre-select titles, *which will then be played in the sequence you selected them, basically, it is a mini-playlist* (up to 10 titles), i.e. in case you need to go and get some more drinks, or are involved in a chit-chat you wish would never end. . . . *Playback of the selected song starts automatically after the current one.*” (Zatkovich Decl. Ex. 2013, ¶63; Ex. 2008, p. 20 (emphasis added)).

Similarly, in describing the SIREN™ Jukebox, the operator’s manual (published in 2000, Ex. 2009) indicates that “Siren always performs playback using the songs and sequence displayed in the Current Playlist,” though “users can specify whether the Current Playlist is generated using the original order, or with a random order...[or] whether Current Playlist Playback occurs once, or is looped infinitely.” (Zatkovich Decl. Ex. 2013, ¶63; Ex. 2009, p. 41, 43, emphasis added). In order to playback music from a custom playlist, a user is instructed to “[s]elect the desired playlist. The *playlist’s songs are listed...Siren begins playing the first song in the list and continues through the playlist.*” (Zatkovich Decl. Ex. 2013, ¶63; Ex. 2009, p. 45 (emphasis added)).

The *Microsoft Windows Media™ Player 7 Handbook*, published October 4, 2000 (Ex. 2010, “*Microsoft Handbook*”), likewise provides that “[a] playlist is a convenient way to organize groups of audio and video files. *The term comes from the radio industry and refers to the list of songs that a disc jockey plays on a particular radio program.*” (Zatkovich Decl. Ex. 2013, ¶63; Ex. 2010, p. 49, emphasis added). The *Microsoft Handbook* also provides that selecting the “Repeat” button “repeats the playing of the entire current playlist, not specific items in a playlist. If you want to repeat only one item, create a new playlist, put only that item in it, and repeat that playlist.” (Zatkovich Decl. Ex. 2013, ¶55; Ex. 2010, p. 40, emphasis added).

a. *Items are arranged to be played in a sequence*

Each of these exemplary publications is consistent with the understanding by a person having ordinary skill in the art in 2000 that the term “playlist” denotes media items (e.g., songs) *arranged to be played in a sequence* (i.e., as a group, without having to select individual songs for playback). (Zatkovich Decl. Ex. 2013, ¶¶65-66). For example, the *TerraTec Manual* provides that “you can pre-select titles, *which will then be played in the sequence you selected them, basically, it is a mini-playlist* (up to 10 titles). . . . *Playback of the selected song starts automatically after the current one.*” (Zatkovich Decl. Ex. 2013, ¶65; Ex. 2008, p. 20, emphasis added).

In fact, the Jeffay Report cites to additional publications that further evidence that term “playlist” refers to a list referencing media items *arranged to be played in a sequence* (i.e., as a group in a continuous fashion, one after another, without having to select individual songs for playback). For example, the Jeffay Report cites to U.S. Patent No. 5,168,481 to Culbertson *et al.* (Ex. 1013, “Culberston”), which is directed to an “automated digital broadcast system which is capable of reliable operation for long periods of time without human assistance.” (Ex. 1013, 1:44-47). (*See* Ex. 1011, ¶19). “The control software reads a ‘playlist’ file which contains the sequence of selections to be played for a defined 24 hour period.” (Ex. 1013, 2:63-65.) “The system executes control software to perform the following functions. It reads from a data storage device into memory a compiled playlist of selections for a given period of time, such as 24 hours. It sends control signals, using appropriate interface hardware, to the audio playback devices to start and stop play of selections according to the playlist schedule.” (Ex. 1013, 1:52-58).

Likewise, the Jeffay Report cites to *MP3: The Definitive Guide*, by Scot Hacker, which was purportedly published in March 2000 (Ex. 1020, “Hacker”). (*See* Ex. 1011, ¶21). In Hacker’s Glossary, playlist is defined as a text file that “allows users to create *custom playback sequences*”:

Playlist

A text file referencing one or more paths to MP3 files on a system. Playlists allow users to create custom playback sequences on their hard drives without physically rearranging files. Playlists can typically be created by dragging MP3 files or directories into a player's playlist editor window, by running system queries, or by using a specialized playlist creation tool such as Helium for Windows.

Ex. 1015, p. 372.

Thus, as evidenced by the exemplary publications cited in the declaration of Ivan Zatkovich, as well as the various documents relied upon in the Jeffay Report as purportedly demonstrating the state of the art at the time of the invention, a person of ordinary skill in the art would have understood the plain and ordinary meaning of “playlist” to denote a list that references media items *arranged to be played in a sequence* (i.e., one after another as a group, without having to select individual songs for playback). (Zatkovich Decl. Ex. 2013, ¶66).

b. *A list referencing media items*

The exemplary, contemporaneous publications are also consistent with the understanding by a person having ordinary skill in the art in 2000 that the term “playlist” denotes *a list referencing media items* arranged to be played in a sequence. (Zatkovich Decl. Ex. 2013, ¶¶79-81).

For example, the *TerraTec Manual* provides that “[t]he playlist is a pre-selected sequence of titles you wish the m3po to play.” (Zatkovich Decl. Ex. 2013, ¶81; Ex. 2008, p. 10). Likewise, the *Microsoft Handbook* provides that the term “playlist” “comes from the radio industry and *refers to the list of songs* that a disc

jockey plays on a particular radio program.” (Zatkovich Decl. Ex. 2013, ¶80; Ex. 2010, p. 49, emphasis added).

As evidenced by these publications, a PHOSITA would have understood the plain and ordinary meaning of “playlist” to denote a *list referencing media items* arranged to be played in a sequence. (Zatkovich Decl. Ex. 2012, ¶79).

2. The specification of the ‘952 Patent uses “playlist” consistent with its plain and ordinary meaning

The ‘952 Patent uses the term “playlist” to refer to a list of media items arranged to be played in a sequence consistent with its plain and ordinary meaning to one of ordinary skill in the art. (Zatkovich Decl. Ex. 2012, ¶¶ 60, 65, 74).

a. Items are arranged to be played in a sequence

The ‘652 Patent uses the term “playlist” to refer to a list referencing media items *arranged to be played in a sequence* consistent with its plain and ordinary meaning. (Zatkovich Decl. Ex. 2013, ¶¶68-72). The ‘652 Patent provides, for example, that a “playlist” will typically start at the beginning of a list and not stop playing until it “runs out of songs to play.” (Zatkovich Decl. Ex. 2013, ¶¶68-69; Ex. 1001, 24:31-43). That is, playing of items in a playlist occurs in a sequence and does not require a user to manually select the next song to play when the current song ends. (Zatkovich Decl. Ex. 2013, ¶69). That the ‘652 Patent additionally indicates that a user can repeat or skip songs indicated by the playlist, shuffle the order of songs indicated by the playlist, or repeat playback of the

playlist (*see, e.g.*, Ex. 1001, 24:31-43) is also fully consistent with the PHOSITA's understanding that the playback of songs indicated by a playlist can be manipulated, as evidenced by the exemplary contemporaneous publications. (Zatkovich Decl. Ex. 2013, ¶¶70-71).

The Board's preliminary construction of "playlist" cites to a single portion of the '952 Patent at column 21, lines 63-65 as providing the definition of "a list of audio files." This passage of the '952 Patent, however, describes only a single aspect of a particular embodiment (i.e., playlist 1528), but neither attempts to provide a comprehensive definition of a playlist nor *negate* the fundamental characteristic that playlists (including playlist 1528) are arranged to be played in a sequence. That is, the Board's determination that its preliminary construction of "playlist" is "consistent with" certain aspects of the specification renders the construction incomplete and inconsistent with the customary meaning of the term "playlist" and with the specification of the '952 Patent, as a whole. (Zatkovich Decl. Ex. 2013, ¶72).

Accordingly, for purposes of this proceeding, the broadest reasonable interpretation of "playlist" should include an indication that the list of media items are "arranged to be played in a sequence."

b. *A list referencing media items*

The Petition's and the Jeffay Report's allegation that a playlist is "a list of audio files or URLs of where the audio files were retrieved from" or from where the audio files *can be* downloaded (*see* Ex. 1011, ¶¶28-29) is inaccurate and was not adopted by the Board.

The construction of "a list of audio files or URLs..." applied by the Petition suggests that a "playlist" within the broadest reasonable interpretation is "a list of audio files or a list of URLs of where audio files are retrieved from." On its face, this interpretation mischaracterizes the passage of the '952 Patent that was apparently relied upon, which explicitly indicates that "[e]ach network enabled audio device 1510 has a storage space 1512 for a playlist 1528, which is a list of audio files and associated URL's of where the audio files were retrieved from." (Ex. 1001, 21:62-65, emphasis added). (*See* Zatkovich Decl. Ex. 2013, ¶77).

Indeed, as discussed in detail below, the Petition's and the Jeffay Report's reliance on a construction utilizing the disjunctive "or" (as opposed to the conjunctive "and") renders the Petition fatally defective because the Petition's indefinite mapping of the claims to the alleged prior art fails to put forth any evidence of "how the construed claim is unpatentable under the statutory grounds" for failing to "specify where each element of the claim is found in the prior art patents or printed publications relied upon," as required under 37 C.F.R. § 42.104.

Moreover, a person having ordinary skill in the art would understand that a playlist need not include URLs and that a list of URLs alone is not a playlist within the meaning of the ‘952 Patent. (Zatkovich Decl. Ex. 2013, ¶78). The passage of the ‘952 Patent upon which the Petition’s proposed construction is based describes only a single embodiment of a playlist (i.e., playlist 1528) being appended to include URLs. This passage is not, however, a characterization of every playlist described in the ‘952 Patent or an attempt to define a playlist as necessarily including a URL. Indeed, the ‘952 Patent specifically contemplates an embodiment in which the playlist is assigned to a device, and only thereafter, is a location or source from which a song identified in the playlist obtained. (Zatkovich Decl. Ex. 2013, ¶90; Ex. 1001, 4:50-5:3, 28:11-43, and Figure 19B).

What is common among the playlists described in the ‘952 Patent—and is consistent with the meaning of the term to one of ordinary skill in the art—is that each playlist of the ‘952 Patent contains *a list referencing the media items to be played* (in a sequence). (Zatkovich Decl. Ex. 2013, ¶85).

Indeed, the ‘952 Patent indicates that three distinct pieces of information are received or obtained by the electronic device in order to play songs indicated by an assigned playlist: i) a playlist identifying a plurality of media items (e.g., by song title); ii) information enabling the electronic device to obtain the media items (e.g., a location or source from which a song identified in a playlist may be obtained);

and iii) the media items themselves (e.g., an audio file to be streamed or downloaded). (Zatkovich Decl. Ex. 2013, ¶¶32,87).

The words of claims 1 and 9 track this central feature of the ‘952 Patent and evidence the meaning of the term playlist as would be understood by a person skilled in the art in light of the ‘952—both through the explicit recitation of both receiving a “playlist *identifying* a plurality of songs” and receiving or providing “information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source.” (Zatkovich Decl. Ex. 2013, ¶87). That is, the challenged claims on their face distinguish between the playlist (e.g., identifying a plurality of songs by title), information enabling the electronic device to obtain the song (e.g., URLs), and the song itself. (Zatkovich Decl. Ex. 2013, ¶87).

Indeed, it is key for the ‘952 Patent that a playlist *identify* the songs (e.g., by title) such that the user can assign, compose, and/or manipulate the playlists and the songs contained therein. (Zatkovich Decl. Ex. 2013, ¶¶36,88; Ex. 1001, 4:29-30 (“The play lists include titles of audio from a variety of audio sources.”), 4:54-55 (“Next, the process provides a first software module to manage playlists of songs. The software module allows a user to compose playlists from a variety of audio sources.”), and 22:48-50 (“Within the playlist, the URL’s indicate the

location from which the audio files associated with the song titles in the playlist can be downloaded.”)).

As such, claims 1 and 9 of the ‘952 Patent and the various embodiments described within the ‘952 Patent specification consistently distinguish between the information identifying a song (e.g., song titles) as part of a “playlist,” whereas information for obtaining the song (e.g., URLs) is distinct from a playlist and can be obtained independently therefrom. (Zatkovich Decl. Ex. 2013, ¶¶34-39, 88-91).

Accordingly, for purposes of this proceeding, the broadest reasonable interpretation of “playlist” should be in accordance with its customary meaning and include an indication that a playlist is “a list referencing media items” arranged to be played in a sequence.

D. Construction Of “Assigned To The Electronic Device”

In the Preliminary Response, Patent Owner submitted that the broadest reasonable interpretation of a playlist “assigned to the electronic device” from the vantage point of one of ordinary skill in the art at the time of the invention of the ‘652 Patent is a playlist (as defined above) that is “directed to the electronic device,” while the Petitioner indicated that the Board’s preliminary construction for this term from the ‘594 IPR should apply to the instant proceedings.

In its Institution Decision, the Board determined that express construction of this phrase was not required and that the ordinary and customary meaning should

apply. For purposes of these proceedings, Patent Owner defers to the Board's determination to not expressly construe the phrase "assigned to the electronic device." Patent Owner nonetheless reserves its right to present evidence as to the proper construction of the term in any other proceeding before the Board or other tribunal.

V. BERMAN DOES NOT ANTICIPATE CLAIMS 9, 10, AND 14

The Petition fails to demonstrate by a preponderance of the evidence the anticipation of claims 9, 10, and 14 by Berman.

A. Neither The Petition Nor The Jeffay Report Apply A Proper Claim Construction To The Anticipation Analysis

First, as discussed above (*supra* II), anticipation under § 102 is a two-step inquiry, which first requires a proper construction of the claims and then a "comparison of the *properly construed claim* to the prior art." *Medichem*, 353 F.3d at 933 (emphasis added). Because the totality of the Petition's and the Jeffay Report's analysis of claim 9 with respect to Berman is premised on an improper claim construction, the Petitioner cannot meet its burden of proving unpatentability of the challenged claims in its Petition. *See Microsoft Corp.*, IPR2012-00026, Paper No. 17 at 21, 24 and *ZTE Corporation*, IPR2013-00139, Paper No. 15 at 27 ("Because ZTE's analysis of what is covered by the six means-plus-function elements recited in independent claim 1 within the 'repository' is incorrect, *ZTE has not properly applied those elements onto the disclosure of EP '139*).

Accordingly, for that reason alone, ZTE has not demonstrated a reasonable likelihood that it would prevail with respect to claims 1-4, 8-11, and 14-17.”).

Thus, if the Board ultimately finds that the Petition applied the wrong claim construction, the Board’s only option is to find the claims not unpatentable, as the Petitioner will have provided no analysis or evidence in its Petition to show by a preponderance of the evidence that the claims are anticipated or obvious under a proper claim construction.

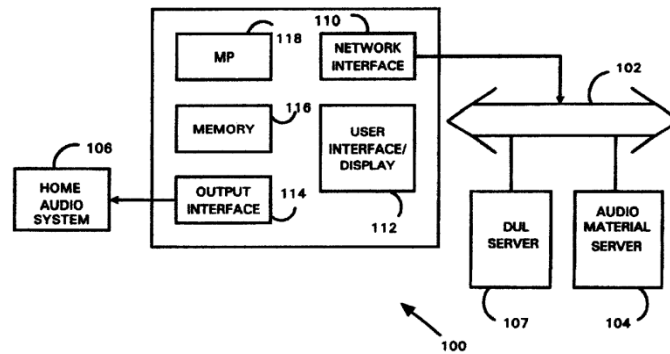
B. Legal Standard Of Anticipation

To anticipate, “[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed.Cir.1991). “[T]he reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art.” *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1473 (Fed. Cir. 1997); MPEP § 2131 (8th Ed., Rev. 9, August 2012).

C. Summary Of Berman

U.S. Patent No. 6,502,194 of Berman et al. (“Berman”), entitled “System for Playback of Network Audio Material on Demand,” discloses a system for on-demand playback of audio material on a playback apparatus that “retrieves audio

data from a remote server and plays them back in real time, using a home audio system, *in response to user selection.*” (Ex. 1003, Abstract (emphasis added)).



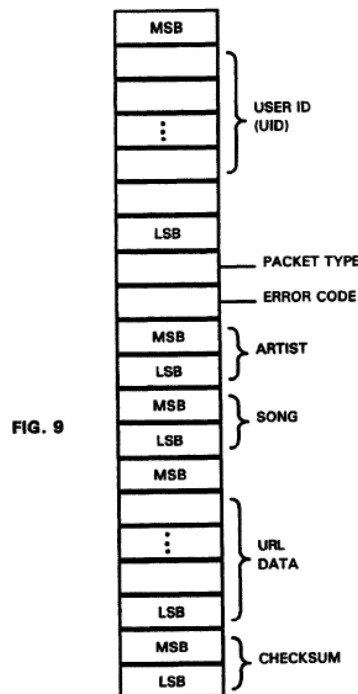
As shown in Figure 1 of Berman, the system includes one or more audio material servers (104) that aggregate digital audio material and a directory and user list (“DUL”) server (107) that provides the “[a]ccess to the audio material and authority for distribution rights.” (Ex. 1003, 4:47-64; *see also* Zatkovich Decl. Ex. 2013, ¶97). The DUL server acts as a ‘gatekeeper’ to maintain a catalog of all available songs contained on the audio material server(s) to which a user has rights. This catalog is known as a “Song List.” (*See* Ex. 1003, 7:4-13; *see also* Zatkovich Decl. Ex. 2013, ¶97). The system of Berman also includes a playback unit (100) that retrieves selected songs from the audio material server (104) for playback and maintains its own copy of the Song List. (*see* Ex. 1003, FIG. 4 and 7:35-38; *see also* Zatkovich Decl. Ex. 2013, ¶97).

Importantly, it is the *playback unit* (100) that Petitioner equates with the “electronic device” recited in the challenged claims. (*See* Paper 1, p. 24).

Accordingly, it is Petitioner's burden is to show that each and every method step of the challenged claims is performed by playback unit (100).

With reference to Figure 3 of Berman, when the playback unit (100) is powered on, the DUL server (107) synchronizes its Song List with the Song List maintained on the playback unit (100). (Ex. 1003, 6:55-57; *see also* Zatkovich Decl. Ex. 2013, ¶98). Thereafter, at step 302, the user selects a music category or type of song desired for playback (by Artist, Title, etc.) on the playback unit (100), and the playback unit (100) sends the "version number" of the playback unit's Song List to the DUL server in step 304 to confirm that the playback unit has the latest version of the Song List (steps 306 and 308). (Ex. 1003, 9:67-10:2 ("The next two bytes comprise a song list version field that provides the version number of the song list currently stored in the memory of the playback unit"); *see also* Zatkovich Decl. Ex. 2013, ¶99). Upon verification of the user's access rights, the user can then select which song they wish to play (step 310). (*see* Ex. 1003, 7:21-30; *see also* Zatkovich Decl. Ex. 2013, ¶100). The playback unit (100) then requests the URL of the selected song from the DUL server in step 312, and the DUL server (107) sends the URL of the selected song back to the playback unit (100) in step 314. (Ex. 1003, 7:30-37 and Figure 7; *see also* Zatkovich Decl. Ex. 2013, ¶100).

With reference to Figure 9, which is reproduced below, Berman discloses that the data packet sent from the DUL server contains the URL for a *single*, selected song. (Ex. 1003, 9:49-51; *see also* Ex. 1003, 10:52-6:5 and Ex. Zatkovich Decl. Ex. 2013, ¶100). That is, in order to playback a selected song, the DUL server receives a request for a single song (or a portion thereof) (as shown in Figure 7) and responds with a single URL for that selected song (as shown in Figure 9). (*See* Zatkovich Decl. Ex. 2013, ¶100).



With reference now to Figure 4, Berman indicates that “[o]nce the song URL is received, the playback unit initiates communication with the appropriate audio material server to request the song from the appropriate directory.” (Ex. 1003, 7:41-44; *see also* Zatkovich Decl. Ex. 2013, ¶101). Upon confirming that

the user is authorized to receive the requested audio material, in step 412, “the audio material server transmits the audio material (comprising a sound file or streaming audio information) to the playback unit” (Ex. 1003, 8:27-34; *see also* Zatkovich Decl. Ex. 2013, ¶101).

Figure 5 of Berman depicts the processing steps performed by the playback unit (100) during operation. (Ex. 1003, 8:46-50). Berman discloses that a song is played on the playback unit (100) *only when the user initiates a “New Track” event for each song that a user wishes to play:*

The detection of a user action at the user interface and display is represented by the first FIG. 5 flow diagram box numbered 502, which indicates that the processor detects a ‘New Track’ event. ***A ‘New Track’ event is defined to be a user action such as selection of the Play button, Skip Track button, or other button such as ‘Jump Track’ or ‘Change Disk’ or the like.*** Upon receipt of a ‘New Track’ event, the microprocessor determines the system operating mode, which may comprise either a normal mode, random mode, or custom mode. This step is represented by the flow diagram box numbered 504.

(Ex. 1003, 8:63-9:15 (emphasis added)).

As shown in Figure 5, once the track begins streaming, the processor then returns to step 501 to perform any “housekeeping chores” and then step 502 to

determine if a “New Track” event has been detected. (Zatkovich Decl. Ex. 2013, ¶103).

D. Berman Does Not Anticipate Claim 9, 10, Or 14

In its claim chart, the Petition alleges that the Song List provided by the DUL server of Berman meets the recitation of a “playlist,” as recited in claim 9:

Berman discloses receiving, at a playback unit (electronic device), a song list (playlist) assigned to the playback unit, the song list identifying a plurality of songs, wherein ones of the plurality of songs are not stored on the playback unit.

A playback unit is connected through a network to an audio material server as well as a directory and user list (“DUL”) server. Berman, 4:47-5:4 and Fig. 1. The DUL server provides an updated song list to the playback unit. Berman, 7:14-19 and Fig. 3. The playback unit 100 receives a song list from the DUL server 107. *See, e.g.*, Berman, Fig. 3, step 308 (“DUL SENDS UPDATED SONG LIST TO PLAYBACK UNIT”); *see also* Berman, Fig. 8, 10:23-30 (“**confirm that the updated song list information was sent to and received by the correct playback unit.**”) (emphasis added).

(Paper 1, pp. 24-25 (emphasis original)).

That is, the Petition relies on step 308 (“DUL SENDS UPDATED SONG LIST TO PLAYBACK UNIT”) of Figure 3 of Berman as meeting the recitations of “receiving, at an electronic device, a playlist assigned to the electronic device.”

Berman's Song List, however, is not "a list referencing media items arranged to played in a sequence," under the proper construction of playlist. (Zatkovich Decl. Ex. 2013, ¶108). Dr. Jeffay conceded this during cross-examination:

Q. Is [the Song List] a list in which media items or songs are arranged to be played in the sequence?

MS. REISTER: Objection. Form. Scope. Relevance.

A. **I don't believe that Berman discloses that they're arranged to be played in a sequence.**

(Jeffay Tr. Ex. 2014, at 56:21-62:24 (emphasis added)).

Indeed, the Song List of Berman is not even a list of songs to be played, much less a list of songs arranged to be played in a sequence, as one of ordinary skill in the art would understand the term "playlist" to require in light of the '952 Patent. Rather, the Song List of Berman is merely a catalog of all available songs to which the user has rights. (See Zatkovich Decl. Ex. 2013, ¶108). That is, the Song List only identifies those songs for which the user has *authorization for playback*. (Zatkovich Decl. Ex. 2013, ¶108).

To a person of ordinary skill in the art at the time of the invention of the '952 Patent, a playlist was distinct in name and function from other types of media lists. (See Zatkovich Decl. Ex. 2013, ¶67). For example, though an online music store could offer a "catalog" of songs from which songs could be purchased and

played, unless the songs identified in the list were provided for playback one after another in a sequence, the list would not be considered a playlist by a person having ordinary skill in the art. (See Zatkovich Decl. Ex. 2013, ¶67). As summarized above, the ‘952 Patent highlights the role of the playlist (as opposed to the audio content itself) in the operation of a network-enabled electronic device. (See Zatkovich Decl. Ex. 2013, ¶31). Specifically, the ‘952 Patent provides that the *receipt of an assigned playlist* by a network-enabled electronic device allows the playlist-receiving device to obtain and play the audio content indicated by the playlist. (See Zatkovich Decl. Ex. 2013, ¶31). The central nature of the playlist to the ‘952 Patent is reflected in claim 9, which on its face indicates that three distinct pieces of information are received or obtained by the electronic device in order to the play the songs indicated by a playlist assigned thereto: a playlist identifying a plurality of media items; information enabling the electronic device to obtain the media items; and the media items themselves. (See Zatkovich Decl. Ex. 2013, ¶¶85-86).

Berman does not disclose or suggest such a method that includes receiving a playlist assigned to an electronic device to enable the device to obtain and playback the music indicated thereby. Rather, the only audio material that is played by the playback unit of Berman is *selected on the playback unit itself*, and the listing of such audio material remains on the playback unit (100). (See

Zatkovich Decl. Ex. 2013, ¶115). At no time does the playback unit ever receive a playlist or any other list of selected songs for playback from the servers. (See Zatkovich Decl. Ex. 2013, ¶116). Indeed, because Berman indicates that the playback unit requests URLs from the audio material server (104) only one song at a time, the servers would have no knowledge of the plurality of songs selected for playback by the playback unit and thus could not provide an assignment of such songs identified by the user at the playback unit. (See Ex. 2007, ¶¶112,116).

This is clear because *only after* the Song List (or catalog) is updated in step 308, *can the user actually select* one or more songs for playback on the playback unit (100) (step 310). (Zatkovich Decl. Ex. 2013, ¶109). The Song List does not therefore identify songs *to be played* by the playback unit (100), sequentially or otherwise, but merely represents a list of possible songs from which a user can select. (Zatkovich Decl. Ex. 2013, ¶109). In fact, until the user makes a particular selection at the playback unit (100), there can be no list of items arranged for playback.

The Petition fails to identify with particularity any other element in Berman that purportedly meets the recitation of “receiving a playlist assigned to the electronic device” as required under 37 C.F.R. 42.104(b). As such, the Petition’s mere identification of step 308 in Figure 3 (“DUL SENDS UPDATED SONG

LIST TO PLAYBACK UNIT”) cannot represent the step of receiving a playlist assigned to the electronic device as recited in claim 9.

Thus, not only is the Petition deficient for failing to establish by a preponderance of the evidence that the playback unit receives a playlist as discussed above, but there is no indication in Berman of any list received at the playback unit (100) referencing media items *arranged to be played in a sequence*.

Accordingly, Patent Owner respectfully requests that the Board confirm the patentability of claim 9 with respect to Berman. The material distinctions discussed above between claim 9 and Berman apply equally to dependent claims 10 and 14. Since the dependent claims are missing at least the material limitations of the claim from which they depend, for the same reasons, Berman also does not detract from the patentability of claims 10 and 14.

VI. BERMAN DOES NOT RENDER OBVIOUS CLAIMS 1-3

The Petition fails to demonstrate by a preponderance of the evidence that claims 1-3 are obvious over Berman.

A. Neither The Petition Nor The Jeffay Report Apply A Proper Claim Construction To The Obviousness Analysis Over Berman

First, as discussed above (*supra* II), obviousness under § 103 is a two-step inquiry, which first requires a proper construction of the claims and then a “comparison of the *properly construed claim* to the prior art.” *Medichem*, 353

F.3d at 933 (emphasis added). The Petition and the Jeffay Report have failed, however, to put forth any analysis using the construction adopted by the Board in the Institution Decision. Without the required “comparison of the properly construed claim to the prior art” in the Petition, the Board cannot determine that Petitioner satisfied its burden without impermissibly substituting its own analysis for the Petitioner’s. *See CallCopy*, IPR2013-00486, Paper No. 11 at 10.

Thus, if the Board ultimately finds that the Petition applied the wrong claim construction, the Board’s only option is to find the claims not unpatentable, as the Petitioner will have provided no analysis or evidence in its Petition to show by a preponderance of the evidence that the claims are anticipated or obvious under a proper claim construction.

B. Legal Standard Of Obviousness

In any obviousness analysis, the following *Graham* factors must be considered: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406–407 (2007) (noting that these four factors “continue to define the inquiry that controls”). Although obviousness is a question of law, it is premised on the underlying factual

determinations regarding the four factors noted above. *Graham*, 383 U.S. at 17; *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009).

“Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)); MPEP § 2141 (8th Ed., Rev. 9, August 2012). “Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.* (citing *KSR*, 550 U.S. at 421). In *KSR*, the Supreme Court explained that it is important to identify a reason that would have prompted a person of ordinary skill to combine the prior art elements in the way claimed in the challenged patent. 550 U.S. at 418-19.

Importantly, the Federal Circuit warns that “[c]are must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’” *In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011) (quoting *Grain Processing Corp. v. American-Maize Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988)); *see also KSR*, 550 U.S. at 421 (“A factfinder should be aware...of the distortion caused by hindsight bias and must be cautious

of arguments reliant upon ex post reasoning.”). To that end, “[a] reason for combining disparate prior art references is a critical component of an obviousness analysis; ‘this analysis should be made explicit.’” *InTouch Tech., Inc. v. VGO Comm’s, Inc.*, 2014 U.S. App. LEXIS 8745, *58 (citing *KSR*, 550 U.S. at 418).

Consistent with the Federal Circuit, the Board has also held in numerous orders denying institution that “a petitioner must show some *reason* why a person of ordinary skill in the art would have thought to combine *particular* available elements of knowledge, as evidenced by the prior art, to reach the claimed invention.” *In Heart Failure Techs., LLC v. CardioKinetix, Inc.*, IPR2013-00183, Paper No. 12 at 9 (July 31, 2013) (emphasis in original), (citing *KSR*, 550 U.S. at 418); *see also Motorola Mobility LLC, et al. v. Arendi S.A.R.L.*, IPR2014-00203, Paper No. 10 at 15-16 (June 5, 2014) (denying institution in part because Petitioner “has not provided a reason why a person of ordinary skill in the art would modify the combination to arrive at the claimed invention”); *Wowza Media Systems, LLC et al. v. Adobe Systems Inc.*, IPR2013-00054, Paper No. 12 at 15 (denying institution of IPR, finding that Petitioner offered “no convincing rationale, in light of the teaching of the prior art, with respect to why one of ordinary skill in the art would have chosen [to arrive at the claimed invention]”). Thus, an analysis of obviousness requires a showing of some reason for why a person of ordinary skill in the art in the relevant time frame would have combined the prior art elements.

C. Berman Does Not Render Obvious Claims 1-3

The information presented in the Petition fails to establish that Berman discloses “providing the playlist to the electronic device,” under the proper claim construction of “playlist” set forth herein. As discussed above with respect to claim 9, the Petition again alleges that the updated Song List provided by the DUL server of Berman represents the recited playlist:

Berman discloses providing the song list (playlist) to the playback unit (electronic device).

The playback unit 100 receives a song list from the DUL server 107. *See, e.g.,* Berman, Fig. 3, step 308 (“**DUL SENDS UPDATED SONG LIST TO PLAYBACK UNIT**”) (emphasis added).

(Paper 1, pp. 30 (emphasis original)).

The reasoning provided above with regard to Berman’s failure to disclose or suggest that a playlist is received by an electronic device as recited in claim 9 applies with equal force to establish the deficiencies of the Petitioner’s arguments regarding claim 1.

Simply, the playback unit (100) does not receive a “playlist” from the DUL server (107) because the DUL server (107) does not provide a “playlist.”

(Zatkovich Decl. Ex. 2013, ¶¶108,117). Rather, the Song List of Berman that is updated by the DUL server (107) is a catalog of all available songs to which the user has rights such that the Song List merely identifies those songs for which the

user has *authorization for playback*. (Zatkovich Decl. Ex. 2013, ¶¶107-108). The Song List of Berman is not, however, a list of songs arranged to be played in a sequence, as one of ordinary skill in the art would understand the term “playlist.” (Zatkovich Decl. Ex. 2013, ¶107).

In fact, the only audio material that is played by the playback unit of Berman is *selected on the playback unit itself*, and the listing of such audio material remains on the playback unit (100). (Zatkovich Decl. Ex. 2013, ¶115). At no time does the DUL server (107) provide a playlist or any other list of selected songs for playback. (See Zatkovich Decl. Ex. 2013, ¶116). Petitioner does not, and cannot, identify any other element in Berman that purportedly meets the recitation of “providing a playlist to the electronic device” as required under 37 C.F.R. 42.104(b).

Accordingly, Patent Owner respectfully requests that the Board confirm the patentability of claim 1 with respect to Berman. The material distinctions discussed above between claim 1 and Berman apply equally to claims 2 and 3, which depend from claim 1.

VII. LOGAN DOES NOT RENDER OBVIOUS THE CHALLENGED CLAIMS

The Petition fails to demonstrate by a preponderance of the evidence that claims 1-3, 9-11, and 14 are obvious over Logan.

A. Neither The Petition Nor The Jeffay Report Apply A Proper Claim Construction To The Obviousness Analysis Over Logan

As discussed above (*supra* II), the Petition and the Jeffay Report have failed to put forth any obviousness analysis using the construction adopted by the Board in the Institution Decision. Without the required “comparison of the properly construed claim to the prior art” in the Petition, the Board cannot determine that Petitioner satisfies its burden without impermissibly substituting its own analysis for the Petitioner’s. *See CallCopy*, IPR2013-00486, Paper No. 11 at 10.

Thus, if the Board ultimately finds that the Petition applied the wrong claim construction, the Board’s only option is to find the claims not unpatentable, as the Petitioner will have provided no analysis or evidence in its Petition to show by a preponderance of the evidence that the claims are anticipated or obvious under a proper claim construction.

B. Summary Of Logan

U.S. Patent No. 6,199,076 of Logan *et al.* (“Logan”) is entitled “Audio Program Player Including a Dynamic Program Selection Controller,” and is directed to a system in which conventional Internet radio programs are organized by subject and topic (with a preceding announcement of the subject and/or topic during playback) “to allow the listener to dynamically and interactively locate and select desired programming from the available collection in an easy and intuitive way without the need for a visual display screen.” (Ex. 1004, 1:59-2:3; Zatkovich

Decl. Ex. 2013, ¶¶118,130). Prior to the introduction of Internet radio, Logan discloses that “[t]he three dominant commercial systems for providing audio programming to a listeners are broadcast radio systems, cassette tape playback systems and compact disk playback systems.” (Ex. 1004, 1:12-15; Zatkovich Decl. Ex. 2013, ¶¶118,119). Logan discloses that each of these suffers from distinct disadvantages relative to the “richly diverse” selection of audio programs available to users of Internet radio, including real-time playback of specialized information not offered by conventional broadcast media. (Ex. 1004, 1:50-59; Zatkovich Decl. Ex. 2013, ¶120).

Logan thus discloses an Internet radio audio program content distribution system in which “a host system organizes and transmits program segments” to a player device. (Ex. 1004, Abstract; Zatkovich Decl. Ex. 2013, ¶122). The host system also transmits a schedule for playing the program segments to the player device. (Ex. 1004, 2:47-50; Zatkovich Decl. Ex. 2013, ¶122). Specifically, the host server (101) assembles and provides to the player device (103) a “download compilation file 145” that includes a schedule file of the program segments to be played. (Ex. 1004, 6:51-7:20; Zatkovich Decl. Ex. 2013, ¶122). The schedule file consists of 32-bit program segment identification numbers (“ProgramIDs”), which can be compiled into a sequencing or selections file that contains detailed information about the sequence of events which can occur during playback. (Ex.

1004, 12:3-10; Zatkovich Decl. Ex. 2013, ¶122). The schedule file containing ProgramIDs is simply a list of “numbers” or “key value[s].” (*See* Ex. 1004, 12:5-7, 17:10-13, and 17:54; Zatkovich Decl. Ex. 2013, ¶139).

As described with reference to Figure 1 of Logan, the contents of the compilation file (145) of the host server (101) are “placed in a predetermined FTP download file directory and assigned a filename known to the player 103” to allow the player device (103) to access the program schedule and program segments. (Ex. 1004, 6:53-55). The predetermined FTP download file directory is also used to provide the content to the user’s device: “download file or files containing programming and advertising segments as well as subscriber specific data are . . . moved from storage unit 145 utilizing the FTP server.” (Ex. 1004, 8:29-33). The “host assembles program schedules” (Ex. 1004, 9:14) and “the server . . . compiles one or more files for downloading to the subscriber at step 207 which include programming and advertising segments” (Ex. 1004, 8:20-23). (Zatkovich Decl. Ex. 2013, ¶123).

In order to “allow the listener to dynamically and interactively locate and select desired programming from the available collection in an easy and intuitive way without the need for a visual display screen and using only simple selection controls” (Ex. 1004, 1:64-2:3), “[t]he host organizes the program segments by subject matter and creates the scheduled programming in accordance with

preferences of each subscriber.” (Ex. 1004, Abstract; Zatkovich Decl. Ex. 2013, ¶124). Specifically, Logan discloses:

Each given program segment is preferably preceded by a topic description segment, and the program skipping mechanism is [*sic*] the player is preferably adapted to automatically skip to the next topic description, bypassing the intervening program content, whenever a skip command is receive when a topic description is being played. Similarly, **related topics (program segments) are sequentially grouped together by subject category**, and a subject description program segment advantageously precedes each subject collection.

(Ex. 1004, 2:62-3:4 (emphasis added)).

Like the topic announcements that provide the ability to skim topics (program segments), each “subject” begins with or is preceded by a spoken announcement of the subject such that the user can skip from subject announcement to subject announcement to locate a particular subject of interest. (Ex. 1004, 29:49-57; Zatkovich Decl. Ex. 2013, ¶124). “In this way, the listener can rapidly skim through subject categories, one at a time, until a desired subject is reached, and then allow the player to play topic descriptions one at a time until a desired topic (program segment) is reached.” (Ex. 1004, 3:8-11 and 15:21-42). For example, Logan provides that the “program compilation for a given subscriber might illustratively consist of seven subjects: world news, national news, local news, computer trade news, email and voice mail messages, country music,

classical music. . . .” (Ex. 1004, 30:31-35; *see also* Zatkovich Decl. Ex. 2013, ¶125). “If a given program compilation as defined by the Selections file (having the format illustrated at 351 in FIG. 5) contains one hour of programming divided into 8 different subjects collections, the user can quickly locate a subject of interest by skipping from subject announcement to subject announcement until a subject of interest is announced, at which time the player is allowed to proceed to the next level in the hierarchy, a ‘topic’ announcement for the first program segment in that subject collection.” (Ex. 1004, 29:58-67).

C. Logan Does Not Render Obvious Claims 1-3, 9-11, Or 14

Logan does not render obvious any of the challenged claims, as there is no teaching in Logan of “providing to” or “receiving at” an electronic device a playlist *identifying a plurality of songs*, as recited in claims 1 and 9, respectively. Moreover, the Petition has failed to provide sufficient reasons why a person of ordinary skill in the art would have modified Logan to arrive at the claimed invention.

1. Logan’s ProgramID does not identify a song

Logan does not disclose providing a playlist to an electronic device or receiving at an electronic device a playlist assigned to the electronic device, the playlist *identifying* a plurality of songs, because the ProgramIDs in the schedule file of Logan do not identify a song. (Zatkovich Decl. Ex. 2013, ¶¶139-141).

As noted above, one of the more significant innovations disclosed in the ‘952 Patent was the role of the playlist in content distribution systems. (Zatkovich Decl. Ex. 2013, ¶138). Specifically, the ‘952 Patent provides that receipt of a centrally-managed playlist by an electronic device allows the receiving device to obtain audio content of the songs indicated in the playlist from one or more remote sources and to play the songs identified by the playlist. (Ex. 1001, Figures 19B-19C and 27:47-30:18). The ‘952 Patent describes playlists made up entirely of a plurality of songs, and it is key that a playlist *identify* the songs (e.g., “the playlists include ***titles of audio*** from a variety of audio sources by title,” Ex. 1001, 4:29-30) to the user such that the user can assign, compose, and/or manipulate the playlists and the songs contained therein. (*See also* Ex. 1001, 4:54-55 (“Next, the process provides a first software module to manage playlists of songs. The software module allows a user to compose playlists from a variety of audio sources.”)). Indeed, in every portion of the ‘952 Patent that explicitly shows the contents of a playlist, the *title* of the song is identified as being included in the playlist such that the user of the systems described in the ‘952 Patent can receive, display, edit, and delete songs therefrom. *See* Figures 17D, 17E, 17H, 18D, 18E, 18F of the ‘952 Patent. (Zatkovich Decl. Ex. 2013, ¶138).

There are no embodiments described in the ‘952 Patent in which a URL, for example, serves as information *identifying* a song. (Zatkovich Decl. Ex. 2013,

¶138). Likewise, the challenged claims of the ‘952 Patent similarly distinguish between the information for *identifying* a song and the information enabling the electronic device to obtain a song. (Zatkovich Decl. Ex. 2013, ¶138).

Rather than any information in a playlist *identifying* a song, the 32 bit program segment identification numbers (ProgramIDs) in Logan’s schedule file (at best) identify the *location* of a program segment in the FTP directory on the host. (Zatkovich Decl. Ex. 2013, ¶140). This schedule file, as a list of “numbers” or “key value[s],” (Ex. 1004, 12:5-7 and 17:54), does not even identify that a segment is a song (as opposed to a news segment, advertisement, etc.), much less identify that particular song to a user (e.g., by its title). (Zatkovich Decl. Ex. 2013, ¶140).

To the contrary, Logan uses audio clips to identify to the user of the playback device what the content of a particular program segment is, not the ProgramIDs within the schedule file. (Ex. 1004, 30:45-46, music selections “are preceded with a brief announcement identifying the musical selection which follows”), while the ProgramIDs themselves provide no indication of what songs, if any, are contained in the program assembled by the host until he/she listens to it. (Zatkovich Decl. Ex. 2013, ¶141).

In light of the above, the Board should confirm the patentability of claims 1 and 9 (and claims which depend therefrom) at least because the Petition has failed to demonstrate that Logan discloses providing a playlist to an electronic device or

receiving at an electronic device a playlist assigned to the electronic device, the playlist *identifying* a plurality of songs.

2. One cannot conclude that Logan’s “music selection” program segments are songs

Logan does not disclose providing a playlist to an electronic device or receiving at an electronic device a playlist assigned to the electronic device, the playlist identifying a plurality of songs. (Zatkovich Decl. Ex. 2013, ¶126).

Rather, Logan describes the Internet radio audio programs as “compressed audio files and/or text” (Ex. 1004, 4:46-47), which can include a collection of related program segments on such “subjects” as “world news, national news, local news, computer trade news, email and voice mail messages, country music, classical music. . . .” (Ex. 1004, 30:31-35; Zatkovich Decl. Ex. 2013, ¶126). As discussed above, the Internet radio system of Logan provides that each “subject” begins with a subject announcement to allow the user to skip from subject to subject until locating a subject of interest. (Ex. 1004, 30:37-42; Zatkovich Decl. Ex. 2013, ¶126). Then, the user can “proceed to the next level of hierarchy” to a “topic” announcement for the first program segment (i.e., topic) in that subject (i.e., collection of related topics). (Ex. 2013, 29:58-67; Zatkovich Decl. Ex. 2013, ¶126).

Thus, Logan provides an Internet radio audio program content distribution system in which a host system organizes and transmits Internet radio programs by

subject and topic such that a person of ordinary skill in the art would understand that the contents of a music-related program segments (i.e., topics) are genre-based “audio recording[s] of a broadcast radio program” (Ex. 1004, 40:20-22), such as an FM radio country music station broadcast, that have been recorded and stored. (Zatkovich Decl. Ex. 2013, ¶128). As explained by Petitioner’s expert during cross-examination, it is commonly understood that Internet radio audio programs are “meant to replicate the analog to analog radio in the digital—digital environment”:

Internet radio, as I use the term and I think is commonly understood is a streaming service where somebody puts content online and, typically, you know, they control the content -- they control the programming, and it's just offered as a singleton entity, either you select it or don't select it, and there's no selections typically within, and it can be either prerecorded or live, and you stream it. It's meant to replicate the analog of [*sic*] analog radio in the digital-digital environment.

(Jeffay Tr. Ex. 2014, 55:10-20).

That is, in replicating the analog-to-analog radio in the digital-digital environment of Logan, each “music selection (topic)” (i.e., program segment) could therefore contain a recording of a broadcast radio program, which itself contains talk radio, DJ intros, advertisements, as well as music. (Zatkovich Decl. Ex. 2013, ¶128).

In light of the above, the Board should confirm the patentability of claims 1 and 9 (and claims which depend therefrom) at least because the Petition has failed to demonstrate that Logan discloses providing a playlist to an electronic device or receiving at an electronic device a playlist assigned to the electronic device, the playlist identifying a plurality of songs.

3. The Jeffay Report fails to demonstrate that a person of ordinary skill in the art would modify Logan as suggested

Dr. Jeffay's above-quoted testimony regarding broadcasters' control of the content in the analog AM/FM radio setting (and its parallel replication in the digital-digital environment) likewise belies the Jeffay Report's proffered motivation to modify Logan to arrive at the claimed invention:

45. A person skilled in the art would have reason to use the "schedule file" of Logan as playlist consisting of only songs because Logan discloses that the program segments on the schedule file can include music files and the Background of the Invention includes AM/FM radio, where music-only programming was common. Ex. 1004, 1:16-18, 4:38-41, 5:13-17, 5:60-65 and 7:1-13.

(Ex. 1011, ¶45).

As discussed in the '952 Patent itself, Internet radio systems and the use of centrally-managed playlists are fundamentally different operations for obtaining audio content. (Zatkovich Decl. Ex. 2013, ¶129). For example, whereas the Internet Radio mode disclosed in the '952 Patent "allows the user to select a

preferred type of program material (e.g., Sports, Weather, News, All, etc.)” from a list of program types and then a particular Web broadcast from a list of available programs corresponding to the selected program type (Ex. 1001, 11:45-54), the playlist mode of operation of the ‘952 Patent provides that the receipt of a playlist identifying a plurality of songs enables the user to assign, compose, and/or manipulate the playlists and the songs contained therein. (Zatkovich Decl. Ex. 2013, ¶¶57, 129,138).

A person of ordinary skill in the art would appreciate that if Logan’s disclosure resembles anything within the ‘952 Patent, it is the ‘952 Patent’s Internet Radio mode, rather than the playlist mode in which a playlist is assigned to an electronic device, the playlist identifying a plurality of “songs.” (Zatkovich Decl. Ex. 2013, ¶131).

Logan is explicitly directed to a system in which conventional Internet radio programs are organized by subject and topic (with a preceding announcement of the subject and/or topic during playback) to allow a user to select a desired Internet radio audio program without a visual display. (Zatkovich Decl. Ex. 2013, ¶131). As such, it would be understood by a person of ordinary skill in the art in light of the totality of Logan’s disclosure that any reference to music files would be to “the music selections (‘topics’) within a music subject, the *contents* of the music-related program segments (i.e., topics) being “audio recording[s] of a broadcast radio

program....” (Ex. 1004, 40:20-22; Zatkovich Decl. Ex. 2013, ¶128).

Moreover, the Jeffay Report’s allegation that Logan’s reference in its background to AM/FM radio “where music-only programming was common” would not have motivated a person of ordinary skill in the art to modify Logan’s system such that the schedule file of Internet radio program segments is instead used as a playlist consisting only of songs because Logan’s system is specifically designed to utilize “audio recordings of a broadcast radio program.” (Zatkovich Decl. Ex. 2013, ¶136). That is, in view of the understanding that each “music selection” program segment already utilizes AM/FM broadcasts, there would be no further motivation provided by the knowledge of the existence of AM/FM radio to modify the schedule file of Logan, as alleged by the Jeffay Report. (Zatkovich Decl. Ex. 2013, ¶136).

Logan does not disclose that the music files are “songs” and the Jeffay Report contains no analysis of why or how the Internet radio system of Logan would collect, catalog, and provide a library of “songs” as opposed to recorded radio broadcasts. (Zatkovich Decl. Ex. 2013, ¶137). Further, as evidenced by the ‘952 Patent itself, one of ordinary skill in the art would consider an Internet radio mode of operation as fundamentally distinct from a playlist mode of operation. (Zatkovich Decl. Ex. 2013, ¶129).

In light of the above, the Board should confirm the patentability of claims 1 and 9 (and claims which depend therefrom) at least because the Petition has failed to offer any “convincing rationale” in light of Logan’s teachings to the contrary why one of ordinary skill in the art would have chosen to modify Logan to arrive at the claimed inventions.

VIII. CONCLUSION

For all the reasons above, the Board should find that Petitioner has failed to meet its burden of proving invalidity of all of the challenged claims.

Dated: February 4, 2015

Respectfully submitted,
By: /Thomas Engellenner/
Thomas Engellenner, Reg. No. 28,711
Pepper Hamilton LLP
125 High Street
19th Floor, High Street Tower
Boston, MA 02110
(617) 204-5100 (telephone)
(617) 204-5150 (facsimile)
Attorney for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on February 4, 2015, a true and accurate copy of this paper, PATENT OWNER'S RESPONSE TO THE DECISION TO INSTITUTE A TRIAL FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,045,952 and its Exhibits, were served on the following counsel for Petitioners Samsung Electronics Co., Ltd. *et al.* and Petitioners LG Electronics, Inc., *et al.*, via email:

Andrea G. Reister
Gregory S. Discher
Covington & Burling LLP

areister@cov.com
gdischer@cov.com

Dori Johnson Hines, Esq.
Jonathan R. Stroud, Esq.
Finnegan, Henderson, Far

dori.hines@finnegan.com
jonathan.stroud@finnegan.com

Dated: February 4, 2015

By: /Thomas Engellenner/
Thomas Engellenner, Reg. No. 28,711
Pepper Hamilton LLP
125 High Street
19th Floor, High Street Tower
Boston, MA 02110
(617) 204-5100 (telephone)
(617) 204-5150 (facsimile)
Attorney for Patent Owner