CONFIDENTIAL BUSINESS INFORMATION - SUBJECT TO PROTECTIVE ORDER

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C. 20436

Before the Honorable David P. Shaw
Administrative Law Judge

In the Matter of **CERTAIN DIGITAL MEDIA DEVICES, INCLUDING TELEVISIONS, BLU-RAY DISC PLAYERS, HOME THEATER SYSTEMS, TABLETS AND MOBILE PHONES, COMPONENTS THEREOF AND ASSOCIATED SOFTWARE**	**Investigation No. 337-TA-882**

REBUTTAL EXPERT REPORT OF MR. IVAN ZATKOVICH REGARDING VALIDITY OF U.S. PATENT NOS. 8,050,652, 8,045,952, and 6,618,593

[redacted]

IX. RESPONSE TO JEFFAY INVALIDITY REPORT REGARDING THE QURESHEY PATENTS

168. On November 12, 2013, Respondents and Intervenor jointly served the Expert Report of Kevin Jeffay, Ph.D. Regarding U.S. Patent Nos. 8,045,952 and 8,050,652 ("Jeffay Report"). In the Jeffay Report, Dr. Jeffay sets forth his opinions regarding the state of the art, level of ordinary skill in the art, priority dates, claim construction, and invalidity of the asserted claims of the Qureshey Patents.

169. I have reviewed the Jeffay Report, the references cited therein, and the other materials considered by Dr. Jeffay in preparing his report. The following is my response to the analysis and opinions set forth in the Jeffay Report.

A. State of the Art

170. The Jeffay Report states that as of the year 2000 a user was able to use a personal computer to manually create media playlists for local storage by the computer. (Jeffay Report ¶¶ [083]-[094].) The Jeffay Report also provides Dr. Jeffay's opinions regarding the alleged state of the art with respect to Internet radio and streaming media. (Jeffay Report ¶¶ [095]-[0103].)

171. Dr. Jeffay did not allege that this "state of the art" anticipates or renders obvious the asserted claims of the Qureshey Patents alone or in combination with any other alleged prior art, and accordingly, I understand that no response is required. In any event, in my opinion, the technologies referenced by Dr. Jeffay are at most cumulative of the prior art previously considered by the United States Patent & Trademark Office ("PTO") during the prosecution of the Qureshey Patents. This includes, for example, one or more of the *White*, *Logan*, and/or *Abecassis* patents addressed below, over which the PTO previously determined that the claims of the Qureshey Patents are novel and nonobvious.

B. Relevant Field and Level of Ordinary Skill in the Art

172. Dr. Jeffay states that "a person of ordinary skill in the art as of the effective filing dates of the '952 and '652 Patents in November of 2000 would have a Bachelor of Science degree in in [sic] electrical engineering, computer engineering, computer science, or equivalent thereof, and one to two years of experience with computer and multimedia networking. More education could substitute for experience, and that experience, especially when combined with training, could substitute for formal college education." (Jeffay Report, ¶ [0106].)

173. In my opinion, there is no material difference in our respective opinions regarding the relevant field ("media file sharing" versus "computer and multimedia networking") and the appropriate level of skill of a person having ordinary skill in the art (e.g., Bachelor of Science in electrical engineering, computer science, or equivalent with 1-2 years of experience in the relevant field).

174. However, in my opinion, Dr. Jeffay did not actually apply the above-stated level of skill in reaching his conclusions regarding invalidity.

a. Dr. Jeffay's Obviousness Combinations Require Higher Than Ordinary Skill

175. In addition to other deficiencies in Dr. Jeffay's invalidity analyses identified below, in my opinion Dr. Jeffay effectively applied a much higher level of skill in reaching his conclusions that the asserted claims of the Qureshey Patents are obvious. For example, as an alleged motivation to combine prior art references, Dr. Jeffay states:

> I am aware of no technological reason that would have prevented a person of skill in the art from combining the different technologies discussed in the prior art references, including but not limited to home networks, peer-to-peer networks, host-client networks (those with a central host), personal audio players, karaoke systems, jukeboxes, and wireless players." (Jeffay Report ¶ [0230]; underlining added.)

176. In my opinion, Dr. Jeffay's obviousness analysis applies a level of skill much closer to his own Ph.D. in computer science and experience "designing, building, analyzing, and

teaching distributed multimedia computer systems for over 10 years" in reaching his conclusions regarding invalidity. (Jeffay Report, ¶ [0106].) Not a bachelor's degree with 1-2 years of experience. In fact, the above quotation from Dr. Jeffay's report refers to "a person of skill in the art," not a person of *ordinary* skill in the art. Thus, in my opinion, Dr. Jeffay's report at most highlights what might possibly have been achieved by a person of much higher skill as of the priority date of November 8, 2000 or through extraordinary experimentation (e.g., allegedly because there was "no technological reason" for it not to work), not what would have been obvious to a person having ordinary skill in the art as of the effective date of the Qureshey Patents.

177. First, the very concepts that Dr. Jeffay relies on as alleged motivation to combine references illustrate the vast extent of inter-disciplinary knowledge that would be required to combine or modify the various techniques of shared media management described in the prior art references upon which Dr. Jeffay relies. These concepts include streaming, decompression, user interface management, and playback of media across different types of networks (e.g., home networks, peer-to-peer networks, host-client networks (with central host)) and different types of devices with different requirements and limitations (e.g., personal audio players, karaoke systems, jukeboxes, and wireless players). In my opinion, even if a person having ordinary skill in the art (Bachelor's with 1-2 years of experience) would have been generally familiar with these principles, a person of ordinary skill in the art would not have been able to modify, combine, or redesign these technologies as arbitrarily suggested by Dr. Jeffay.

178. Second, research and development into multimedia networking was still in its relatively early stages in 2000. The World Wide Web did not even exist until 1993, and the first commercial streaming application of very limited capability (CU-SeeMe) was not available until

1995. I am not aware of any University undergraduate curriculum offered in the areas of streaming, decompression, playback, etc. that taught how to meaningfully combine and apply those concepts as of 2000, and even someone with or working towards a Masters or Doctorate in Computer Science or Engineering at that time would have needed to attend a University that was conducting research into this new and emerging field. In my opinion, a person having ordinary skill in the art would not have understood how to modify or combine systems of the prior art in the manner suggested by Dr. Jeffay, nor would there have been a likelihood of success in doing so.

179. A good example of the complexity that Dr. Jeffay's purported obviousness combinations would entail, and thus the higher than ordinary skill in the art that would be required to make them, are Dr. Jeffay's opinions in view of the *Lipscomb* patent. As described in greater detail in later sections of my report, in several instances the Jeffay Report alleges that it would have been obvious to combine *Lipscomb* with another system (separately, with each of the *RealPlayer*, *Ninja Jukebox*, *Langdon*, *Logan*, and *White* systems) in order to impart to that system a real-time functionality that would allow a user's device to request supplemental information related to a song in real time while the song is playing, as defined in claim 11 of the '652 Patent.

180. In each instance, there is no discussion in the Jeffay Report regarding how the different types of networks in these systems (e.g., home networks, peer-to-peer networks, host-client networks (with central host)), or different types of devices with different requirements and limitations (e.g., personal audio players, karaoke systems, jukeboxes, and wireless players), would allegedly have been obvious to combine by a person having ordinary skill in the art or how they would be combined. The Jeffay Report simply assumes that a person having ordinary

skill in the art could do so, and would have done so because "a person of skill in the art would have understood that to the average consumer, additional features are generally considered better." (Jeffay Report, p. 91.) However, consumers' desire for omni-capable products does not mean that a person having ordinary skill in the art would have deemed it obvious to, or would have had the capability to, adapt functionality that was allegedly available on one media platform to another platform or have a reasonable likelihood of success in doing so.

181. In addition, in my opinion, adding real time functionality to a system to allow a user's computing device to request supplemental information related to a song in real time while the song is playing is not trivial. For example, *Lipscomb* upon which Dr. Jeffay relies does not disclose or suggest this feature. *Lipscomb* relates to a media library system that uses *synchronous* processing to batch download songs and other information to a local device before a user plays music or views corresponding information. The *Lipscomb* user device thus pre-downloads all available information (e.g., lyrics, notes, etc.) from a server before the user device plays any songs. The invention defined in claim 11 of the '652 Patent, on the other hand, is directed to a multi-tasking media management system that allows real-time *asynchronous* operations such as requesting supplemental information regarding a song while the song playing. An asynchronous system (also known as a multithreaded system) requires a sophisticated request and response protocol, not to mention event driven actions, and thus is much more complex than a synchronous system. In my opinion, the real-time functionality defined by claim 11 of the '652 Patent would not have been obvious to a person having ordinary skill in the art.

b. The Obviousness Combinations are Not Supported

182. The Jeffay Report also repeatedly states in footnotes and without supporting reasoning, citations, or explanation that "To the extent that it is found that an element of these

claims is not expressly disclosed by [reference], it is my opinion that these claims are nonetheless obvious to a person of ordinary skill in the art." (Jeffay Report, pp. 72-91, footnotes 3-21.) I understand that because these opinions are just conclusions without support, no response is required. In any event, as a general matter I disagree that a person having ordinary skill in the art would have found it obvious to modify the references discussed below in the manner claimed in the Qureshey Patents. The Qureshey Patents claim significant improvements over the systems described in these references, which in my opinion, would not have been obvious to person having ordinary skill in the art. For example, many of these references describe the use of a personal computer to manually create media playlists for local storage by the computer. The PTO already considered these types of systems, and determined that the inventions claimed in the Qureshey Patents are novel and nonobvious. For example, in my opinion, none of the cited references teaches or suggests an electronic device that receives a playlist assigned to the device from a central or remote system, where the playlist identifies a plurality of songs, as disclosed and claimed in the Qureshey Patents.

C. Priority Dates of the Qureshey Patents

183. Dr. Jeffay assumed that the '952 and '652 Patents are entitled to the November 8, 2000 priority date for the purposes of his analysis. (Jeffay Report, ¶ [076], "The '952 and '652 Patents share the same specification, and as explained below, I treat both patents as if they were filed on November 8, 2000."; Jeffay Report, ¶ [0104], "I have been asked to assume November 8, 2000, as the earliest effective filing date of the '952 and '652 Patents.") There is no dispute between Dr. Jeffay and me on this point.

184. As set forth on the face of the '952 Patent, the application for the '952 Patent was filed on November 27, 2006 and is a continuation of application number 09/805,470 filed on March 12, 2001, which is a continuation-in-part of application number 09/096,703 filed on June

12, 1998. On its face, the '952 Patent also claims priority to two provisional applications filed on November 8, 2000 and January 22, 1998.

185. As set forth on the face of the '652 Patent, the application for the '652 Patent was also filed on November 27, 2006 and is a continuation of application number 09/805,470 filed on March 12, 2001, which is a continuation-in-part of application number 09/096,703 filed on June 12, 1998. On its face, the '652 Patent also claims priority to the same two provisional applications filed on November 8, 2000 and January 22, 1998.

186. Based on my review, in my opinion the subject matter claimed in the asserted claims of the '952 and '652 Patents was conceived and reduced to practice at least as early as the November 8, 2000 filing date of U.S. Provisional Application No. 60/246,842 ("Provisional"). For example, the Qureshey Patents and the Provisional filed November 8, 2000 have nearly identical figures and description, including Figures 1-19C and the corresponding description in the specification, which support the subject matter of the asserted claims. In the summary of the Qureshey Patents above, parallel citations to the Qureshey Patents and to the Provisional are provided.

D. Claim Construction

187. Dr. Jeffay, for the most part, adopts the claim constructions proposed by Respondents. For the reasons set forth above, it is my opinion that the Respondents' constructions are incorrect. In any event, it is my opinion that the prior art upon which Dr. Jeffay relies does not anticipate or render obvious the asserted claims of the Qureshey Patents under any of the parties' or Staff's proposed constructions.

188. For the claim terms "Internet radio broadcast" and "Internet radio mode of operation," Dr. Jeffay purports to adopt the constructions offered by Respondents. (Jeffay Report, pp. 53-57 and 59-61.) However, in my opinion, Dr. Jeffay's treatment of these claim

terms in his analysis of the prior art indicates that he has effectively provided a new interpretation or construction for these claim terms. Dr. Jeffay now appears to allege that since Internet radio broadcasts are "streamed to listeners as a unicast" and "all publically accessible content on the Internet in 2000, as well as today, is transmitted via unicast" (Jeffay Report [0135]-[0136]), any Internet-enabled device that can access public content over the Internet inherently has an Internet radio mode of operation for receiving Internet radio broadcasts. (E.g., Jeffay Ex. 26, p. 16, "A person having ordinary skill in the art at the time of the alleged invention would understand that 'commercial service' [over the Internet] as disclosed in *Busam* constitutes an Internet radio broadcast, and that *Busam* teaches that API applications for communicating with the commercial service would constitute an Internet radio mode of operation.") I disagree. All unicast content streamed over the internet is not an "Internet radio broadcast" (e.g., the content of broadcast programming simultaneously available via traditional FM or AM radio stations). In addition, just because a device has the ability to access some content over the Internet does not mean that the device has the capability to access and play Internet radio broadcasts. For example, as explained in the Qureshey Patents, a web browser with a particular plug-in may be required in order to access and play Internet radio broadcasts. ('952 Patent, 3:42-45.)

189. Lastly, the Jeffay Report acknowledged the existence of Respondents' positions that certain claims in the Qureshey Patents are limited to a specific "order of steps" and that "Where indicated by language and syntax of claim language, order is required." (Jeffay Report, p. 42, referencing '952 claim 9 and '652 claims 1 and 42.) However, Dr. Jeffay did not provide any opinion on this issue, or provide any opinions whether the prior art references upon which he relies would meet the "order of steps" requirement if adopted by the ALJ. Accordingly, if

Respondents' proposed construction regarding the "order of steps" is adopted, in my opinion Dr. Jeffay and Respondents have not shown (nor even alleged) that the alleged prior art relied upon by Dr. Jeffay meets this requirement and thus cannot prove invalidity by clear and convincing evidence.

E. The Qureshey '652 Patent Specification Adequately Describes and Enables Claims 13 and 55

190. The Jeffay Report alleges that dependent claims 13 and 55 of the '652 Patent are invalid for lack of adequate written description in the specification of the '652 Patent and for lack of enablement. (Jeffay Report at ¶¶ [0170]-[0173].) Dr. Jeffay alleges that "a person of ordinary skill in the art would not understand how a device both 'receive[s]' and 'display[s]' a 'recommended song'" (Jeffay Report at ¶ [0172]). I disagree.

191. First, I understand that this alleged basis of invalidity was not previously raised by Respondents in this Investigation and thus is untimely.

192. Second, in my opinion, at least the '652 Patent, Figure 20C and 31:12-38, provide adequate written description for and enable the inventions claimed in claims 13 and 55 of the '652 Patent. For example, the '652 Patent specification describes that "When the user presses the menu button 1822, the 'similar' menu item is chosen and a listing of albums that are from a genre of music similar to that of the audio source or from artists that are in some way similar to the artist of the audio source is presented. If the 'similar' menu item is performed on Moby and 'Porcelain,' a list of techno songs from Moby and/or techno songs from other artists can be presented." ('652 Patent, 31:24-31.) In other words, via a graphical user interface, the user is provided with songs, or a list of songs, that relate to a previously active artist or album. In my opinion, a person having ordinary skill in the art would understand that these similar songs, or listing of similar songs, would constitute the receipt of "recommended songs" and that providing

the information or content corresponding to these songs via the graphical user interface would constitute the display of the recommended songs as claimed.

F. The Asserted Claims of the Qureshey Patents are Not Anticipated By Nor Obvious From The Cited References

1. Busam - U.S. Patent No. 8,281,001

193. The Jeffay Report alleges that the Busam patent anticipates all of the asserted claims of the '952 Patent, i.e., claims 1, 2, 3, 4, 9, 10, 11, 12, and 14, and all of the asserted claims of the '652 Patent, i.e., claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 45, 47-49, 50, 52, and 55. (Jeffay Report ¶¶ [0176]-[0177].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that the asserted claims are obvious from the Busam patent. (Jeffay Report, p. 72, footnotes 3-4.) I disagree for the reasons set forth below.

a. The Busam Patent is Not Prior Art to the Qureshey Patents

194. The Busam patent was filed on September 19, 2001 and claims priority to U.S. provisional patent application no. 60/233,741, filed on September 19, 2000. The Busam patent is Exhibit 23 to the Jeffay Report. (882PRIOR00011750-11770.) The Busam provisional application is Exhibit 24 to the Jeffay Report. (LG-ITC882-00175959-175976.)

195. As Dr. Jeffay acknowledges, the nonprovisional application for the Busam patent was filed after the November 8, 2000 priority date of the Qureshey Patents. (Jeffay Report ¶ [0174].)[1] Thus, on its face, the Busam patent is not prior art to the Qureshey Patents.

196. To prove that the Busam patent is prior art, the Jeffay Report was required to demonstrate with clear and convincing evidence that the allegedly relevant portions of the Busam patent are supported by adequate written description in the Busam provisional

application. The Jeffay Report fails to make such a showing. Accordingly, in my opinion, the Jeffay Report fails to demonstrate that the Busam patent is prior art to the Qureshey Patents.

197. The Jeffay Report concludes, without explanation, that the Busam patent is prior art to the Qureshey Patents because "it is my understanding that Busam can reach back to the filing date of the provisional application (September 19, 2000) it claims priority to because … the provisional supports the relied on disclosure in the patent issued to Busam." (Jeffay Report ¶ [0174], emphasis added.) However, the body of Dr. Jeffay's report cites only to the text of the Busam patent, not to the provisional, and does not even try to explain how the provisional supports the Busam patent. (Jeffay Report ¶ [0174]-[0177].) Similarly, the claim charts attached as Exhibits 25 and 26 to the Jeffay Report broadly cite to almost the entire Busam provisional application but do not explain how it allegedly provides an adequate written description of the cited portions of the Busam patent on which Dr. Jeffay relies. (E.g., Jeffay Exhibit 25, p. 1 and Jeffay Exhibit 26, p. 1, concluding without explanation that "*Busam* qualifies as prior art … *See, e.g.*, U.S. Provisional Patent Application No. 60/233,741 at 1-5, 7-8, Figs. 1-2.") No analysis or explanation is provided.

198. In addition, the repeated but conclusory statements in Exhibits 25 and 26 of the Jeffay Report that "At least the above-cited disclosures from Busam were contained in substance in U.S Provisional Patent Application No. 60/233,741" do not demonstrate that the Busam provisional application provides adequate written description for the Busam patent. (E.g., Jeffay Exhibit 25, pp. 6, 7, 8, 10, 12, 13, 15, etc.; Jeffay Exhibit 26, pp. 5, 12, 13, 19, 21, etc.; underlining added.) The Jeffay Report does not cite to or explain any particular "substance" of

---

[1] The Jeffay Report states incorrectly that Busam "was filed on July 4, 2002." (Jeffay Report, ¶ [0174].) The application for the Busam patent was filed on September 19, 2001. Both dates are after the November 8, 2000 priority date of the Qureshey Patents.

the Busam provisional application, much less explain how it provides adequate written description for the cited portions of the Busam patent. Moreover, even a cursory review of the Busam provisional application (3 Figures and corresponding description) reveals that it describes far less than the Busam patent (12 Figures and corresponding description). (Compare Jeffay Ex. 24 with Jeffay Ex. 23.)

199. Lastly, the repeated statements in the Jeffay Report that the "Provisional Application No. 60/233,741 provides written description for the claimed invention of Busam" are irrelevant. (E.g., Jeffay Exhibit 25, pp. 6, 7, 8, 10, 12, 13, 15, etc.; Jeffay Exhibit 26, pp. 5, 12, 13, 19, 21, etc.) The claims of the Qureshey Patents are the focus of the validity analysis, not the claims of the Busam patent. If the Busam provisional application does not contain an adequate written description of the cited portions of the Busam patent that are alleged to anticipate the asserted claims of the Qureshey Patents, the Busam patent is not prior art and cannot invalidate those claims. The Jeffay Report failed to prove that the Busam patent is prior art.

b. The Busam Patent is Not Entitled to the Priority Date of the Busam Provisional Application

200. Based on my review of the Busam provisional application, it is my opinion that the Busam provisional does not adequately describe the portions of the Busam patent cited in the Jeffay Report. Accordingly, in my opinion, the Busam patent is not prior art to the asserted claims of the Qureshey Patents and cannot invalidate those claims.

201. For example, the Jeffay Report alleges that "Busam discloses methods and systems for sharing playlists and audio files in a device-to-device network containing media player devices." (Jeffay Report ¶ [0175].) In alleged support, Dr. Jeffay's claim charts cite to portions of the Busam patent, including, for example, 1:51-54 ("an entity can transfer files,

stream files, create and use playlists …") and FIG. 9 ("FIG. 9 is a flowchart describing the process that a device uses to display a playlist"). (Jeffay Report, Ex. 25, pp. 2 and 32; Ex. 26, pp. 6 and 60.) However, the Busam provisional application does not contain an adequate written description of these cited portions. For example, nowhere does the Busam provisional application even contain the words "playlist" or "song," much less describe (in words or substance) a "playlist identifying a plurality of songs" as is required by all of the independent claims of the Qureshey Patents ('952 Patent, claims 1 and 9; '652 Patent claims 1 and 42). The Busam provisional application also does not contain an adequate written description of the above-cited portions of the Busam patent (FIG. 9 and 1:51-54) upon which Dr. Jeffay relies. The limited description in the Busam provisional application that "Content can be, but is not limited to, video, audio, pictures, and literature" (Jeffay Ex. 24, 4:21) does not disclose or suggest a "playlist identifying a plurality of songs," nor the receipt of a playlist that is assigned to the electronic device as claimed ('952 Patent claims 1 and 9, '652 Patent claims 1 and 42).

202. In my opinion, the Busam provisional application also does not contain an adequate written description of an electronic device that receives information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source, as claimed in the asserted claims of the Qureshey Patents ('952 Patent claims 1 and 9, '652 Patent claims 1 and 42). For example, the Jeffay Report cites to the Busam patent, 7:54-61, which refers to "the name of the device that the item is being stored on, and the path on that device to the item," as allegedly satisfying these claim requirements. (Jeffay Report, Ex. 25, pp. 9 and 37; Ex. 26, pp. 30 and 69.) However, there is no corresponding disclosure in the Busam provisional application, and therefore, this description in the Busam patent is not prior art to the Qureshey Patents. The limited description in the Busam provisional application that, for example, "file

movement can be permitted or restricted between devices" (Jeffay Ex. 24, 4:11) is plainly deficient because it does not disclose or suggest any of the details regarding how the electronic devices might accomplish a file transfer.

203. In addition, in my opinion, the Busam provisional application does not contain an adequate written description of the specific methods claimed in claims 2, 3, 4, 10, 11, and 12 of the '952 Patent. These claims define, for example, ways in which an electronic device can obtain, from at least one remote source, one or more songs of a playlist that is assigned to the electronic device. Claim 12 of the '952 Patent defines, for example, that if the electronic device is unable to connect to a remote source to obtain one or more songs of the playlist, a request is provided to a central server, the server uploads the songs, and the electronic device receives the songs from the central server.

204. First, the Jeffay Report does not cite to any specific portions of the Busam provisional application that allegedly disclose the elements of these claims and, accordingly, in my opinion does not demonstrate that these claims are invalid by clear and convincing evidence.

205. Second, the Busam provisional only describes a "Network Rerouting" procedure for use in transferring "messages" between devices in the specific instance when "[t]he use of network address translation can make it difficult to connect two machines with globally (but not locally) invalid IPs. An example of this is the commonly used 192.168.1* domain. In instances where machine [sic] are unable to create direct connections, the central server, which would have a globally valid IP, will act as a conduit between the two devices, forwarding messages to the proper machine." (Jeffay Ex. 24, p. 5, lines 19-24.) These references to "messages" and issues with network address translation do not disclose or suggest the specific methods claimed in the Qureshey patents for obtaining songs of a playlist assigned to an electronic device, or how that

might be accomplished. In my opinion, a person of ordinary skill in the art would not have applied this description in the Busam provisional application to the problem, recognized in the Qureshey Patents, of how to obtain songs of a playlist assigned to an electronic device. Thus, in my opinion, any reliance on the Busam provisional application for this purpose would necessarily utilize impermissible hindsight reconstruction, impermissibly using the asserted patent claims of the Qureshey Patents as a roadmap to piece together different pieces of prior art in an attempt to satisfy all of the claim elements.

206. In my opinion, the Busam provisional application also does not contain an adequate written description of at least the following claim elements of the Qureshey Patents, and again, the Jeffay Report points to none: (i) "identifying ones of the plurality of songs in the playlist that are not stored on the electronic device" ('952 Patent, claim 1); (ii) "a personal audio network server … [that] enables a user to assign the playlist to the electronic device" ('952 Patent, claim 14); (iii) "send a request to a remote source for supplemental information related to a song in real time" ('652 Patent, claim 11). Accordingly, the Busam patent is not prior art and cannot anticipate these claims.

207. In view of the foregoing, it is my opinion that the Busam provisional application does not provide an adequate written description of the cited portions of the Busam patent. Accordingly, the effective date of the Busam patent is its September 19, 2001 filing date, not the September 19, 2000 filing date of the Busam provisional application, and thus the Busam patent is not prior art to the asserted claims of the Qureshey Patents.

c. The Busam Patent Does Not Disclose or Suggest the Inventions Claimed in the Qureshey Patents

208. It is also my opinion that, irrespective of whether the subject matter of the Busam patent is adequately described in the Busam provisional application (my opinion is that it is not),

the Busam patent does not disclose the claimed invention of the Qureshey Patents. Accordingly, even assuming that the Busam patent is entitled to the September 19, 2000 priority date of the Busam provisional application, it is my opinion that the Busam patent does not anticipate or render obvious the asserted claims of the Qureshey Patents. For example, the Busam patent does not disclose or suggest the claim elements of the Qureshey Patents discussed below.

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

209. In my opinion, the Busam patent does not disclose "receiv[ing] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1). Rather, Busam refers to the use of a graphical user interface (GUI) on an electronic device to create a playlist for use on that device. (Busam patent, Figure 8 and 7:43-47, "while search results are being displayed or a list of items from a device are being displayed, the GUI [of the device] may include buttons for creating and editing playlists. If the user selects to create a playlist, the user will also need to input the name of the new playlist.") The playlist is created on the device; it is not assigned to the device as required by the claims of the Qureshey patents, which is fundamentally different.

210. The Busam patent also states that a user can use the GUI of an electronic device to manually enter "the name of the playlist" that the user wishes to access on the electronic device. (Busam patent, 7:62-67 and Figure 9.) The description in the Busam regarding Figure 9 is unclear due to a typographical error. (Busam patent, 7:62-8:2, "If the playlist is [sic] another device that the user is authorized to access, it is retrieved from that device. In step 284, the system determines whether each item on the playlist is stored on an accessible device.") Even

assuming that this description is intended to suggest that a playlist is retrieved from another device in response to the user entering the name of the playlist, and not just that a media item of the playlist is retrieved from another device, the playlist would not be assigned to the electronic device as defined by the claims of the Qureshey Patents. Rather, similar to the process shown in Figure 8 of Busam and described above, this again refers to allowing a user to input a playlist name via a GUI of a device to cause the playlist to be displayed on that device. Here, the Busam server is simply a search tool. It does not teach or suggest a central element and benefit of the Qureshey Patents, including a central or remote system for managing personal playlists that causes playlists to be assigned to specific user devices, such as when a user device logs into a personal account.

211. In my opinion, for at least the foregoing reasons that the Busam patent does not disclose or suggest assigning a playlist to an electronic device, the Busam patent also does not disclose or suggest: (i) the specific methods for obtaining from a remote source the ones of the plurality of songs of the playlist assigned to the electronic device ('952 Patent, claims 2, 3, 4, 10, 11, and 12); and (ii) "a personal audio network server … [that] enables a user to assign the playlist to the electronic device" ('952 Patent, claim 14).

(2) identifying ones of the plurality of songs in the playlist that are not stored on the electronic device

212. In my opinion, the Busam patent also does not disclose "identifying ones of the plurality of songs in the playlist that are not stored on the electronic device" ('952 Patent, claim 1). The Jeffay Report cites to the Busam patent, 7:65-8:5, as allegedly showing this feature ("the system determines whether each item on the playlist is stored on an accessible device. Each item on the playlist that is on an accessible device is then reported using the GUI."). (Jeffay Ex. 25, p. 7.) However, this only refers to determining whether or not *other devices* in the Busam system

have stored the media items of the playlist in their respective memories, not whether or not the media items are stored in the memory of the user's device. (See e.g., Busam, 4:58-59, indicating that the "accessible devices" are different than the user's electronic device itself (the "requesting device") because "the server sends a list of accessible devices to the requesting device.")

213. Specifically, when a requesting device in the Busam system issues a search request to the server, the server forwards the request to each of the accessible devices and "all of the devices that received the search request will perform a search." (Busam patent, 7:5-10.) Each accessible device performs the search and then forwards its search results back to the requesting device either directly, or indirectly via the server. (Busam patent, 7:11-24.) In other words, each of the accessible devices determines whether one or more media items corresponding to the search request is stored in its own local memory and then forwards that information to the user's requesting device. There is no disclosure or suggestion in Busam that the system (e.g., the server or the requesting device itself) also determines whether or not the media items of a playlist are stored on the requesting electronic device. Busam also does not display information to the user identifying whether or not media items are stored locally on the user's requesting device, or on an accessible device, which further demonstrates that the Busam system does not "identify[] ones of the plurality of songs in the playlist that are not stored on the electronic device" as required by claim 1 of the '952 Patent.

(3) send a request to a remote server for supplemental information related to a song in real-time while the song is playing

214. In my opinion, the Busam patent also does not disclose or suggest an electronic device that is configured to "send a request to a remote source for supplemental information related to a song in real-time while the song is playing" ('652 Patent, claim 11).

215. The Jeffay Report cites to the Busam patent, FIG. 7, 6:56-64, and Table 1 as allegedly disclosing this feature. (Jeffay Report, Ex. 26, p. 44, "Busam discloses that devices store supplemental information related to a song such as song titles, movie titles, albums, artists, genre, bitrate, and other information.") However, the cited portions only refer to the receipt of a list of media items matching a search criteria and additional information (e.g., artist and album information) before a media item begins playing. The Busam patent does not disclose or suggest sending a request to a remote source for supplemental information related to a song in real-time while a media item is playing.

216. In my opinion, Dr. Jeffay also fails to establish that this claim feature of claim 11 of the '652 Patent was an "obvious design choice to try" as alleged in the Jeffay Report. (Jeffay Report, Ex. 26, p. 46.) The Jeffay Report does not demonstrate that this feature was one of a finite number of identified, predictable solutions in the relevant art that would have been obvious to incorporate into the Busam system with a reasonable expectation of success.

217. For example, sending a request to a remote source for supplemental information related to a song in real-time while the song is playing is fundamentally different than the approach described in Busam of issuing a single search request for all information related to all media items before playback begins. Issuing a request for supplemental information related to a song while the song is playing (instead of before the song begins playing) can, for example, reduce the upfront network load and the storage requirements of the requesting device since the supplemental information will only be requested and provided over the network when (and if) the song is actually played and the supplemental information is requested. Busam also teaches away from modifying the Busam system to issue supplemental requests for information to the Busam server after the requesting device has issued an initial search request. Busam states that

"If the server was used to transfer data, then the server may become overloaded and the network will no longer function with reasonable performance." (Busam patent, 8:58-60.)

(4) Internet radio broadcast mode

218. In my opinion, the Busam patent also does not disclose or suggest an electronic device that has an "Internet radio broadcast mode" in which the device is capable of playing an "Internet radio broadcast" ('652 Patent, claims 1 and 42).

219. The Jeffay Report appears to allege that since Internet radio broadcasts are "streamed to listeners as a unicast" and "all publically accessible content on the Internet in 2000, as well as today, is transmitted via unicast" (Jeffay Report [0135]-[0136]), the Busam patent necessarily discloses this claim element simply because the user device is capable of accessing the Internet. (E.g., Jeffay Ex. 26, p. 16, "A person having ordinary skill in the art at the time of the alleged invention would understand that 'commercial service' [over the Internet] as disclosed in *Busam* constitutes an Internet radio broadcast, and that *Busam* teaches that API applications for communicating with the commercial service would constitute an Internet radio mode of operation.") I disagree. All unicast content streamed over the internet is not an "Internet radio broadcast" (e.g., the content of broadcast programming simultaneously available via traditional FM or AM radio stations). In addition, just because a device has the ability to access some content over the Internet does not mean that the device has the capability to access and play Internet radio broadcasts. For example, as explained in the Qureshey Patents, a web browser may be required to have a particular plug-in in order to access and play Internet radio broadcasts. ('952 Patent, 3:42-45.)

d. Reference Combinations Based on the Busam Patent are Not Prior Art

220. In addition to Dr. Jeffay's opinions regarding anticipation, the Jeffay Report proposes 14 reference combinations that include the Busam patent, and asserts that certain claims of the Qureshey Patents are obvious in view of these references. (Jeffay Report, § IX.C.)

221. In my opinion, the asserted claims of the Qureshey Patents are not obvious from the Busam patent taken alone or in the combinations proposed by Dr. Jeffay. As demonstrated above, the Busam patent is not prior art to the Qureshey Patents. Nowhere does Dr. Jeffay cite to the Busam provisional application in connection with his obviousness analysis, much less demonstrate with clear and convincing evidence that the Busam provisional application contains an adequate written description of the cited portions of the Busam patent. Accordingly, because the reference combinations that involve the Busam patent are not prior art to the asserted claims of the Qureshey Patents, these reference combinations cannot invalidate those claims.

222. The 14 reference combinations involving the Busam patent are identified in the table below. As shown, in every instance, the Jeffay Report relies on a description of the "playlist" functionality in the Busam patent in the proposed reference combination as alleged motivation to combine the references. This is improper. The Busam provisional application does not contain a corresponding written description of any playlist functionality. Therefore, reliance on the alleged "playlist" description in the Busam patent demonstrates conclusively that these reference combinations involving the Busam patent, and the alleged motivation to combine these references, are not prior art to the asserted claims of the Qureshey Patents.

	Busam Reference Combination	**Allegedly Obvious Claims**	**Alleged Motivation to Combine Not Supported by Busam Provisional Application** (all underlining added for emphasis)
1.	RealPlayer in combination with Busam patent	'952: 4, 11, 12, 14 '652: 7, 48, 49	"Further, each of the RealPlayer software systems and each of the Real Player Manuals and Busam teach methods and systems for users to create playlists that allow a user to listen to audio from multiple sources,

	Busam Reference Combination	**Allegedly Obvious Claims**	**Alleged Motivation to Combine Not Supported by Busam Provisional Application** (all underlining added for emphasis)
		(Jeffay Report, pp. 95-97 and Exs. 57 and 58)	including digital audio files stored on remote locations on a network. … Busam, 7:40-61." (Jeffay Report, p. 95)
2.	Ninja Jukebox in combination with Busam patent	'952: 11, 12 '652: 7, 48, 49 (Jeffay Report, pp. 103-105 and Exs. 63 and 64)	"Further, Ninja Jukebox and Busam teach methods and systems for users to create playlists that allow a user to listen to audio from multiple sources, including digital audio files stored on remote locations on a network. … Busam, 7:40-61." (Jeffay Report, pp. 103-104)
3.	Lipscomb in combination with Busam patent	'952: 4, 12 (Jeffay Report, pp. 106-108 and Ex. 34)	"Further, both Lipscomb and Busam teach methods and systems for users to create playlists that allow a user to listen to audio from multiple sources, including digital audio files stored on remote locations on a network. … Busam, 7:40-61." (Jeffay Report, pp. 107 and 108-109)
4.	Busam patent in combination with Lipscomb	'652: 11 (Jeffay Report, pp. 108-110 and Ex. 26)	
5.	Busam patent in combination with White	Not specified[2]	"Both Busam and White teach methods for users to create playlists that allow a user to listen to audio from multiple sources, including digital audio files stored on remote locations on a network. … Busam, 7:40-61." (Jeffay Report, p. 110.) "Each of Busam, Lipscomb, and White teach methods for users to create playlists that allow a user to listen to audio from multiple sources, including digital audio files stored on remote locations on a network. … Busam, 7:40-61." (Jeffay Report, p. 134)
6.	White in combination with Busam patent	'952: 1, 2, 3, 4, 10, 11, 12, 14, '652: 49 (Jeffay Report, pp. 133-136 and Exs. 28 and 29)	
7.	Busam patent in combination with Langdon	Not specified[3]	"Both Busam and Langdon teach methods for users to create playlists that allow a user to listen to audio from

[2] Dr. Jeffay's claim charts for Busam do not reference the White patent. (Jeffay Report, Exs. 25 and 26.) However, the body of the Jeffay Report alleges, without citation to particular claims, that Busam in view of White renders obvious "any of the limitations of the claims of the '652 or '952 Patents." (Jeffay Report, p. 110.) The Jeffay Report also alleges that "For example, to the extent BHM contends that Busam does not disclose an Internet radio broadcast, playback from an optical disc, displaying a list of Internet radio broadcast stations, a wireless transceiver, supplemental information related to a song, or a wireless remote control under any parties' proposed construction, it would have been obvious to a person having ordinary skill in the art at the time of the alleged invention to combine the teachings of Busam with the teachings of White regarding these limitations to cure any alleged deficiencies of Busam." (Jeffay Report, p. 110.)

[3] Dr. Jeffay's claim charts for Busam do not reference the Langdon patent. (Jeffay Report, Exs. 25 and 26.) However, the body of the Jeffay Report alleges, without citation to particular claims, that Busam in view of Langdon renders obvious "any of the limitations of the claims of the '652 or '952 Patents." (Jeffay Report, p. 112.) The Jeffay Report also alleges that "For example, to the extent BHM contends that Busam does not disclose receiving and playing an Internet radio broadcast while in an Internet radio mode of operation, functionality to display a list of Internet radio broadcast stations, functionality to obtain and play files stored on an optical disc or data storage device, receiving audio files via a wireless transceiver of the electronic device, or obtaining supplemental information related to a song, under any parties' proposed construction, it would have been obvious to a person having ordinary skill in the art at the time of the alleged invention to combine the teachings of Busam with the teachings of Langdon regarding these limitations to cure any alleged deficiencies of Busam." (Jeffay Report, p. 113.)

	Busam Reference Combination	**Allegedly Obvious Claims**	**Alleged Motivation to Combine Not Supported by Busam Provisional Application** (all underlining added for emphasis)
8.	Langdon in combination with Busam patent	'952: 2, 3, 4, 10 '652: 13, 55 (Jeffay Report, pp. 120-123 and Exs. 40 and 41)	multiple sources, including digital audio files stored on remote locations on a network. … Busam, 7:40-61." (Jeffay Report, pp. 113 and 121)
9.	Busam patent in combination with Sass	'652: 1, 6, 7, 42, 47, 48 (Jeffay Report, p. 116)	"it would have been obvious to a person having ordinary skill in the art at the time of the alleged invention to combine the teachings of Busam with the teachings of Sass to cure Sass's alleged deficiency and practice this limitation. For example, Busam teaches "assigning a playlist to an electronic device, the playlist identifying a plurality of songs." (Jeffay Report, Ex. 37, p. 3) "'While using the device-to device network, an entity can transfer files, stream files, create and use playlists, send commands to various devices and explore the contents of various devices.' *See, e.g.*, *Busam* 1:51-54." (Jeffay Report, Ex. 37, p. 3)
10.	Sass in combination with Busam patent	'952: 1, 9 '652: 1, 3, 4, 6, 7, 10, 11, 13, 44, 49, 50 (Jeffay Report, pp. 128-130 and Exs. 37 and 38)	
11.	Logan in combination with Busam patent	'952: 2, 3, 4, 10, 11, 12, and 14 (Jeffay Report, pp. 126-128 and Ex. 31)	"In addition, a person having ordinary skill in the art would have been motivated to combine the teachings of Logan regarding selection and playing of audio files identified by a playlist on a wireless handheld device with the teachings of White, Abecassis, Lipscomb, and/or Busam pertaining to associated electronic devices and sharing of information, e.g., playlists between associated devices." (Jeffay Report, p. 127)
12.	McLaughlin in combination with Busam patent	'652: 1 (Jeffay Report, pp. 131-133 and Ex. 43)	"Furthermore, a person having ordinary skill in the art would have been motivated to combine the teachings of McLaughlin regarding selection and retrieval of audio files identified by a playlist with the teachings of Langdon and/or Busam regarding other means for transferring and obtaining audio files for a user device, including peer-to-peer networking, as these references were directed to the same purpose" (Jeffay Report, p. 132)
13.	Abecassis in combination with Busam patent	'952: 4, 11, 12 (Jeffay Report, pp. 137-139 and Ex. 45)	"Both Abecassis and Busam pertain to the same general field. … both of these references teach methods for users to create playlists that allow a user to listen to audio from multiple sources, including digital audio files stored on remote locations on a network. *See, e.g.*, Ex. 23, Busam, at 1:45-54, 4:20-30, Figs. 8-9;" (Jeffay Report, p. 137)
14.	Music in the Home in combination with Busam patent	'952: 2, 3, 4, 9, 11, 12 '652: 1 (Jeffay Report, pp. 139-143 and Exs. 67 and 68)	"Music in the Home and Busam teach methods and systems for users to create playlists that allow a user to listen to audio from multiple sources, including digital audio files stored on remote locations on a network. … Busam, 7:40-61." (Jeffay Report, p. 142)

223. In view of the foregoing, it is my opinion that the Jeffay Report does not demonstrate with clear and convincing evidence that the Busam patent and the alleged reference combinations involving the Busam patent are prior art to the asserted claims of the Qureshey Patents. Based on my review, it is my opinion that they are not prior art. Accordingly, in my opinion, the asserted claims of the Qureshey Patents are not obvious from the Busam patent taken alone or in combination with theses references.

2. White - U.S. Patent No. 7,187,947

224. The Jeffay Report alleges that the White patent ("*White*") anticipates claims 1 and 9 of the '952 Patent, and claims 1, 3, 4, 6, 7, 10, 13, 42, 44, 45, 47, 48, 50, 52, and 55 of the '652 Patent. (Jeffay Report ¶¶ [0180]-[0181].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that these claims are obvious from the White patent. (Jeffay Report, p. 73, footnotes 5-6.) I disagree for the reasons set forth below.

a. White was Considered by the USPTO in the Prosecution of the Qureshey Patents

225. As an initial matter, I note that *White* was considered by the United States Patent & Trademark Office ("PTO") during the prosecution of the '952 and '652 Patents. *White* is cited on the face of each of the '952 and '652 Patents (Jeffay Ex. 1, BHM-ITC-000195 and Jeffay Ex. 2, BHM-ITC-000270), and was initialed by the PTO patent examiner as considered. ('952 and '652 Patent Prosecution Histories, BHM-ITC-007594 and BHM-ITC-008312.) Thus, the PTO determined that the claims of the Qureshey Patents are novel and nonobvious in view of *White*. I understand that this is a factor to consider when opining on the validity of an issued patent. However, Dr. Jeffay does not mention this in his report.

b. White Does Not Disclose or Suggest the Inventions Claimed in the Qureshey Patents

226. In my opinion, and as previously determined by the PTO, *White* does not disclose or suggest the inventions claimed in the Qureshey Patents. Accordingly, for at least the reasons set forth below, it is my opinion that *White* does not invalidate the asserted claims.

227. For example, *White* does not disclose or suggest core features of both the '952 and '652 Patents, including an electronic device that receives a playlist assigned to the device from a central or remote system, where the playlist identifies a plurality of songs, as well as the receipt of information enabling the user's device to obtain one or more songs from a remote source rather than local storage of the user's device.

228. *White* describes a system for communicating media files selected by a user from a server to the user's device. A user accesses a web page via the Internet. From the webpage, the user selects specific audio content, i.e., "audio information" such as multiple songs. (*White*, 16:1-6 and Figure 8, "a user selects desirable audio information. For example, a user may select a single song, a plurality of different songs, an entire album, a broadcast station ….") The server then creates a "playlist" that includes the selected audio information by obtaining and accessing URLs that allow the server to retrieve and assemble the selected audio information. (*White*, 16:11-19.) The user selects a destination for the assembled audio content, such as "a remote electronic device, a automobile audio system, a home stereo system, a home computer" etc. (*White*, 16:20-22.) The server then transmits the assembled audio content to the selected destination. (*White*, 16:35-37 and 16:52-54, "Upon formatting the information, the method may then proceed to step 807 where the audio information is wirelessly communicated to the selected device.")

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

229. In my opinion, *White* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

230. The Jeffay Report cites to *White*, Figure 8 and the corresponding description at 16:1-11 and 17:7-13, as allegedly showing these claimed features. (Jeffay Ex. 28, pp. 2-3 and 35-36; Jeffay Ex. 29, pp. 17-18 and 47-48.) However, as described above, this cited portion of *White* refers to a server that assembles desired audio content (i.e., the "audio information") selected by the user. *White* refers to this assembled collection of audio content as a "playlist" (*White*, 16:6-9), but once assembled the server transmits only the actual content to a user's device (*White*, 16:35-37 and 16:52-54). *White* does not disclose or suggest that the server sends the playlist itself to the user's device, including the titles corresponding to the selected audio content that "identif[y] the plurality of songs," as claimed in the Qureshey Patents.

231. In addition, Dr. Jeffay's reliance on *White* plainly conflates the requirement for the receipt of a playlist, which identifies content, with the receipt of the content itself. In my opinion, a person having ordinary skill in the art would not have understood the transmission and receipt of audio content itself to satisfy the requirement for the receipt of a playlist identifying a plurality of songs as claimed in the Qureshey Patents. For example, the claims of the Qureshey Patents define that receiving the playlist and obtaining the content are separate claim requirements. ('952 Patent claim 9 and '652 Patent claim 42, defining "obtaining the … songs" as being separate from "receiving … a playlist"; also '652 Patent claim 1, "obtain the … songs" separate from "receive the playlist.")

(2) receiving information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source

232. In my opinion, *White* also does not disclose an electronic device that receives "information … enabling the electronic device to obtain the ones of the plurality of songs … from at least one remote source" ('952 Patent, claims 1 and 9; '652 Patent, claims 1 and 42).

233. The Jeffay Report again cites to *White*, Figure 8 and the corresponding description at 16:1-19, as allegedly showing this feature. (Jeffay Ex. 28, pp. 7-9 and 38-40; Jeffay Ex. 29, pp. 21-23 and 51-53). However, as described above, this only describes that the server in *White* transmits the actual audio content (i.e., the "audio information") selected by the user to the user's device. *White* does not disclose or suggest that the server sends to the user's device information that enables the device to obtain the songs from at least one remote source (e.g., URLs to the audio content) as claimed in the Qureshey Patents.

234. Indeed, *White* teaches away from the approach claimed in the Qureshey Patents by stating that the server in the *White* system assembles the selected audio content for transmission to the user's device using the URLs for that content. *White* states that its system operates "by removing the requirement that information be communicated asynchronously to an electronic device." (*White*, 6:27-29, underlining added.) In other words, *White* describes that its system provides the audio content to a user's device at a time that is determined by the server, not asynchronously in response to the user's device receiving and utilizing information that enables the user's device to obtain the audio content. *White* describes that its server must "query the selected device to determine if capacity is available" (*White*, 16:65-17:2), which further demonstrates that the content delivery is controlled by the server and not the user's device.

(3) identifying ones of the plurality of songs in the playlist that are not stored on the electronic device

235. The Jeffay Report again cites to *White*, Figure 8 and the corresponding description at 16:1-19, as allegedly showing the feature claimed in claim 1 of '952 Patent of "identifying ones of the plurality of songs in the playlist that are not stored on the electronic device." (Jeffay Ex. 28, pp. 5-6.) However, the cited portion of *White* has nothing to do with determining what is, or is not, stored on the user's device. It relates only to operations performed by the server to access and assemble audio content from remote sources. *White* also does not display information to the user (either via the web page or by causing information to be displayed on the user device) identifying whether or not media items are stored locally on the user's device, which further demonstrates that *White* does not identify ones of the plurality of songs in the playlist that are not stored on the electronic device as required by claim 1 of the '952 Patent.

236. For at least the foregoing reasons, it is my opinion that *White* does not anticipate or render obvious the asserted claims of the Qureshey Patents.

c. White in Combination with Lipscomb

237. The Jeffay Report alleges that *White* in combination with *Lipscomb* renders obvious dependent claim 11 of the '652 patent, which is directed to, for example, an electronic device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. (Jeffay Report, ¶¶ [0358] and [0181].) I disagree. First, claim 11 depends from claim 1 of the '652 Patent. As described in my report, neither *White* nor *Lipscomb* disclose or suggest all of the elements of independent claim 1, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *White* and *Lipscomb* would not disclose or suggest this claim element. Second, as described in connection with *Lipscomb*, *Lipscomb* does not disclose or suggest a user computing device that sends a request to a remote server for supplemental

information related to a song in real-time while the song is playing. Accordingly, *White* in combination with *Lipscomb* also does not disclose or suggest this additional feature of claim 11.

238. In addition, to the extent that the Jeffay Report alleges that *White* in combination with *Lipscomb* renders obvious any of dependent claims 2, 3, 4, 10, 11, 12, and 14 of the '952 Patent (Jeffay Report, ¶ [0180]), this is not addressed in substance or explained in the Jeffay Report or exhibits. These references refer to different systems and the Jeffay Report does not explain why it allegedly would have been obvious to a person having ordinary skill in the art to combine them nor why there would have been a reasonable expectation of success in doing so.

3. Logan - U.S. Patent No. 6,199,076

239. The Jeffay Report alleges that the Logan patent ("*Logan*") anticipates claims 1 and 9 of the '952 Patent, and claims 1, 3, 4, 6, 7, 10, 42, 44, 45, 47, 48, 49, 50, and 52 of the '652 Patent. (Jeffay Report ¶¶ [0184]-[0185].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that these claims are obvious from *Logan*. (Jeffay Report, pp. 74-75, footnotes 7 and 8.) I disagree for the reasons set forth below.

a. Logan was Considered by the USPTO in the Prosecution of the Qureshey Patents

240. As an initial matter, I note that *Logan* was considered by the United States Patent & Trademark Office ("PTO") during the prosecution of both the '952 and '652 Patents. It is cited on the face of each of the '952 and '652 Patents (Jeffay Ex. 1, BHM-ITC-000195 and Jeffay Ex. 2, BHM-ITC-000270), and was initialed by the PTO patent examiner as considered. ('952 and '652 Patent Prosecution Histories, BHM-ITC-007247 and BHM-ITC-007963.) Thus, the PTO determined that the claims of the Qureshey Patents are novel and nonobvious in view of *Logan*. I understand that this is a factor to consider when opining on the validity of an issued patent. However, Dr. Jeffay did not mention this in his report.

b. Logan Does Not Disclose or Suggest the Inventions Claimed in the Qureshey Patents

241. In my opinion, and as previously determined by the PTO, *Logan* does not disclose or suggest the inventions claimed in the Qureshey Patents. Accordingly, for at least the reasons set forth below, it is my opinion that *Logan* does not invalidate the asserted claims.

242. *Logan* describes a content distribution system in which "a host system organizes and transmits program segments" and a schedule for playing the program segments to a player device. (*Logan*, Abstract; 2:47-50.) "The host organizes the program segments by subject matter and creates the scheduled programming in accordance with preferences of each subscriber." (*Logan*, Abstract.)

243. *Logan* states 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 …." (*Logan*, 30:31-35.) For the music subjects, "the music selections ('topics') within each of the two music subjects, 'country music' and 'classical music,' are preceded with a brief announcement identifying the musical selection which follows, allowing the user to quickly skip from announcement to announcement until a desired selection is found. … the subscriber may request that the announcements be suppressed during continuous play …." (*Logan*, 30:43-51.)

244. To allow the player device to access the program schedule and program segments, *Logan* states that the contents of the compilation/storage unit 145 of the host server are "placed in a predetermined FTP download file directory and assigned a filename known to the player 103." (*Logan*, 6:53-55.) Specifically, the host system assembles and provides to the player device a "download compilation file 145" that includes the ProgramIDs corresponding to the program segments of a program schedule. (*Logan*, 6:51-66; see also FIG. 5, showing the

program IDs scheduled for playback in a sequence.) 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" (*Logan*, 8:29-33). See also, *Logan*, 9:14 and 8:20-23, which state that the "host assembles program schedules" and "the server … compiles one or more files for downloading to the subscriber at step 207 which include programming and advertising segments."

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

245. In my opinion, *Logan* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

246. The Jeffay Report cites to *Logan*, 2:47-50 and 6:51-55, as allegedly showing these claimed features. (Jeffay Ex. 31, pp. 1-2 and 28; Jeffay Ex. 32, pp. 21 and 47). However, as described above, these portions of *Logan* only refer to providing the player device with a session schedule or compilation that includes a plurality of ProgramIDs for program segments.

247. First, as described in *Logan*, program segments are "compressed audio files and/or text" (*Logan*, 4:46-47) on subjects including "world news, national news, local news, computer trade news, email and voice mail messages, country music, classical music …." (*Logan*, 30:31-35.) *Logan* does not disclose or suggest that the program segments are "songs." Indeed, when *Logan* refers to program segments that correspond to "country music" and "classical music," *Logan* states that the music selections correspond to "topics." (*Logan*, 30:43-

45, "the music selections ('topics') within each of the two music subjects, 'country music' and 'classical music,'…."). In my opinion, this reference to music "topics" indicates that music-related program segments in *Logan* are genre radio broadcasts, such as programs of a country music station or a classical music station that have been recorded and stored. (See also, *Logan*, 40:20-22, referring to a music program segment as "an audio recording of a broadcast radio program ….") A recording of a broadcast radio program, which itself contains talk radio, DJ intros, advertisements, and music, is not a "song."

248. Second, to the extent that the Jeffay Report is now interpreting the claim element "playlist identifying a plurality of songs" to include recordings of broadcast audio programs, that interpretation conflicts with the usage of these terms in the claims and specification of the Qureshey Patents. For example, the claims of the '652 Patent distinguish between songs of a playlist in a "playlist mode of operation," on one hand, from the broadcast content of an "Internet radio mode of operation," on the other. ('652 Patent, claims 1 and 42.) The specification of the Qureshey Patents also distinguishes between the two (e.g., compare '952 Patent, Figure 11 and 16:48, referring to "a playlist including songs," with Figure 6A and 14:22-25, referring to "audio program sources such as live broadcasts 620, archived broadcasts 624").

249. Third, I disagree with Dr. Jeffay's argument that *Logan* discloses a "playlist identifying a plurality of songs" simply because *Logan* states that the program segments can include "music files." (Jeffay Ex. 31, pp. 3 and 30; Jeffay Ex. 32, pp. 22 and 49.) As stated above, *Logan* describes that the music file of a program segment can be "an audio recording of a broadcast radio program." (*Logan*, 40:20-22; 5:60-65.) *Logan* does not disclose that the music files are the songs of a playlist, or how the *Logan* system would collect, catalog, and provide a

library of songs instead of recorded radio broadcasts. Again, a broadcast radio program that itself contains talk radio, DJ intros, advertisements, and music, is not a "song."

250. Lastly, *Logan* describes that the multiple ProgramIDs that are provided to the player device are just a list of "numbers" or "key value[s]." (*Logan*, 12:5-7 and 17:54.) They do not include the titles of the program segments. Thus, even assuming that the "ProgramIDs" correspond to program segments the underlying contents of which are songs (I disagree that recorded radio broadcasts are "songs" as stated above), the ProgramIDs are not a "playlist identifying a plurality of songs" as claimed in the Qureshey Patents. Further supporting my opinion that *Logan* does not identify music-related content by title, *Logan* describes that music selections "are preceded with a brief announcement identifying the musical selection which follows" (Logan, 30:45-46). Thus, *Logan* uses audio clips to tell the user what the content is, not titles within a playlist.

(2) receiving information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source

251. In my opinion, *Logan* also does not disclose an electronic device that receives "information … enabling the electronic device to obtain the ones of the plurality of songs … from at least one remote source" ('952 Patent, claims 1 and 9; '652 Patent, claims 1 and 42).

252. The Jeffay Report argues that *Logan* discloses this claim element because the *Logan* player device is capable of, i.e., is "put into an operative condition for," downloading audio files:

> a person of ordinary skill in the art at the time of the alleged invention would have understood *Logan* to have disclosed "providing information to the electronic device enabling (at least putting into an operative condition for) 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.

(Jeffay Ex. 31, pp. 10 and 34, underlining added; also Jeffay Ex. 32, pp. 24 and 54.)

253. Similarly, the Jeffay Report argues that "*Logan* teaches that the information received from the 'host server' enables, or puts the device in an operative condition for 'downloading' that file" and Dr. Jeffay points to the "download compilation file 145" that is received from the host server as the information that enables the player device to obtain the audio files. (Jeffay Ex. 31, pp. 10 and 33-34; Jeffay Ex. 32, pp. 23 and 54.)

254. However, as described above, the "download compilation file 145" only includes the ProgramIDs corresponding to the program segments of a program schedule. (*Logan*, 6:51-66.) At most, these ProgramIDs are what enable the device to play the program segments in a predefined sequence. (See e.g., the schedule in *Logan*, Figure 5, which uses the ProgramIDs to define the order in which to play the program segments.) The download compilation file 145 or ProgramIDs do not enable the player device to obtain the songs. Rather, as described above, the *Logan* player device obtains the program segments by accessing "a predetermined FTP download file directory and assigned a filename known to the player 103." (*Logan*, 6:53-55, underlining added.) In other words, even before the player device receives the download compilation file with the ProgramIDs, it already knows the predetermined location for downloading program segments and thus has all of the information it needs to obtain them. Indeed, the *Logan* player device always accesses the same predetermined location to obtain the download compilation file 145 and the program segments. (*Logan*, 6:51-66 and 8:29-33.)[4]

255. For at least the foregoing reasons, it is my opinion that *Logan* does not anticipate or render obvious the asserted claims of the Qureshey Patents.

[4] *Logan* indicates that the download compilation file 145 and program segments can be stored in a predetermined FTP download file directory, or alternatively, "storage areas on the web server 141 or at any other accessible location on the Internet." (Logan, 18:60-65.) Regardless of the type of remote storage area, *Logan* states that the storage area location is predetermined and known to the player device even before it obtains a download compilation file. (*Logan*, 6:53-55.)

c. Logan in Combination with White, Lipscomb, and/or Abecassis

256. The Jeffay Report alleges that *Logan* in combination with *Lipscomb* renders obvious dependent claim 11 of the '652 patent, which is directed to, for example, an electronic device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. (Jeffay Report, ¶¶ [0338] and [0185].) I disagree. First, claim 11 depends from claim 1 of the '652 Patent. As described in my report, neither *Logan* nor *Lipscomb* disclose or suggest all of the elements of independent claim 1, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Logan* and *Lipscomb* would not disclose or suggest this claim element. Second, as described in connection with *Lipscomb*, *Lipscomb* does not disclose or suggest a user computing device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. Accordingly, *Logan* in combination with *Lipscomb* also does not disclose or suggest this additional feature of claim 11.

257. The Jeffay Report also alleges that *Logan* in combination with *Lipscomb*, *White*, and/or *Abecassis* renders obvious dependent claims 13 and 55 of the '652 Patent, directed to, for example, receiving and displaying a recommended song. (Jeffay Report, ¶ [0185].) I disagree. Claims 13 and 55 depend from independent claims 1 and 42 of the '652 Patent. As described in my report, none of these references disclose or suggest all of the elements of these independent claims of the '652 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, these references would not disclose or suggest these claim elements.

258. The Jeffay Report also alleges that *Logan* in combination with *White* and/or *Abecassis* renders obvious dependent claims 2, 3, 4, and 10 of the '952 Patent, and that *Logan* in

combination with *Abecassis* renders obvious dependent claims 11, 12, and 14 of the '952 Patent, directed to, for example, ways in which an electronic device can obtain, from at least one remote source, one or more songs of a playlist that is assigned to the electronic device. (Jeffay Report, ¶¶ [0184] and [0337]; Jeffay Ex. 31.) I disagree. These dependent claims all depend from independent claims 1 and 9 of the '952 Patent. As described in my report, none of these references disclose or suggest all of the elements of these independent claims of the '952 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, these references would not disclose or suggest these claim elements. In addition, these references refer to different types of systems with different network topologies and the Jeffay Report does not explain why it allegedly would have been obvious to a person having ordinary skill in the art to combine them nor why there would have been a reasonable expectation of success in doing so.

4. Lipscomb - U.S. Patent No. 7,020,704

259. The Jeffay Report alleges that the Lipscomb patent ("*Lipscomb*") anticipates claims 1, 2, 3, 9, 10, 11, and 14 of the '952 Patent, and claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 45, 47, 48, 49, 50, 52, and 55 of the '652 Patent. (Jeffay Report ¶¶ [0188]-[0189].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that these claims are obvious from *Lipscomb*. (Jeffay Report, p. 76, footnotes 9 and 10.) I disagree for the reasons set forth below.

260. *Lipscomb* refers to "a system for distributing media assets" to media player devices over a network. (*Lipscomb*, Abstract.) The media assets can include "video assets such as movies and other video productions from one or more production companies" and "audio assets such as music and other audio productions from one or more record companies." (*Lipscomb*, 2:13-20.) The system includes a portal, which is a "computer server or group of

servers," that "downloads and/or streams media assets … to media player devices." (*Lipscomb*, 2:34-36 and 3:17.)

261. *Lipscomb* performs rights management with respect to each media asset, on a per-asset basis, in order to determine whether a media asset can be accessed by one or more media players:

> A user may have multiple media player devices 200 and therefore desire access to media assets that he/she has purchased the rights to, on each media player, if that user has purchased rights of sufficient scope to permit access on multiple media players. Those assets to which a user has purchased digital access rights on one or more media players are hereinafter referred to as a user's licensed assets. Moreover, multiple users within a "family" may have different levels of access (*Lipscomb*, 3:1-10, underlining added.)
>
> Any music or video file in the media player can have … rights restrictions (*Lipscomb*, 9:40-43.)
>
> the rights management rules can provide for a limited number of plays or uses of a particular asset, a limited number of days during which the asset can be used, or a limited number of other individuals with which the user may share the asset. (*Lipscomb*, 11:11-15.)

262. *Lipscomb* describes two different types of media player devices, i.e., one type that includes a client database application 270 for local storage of media assets (for which download and/or streaming of media assets can be performed), and another type of media player device that does not include local storage (such that only streaming of media assets is allowed). (*Lipscomb*, 4:7-10, 5:50-6:18, and Figure 3.)

263. *Lipscomb* describes that "A user may create a playlist manually from a master database or generate playlists randomly based on database searches." (*Lipscomb*, 9:48-50.) For media player devices that include a client database application 270 (and thus have a local storage capability), *Lipscomb* states that the media player device "may have some local memory in which a playlist of media assets can be stored. The locally stored playlist would contain a subset of the user's complete on-line database." (*Lipscomb*, 6:15-18.) "The media player device is

capable of adding URL reference to its playlist" for use in streaming music or video. (*Lipscomb*, 8:36-40.)

264. *Lipscomb also* states that "portal 300 may be used to create, edit, or delete a playlist of assets" (*Lipscomb*, 4:34-35).

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

265. In my opinion, *Lipscomb* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42), or "assigning a playlist to an electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

266. The Jeffay Report alleges, without citation to *Lipscomb*, that "Lipscomb discloses systems and methods for creating and sharing playlists among specific devices across a network." (Jeffay Report, ¶ [0187], underlining added.) I disagree. *Lipscomb* does not disclose or suggest sharing playlists amongst user devices, and the Jeffay Report fails to support this statement with citations to *Lipscomb* in the body of the report or in the claim charts for the *Lipscomb* patent (Jeffay Exs. 34 and 35).

267. As described above, *Lipscomb* states that each media asset that can be accessed across one or more media player devices, not playlists. This is fundamentally different than sharing playlists across devices, and has significant implications. Specifically, *Lipscomb* performs rights management on a per-"media asset" basis, where each media asset has its own permissions or restrictions set such that it can be accessed "on one or more media players" with "different levels of access." (*Lipscomb*, 3:1-10; also 9:40-43 and 11:11-15.) *Lipscomb* does not disclose or suggest applying rights management to playlists of media assets, sharing playlists of

media assets across multiple devices, or how that might be accomplished. By way of example only, *Lipscomb* does not disclose or suggest how a playlist of media assets could be shared within the *Lipscomb* system when each of its separately-managed media assets has an independent set of permissions or restrictions for rights management (e.g., what happens when only a subset of the media assets of a playlist have permissions that allow for sharing?). *Lipscomb* does not disclose or suggest the answers to these questions and, in my opinion, did not enable a person of ordinary skill in the art to do so without undue experimentation. This further demonstrates that *Lipscomb* does not disclose or suggest sharing playlists between user devices.

268. Dr. Jeffay's citation to the data "synchronization" process in *Lipscomb*, 10:15-43, is similarly misplaced. (Jeffay Ex. 34, pp. 4 and 34; Jeffay Ex. 35, pp. 19 and 50.) This only refers to a process for media player devices to synchronize an "asset or its metadata" with the portal (*Lipscomb*, 10:25-27, referencing synchronization "[w]hen an asset or its metadata is added, modified or deleted"; underlining added; also 10:6-9 and 4:2-6). This does not refer to playlist sharing or synchronization. As explained above, assets are not playlists, and *Lipscomb* does not disclose or suggest a process for receiving playlists, much less synchronizing playlists or how that might work. The asset metadata (e.g., information regarding the artist or genre) also is not a playlist. (*Lipscomb*, 4:36-39.)

269. Lastly, the Jeffay Report cites to *Lipscomb*, 4:33-36 and 9:46-61. (Jeffay Ex. 34, pp. 1-3 and 32-34; Jeffay Ex. 35, pp. 17-18 and 48-49.) However, as described above, neither of these cited portions discloses or suggests that the user's device receives a playlist assigned to the device as claimed. The cited portion at 9:46-61 only refers to a user utilizing a local player device to "create a playlist manually from a master database or generate playlists randomly based on database searches." In other words, the playlist is created on the local device, it is not

assigned to the device as required by the claims of the Qureshey Patents which is fundamentally different. The cited portion at 4:33-36 is also distinguishable as it only refers to "portal 300 … used to create, edit, or delete a playlist of assets". *Lipscomb* does not disclose or suggest that the portal transmits the playlist to the device, including the titles corresponding to the selected audio content that "identif[y] the plurality of songs," as claimed in the Qureshey Patents. For example, as described above in connection with the *White* patent, once a playlist was created on the *White* server, the *White* server transmitted only the media content itself to the device. (*White*, 16:35-37 and 16:52-54.) In my opinion, at most *Lipscomb* is cumulative of (does not add anything new to) this similarly-deficient disclosure of *White*, which was previously considered by the PTO.

(2) receiving information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source

270. In my opinion, *Lipscomb* also does not disclose or suggest an electronic device that receives "information … enabling the electronic device to obtain the ones of the plurality of songs … from at least one remote source" ('952 Patent, claims 1 and 9; '652 Patent, claims 1 and 42).

271. The Jeffay Report cites to *Lipscomb*, 8:33-38, as allegedly showing these features. (Jeffay Ex. 34, pp. 9 and 36-38; Jeffay Ex. 35, pp. 22 and 53-54.) However, as described above, the cited portion only refers to a media player that "is capable of adding URL reference to its playlist." (*Lipscomb*, 8:36-40.) *Lipscomb* does not disclose or suggest that the media player device receives the URL at all (e.g., instead of the URL being user generated, generated automatically by the media player device, or residing only on the portal server), much less that the media player receives the URL "when the media player device connects to the portal" as alleged by Dr. Jeffay. (Jeffay Ex. 34, pp. 9 and 37-38; Jeffay Ex. 35, pp. 22-23 and 53-54, quoting a different description in *Lipscomb* at 6:5-15.) The description in *Lipscomb* at 6:5-15

does not disclose or suggest that the media player device receives any URLs when the user connects to the portal, much less the URLs corresponding to the songs of a playlist for use by the media player to obtain the songs. It refers to a player device that lacks local storage and thus must connect to the portal to view available music.

(3) requesting supplemental information related to a song in real time while the song is playing

272. In my opinion, *Lipscomb* does not disclose or suggest an electronic device adapted to "send a request to a remote server for supplemental information related to a song in real-time while the song is playing" ('652 Patent, claim 11).

273. The Jeffay Report cites to *Lipscomb*, 9:13-45, as allegedly showing these features. (Jeffay Ex. 35, p. 37.) However, the cited portion only relates to a "Listen while record" function that allows a user to listen to a song at the same time the song is being recorded from a local CD to local memory. This does not disclose or suggest that the user's computer issues a request to a remote server for supplemental information about the song while the song is playing. In addition, while *Lipscomb* describes that "Any music or video file in the media player can have an extensive database of MetaData referenced to it … images, lyrics, notes," *Lipscomb* states that "All data is … incorporated into client database of media player device." (*Lipscomb*, 9:39-45; underlining added.) There is no disclosure or suggestion that this information is requested from a remote database in real time while the song is playing.

274. Indeed, based on my review, *Lipscomb* is a media library system that requires the system to batch download songs and other information to a local device before a user can play music or view corresponding information. In other words, as part of a synchronization process described below, the *Lipscomb* user device is required to pre-download all available information (e.g., lyrics, notes, etc.) from a server to the local device before the user device can be used to

play songs. The invention claimed in the '652 Patent, on the other hand, indicates a multi-tasking media management system that allows real-time asynchronous operations such as requesting supplemental information while playing a song.

275. *Lipscomb* only describes synchronous operations. For example, the algorithm described in Figure 9 is a synchronous request and reply protocol (e.g., step 3010 must complete first before step 3020 can begin). This type of protocol does not support the ability to request of supplemental information in real-time while the local device is currently processing a song request and playing that song.

276. In addition, the *Lipscomb* display also indicates a synchronous system. Figure 10, for example, does not allow the user to access the player controls (e.g. play, pause, stop, etc.) while the user is viewing artist information. And conversely, while the user does have access to the player controls in Figure 8 to play a song, no supplemental information can be requested or displayed.

277. *Lipscomb* does not perform requests for supplemental information in real-time while a song is playing. Rather, when music is requested from a server, it must be obtained before it can be played. *Lipscomb* requires a batch synchronization operation for the purpose of downloading any music or other information missing from the local device before the user can access the player. For example, *Lipscomb* Figure 11 clearly shows the decision box 525 indicating that all information must be synchronized with the local device before the media player is enabled for use (step 530, in Figure 11; see also Figure 9). This requirement to download all media and information in a batch operation before being able to play or access that information teaches away from real-time functionality. Further, when media is streamed, there is no disclosure or suggestion in *Lipscomb* that supplemental information is requested or received

and, as described above, the graphical user interface in *Lipscomb* does not support supplemental requests in real time. (*Lipscomb*, Figures 8 and 10.)

278. Thus, whereas the '652 Patent claims the ability to request supplemental information in real time, including multiple asynchronous requests corresponding to requests for music and then requests for supplemental information while a song is playing, *Lipscomb* describes a synchronous request and response system. The portion of *Lipscomb* cited in the Jeffay Report, i.e., recording the music while it is playing (*Lipscomb*, 9:13-45), is a function dedicated to just the local device and does not relate to any coordination of asynchronous requests to a remote server.

279. For at least the foregoing reasons, it is my opinion that *Lipscomb* does not anticipate or render obvious the asserted claims of the Qureshey Patents.

5. Sass - U.S. Patent No. 6,823,225

280. The Jeffay Report alleges that the Sass patent ("*Sass*") anticipates claims 1 and 9 of the '952 Patent, and claims 1, 4, 6, 7, 10, 13, 42, 45, 47, 48, 52, and 55 of the '652 Patent. (Jeffay Report ¶¶ [0192]-[0193].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that these claims are obvious from *Sass*. (Jeffay Report, pp. 77-78, footnotes 11 and 12.) I disagree for the reasons set forth below.

281. *Sass* refers to a server system that "makes it possible for users in many regions to hear radio broadcasts and stations from outside of their current geographical area," where the radio broadcasts can be live or prerecorded. (*Sass*, 8:7-9; see also 9:1-6, "If the network happens to be the Internet, then the device can play a program from nearly anywhere in the world" and 1:49-51, the server "allows a user to contemporaneously select, receive, and play live and prerecorded audio programs.") The receiver "may be portable so that it can be transported like a radio or tape player," may have a network connection, and may also receive "standard radio

frequency broadcasts" available in the receiver's geographical region. (*Sass*, 4:22-23 and 6:32-33.)

282. *Sass* states that the "live and prerecorded audio programs" available to the receiver via the network correspond to the traditional types of programming available from radio stations (e.g., sports, news, music, comedy, gospel, etc.):

> For example, if a user wanted to listen to a sports program, the user can view a list of sports programs and select a specific program or station in a category. Other possible categories include news, every category and subcategory of music, comedy, specific performers, language, gospel, live events (e.g. concerts and performances), financial, weather, traffic and information relevant to a geographic and location.

(*Sass*, 7:66-8:5.)

283. When the user's receiver connects to a server, "server 14 may, if requested, transmit data from station guide 44 to receiver 12." (*Sass*, 7:12-13.) "Station guide 44 is a catalog or list of programs and program information" corresponding to the radio stations that the receiver can access from the server. (*Sass*, 7:1-2.) "After receiver 12 has received station guide data, it will present a list of programs currently available to the user." (*Sass*, 7:16-18.) "The listing may include, but are not limited to, such data as station names, category and group of each station, and the network address of each station." (*Sass*, 7:61-63.) During play of a program selected by a user, the system can "determine commercials that are relevant to a user and play them at selected points in a program." (*Sass*, 11:11-13.)

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

284. In my opinion, *Sass* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device, the

playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

285. The Jeffay Report cites to *Sass*, 7:1-7 and 7:16-22, as allegedly showing these claimed features. (Jeffay Ex. 37, pp. 1-2 and 14-15; Jeffay Ex. 38, pp. 13-14 and 43-44.) However, as described above, these portions of *Sass* only refer to a receiver that receives and plays live or prerecorded radio broadcasts from inside or outside of its geographical area. Particularly, the server in *Sass* provides the receiver with a "station guide 44" including "a catalog or list of programs and program information" corresponding to the radio stations that are accessible to the receiver. (*Sass*, 7:1-2; also 8:7-9, 9:1-6, 1:49-51.) *Sass* does not disclose or suggest that the server assigns to a receiver, or that the receiver receives, a playlist identifying a plurality of songs as claimed in the Qureshey Patents.

286. First, a live or prerecorded broadcast radio program, which contains talk radio, DJ intros, advertisements, and music, is not a "song." The specification of the Qureshey Patents plainly distinguishes the two (e.g., compare '952 Patent, Figure 11 and 16:48, referring to "a playlist including songs," with Figure 6A and 14:22-25, referring to "audio program sources such as live broadcasts 620, archived broadcasts 624"). The claims of the '652 Patent also distinguish between the songs of a playlist within a "playlist mode of operation," on one hand, and the broadcast content of an "Internet radio mode of operation," on the other. ('652 Patent, claims 1 and 42.)

287. Second, the description in *Sass* that it inserts "commercials … in a program" (*Sass*, 11:11-13) also demonstrates that the "programs" in *Sass* are not "songs," but rather are live or prerecorded radio broadcasts. Interpreting the "programs" in *Sass* to be "songs" would be nonsensical, because the insertion of commercials into a song would interrupt and effectively

ruin the song. Radio broadcasts, on the other hand, with their different parts (e.g., talk, music, news) are ideally suited for insertion of commercials in between those parts.

288. Third, *Sass* does not disclose or suggest that the live or prerecorded programs in the "schedule 44" of *Sass* are arranged to be played in a sequence. This further demonstrates that schedule 44 is not a playlist. Rather, *Sass* only describes that when a user selects a particular program via a receiver, the receiver plays that program. (*Sass*, 2:64-67.) In addition, the user controls (e.g., fast forward and rewind) via the receiver are specific to a selected program. (*Sass*, 4:32-37) There is no disclosure or suggestion in *Sass* to link the programs together in a playlist or allow the user to, for example, skip to a "next" program.

(2) identifying ones of the plurality of songs in the playlist that are not stored on the electronic device

289. In my opinion, *Sass* also does not disclose or suggest "identifying ones of the plurality of songs in the playlist that are not stored on the electronic device" ('952 Patent, claim 1).

290. Without explanation or citation, Dr. Jeffay alleges in the body of his report and that *Sass* anticipates this claim. (Jeffay Report, ¶ [0192].) However, Dr. Jeffay's claim chart for the '952 Patent alleges that "*Sass*, in combination with *Busam*" shows this claim element. (Jeffay Report, Ex. 37, p. 8-10; emphasis added.) A combination of references is not anticipation, and the claim chart does not cite to any description in *Sass* in connection with this claim element. Accordingly, *Sass* cannot anticipate or render obvious claim 1 of the '952 Patent.

291. For at least the foregoing reasons, it is my opinion that *Sass* does not anticipate or render obvious the asserted claims of the Qureshey Patents. In addition, to the extent that Dr. Jeffay alleges that these claims are obvious from *Sass* in combination with the Busam patent (Jeffay Ex. 37, pp. 1, 3-8, and 15-19), I disagree for at least the reasons stated above that the

Busam patent is not prior art to the Qureshey Patents and Busam also does not disclose or suggest the claimed features of the Qureshey Patents. Accordingly, even if Busam and *Sass* could be combined, the combination would not meet the claimed requirements of the Qureshey Patents.

a. Sass in Combination with Hempleman

292. The Jeffay Report alleges that *Sass* in combination with *Hempleman* renders obvious "supplemental information related to a song" (which is an apparent reference to dependent claim 11 of the '652 patent, albeit not addressed in Dr. Jeffay's claim charts for the '652 Patent). (Jeffay Report, ¶ [0348].) I disagree. First, claim 11 depends from claim 1 of the '652 Patent. As described in my report, neither *Sass* nor *Hempleman* discloses or suggests all of the elements of independent claim 1, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Sass* and *Hempleman* would not disclose or suggest this claim element or any other dependent claims of the '652 Patent. (See e.g., Jeffay Report, ¶ [0348], reference to "optical disc" functionality, which could be interpreted as a reference to dependent claims 3, 44, and 50 of the '652 Patent albeit not referenced in Dr. Jeffay's claim charts.) Second, as described in connection with *Hempleman*, *Hempleman* does not disclose or suggest a user computing device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. Accordingly, *Sass* in combination with *Hempleman* also does not disclose or suggest this additional feature of claim 11.

6. Langdon - U.S. Patent No. 7,734,688

293. The Jeffay Report alleges that the Langdon patent ("*Langdon*") anticipates claims 1, 2, 3, 4, 9, 10, 11, and 14 of the '952 Patent, and claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 45, 47, 48, 50, 52, and 55 of the '652 Patent. (Jeffay Report ¶¶ [0196]-[0197].) In the alternative, the

Jeffay Report alleges in footnotes and without explanation that these claims are obvious from *Langdon*. (Jeffay Report, p. 79, footnotes 13 and 14.) I disagree for the reasons set forth below.

294. *Langdon* refers to a portable wireless music player that downloads "music or other programming" (i.e., content) to the player. (*Langdon*, Abstract.) The player device "plays the programming, which may be music, or an online radio station, or other online information." (*Langdon*, 6:63-65.)

295. To "keep the cost of the wireless device very low so that the devices are almost 'throw-away' devices" (*Langdon*, 4:1-7; also 4:29-35), the user utilizes a remote client on a separate personal computer 20 (i.e., a separate device than the wireless player device 40) to connect to a music provider 12 to predefine a collection of programming (referred to as a "play list" in *Langdon*) that is available for download to the wireless player device.

296. Specifically, *Langdon* states that its system "allows the user to predefine the play list at the music service provider from a remote terminal such as a computer connected to the Internet, and subsequently, the player downloads and plays the music tracks (or radio stations or other online information)." (*Langdon*, 6:19-23.) In other words, because the player device is "a simple device with limited functionality" (*Langdon*, 4:1-2; also 4:30-32), the user predefines, and the provider stores, information that identifies the content to be downloaded to the player device when the player device connects to the provider. (*Langdon*, 4:7-20, "the particular user has a predefined play list stored in database 14 of music provider 12"; also 2:44-46 and 2:61-63.) The player device "comprises instructions in the memory that direct the processor to connect the service provider over the wireless network, to download programming" (*Langdon*, 2:51-53; see also Abstract, "The player connects to the music service provider over a wireless service network and downloads music to the player").

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

297. In my opinion, *Langdon* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

298. The Jeffay Report cites to *Langdon*, 1:65-67, 2:36-38, 2:50-55, 5:18-21, and 6:22, as allegedly showing these claimed features. (Jeffay Ex. 40, pp. 1-4 and 37-39; Jeffay Ex. 41, pp. 15-19 and 47-50). However, as described above, the cited portions of *Langdon* only refer to a player device that downloads actual content (i.e., "music" or "programming") from a provider (e.g., *Langdon*, 2:36-38, 5:18-21). Receiving media content is not the same as receiving a playlist as set forth in the claims of the Qureshey Patents.

299. First, while the content downloaded to the player device is from a predefined collection of content stored by the provider (called a "play list" in *Langdon*), *Langdon* does not disclose or suggest that the player device downloads anything but the content itself. Actual content is not a playlist. In other words, the *Langdon* system operates in a similar manner to the system of the *White* patent described above, in which a "playlist" is created on the *White* server but the server only transmits the media content itself to the device. (*White*, 16:35-37 and 16:52-54.) Thus, in my opinion, *Langdon* is cumulative of (does not add anything new to) this similarly-deficient disclosure of *White*, which was previously considered by the PTO.

300. Second, *Langdon* states that the player device will only "display the files that are in memory" of the player device. (*Langdon*, 6:27.) Thus, even though the entire, predefined collection of items that is available from the provider can include "50 or even 100 items," if the

functionality of the player device is limited such that it can only store "two or three tracks at a time," the player device can only display two or three titles. (*Langdon*, 6:44-46; see also Figure 2, which shows a player device that can store at least 6 tracks at a time and thus can display 6 titles.) That the player device can only display the titles for the files that are stored in local memory, instead of the titles for the full collection of items that is available from the provider, further demonstrates that the player device does not receive a playlist as claimed. In addition, *Langdon* teaches away from increasing the functionality of the player device, stating that "the true advantage of the present invention is in that the portable wireless device may be implemented in a low-cost manner with limited functionality" (*Langdon*, 4:29-32; see also, 4:1-6, stating that "it is desirable to keep the cost of the wireless device very low so that the devices are almost 'throw-away' devices").

301. Lastly, I note that Dr. Jeffay quotes other references in connection with his alleged anticipation analysis in view of *Langdon*. For example, see Jeffay Ex. 40, p. 38, which cites to the Busam patent at 6:61-64 but incorrectly identifies the cited text as a quotation from *Langdon*: "*See also Langdon* 6:61-64 ("In some embodiments, the search can be restricted to just file names, just titles (e.g., movie titles, song titles, etc.), albums, artists, etc., or other information.")" (see also, Jeffay Ex. 41, pp. 16 and 47-48.) The Jeffay Report does not allege much less explain why the claims of the Qureshey Patents would have been obvious from this alleged combination and, in any event, in my opinion the Busam patent is not prior art to the Qureshey Patents for the reasons stated above. The Jeffay Report also cites to the claims of the *Langdon* patent (e.g., Jeffay Ex. 40, p. 37, 7:17-28), but has not demonstrated that these claims, which were modified during the prosecution of the *Langdon* patent, are entitled to the priority

date of the *Langdon* parent application and based on my review they are not. In any event, in my opinion these cited portions do not cure the deficiencies of *Langdon* identified above.

(2) receiving information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source

302. In my opinion, *Langdon* also does not disclose an electronic device that receives "information … enabling the electronic device to obtain the ones of the plurality of songs … from at least one remote source" ('952 Patent, claims 1 and 9; '652 Patent, claims 1 and 42).

303. The Jeffay Report argues that the portable player device in *Langdon* "receives information that puts the device into an operative condition for downloading one or more items, such as audio files" simply because the player device obtains the items from the music provider. I disagree.

304. First, the Jeffay Report does not cite to any particular "information" disclosed in *Langdon* that is received by the portable player device that allegedly satisfies this claim element. (Jeffay Ex. 40, pp. 7-9 and 40; Jeffay Ex. 41, pp. 19-21 and 50-52.) I disagree that it this claim element is necessarily met simply because the player device obtains content from the music provider.

305. Second, because the "obtaining" the content claim element and the "information enabling" claim element are separate claim elements in the claims of the Qureshey Patents, in my opinion the "information enabling" requirement cannot be interpreted to be the same or presumed satisfied simply because the content is obtained. ('952 Patent, claim 9; '652 Patent claims 1 and 42.)

306. Third, as described above, *Langdon* refers to a portable player device that obtains the content by executing "instructions in the memory that direct the processor to connect the service provider over the wireless service network, to download programming" (*Langdon*, 2:50-

53). In other words, the player device is configured to connect to the service provider, which then directs the downloading of content to the device. Thus, while the service provider may store information that identifies the locations of media items (e.g., URLs) that can be retrieved by the service provider for download to the device, there is no disclosure or suggestion in *Langdon* that this information is provided to the player device for use by the player device to obtain the content. The portable player device only receives the actual content from the media provider. (*Langdon*, 2:36-38, 5:18-21.) In my opinion, this pre-configuring of the player device to access the server provider, which then directs the download of content to the device, is similar to and at most cumulative of (does not add anything new to) the above described disclosure in *Logan* of a predetermined file directory for download of content (*Logan*, 6:53-55), which was previously considered by the PTO.

307. Lastly, *Langdon* teaches away from increasing the functionality or cost of the player device. (*Langdon*, 4:1-6, 4:29-32.) Thus, even assuming (without admitting) that it would have been possible to modify the player device in *Langdon* to meet this claim requirement without undue experimentation, *Langdon* teaches away from such a modification and it would not have been obvious to do so because it would have made the *Langdon* media player device inoperable for its intended purpose.

308. For at least the foregoing reasons, it is my opinion that *Langdon* does not anticipate or render obvious the asserted claims of the Qureshey Patents.

a. Langdon in Combination with Hempleman, Logan, McLaughlin, Sass and/or Lipscomb

309. The Jeffay Report alleges that *Langdon* in combination with *Lipscomb* renders obvious dependent claim 11 of the '652 patent, which is directed to, for example, an electronic device that sends a request to a remote server for supplemental information related to a song in

real-time while the song is playing. (Jeffay Report, ¶¶ [0197] and [0331].) I disagree. First, claim 11 depends from claim 1 of the '652 Patent. As described in my report, neither *Langdon* nor *Lipscomb* disclose or suggest all of the elements of independent claim 1, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Langdon* and *Lipscomb* would not disclose or suggest this claim element. Second, as described in connection with *Lipscomb*, *Lipscomb* does not disclose or suggest a user computing device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. Accordingly, *Langdon* in combination with *Lipscomb* also does not disclose or suggest this additional feature of claim 11.

310. The Jeffay Report alleges that *Langdon* in combination with *Sass* renders obvious dependent claims 13 and 55 of the '652 Patent, directed to, for example, receiving and displaying a recommended song. (Jeffay Report, ¶¶ [0197] and [0330].) I disagree. Claims 13 and 55 depend from independent claims 1 and 42 of the '652 Patent. As described in my report, neither *Langdon* nor *Sass* disclose or suggest all of the elements of these independent claims of the '652 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Langdon* and *Sass* would not disclose or suggest these claim elements.

311. The Jeffay Report also alleges that *Langdon* in combination with *Hempleman*, *Logan*, or *McLaughlin* renders obvious receiving input from a remote control that enables navigating a playlist (which is an apparent reference to dependent claims 8 and 49 of the '652 Patent, albeit not addressed in Dr. Jeffay's claim charts for *Langdon*). (Jeffay Report, ¶ [0325].) I disagree. Claims 8 and 49 depend from independent claims 1 and 42 of the '652 Patent. As described in my report, none of these references disclose or suggest all of the elements of the

independent claims 1 and 42 of the ‘652 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, these references would not disclose or suggest this claim element.

7. McLaughlin - U.S. Patent No. 5,581,479

312. The Jeffay Report alleges that the McLaughlin patent (“*McLaughlin*”) anticipates claims 1, 3, 4, 6, 7, 42, 44, 47, 49, 50, and 52 of the '652 Patent. (Jeffay Report ¶ [0200].) I disagree for the reasons set forth below.

313. The Jeffay Report does not cite or rely upon *McLaughlin* against the ‘952 Patent.

314. *McLaughlin* is directed to optimizing storage, retrieval and transmission of large digital data files that can include video games, video, audio, and other data types to deliver large amounts of data across improved networks sufficient to carry an NTSC encoded signal. (*McLaughlin*, 3:37-39.) Applications of the system "include simultaneous transmission of interactive educational titles to a group of subscribers, video game championships, etc." (*Mclaughlin*, 10:13-15.)

315. To obtain a media item, a customer device interacts with a subscriber interface to send a request to an Information Service Control Point (ISCP) using an unspecified protocol. (*McLaughlin*, 5:58-67.) Details of the subscriber interface and the protocol used "depend upon the nature of the service, and, on the network of the service provider …" (*McLaughlin*, 5:62-6:1) and are not disclosed in *McLaughlin*. Subscriber interfaces at the priority date of the *McLaughlin* patent were typically telephones in a customer residence.

316. A Request Fulfillment Unit (RFU) within the ISCP is in communication with a customer and receives requests from the customer's subscriber interface. (*McLaughlin*, 6:57-58.) *McLaughlin* indicates the design of the RFU allows for directly requesting a title or enabling the customer to perform an initially more general title search aided by functions within the RFU to

narrow down a selection. (*McLaughlin*, 7:4-9, "The communication can be either a direct request for a specific title or a more general request requiring further interactive communication between the RFU 8 and the interface 7. The RFU 8 recognizes whether the request is specific or general, and processing branches accordingly (step S2).") How this might be done is only generally alluded to. (*McLaughlin*, 7:20-24, "Various formats may be employed to facilitate this phase of interactive communication, such as menu screens, voice prompts, etc. (step S3). This phase of interaction ends when the subscriber has requested one or more specific titles (step S2).")

317. After provisioning of a customer selection is validated, the ISCP establishes a communications path and begins sending the data. (*McLaughlin*, 9:8-12, "If the RFU 8 determines at step S8 that it is feasible to fulfill the "M+1st" request, the ISCP 6 establishes a communications path to the subscriber's premises 2 (step S10) and commences transmitting the data that constitutes the title requested (step Sll).")

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

318. In my opinion, *McLaughlin* does not disclose or suggest an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('652 Patent, claims 1 and 42).

319. The Jeffay Report alleges that the description in *McLaughlin* that "one or more specific titles are chosen" by a user (*McLaughlin*, 7:33) discloses or suggests a playlist that meets these claim requirements of the '652 Patent. (E.g., Jeffay Ex. 43, p. 6; also Jeffay Report, ¶ [0199].) Dr. Jeffay acknowledges that the playlist functionality is not explicitly disclosed, but argues that "If multiple titles are chosen the titles implicitly form a playlist, and it is inherent and/or obvious that the titles would have been played in some sequence (or in parallel)." (E.g.,

Jeffay Ex. 43, p. 6; underlining added.) In addition, the Jeffay Report alleges that following statement from *McLaughlin* discloses the assignment of a playlist to a device: "Finally, the retrieved data blocks are transmitted from the central station to the remote station." (E.g., Jeffay Ex. 43, p. 6, citing *McLaughlin*, Abstract.) I disagree.

320. As described above, *McLaughlin* relates to a user computer that allows a user to select one or more specific titles. Even assuming that allowing a user to selecting one or more titles refers to an ability for the user to manually create a playlist (Dr. Jeffay acknowledges *McLaughlin* does not refer to it as a playlist), this selection function is performed locally on the user's device. This does not disclose or suggest a playlist that is assigned to the user's device by a central system and received by the device as claimed in the '652 Patent. Accordingly, *McLaughlin* is fundamentally different than the inventions claimed in the '652 Patent. In my opinion, at most *McLaughlin* is cumulative of the *Abecassis* patent described below, which also referred to creation of a playlist locally on a user's device and which was previously considered by the PTO examiner. *McLaughlin* and *Abecassis* do not disclose or suggest the inventions claimed in the '652 Patent, including a central server for causing playlists to be assigned to user devices, and after a playlist is assigned, a user device that receives the playlist and information and enabling the user's device to obtain one or more songs from a remote source rather than local storage of the user's device.

321. In addition, the retrieval of "data blocks" (i.e., actual media content) by the user's computer in *McLaughlin* does not show or suggest the receipt of a playlist assigned to an electronic device as claimed in the '652 Patent. Dr. Jeffay's argument that this shows the receipt of a playlist (e.g., Jeffay Ex. 43, p. 7, citing *McLaughlin*, Abstract) conflates the requirement for the receipt of a playlist, which identifies content, with the receipt of the content itself. In my

opinion, a person having ordinary skill in the art would not have understood the transmission and receipt of media content itself to satisfy the requirement for the receipt of a playlist identifying a plurality of songs as claimed in the '652 Patent. For example, the claims of the '652 Patent define that receiving the playlist and obtaining the content are separate claim requirements. ('652 Patent claim 42, defining "obtaining the … songs" as being separate from "receiving … a playlist"; also '652 Patent claim 1, "obtain the … songs" separate from "receive the playlist.")

322. In view of these plain differences, it is my opinion that *McLaughlin* does not anticipate or render obvious the asserted claims of the Qureshey '652 Patent for at least the foregoing reasons. In addition, to the extent that Dr. Jeffay alleges that these claims are obvious from *McLaughlin* in combination with the Busam patent (E.g., Jeffay Report, ¶ [0200]), I disagree for at least the reasons stated above that Busam patent is not prior art to the Qureshey '652 Patent and also does not disclose or suggest the claimed features of the '652 Patent. Accordingly, even if the Busam patent and *McLaughlin* could be combined, the combination would not meet the claimed requirements of the Qureshey '652 Patent.

a. McLaughlin in Combination with Langdon

323. The Jeffay Report alleges that *McLaughlin* in combination with *Langdon* renders obvious dependent claims 4, 7, 10, and 52 of the '652 patent, directed to, for example, a data storage device, wireless transceiver, and playing audio through a speaker. (Jeffay Report, ¶ [0200].) I disagree. These claims depend from independent claims 1 and 42 of the '652 Patent. As described in my report, neither of these references discloses or suggests all of the elements of independent claims 1 and 42 of the '652 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, these references would not disclose or suggest this claim element.

8. Abecassis - U.S. Patent No. 6,192,340

324. The Jeffay Report alleges that the Abecassis patent ("*Abecassis*") anticipates claims 1, 2, 3, 9, 10, and 14 of the '952 Patent, and claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 45, 47, 48, 49, 50, 52, and 55 of the '652 Patent. (Jeffay Report ¶¶ [0203]-[0204].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that these claims are obvious from *Abecassis*. (Jeffay Report, pp. 81-82, footnotes 15 and 16.) I disagree for the reasons set forth below.

a. Abecassis was Considered by the USPTO in the Prosecution of the Qureshey Patents

325. As an initial matter, I note that *Abecassis* was considered by the United States Patent & Trademark Office ("PTO") during the prosecution of the '952 and '652 Patents. *Abecassis* is cited on the face of each of the '952 and '652 Patents (Jeffay Ex. 1, BHM-ITC-000195 and Jeffay Ex. 2, BHM-ITC-000270), and was initialed by the PTO patent examiner as considered. ('952 and '652 Patent Prosecution Histories, BHM-ITC-007593 and BHM-ITC-008311.) Thus, the PTO determined that the claims of the Qureshey Patents are novel and nonobvious in view of *Abecassis*. I understand that this is a factor to consider when opining on the validity of an issued patent. However, Dr. Jeffay did not mention this in his report.

b. Abecassis Does Not Disclose or Suggest the Inventions Claimed in the Qureshey Patents

326. In my opinion, and as previously determined by the PTO, *Abecassis* does not disclose or suggest the inventions claimed in the Qureshey Patents. Accordingly, for at least the reasons set forth below, it is my opinion that the asserted claims of the Qureshey Patents are valid over *Abecassis*.

327. *Abecassis* relates to a system for selecting, and providing to a user's device, informational items that are based on the user's preferences (e.g., preferences relating to news, weather reports, advertisements, jokes). (*Abecassis,* Abstract and 17:13-15.) The system

performs "interleaving and sequencing, for the user, a playing of the information items with a playing of a plurality of musical items included in an audio library of the user." (*Abecassis*, Abstract; also 20:66-21:6.) The musical items of the user's audio library can be stored locally by the user's device (in the user's "physical audio library"), or remotely (in the user's "virtual audio library"). (*Abecassis*, 14:35-59 and 2:36-43.) When a musical item is stored remotely, the musical item may be identified by a URL in the local database of the user's device. (*Abecassis*, 14:55-57 and 2:50-51.)

328. *Abecassis* describes two different ways to sequence musical items and informational items for playing to a user. In both approaches, only the actual content (i.e., informational and/or musical items) is provided to the user's device (i.e., the user's "Multimedia Player") after the user device communicates the user's preferences to a provider. (E.g., *Abecassis*, Figures 7, 8, and 11 and 22:37-38, "the information preferences are communicated to an information provider 752"; also, Figure 9 and 27:43-44, "the appropriate user preferences are communicated to the provider.") The user's preferences may be defined, for example, using the graphical user interface displays shown in Figures 5 and 6.

329. In the first approach, the user's device sends the user's preferences to a provider and the "provider then applies the user's preferences, interleaves and sequences the audio and information, and produces a seamless transmission of sequenced and interleaved audio and information that is responsive to the user's preferences and which is played" (*Abecassis*, 27:44-49).

330. In the second approach, the user's device again sends the user's preferences to the provider but then "the audio and/or information that may be required is downloaded from the provider …. In this case the interleaving and sequencing of the audio and information responsive

to the user's preferences 942 is performed by the Multimedia Player" (*Abecassis*, 27:56-60; see also 22:7-15, referring to a "Multimedia Player … processor for interleaving and sequencing, for the user, a playing of the received information with a playing of a plurality of music items"; also 28:1-5).

331. To configure a device with the user's preferences, *Abecassis* describes that the user can cause the device to load the user's preferences from a portable access media "similar to moving a game cartridge from a first game player to a second game player." (*Abecassis*, 13:23-42.)

332. *Abecassis* uses the word "playlist" in its description, but in each instance it refers to one of the two approaches described above for sequencing musical items and informational items for playing by the user's device. That is, the playlist is either a sequence that is constructed locally by the user's device (e.g., *Abecassis*, 15:45-51, "a user's directly prepared and ordered playlist of audio units selected by the user from the user's audio library" or automatically generated from the user's library), or alternatively, a sequence that is constructed remotely by a provider followed by transmission of only the content to the user's device, not the playlist (e.g., *Abecassis*, 21:24-25, "the arrangement of programming conducted by a radio station producer").

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

333. In my opinion, *Abecassis* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

334. First, Dr. Jeffay alleges that "a person having ordinary skill in the art at the time of the alleged invention would have understood that transferring audio between devices is one embodiment of providing the playlist to the electronic device." (Jeffay Ex. 45, p. 7.) I disagree. This plainly conflates the requirement for the receipt of a playlist, which identifies content, with the receipt of the content itself. In my opinion, a person having ordinary skill in the art would not have understood the transmission and receipt of audio content itself to satisfy the requirement for the receipt of a playlist identifying a plurality of songs as claimed in the Qureshey Patents. For example, the claims of the Qureshey Patents define that receiving the playlist and obtaining the content are separate claim requirements. ('952 Patent claim 9 and '652 Patent claim 42, defining "obtaining the … songs" as being separate from "receiving … a playlist"; also '652 Patent claim 1, "obtain the … songs" separate from "receive the playlist.")

335. Second, the Jeffay Report cites to *Abecassis*, 15:45-51, as allegedly showing these claimed features. (Jeffay Report, p. 81, Jeffay Ex. 45, pp. 2 and 29; Jeffay Ex. 46, pp. 7 and 53). However, as described above, this cited portion of *Abecassis* only refers to "a user's directly prepared and ordered playlist of audio units selected by the user from the user's audio library," or a playlist that is automatically generated from the user's library. (*Abecassis*, 15:45-51, emphasis added.) The playlist is created locally on the device; it is not assigned to the device as required by the claims of the Qureshey patents, which is fundamentally different.

336. In addition, although not cited in the Jeffay Report, as described above *Abecassis* states that the sequence of interleaved audio and information can be generated by the provider. (*Abecassis*, 27:44-49.) However, the provider only provides the actual content to the user's device. *Abecassis* does not disclose or suggest that the server sends the playlist itself to the

user's device, including the titles corresponding to the selected audio content that "identif[y] the plurality of songs," as claimed in the Qureshey Patents.[5]

337. In view of these plain differences, it is my opinion that *Abecassis* does not anticipate or render obvious the asserted claims of the Qureshey Patents for at least the foregoing reasons. In addition, as described above, the PTO examiner considered the *Abecassis* reference and determined that it is not disclose or suggest the claimed inventions of the Qureshey Patents.

9. Hempleman - U.S. Patent No. 6,243,725

338. The Jeffay Report alleges that the Hempleman patent ("*Hempleman*") anticipates claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 47, 49, 50, and 52 of the '652 Patent. (Jeffay Report ¶ [0207].) I disagree for the reasons set forth below.

339. The Jeffay Report does not cite or rely upon *Hempleman* against the '952 Patent.

340. *Hempleman* refers to a system that allows users to "rip" songs from a CD and store them locally on the user's device, which is a personal computer. Using the personal computer, a user can then locally create a "playlist" of preferred "audio musical, works or audio/visual works, such as music videos." (*Hempleman*, Abstract) While the playlist can include media such as songs that are stored locally or remotely, the playlist is always stored locally on the user's device. Indeed, the *Hempleman* playlists are always created, stored, and used by a user on a personal computer system that belongs to the user (e.g., *Hempleman*, Figure 1, Steps 2 and 4). Figure 2 shows a standalone system that does not require a network connection. Figures 5-7 show systems capable of operating in networked modes. In all of these

[5] The Jeffay Report also cites to *Abecassis*, 13:62-14:7, which states that a user device can transfer to another user device the "user's preferences, selection criteria, audio, and/or a radio-on-demand session." (Jeffay Ex. 45, pp. 3 and 31; Jeffay Ex. 46, pp. 23 and 27.) This does not disclose or suggest assigning a playlist identifying a plurality of songs as claimed in the Qureshey Patents. For example, a radio-on-demand session is simply a recording of the sequence of audio and information (i.e., the actual content) played on a user device. (E.g., Abecassis, 24:13-14, "recording … the radio-on-demand session as it is being played.")

systems, the playlist is created and stored on the user's computer, within local storage element 12b.

341. In my opinion, *Hempleman* is fundamentally different than the inventions claimed in the ‘652 Patent. For example, *Hempleman* does not disclose or suggest core features of the ‘652 Patent, including an electronic device that receives a playlist assigned to the device from a central or remote system, where the playlist identifies a plurality of songs, and the receipt of information enabling the user's device to obtain one or more songs from a remote source rather than local storage of the user’s device.

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

342. In my opinion, *Hempleman* does not disclose an electronic device that “receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs” (‘652 Patent, claims 1 and 42).

343. The Jeffay Report alleges that *Hempleman* discloses these features at 3:34-37 and 6:38-43. (E.g., Jeffay Ex. 48, pp. 7-8.) I disagree. As described above, *Hempleman*'s "playlists" are always created and stored locally and stored only on the user device, i.e., a personal computer (*Hempleman*, 3:1-12), not a central system as claimed. (*Hempleman*, Figures 1, 2, 5, 6, 7; 3:24-53, 4:4-30, 6:33-8:15.) In Figure 2, *Hempleman* shows that the user builds playlists that reference only his/her locally stored songs or media, i.e., their private media library, and store the playlists in the local database at 12b. In addition, in each of the embodiments associated with Figures 5-7, the system includes a remote source of media that may be assembled and presented to a user, but the playlist is still created and stored locally. In Figure 5, once the local assembly of a playlist is complete the playlist is stored on the user's computer in database 12b. (*Hempleman*, 4-26-30.) Figures 6 and 7 also show systems that locally create and store playlists

in the user's local database 12b (*Hempleman*, 7:11-15), albeit in other contexts such as for a system with billing features and/or use in public establishments. Accordingly, *Hempleman* is fundamentally different than the inventions claimed in the '652 Patent.

344. In addition, in my opinion, *Hempleman* is at most cumulative of *Abecassis* described above, which was previously considered by the PTO examiner. Like *Hempleman*, *Abecassis* also relates to creation of a playlist locally on a user's device, not to a central server for causing playlists to be assigned to specific user devices, and after a playlist is assigned, a user device that receives the playlist and information enabling the user's device to obtain one or more songs from a remote source rather than local storage of the user's device.

(2) Internet radio mode of operation

345. In my opinion, *Hempleman* also does not disclose an Internet radio mode of operation. ('652 Patent, Claim 1 "enable a user of the electronic device to select a desired mode of operation from a plurality of modes of operation comprising an Internet radio mode of operation and a playlist mode of operation"; also claim 42.)

346. *Hempleman* only refers to creating playlists locally on the user's device, where the playing of content is dictated by the sequence of the playlist assembled and then stored on the user's local computer. (*Hempleman*, Figures 1, 5-7; 3:19-23; 3:44-49.) *Hempleman* does not disclose or suggest an Internet radio mode of operation and Dr. Jeffay points to none. As stated above, merely having the ability to access content over a network does not mean that the device has the capability to access and play Internet radio broadcasts as claimed.

(3) send a request to a remote server for supplemental information related to a song in real-time while the song is playing

347. In my opinion, *Hempleman* also does not disclose or suggest an electronic device that is configured to "send a request to a remote source for supplemental information related to a song in real-time while the song is playing" ('652 Patent, claim 11).

348. In connection with this claim, the Jeffay Report cites to portions of *Hempleman* that fail to show or suggest the features of this claim. (Jeffay Ex. 48, p. 43, citing *Hempleman*, 3:1-6 and 6:7-13.) The first citation does not address supplemental information at all, but rather the acquisition of content. The second citation describes the display of information to the user during editing of database tables, not during the playing of songs obtained using information from a playlist assigned from a central system.

349. For at least the foregoing reasons, it is my opinion that *Hempleman* does not anticipate or render obvious the asserted claims of the '652 Patent.

a. Hempleman in Combination with Sass and/or Logan

350. The Jeffay Report alleges that *Hempleman* in combination with *Sass* renders obvious dependent claims 13 and 55 of the '652 Patent, directed to, for example, receiving and displaying a recommended song, and claims 1, 6, 42, and 47 relating to Internet radio broadcasts. (Jeffay Report, ¶¶ [0207], [0305], and [0307].) I disagree. Claims 6, 13, 47, and 55 depend from independent claims 1 and 42 of the '652 Patent. As described in my report, neither *Hempleman* nor *Sass* disclose or suggest all of the elements of these independent claims of the '652 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Hempleman* and *Sass* would not disclose or suggest these claim elements.

351. The Jeffay Report alleges that *Hempleman* in combination with *Logan* renders obvious claims 1, 6, 42, and 47 relating to Internet radio broadcasts. (Jeffay Report, ¶ [0314].) I disagree. Claims 6 and 47 depend from independent claims 1 and 42 of the '652 Patent. As

described in my report, neither *Hempleman* nor *Logan* disclose or suggest all of the elements of these independent claims of the '652 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Hempleman* and *Logan* would not disclose or suggest these claim elements.

10. RealPlayer and the Black Report

352. The Jeffay Report alleges that all of the asserted claims of the '952 Patent, i.e., claims 1, 2, 3, 4, 9, 10, 11, 12, and 14, are anticipated by three separate executable software files for versions G2, 7, and 8 of the RealPlayer software, and by three separate user manuals for that software (hereafter, all six items will be collectively referred to as "*RealPlayer*" unless specifically noted). (Jeffay Report ¶¶ [0215].) The Jeffay Report also alleges that all of the asserted claims of the '652 Patent, i.e., claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 45, 47, 48, 49, 50, 52, and 55, are anticipated by *RealPlayer*. (Jeffay Report ¶ [0217].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that these claims are obvious from *RealPlayer*. (Jeffay Report, pp. 86-87, footnotes 17 and 18.) I disagree for the reasons set forth below.

a. RealPlayer is Not Prior Art to the Qureshey Patents

353. The Jeffay Report relies on the transcript of the October 14, 2013 deposition of a RealNetworks employee, Mr. Matthew Eccles ("Eccles Tr."), and the Black Report, for Dr. Jeffay's opinion and understanding that *RealPlayer* is prior art to the Qureshey Patents. (Jeffay Report, ¶ [0208], "In forming my opinion on the RealPlayer systems, I have reviewed the expert report submitted by Dr. Jerry Black (Exhibit 49), as well as the deposition of Matthew Eccles (Exhibit 50) and all of the materials submitted therewith.")

354. The Black Report was provided by Dr. Jerry Black on November 11, 2013 to address the alleged functionality of the RealPlayer software. (Jeffay Ex. 49, ¶ 12.) Dr. Black had

"not been asked to review any patents or form an opinion on the validity of any patents." (Black Report, ¶ 17.) The Black Report also relies on the Eccles deposition. (Black Report, ¶ 13, "In preparation of this report, I have reviewed a variety of information and documents including the deposition of Matthew Eccles, the exhibits to the deposition of Matthew Eccles, and a variety of other publicly available documents related to the Real Player systems"). Dr. Black purports to rely on "personal knowledge" regarding when the various versions of the *RealPlayer* software and manuals were "available" or "available to the public" (Black Report, ¶¶ 29, 30, and 31), but the only documents and software the Black Report cites are the versions referenced in the Eccles deposition. The Black Report did not provide any "other publicly available documents related to the Real Player systems." (Black Report, ¶ 13.)[6]

355. Based on my review of the Jeffay Report, the Black Report, and the Eccles deposition, it is my opinion that *RealPlayer* has not been established to be prior art to the Qureshey Patents and cannot be established as prior art based on these materials. Indeed, the

[6] The Black Report also makes a number of statements regarding what features of the *RealPlayer* software and system were allegedly publicly available and in public use in the United States, and the dates of such public availability and use, without citing to or providing any documentary evidence in support. The sole basis for Dr. Black's statements is that "In April 1995, I began working for Real Networks" and "I remained at RealNetworks, Inc. until April, 2009." (Jeffay Ex. 49, Black Report ¶¶ 8-10.) This includes, for example, Dr. Black's statements regarding the alleged preloading of *RealPlayer* software onto personal computers and associated contractual agreements between RealNetworks and Microsoft (Black Report ¶ 35), alleged "Timecast" functionality of *RealPlayer* (Black Report ¶¶ 36, 65, 68), alleged RealNetworks promotional materials (Black Report ¶ 48), alleged RealNetworks website instructions regarding how to set up a RealServer and host content (Black Report ¶¶ 55, 71), alleged "Take5" functionality of *RealPlayer* (Black Report ¶ 65, 67), alleged "channels" accessible to *RealPlayer* (Black Report ¶ 69), alleged sharing of RAM files (Black Report ¶ 74), and alleged characteristics of "home networks" utilizing the *RealPlayer* software (Black Report ¶ 75). The Black Report did not cite to or attach any documents that would support or confirm Dr. Black's statements, or that would explain the functionality of these alleged features. RealNetworks also did not produce any documents on these topics in response to the subpoena, nor was RealNetworks' employee, Mr. Eccles, questioned at his deposition on these topics or about Dr. Black's responsibilities while at RealNetworks. In my opinion, the Black Report does not establish that these alleged features of the *RealPlayer* software and system were publicly available or in public use in the United States before the inventions claimed in the Qureshey Patents, nor does the Jeffay Report do so to the extent that the Jeffay Report purports to rely on these statements. In any event, it is my opinion that *RealPlayer* does not disclose or suggest the claimed invention of the Qureshey Patents for the reasons stated in my report.

reliability and accuracy of all of the underlying bases for Dr. Jeffay's assertion that *RealPlayer* is prior art were called into question by Mr. Eccles at his deposition.

356. Specifically, at the time of his deposition, Mr. Eccles had only held his current position of Associate General Counsel at RealNetworks for just over 1 year and had only been employed by RealNetworks Ltd. of the UK in another capacity since March 2005. (Eccles Tr., 7:22-24 and 24:23-24.) Thus, Mr. Eccles did not have personal knowledge regarding any *RealPlayer* software or manuals that might have been published before 2005 or when any were published. In addition, Mr. Eccles acknowledged that although he tried to prepare himself to testify on behalf of RealNetworks, some of the topics of the subpoena "will be beyond my scope of knowledge." (Eccles Tr., 9:11-12.)

357. Mr. Eccles testified that there were 3 sources of information that he consulted in order to prepare for his deposition and to provide an opinion regarding when the *RealPlayer* software and manuals were believed to have been publicly released: (i) a non-public RealNetworks software repository located behind a RealNetworks firewall[7]; (ii) copyright notices in the *RealPlayer* manuals[8]; and (iii) searches performed via a Google public search engine[9]. However, Mr. Eccles himself called into question the accuracy and reliability of these sources of information during his deposition.

358. First, regarding the non-public RealNetworks software repository, Mr. Eccles acknowledged that in order to be able to determine if the *RealPlayer* software was actually made available to the public instead of just placed within non-public storage behind a RealNetworks

[7] Non-public software repository: Eccles Tr., 26:17-27:1, testifying that he looked at "a software repository, which is behind a RealNetworks firewall, so only RealNetworks personnel can access it."
[8] Copyright notices: Eccles Tr., 26:12-14, testifying that his conclusions regarding the date of availability of a user manual were "based on the copyright notice in the associated manual."

firewall, Mr. Eccles would "have to ask some employees who were around at that time, and seek further market information, which I – I believe is available through – through public search engines." (Eccles Tr., 27:7-21.) None of this additional information was sought by Mr. Eccles or provided by RealNetworks in response to the subpoena. Accordingly, Mr. Eccles was unable to conclude that the *RealPlayer* software was actually made available to the public (instead of just internally stored by RealNetworks) as of the alleged release dates.

359. In addition, even as to the alleged release dates, Mr. Eccles was not able to determine the alleged release date with any specificity, further calling into question the accuracy and reliability of the information he reviewed. (*RealPlayer* version G2: Eccles Tr., 26:9-11, 10:24-11:4, and 15:8-16:10, testifying "I cannot tell you that. I don't know." as to the month that *RealPlayer* version G2 was alleged to have been released but he "believed" it was sometime in 1998; *RealPlayer* version 7: Eccles Tr., 28:2-23, 12:24-13:3, and 16:16-17:12, testifying "No" as to whether he could state the month that *RealPlayer* version 7 was alleged to have been released but he "believed" it was in "the 1999 time period."; *RealPlayer* version 8: Eccles Tr.,14:19-20 and 17:23-18:17, testifying that he "believed" *RealPlayer* version 8 was initially launched to the public in "the latter half of 1999.").

360. Second, while purporting to rely on copyright notices in the *RealPlayer* manuals, Mr. Eccles actually refuted the dates contained in these notices. For example, regarding the version 7 manual, Mr. Eccles believed that this manual would have been available in "approximately" the "1999 time period" (Eccles Tr., 16:16-17:12), which conflicts with the "2000" copyright notice in the manual (Jeffay Ex. 54, REAL8820000085, "©RealNetworks, Inc.

---

[9] Google searches: Eccles Tr., 27:23-24 ("I have used Google to try and ascertain when the RealPlayer G2 was launched"); 28:24-29:3 (regarding *RealPlayer* version 7, "Again, I did a Google search"); 29:7-24 (regarding *RealPlayer* version 8, acknowledging that he "did a public search engine search").

2000"). Similarly, regarding the version 8 manual, Mr. Eccles testified that he believed the manual would have been available in "the latter half of 1999" (Eccles Tr., 14:19-20), which again conflicts with the "2000" copyright notice in the manual (Jeffay Ex. 56, REAL8820000193, "©RealNetworks, Inc. 2000"). No explanation for this discrepancy was provided and neither Mr. Eccles nor RealNetworks provided any documentation that would support the earlier (and admittedly approximate) dates to which Mr. Eccles testified. Mr. Eccles and RealNetworks also did not testify with respect to any RealNetworks practices or procedures with respect to the placement of copyright notices on RealNetworks documents (e.g., what can be determined from a "2000" copyright notice in a RealNetworks document?).

361. Third, while purporting to rely on Google searches, Mr. Eccles acknowledged that Google searches are not reliable as proof of the dates when *RealPlayer* was alleged to have been publicly released. (Eccles Tr., 29:7-24, testifying that a Google search indicated a date of "October 1999 date or thereabouts" for version 8 of RealPlayer, but "I'm not tremendously confident about the October date.")

362. Mr. Eccles' testimony, at most, established that RealNetworks had a copy of the software in its non-public archive. He does not have the personal knowledge of the software and user manuals, and did not show as the records custodian that these records were maintained during the course of RealNetworks' normal course of business. He did not show that the records were made at or near a date certain by someone with knowledge, during the ordinary course of business, or that making the record was a regular practice of the business. In view of the foregoing, it is my opinion that the *RealPlayer* versions G2, 7, and 8 have not been established to be prior art to the Qureshey Patents and cannot be established as prior art based on the materials relied upon in the Jeffay Report.

b. RealPlayer Does Not Disclose or Suggest the Inventions Claimed in the Qureshey Patents

363. It is also my opinion that, irrespective of whether *RealPlayer* is prior art, *RealPlayer* does not disclose or suggest the claimed invention of the Qureshey Patents. For example, *RealPlayer* does not disclose or suggest at least the claim elements of the Qureshey Patents discussed below.

364. The *RealPlayer* version G2, 7, and 8 user manuals and executable (.exe) files relate to software for a personal computer (PC) that "gives you access to multimedia both on the Internet and locally on your computer." (Jeffay Ex. 52, G2 manual, REAL8820000018.) Specifically, *RealPlayer* plays media "clips" for the user, which "can be video, audio, video with audio, RealFlash™ animation, RealText™, RealPix™, any combination of these or something completely different." (Jeffay Ex. 52, G2 manual, REAL8820000018.) "Some clips contain more than one song or video; these are called *multi-clips*. A *Multi-clip* strings together several individual clips of content, but you only have to click on it a single time to hear or see all of the media associated with that clip." (Jeffay Ex. 52, G2 manual, REAL8820000018; also Jeffay Ex. 54, 7 manual, REAL8820000108; Jeffay Ex. 56, 8 manual, REAL8820000214.)

365. The *RealPlayer* user manuals state that the *RealPlayer* software could play a clip, or a multi-clip, in response to a user double clicking a RAM (".ram") file or a link to a RAM file. (Jeffay Ex. 52, G2 manual, REAL8820000057, "When you click on a link or a file, Windows checks to see what program is associated with that file-type and automatically launches that program (e.g., double-clicking on a .ram file should launch RealPlayer Plus and begin to play a clip)"; also Jeffay Ex. 54, 7 manual, REAL8820000152; Jeffay Ex. 56, 8 manual, REAL8820000261.) (See also, Jeffay Ex. 52, G2 manual, REAL8820000073, "File Extension: … RAM … RealAudio/RealVideo streamed content"; also Jeffay Ex. 54, 7 manual,

REAL8820000169; Jeffay Ex. 56, 8 manual, REAL8820000284.) The RealPlayer version 8 manual (but not the G2 or version 7 manuals) also states that in the version 8 software "You can create a multi-clip by selecting playable files (clips) from your local directory and dropping them into the player. … This creates a temporary *.*ram* file that links the selected files." (Jeffay Ex. 56, G2 manual, REAL8820000209.)

366. The *RealPlayer* user manuals refer to the multiple media clips that could be played in response to a user accessing a multi-clip RAM file as a "Playlist." (Jeffay Ex. 52, G2 manual, REAL8820000017, "The Playlist bar will not be available unless you are playing a *multi-clip* (a clip that contains other clips in sequence)"; Jeffay Ex. 54, 7 manual, REAL8820000105; Jeffay Ex. 56, 8 manual, REAL8820000209.) Despite this nomenclature, when a multi-clip RAM file was accessed and the first clip referenced in the RAM file was played, only then would the *RealPlayer* receive and display the "title of current clip in Playlist." (Jeffay Ex. 52, G2 manual, REAL8820000017, REAL8820000073, REAL8820000081; Jeffay Ex. 54, 7 manual, REAL8820000105 and REAL8820000189; Jeffay Ex. 56, 8 manual REAL8820000209 and REAL8820000294.) Titles for other clips in the RAM file were not received until those clips were actually played. This is because RAM files only contained the location of each clip but not the names or titles of the clips. This was confirmed via tests of the RealPlayer G2, 7, and 8 executable files as described in greater detail below. (Jeffay Exs. 51, 53, and 55, REAL8820000001_1 (G2 exe), REAL8820000001_2 (7 exe), REAL8820000001_3 (8 exe).)

(1) receiving a playlist identifying a plurality of songs

367. In my opinion, *RealPlayer* does not disclose an electronic device that "receiv[es] … a playlist … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent,

claims 1 and 42) or a "playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

368. The Jeffay Report relies exclusively on the ability for *RealPlayer* to "play a metafile or RAM file, also known as a multiclip" as allegedly showing these claimed features, and cites to the *RealPlayer* manuals, software, and the Black Report in alleged support. (E.g., Jeffay Ex. 57, pp. 2, 10, and 40; also Jeffay Ex. 58, pp. 29 and 63.) However, as described above, accessing a multi-clip RAM file with *RealPlayer* only allows the user's computer to identify the locations where the media clips are stored. The RAM file is not a "playlist identifying a plurality of songs" as claimed in the Qureshey Patents.

369. First, as described above, the RAM file only identifies the locations of media clips. However, receiving the location of a file does not identify the contents of the file, much less "identif[y] a plurality of songs" as claimed. The underlying content that can be accessed by the user's computer via the locations referenced in the RAM file "can be video, audio, video with audio, RealFlash™ animation, RealText™, RealPix™, any combination of these or something completely different." (Jeffay Ex. 52, G2 manual, REAL8820000018; also Jeffay Ex. 54, 7 manual, REAL8820000108; Jeffay Ex. 56, 8 manual, REAL8820000214.) As explained above, the RAM file does not include the name or title of each media file. Indeed, the name or title of each file is not received by or identified to the user's device until (if and when) the file is actually played. Thus, even though the *RealPlayer* manuals refer to the underlying collection of content as a "Playlist," the user's computer never actually receives a list of media items that "identif[ies] a plurality of songs" as claimed in the Qureshey Patents. This is confirmed by the *RealPlayer* user manuals, which state that *RealPlayer* can only display the "title of current clip in Playlist." (Jeffay Ex. 52, G2 manual, REAL8820000017, REAL8820000073,

REAL8820000081; Jeffay Ex. 54, 7 manual, REAL8820000105 and REAL8820000189; Jeffay Ex. 56, 8 manual REAL8820000209 and REAL8820000294.)

370. Second, tests were performed on the *RealPlayer* software (.exe) files produced by RealNetworks and relied upon in the Jeffay Report. (Jeffay Exs. 51, 53, and 55, REAL8820000001_1 (G2 exe), REAL8820000001_2 (7 exe), REAL8820000001_3 (8 exe).) Specifically, the tests performed by Dr. Black on a multi-clip RAM file that contained the locations of two media files were reproduced. (Jeffay Ex. 49, Black Report, ¶¶ 77-80.) The following screen captures were taken during the tests:

RealPlayer G2 RealPlayer 7 RealPlayer 8

371. As shown above, only after the *RealPlayer* software accessed the RAM file and played the first clip did the *RealPlayer* software receive, and then display, the title of the first clip (i.e., "Welcome to RealAudio 3.0"). This demonstrates that RealPlayer does not receive a list of media items "identifying a plurality of songs" as claimed in the Qureshey Patents. Indeed, because the user computer did not receive a playlist identifying a plurality of songs, the user computer was unable to identify the title or name of the second clip via the user interface. Rather, the *RealPlayer* software could only reference the existence of a second clip generally

(which could be video, audio, text, etc.) in the pull-down menu as "Clip 2." The user computer had to wait for delivery of the actual content corresponding to the second clip in order to display the name or title of the clip via the *RealPlayer* interface. This is in contrast to the inventions claimed in the Qureshey Patents, in which the playlist "identifying a plurality of songs" is provided to the electronic device in advance of playback. Thus, advantageously, the electronic device claimed in the Qureshey Patents already has the identifying information it needs to display the titles of the songs of the playlist via the user interface, for example, before a song is played or once playback begins.

372. Third, at most, a multi-clip RAM file allows a user computer with *RealPlayer* to obtain media items from a remote source if, in fact, the location information in the RAM file points to remotely stored media clips instead of local storage. I note that the Jeffay Report relies on the same information (i.e., location information in a multi-clip RAM file) as allegedly satisfying two separate claim requirements. Specifically, in addition to the claim requirement for a "playlist identifying a plurality of songs," the Jeffay Report relies on the same disclosure of a multi-clip RAM file as allegedly satisfying the separate claim requirement for "information enabling the electronic device to obtain the songs from a remote source" as claimed in claim 9 of the '952 Patent and claims 1 and 42 of the '652 Patent. (Jeffay Ex. 57, pp. 12 and 46; Jeffay Ex. 58, pp. 36 and 73, referencing the same Black Report ¶¶ 47-51 relating to multi-clip RAM files.) In doing so, the Jeffay Report reads these separate claim elements in the Qureshey Patents as being the same and effectively redundant, which is improper because I understand that different claim terms are presumed to have different meanings. In my opinion, this further demonstrates that *RealPlayer* does not disclose or suggest a "playlist identifying a plurality of songs" as claimed in the Qureshey Patents.

(2) receiving a playlist assigned to the electronic device

373. In my opinion, *RealPlayer* also does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device … providing the playlist to the electronic device" ('952 Patent, claim 1).

374. Even if a multi-clip RAM file in *RealPlayer* could be considered a "playlist identifying a plurality of songs" as claimed in the Qureshey Patents (and I disagree that it is for the reasons set forth above), the RAM file is not assigned to the user's device as required by the asserted claims of the Qureshey Patents ('952 Patent claims 1 and 9, '652 Patent claims 1 and 42). As described above, the RAM file is accessed by a user double-clicking on a link. (Jeffay Ex. 52, G2 manual, REAL8820000057, "double-clicking on a .ram file should launch RealPlayer Plus and begin to play a clip"; also Jeffay Ex. 54, 7 manual, REAL8820000152; Jeffay Ex. 56, 8 manual, REAL8820000261.) There is no disclosure or suggestion in *RealPlayer* that the RAM files could be assigned to the user's computer as claimed. Allowing a user to "access a RAM file via the internet by clicking on a link," as alleged in the Jeffay Report (Ex. 57 at 2 and 40; also Ex. 58 at 7 and 63), does not teach or suggest a central element and benefit of the Qureshey Patents, including a central or remote system for managing personal playlists that causes playlists to be assigned to user devices upon, for example, the user logging into a personal account.

375. In addition, for RealPlayer version 8 (but not G2 or version 7), the user could create a multi-clip RAM file "by selecting playable files (clips) from your local directory and dropping them into the player." (Jeffay Ex. 56, G2 manual, REAL8820000209.) However, again, allowing a user to create a playlist on a device is fundamentally different than receiving a playlist assigned to the device as claimed.

(3) obtaining the ones of the plurality of songs from the at least one remote source

376. As noted above, Respondents' proposed constructions of the "obtaining" or "obtain" terms in claims 1 and 9 of the '952 Patent, and claims 1 and 42 of the '652 Patent, which have been adopted by Dr. Jeffay, would require "downloading and storing" songs on the electronic device. I disagree with Respondents' proposed construction for the reasons stated above. However, if Respondents' construction is adopted, at least RealPlayer version G2 would not invalidate these claims. The Jeffay Report acknowledges that version G2 did not have the ability to locally cache RealPlayer content. (E.g., Jeffay Ex. 57, pp. 2 and 40, "at least RealPlayer 7 and 8 allowed for caching of certain content.") In addition, in my opinion, it would not have been obvious to modify version G2 to include these features. The Jeffay Report does not substantively address alleged obvious based on version G2, but rather concludes without explanation that it allegedly would have been "obvious to a person of ordinary skill in the art to add caching to the G2 system for the same reasons that it was in fact added to the later versions 7 and 8. (E.g., Jeffay Ex. 57, pp. 6, 9, 13, and 44.) In any event, in my opinion the fact that the feature was not included as part of the G2 release demonstrates nonobviousness because at least RealNetworks did not find it obvious to do so.

377. In addition, to the extent that the Jeffay Report purports to rely on any alleged "Take 5" or "Take5" functionality as being associated with the RAM file functionality of RealPlayer and a user's computer obtaining songs from a remote source (e.g., Jeffay Ex. 57, pp. 12-13 and 46-47; Jeffay Ex. 58, pp. 37 and 78), I similarly note that this functionality was not available through *RealPlayer* G2. (E.g., Jeffay Ex. 54, *RealPlayer* 7 user manual, REAL8820000120, describing Take5 as a new feature "available only through the new RealyPlayer 7.") In any event, I note that the Take 5 functionality related to "SMIL" files, which

are different than the RAM files relied upon by the Jeffay Report. (Jeffay Ex. 54, *RealPlayer* 7 user manual, REAL8820000121 and REAL8820000169; Jeffay Ex. 54, *RealPlayer* 8 user manual, REAL8820000218 and REAL8820000284.) The Jeffay Report does not explain how or why a person having ordinary skill in the art would have combined these two different functionalities of *RealPlayer* in a way that allegedly would have achieved the inventions claimed in the Qureshey Patents, or if it was even possible to do so.

378. For at least the foregoing reasons, it is my opinion that *RealPlayer* does not anticipate or render obvious the asserted claims of the Qureshey Patents.

c. RealPlayer in Combination with Lipscomb and/or Logan

379. The Jeffay Report alleges that *RealPlayer* in combination with *Lipscomb* renders obvious dependent claim 11 of the '652 patent, which is directed to, for example, an electronic device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. (Jeffay Report, ¶ [0218].) I disagree. First, claim 11 depends from claim 1 of the '652 Patent. As described in my report, neither *RealPlayer* nor *Lipscomb* disclose or suggest all of the elements of independent claim 1, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *RealPlayer* and *Lipscomb* would not disclose or suggest this claim element. Second, as described in connection with *Lipscomb*, *Lipscomb* does not disclose or suggest a user computing device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. Accordingly, *RealPlayer* in combination with *Lipscomb* also does not disclose or suggest this additional feature of claim 11.

380. The Jeffay Report also alleges that *RealPlayer* in combination with *Logan* renders obvious dependent claim 14 of the '952 Patent, which is directed to, for example, an electronic device that receives a playlist from a personal audio network server in a personal audio network

that includes a plurality of electronic devices, and claims 1, 6, 42, and 47 of the '652 Patent related to internet radio broadcasts. (Jeffay Report, ¶ [0247].) I disagree. Claim 14 depends from independent claim 9 of the '952 Patent. Claims 6 and 47 dependent from independent claims 1 and 42 of the '652 Patent, respectively. As described in my report, neither *RealPlayer* nor *Logan* disclose or suggest all of the elements of the independent claims of the Qureshey Patents, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *RealPlayer* and *Logan* would not disclose or suggest this claim element.

11. Ninja Jukebox

381. The Jeffay Report alleges that the published paper The Ninja Jukebox ("*Ninja Jukebox*") anticipates all of the asserted claims of the '952 Patent, i.e., claims 1, 2, 3, 4, 9, 10, 11, 12, and 14, and all of the asserted claims of the '652 Patent, i.e., claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 45, 47, 48, 49, 50, 52, and 55. (Jeffay Report ¶¶ [0222]-[0223].) In the alternative, the Jeffay Report alleges in footnotes and without explanation that these claims are obvious from *Ninja Jukebox*. (Jeffay Report, p. 89, footnotes 19 and 20.) I disagree for the reasons set forth below.

382. *Ninja Jukebox* refers to a system that allows a user's device to request and receive music from other devices over the Internet. Specifically, the system "allows a community of users to build a distributed, collaborative music repository that delivers music to Internet clients" (*Ninja Jukebox,* Abstract). The "paper describes the implementation of the Ninja Jukebox service and client, and their evolution through three stages of functionality," referenced as versions 1.0, 2.0, and 3.0. (*Ninja Jukebox*, 882PRIOR00013641, right column.)

383. In version 1.0 of *Ninja Jukebox*, the user's device included client software, called the "Jukebox Client," that communicated with a remote Music Directory. (E.g., *Ninja Jukebox*,

882PRIOR00013642, Figure 1.) The Music Directory provided the user's device with a list of all the songs that could potentially be accessed from all remote storage devices (called "SoundSmiths") connected to the system. Each SoundSmith indexed the music on an audio CD and periodically sent a list of the songs on the CD to the Music Directory. (*Ninja Jukebox*, 882PRIOR00013641, second column, "SoundSmiths periodically send beacons to the Music Directory; through these beacons, they both announce their existence to the MusicDirectory and present the list of songs they maintain."; also, "version 1.0 SoundSmith indexes music on an audio CD in a local CD-ROM drive".) In this way, the Music Directory would "build up an integrated list of all available music and of all running SoundSmiths" that the Music Directory would then provide to the user's device. (*Ninja Jukebox*, 882PRIOR00013641, second column.)

384. Upon the user's device receiving the full catalog of songs from the Music Directory, "The GUI front end [of the Jukebox Client on the user's device] provides the user with controls for constructing playlists, and with familiar play, stop, pause, fast-forward, and reverse buttons." (*Ninja Jukebox*, 882PRIOR00013642, first column.) This allowed the user to manually create playlists locally on the user's device.

385. The Jukebox Client running on the user's device also included song selection backend software to facilitate retrieval and playing of music from SoundSmiths. "The song selection back end selects specific songs to play given the list of currently available music from the Music Directory, the user's manually constructed playlist, and events that are generated when the buttons such as play or stop are pressed." (*Ninja Jukebox*, 882PRIOR00013642, first column.) In other words, the song selection backend software on the user's device determined what commands to issue (e.g., to start or stop the streaming of audio in response to user selections to "play" or "stop" music), and which SoundSmiths the commands should be sent to

(which would depend on what music was desired to be played from the full catalog of music or the user's manually constructed playlist). The SoundSmiths streamed the audio to the user's device. (*Ninja Jukebox*, 882PRIOR00013641, second column, "SoundSmith serves music by streaming it off of an audio CD".)

386. In version 2.0 of *Ninja Jukebox*, the user's ability to manually create playlists locally on the user's device remained unchanged. (*Ninja Jukebox*, 882PRIOR00013644, second column, "In the v1.0 and v2.0 Jukebox services, song playlists are manually constructed by users".) However, the system was modified (i) to allow for playback from MP3 files stored on the SoundSmiths in addition to CDs, (ii) to provide security measures to prevent unauthorized access to music, and (iii) to alter the content of the beacon signals that the SoundSmiths sent to the Music Directory. (*Ninja Jukebox*, 882PRIOR00013642-644, Section 3.2.) With respect to the beacon signals, as modified the "SoundSmiths only report their existence to the MusicDirectory rather than the complete list of music that they manage; in the v2.0 infrastructure, clients discover SoundSmiths through the MusicDirectory, but then ask each individual SoundSmith for its list of locally available music." (*Ninja Jukebox*, 882PRIOR00013643, first column.) In other words, the Music Directory only provided the user's device with a list of the connected SoundSmiths. The user's device had to contact each SoundSmith separately in order to build the full catalog of potentially available music.

387. Version 3.0 of *Ninja Jukebox* "extended the Jukebox service to provide song selection based on inferred user preferences as well as some simple collaborative filtering functionality." (*Ninja Jukebox*, 882PRIOR00013644, second column.) Version 3.0 of *Ninja Jukebox* kept intact the ability for a user to manually create playlists locally on the user's device (the same functionality present in versions 1.0 and 2.0), but in version 3.0 "Our collaborative

filtering extension refines this selection with an infrastructural 'DJ' service that exploits individual and collaborative song preferences." (*Ninja Jukebox*, 882PRIOR00013644, second column.)

388. Specifically, a "DJ implementation" was introduced in version 3.0 to collect and infer information about users' preferences and "update[] a persistent database" with these preferences. (*Ninja Jukebox*, 882PRIOR00013644, second column, to 882PRIOR00013645, first column.) These preferences were then used for "collaborative filtering," i.e., to allow a user to use their own or "someone else's preferences for song selection," or "combine the preferences of multiple other public users and use the result to drive the Jukebox client's song selection algorithm." (*Ninja Jukebox*, 882PRIOR00013645, first column, underlining added.) In other words, the Jukebox Client running on the user's device would obtain the preferences of one or more users from the DJ service, and then apply the preferences as a filtering criteria to narrow down the full catalog of songs that were potentially available from the SoundSmiths. (See also, *Ninja Jukebox*, 882PRIOR00013639, Abstract, "'Ninja Jukebox' … performs simple collaborative filtering based on users' song preferences inferred by the service."; 882PRIOR00013639, second column, "Jukebox allows … simple collaborative filtering to allow individual users to filter their music preferences according to other community members' explicit and implicit recommendations.")

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

389. In my opinion, *Ninja Jukebox* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an

electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

390. The Jeffay Report alleges that "Ninja Jukebox … discloses a method for sharing audio content and playlists stored on different devices among those devices," and cites to all three versions of the *Ninja Jukebox* as allegedly showing these claimed features. (Jeffay Report, ¶ [0221]; Jeffay Ex. 63, pp. 2-9 and 43-50; Jeffay Ex. 64, pp. 23-32 and 66-76). I disagree.

391. First, the Jeffay Report cites to the description in *Ninja Jukebox* of a graphical user interface (GUI) on the user's device that "provides the user with controls for constructing playlists" (Jeffay Ex. 63, pp. 2 and 43, Jeffay Ex. 64, pp. 24 and 67, citing *Ninja Jukebox*, 882PRIOR00013642). However, as described above, this cited portion of *Ninja Jukebox* explicitly refers to a playlist that is manually created by the user locally on the user's device, which is fundamentally different. It is not assigned to or received by the device as claimed in the Qureshey patents. In my opinion, at most it is cumulative of *Abecassis* described above, which refers to creation of a playlist locally on a user's device and which was previously considered by the PTO examiner.

392. Second, the Jeffay Report states that "in the original version, the MusicDirectory kept track of all of the available songs and would provide a song list to the Jukebox clients." (Jeffay Ex. 63, pp. 3 and 44, Jeffay Ex. 64, pp. 25 and 68, underlining added.) This refers to the description in *Ninja Jukebox* that the Music Directory (in version 1.0 of the software) provides the user's device with the full catalog of music that could potentially be accessed from all of the SoundSmiths connected to the system. To the extent that Dr. Jeffay alleges that this full catalog is a "playlist assigned to the electronic device" as claimed in the Qureshey Patents, I disagree, and in my opinion, Dr. Jeffay's argument represents a fundamental misreading of *Ninja Jukebox*

and the Qureshey Patents. A catalog of songs is not a playlist, and nowhere does *Ninja Jukebox* disclose or suggest that the full catalog of music that is potentially available to the user's device from all of the SoundSmiths is a playlist, much less a playlist that is assigned to the user's device. Rather, the full catalog, by definition, is the full universe of songs that could potentially be accessed via the system, not a set of songs that is assigned or directed to a user's device for playback in sequence by the user's device. For example, *Ninja Jukebox* does not disclose or suggest that that full catalog of "4,400 songs" corresponding to "320 hours of music" is a playlist, much less a playlist that is directed to a user's device. Indeed, as described above, *Ninja Jukebox* expressly states that it provides a separate "playlist" functionality that allows the user to locally define a playlist by manually selecting a subset of the full catalog. (E.g., *Ninja Jukebox*, 882PRIOR00013644, second column, "song playlists are manually constructed by users".)

393. Third, the Jeffay Report cites to the description in *Ninja Jukebox* of the "collaborative filtering functionality" that was added to version 3.0 of the software. (Jeffay Ex. 63, pp. 2 and 43, Jeffay Ex. 64, pp. 25 and 67, citing *Ninja Jukebox*, 882PRIOR00013644.) However, as described above, version 3.0 of *Ninja Jukebox* did not change the above-described playlist functionality that was present in both versions 1.0 and 2.0 of the software, wherein playlists were created manually by the user locally on the user's device. The "collaborative filtering functionality" simply reduced the full catalog of potentially available music to a smaller, more targeted catalog of potentially available music for presentation to the user via the GUI of the user's device. Specifically, the "DJ service" provided the user's device with a set of user preferences for use by the user's device "to drive the Jukebox client's song selection algorithm." (*Ninja Jukebox*, 882PRIOR00013645, first column.) Indeed, as described above, starting with the changes in version 2.0 of the software, the user's device had to contact each SoundSmith

separately in order to build the full catalog of potentially available music, and thus only the user device could apply the filtering criteria to the catalog to reduce its size. (*Ninja Jukebox*, 882PRIOR00013643, first column.) Again, this did not alter the express statement in *Ninja Jukebox* that it provided a separate "playlist" functionality to allow a user to locally and manually define a playlist based on the filtered catalog. (E.g., *Ninja Jukebox*, 882PRIOR00013644, second column, "song playlists are manually constructed by users".)

394. In view of these plain differences, it is my opinion that *Ninja Jukebox* does not anticipate or render obvious the asserted claims of the Qureshey Patents for at least the foregoing reasons.

a. Ninja Jukebox in Combination with Lipscomb, Hempleman, and/or Logan

395. The Jeffay Report alleges that *Ninja Jukebox* in combination with *Lipscomb* or *Hempleman* renders obvious dependent claim 11 of the '652 patent, which is directed to, for example, an electronic device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. (Jeffay Report, ¶ [0223].) I disagree. First, claim 11 depends from claim 1 of the '652 Patent. As described in my report, none of *Ninja Jukebox*, *Lipscomb*, or *Hempleman* disclose or suggest all of the elements of independent claim 1, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Ninja Jukebox* and *Lipscomb*, or *Ninja Jukebox* and *Hempleman*, would not disclose or suggest this claim element. Second, as described in connection with *Lipscomb* and *Hempleman*, these references do not disclose or suggest a user computing device that sends a request to a remote server for supplemental information related to a song in real-time while the song is playing. Accordingly, *Ninja Jukebox* in combination with *Lipscomb*, or *Ninja Jukebox* in combination with

Hempleman, also do not disclose or suggest this additional feature of claim 11. Third, *Ninja Jukebox* and *Hempleman* refer to fundamentally different types of systems with different network topologies and the Jeffay Report does not explain why it allegedly would have been obvious to a person having ordinary skill in the art to combine them nor why there would have been a reasonable expectation of success in doing so. *Ninja Jukebox* referred to a distributed system, with distributed software components residing on separate workstations and servers, whereas *Hempleman* referred to client-server system.

396. The Jeffay Report also alleges that *Ninja Jukebox* in combination with *Logan* renders obvious dependent claim 49 of the '652 Patent, which is directed to, for example, receiving input from a remote control that enables navigating a playlist. (Jeffay Ex. 64, p. 95; Jeffay Report, ¶ [0268].) I disagree. Claim 49 depends from independent claim 42 of the '652 Patent. As described in my report, neither *Ninja Jukebox* nor *Logan* disclose or suggest all of the elements of independent claim 42 of the '652 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, *Ninja Jukebox* and *Logan* would not disclose or suggest this claim element.

12. Music In The Home

397. The Jeffay Report alleges that the published paper "Music In The Home: Interfaces for Music Appliances" ("*Music In The Home*") anticipates all of the asserted claims of the '952 Patent, i.e., claims 1, 2, 3, 9, 10, 11, 12, and 14, and all of the asserted claims of the '652 Patent, i.e., claims 1, 3, 4, 6, 7, 10, 11, 13, 42, 44, 45, 47, 48, 49, 50, 52, and 55. (Jeffay Report ¶¶ [0226]-[0227].) In the alternative, the Jeffay Report alleges in a footnote and without explanation that the claims of the '652 Patent are obvious from *Music In The Home*. (Jeffay Report, p. 91, footnotes 21.) I disagree for the reasons set forth below.

398. *Music In The Home* refers to a "design concept" for a graphical user interface (GUI) for a touch screen located in a user's home. (*Music In The Home*, Abstract; p. 46, "touch screen in the kitchen".) The publication openly acknowledges that "There are a number of hardware, software and media developments which must occur for the scenario to become possible," which are not addressed in the publication. (*Music In The Home*, p. 47, first column.) For example, the publication simply "assume[s] that there will be some sort of home server." (*Music In The Home*, p. 47, first column, underlining added.) The sole focus of the publication is to provide "an idealised look at how music consumption might occur in the future." (*Music In The Home*, p. 47, first column.) However, in my opinion, the publication does disclose or suggest how to accomplish it and does not enable a person having ordinary skill in the art to do so. Only conceptual displays (mock-ups) for the graphical user interface functionality are provided. (E.g., title of the publication, "Music In The Home: Interfaces for Music Appliances"; p. 45, "In this paper, we present a user interface design"; p. 51, "In this paper we have shown how visual information seeking and dynamic queries can be adapted for use in information appliances with touch screens"; Figures 1-7.)

399. In addition, the publication acknowledges that although mock-up displays for touch screens are shown, "Future Work" would be necessary in order to "map the functionality onto other home devices such as remote controls and television displays" (*Music In The Home*, p. 51, first column).

400. The mock-up displays for touch screens shown in *Music In The Home* refer in several instances to a "Playlist" and associated user interface functionality. (*Music In The Home*, Figures 2, 4, 6, and 7.) However, as described above, *Music In The Home* does not disclose or suggest any of the details regarding how the user interface displays are generated, or how content

corresponding to the playlist is played in response to a user selection. *Music In The Home* only refers to the user interface functionality, i.e., the ability for a user to create, view, edit, and listen to playlists in response to touch screen options. (*Music In The Home*, Figures 2, 4, 6, and 7.)

(1) receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs

401. In my opinion, *Music In The Home* does not disclose an electronic device that "receiv[es] … a playlist assigned to the electronic device … the playlist identifying a plurality of songs" ('952 Patent, claim 9; '652 Patent, claims 1 and 42) or "assigning a playlist to an electronic device, the playlist identifying a plurality of songs … providing the playlist to the electronic device" ('952 Patent, claim 1).

402. The Jeffay Report cites to *Music In The Home*, the "3.2 Playlist" description at p. 48 and Figures 2 and 4, as allegedly showing these claimed features. (Jeffay Ex. 67, pp. 2-4 and 57-59; Jeffay Ex. 68, pp. 6-8 and 47-49). However, as described above, these cited portions of *Music In The Home* only refer user interface displays for a touch screen. They do not disclose or suggest any of the details regarding how the user interface displays are generated, or how content corresponding to the playlist is played in response to a user selection. (E.g., *Music In The Home*, p. 48, second column, "As shown in Fig. 4, tracks may be played immediately or added to the playlist from this window."; "When a Play list title is touched it starts to play immediately.") Rather, as described above, *Music In The Home* acknowledges that "There are a number of hardware, software and media developments which must occur for the scenario to become possible," which are not addressed in the publication. (*Music In The Home*, p. 47, first column.) *Music In The Home* does not disclose or suggest that the information appliance in the user's home receives a playlist identifying a plurality of songs, instead of, for example, the user utilizing the touch screen itself to creating the playlist locally on the information appliance.

Indeed, Figures 4 and 7 of *Music In The Home* show interfaces from which the user creates the playlist locally.

403. The Jeffay Report also cites to the description in *Music In The Home,* p. 46, that on "a touch screen in the kitchen … a catalogue of available music appears on the screen." (Jeffay Ex. 67, pp. 5 and 60; Jeffay Ex. 68, pp. 9 and 50; underlining added). Again, *Music In The Home* does not disclose how the user interface display is generated to cause the catalogue of music to "appear on the screen." In addition, *Music In The Home* does not disclose or suggest that the "catalogue of available music" is a playlist. Likewise, *Music In The Home* does not disclose or suggest that the search results resulting from a process to "query and combine information" are a playlist. (Jeffay Ex. 67, pp. 5 and 60; Jeffay Ex. 68, pp. 9 and 12; citing *Music In The Home,* p. 47, second column.)

404. In addition, the Jeffay Report cites to the description in *Music In The Home,* p. 47, that a user "turns on the TV and uses the remote control to choose … the playlist … she again uses the remote control to send the audio to the bedroom." (Jeffay Ex. 67, pp. 5 and 60; Jeffay Ex. 68, pp. 9 and 50; underlining added.) However, sending "audio" (i.e., the content itself) to another device is not the same as sending a playlist identifying a plurality of songs as claimed. Thus, this does not disclose or suggest that a user can "transfer playlists from one devicce [sic] to another" as alleged in the Jeffay Report. (Jeffay Ex. 67, p. 6.) Similarly, Dr. Jeffay's conclusions that "Music in the Home further discloses a method for sharing audio content and playlists stored on different devices" (Jeffay Report, p. 90) and that "Music In The Home discloses managing playlists and sending them to associated devices" (Jeffay Ex. 67, pp. 1 and 57) are not supported, and the Jeffay Report does not point to any support for his conclusions in the publication.

405. In addition, the Jeffay Report alleges that "a person having ordinary skill in the art at the time of the alleged invention would have understood that 'sending the audio' (e.g., playlist) to a particular device is one embodiment of providing the playlist to the electronic device." (Jeffay Ex. 67, pp. 8-9.) I disagree. Again, this plainly conflates the requirement for the receipt of a playlist, which identifies content, with the receipt of the content itself. In my opinion, a person having ordinary skill in the art would not have understood the transmission and receipt of audio content itself to satisfy the requirement for the receipt of a playlist identifying a plurality of songs as claimed in the Qureshey Patents. For example, the claims of the Qureshey Patents define that receiving the playlist and obtaining the content are separate claim requirements. ('952 Patent claim 9 and '652 Patent claim 42, defining "obtaining the … songs" as being separate from "receiving … a playlist"; also '652 Patent claim 1, "obtain the … songs" separate from "receive the playlist.")

406. Lastly, I note that Dr. Jeffay quotes a different reference in connection with his alleged anticipation analysis in view of *Music In The Home*. The Jeffay Report cites to the Busam patent at 4:24-29 but incorrectly identifies the cited text as a quotation from *Music In The Home*: "'As discussed above, each device on the device-to-device network can implement one or more of the device-to-device API functions: searching, downloading, sharing, streaming from other devices, streaming to other devices, creating/managing playlists across multiple devices, issue commands, receive commands and proxy services.' *See, e.g., Music In the Home See, e.g.,* 4:24-29." (Jeffay Ex. 68, p. 40.) A combination of references cannot be used to show anticipation, and the Jeffay Report does not allege much less explain why the independent claims (or dependent claims) of the Qureshey Patents would allegedly have been obvious from this

combination. In any event, in my opinion the Busam patent is not prior art to the Qureshey Patents for the reasons stated above.

(2) receiving information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source

407. In my opinion, *Music In The Home* also does not disclose an electronic device that receives "information … enabling the electronic device to obtain the ones of the plurality of songs … from at least one remote source" ('952 Patent, claims 1 and 9; '652 Patent, claims 1 and 42).

408. As described above, *Music In The Home* refers to user interface displays and acknowledges that "There are a number of hardware, software and media developments which must occur for the scenario to become possible," which are not addressed in the publication. (*Music In The Home*, p. 47, first column.) The Jeffay Report cites to the description in *Music In The Home*, p. 47, that "There will be a number of local and online indices of available music and it is essential that it is possible to query and combine the information in these databases." (Jeffay Ex. 67, pp. 10 and 62; Jeffay Ex. 68, pp. 9 and 12.) However, this relates to a proposed search functionality. *Music In The Home* does not disclose or suggest that the results of such a "query and combine" process are a playlist, nor that this information is provided to the information appliance that includes the touch screen instead of, for example, simply residing on "some sort of home server" as stated in *Music In The Home* (p. 47, first column). Thus, in my opinion, *Music In The Home* does not disclose or suggest an electronic device that receives information enabling the device to obtain song(s) from a remote source as claimed.

409. In addition, the Jeffay Report alleges that "One of skill in the art would understand that in order to download a song from the web, or to play a song stored on another device in the network, the device would require, at a minimum, information regarding the

location of the song." (Jeffay Ex. 67, pp. 11 and 64.) I disagree. For example, as described above, in my opinion *Music In The Home* does not disclose or suggest that a user can download a song of a playlist from the web, or play it from another device on the network. Rather, the user interface displays in *Music In The Home* show that the playlist is created locally via the touch screen on the information appliance. In addition, once a song is part of the playlist, there is no disclosure or suggestion that the information appliance accesses the song from remote storage instead of, for example, local storage of the information appliance. *Music In The Home* does not disclose or suggest that the information appliance that includes the touch screen receives, for example, URLs that can be used by the information appliance to obtain the songs of a playlist.

410. For at least the foregoing reasons, it is my opinion that *Music In The Home* does not anticipate or render obvious the asserted claims of the Qureshey Patents.

a. Music in the Home in Combination with Ninja Jukebox

411. I disagree to the extent that the Jeffay Report alleges that *Music in the Home* in combination with *Ninja Jukebox* renders obvious dependent claims 2, 3, 4, 10, 11, 12, and 14 of the '952 Patent, which are directed to, for example, ways in which an electronic device can obtain, from at least one remote source, one or more songs of a playlist that is assigned to the electronic device. (Jeffay Report, ¶ [0226]; Jeffay Ex. 31.) These dependent claims all depend from independent claims 1 and 9 of the '952 Patent. As described in my report, none of these references disclose or suggest all of the elements of these independent claims of the '952 Patent, including at least receiving a playlist assigned to the electronic device, the playlist identifying a plurality of songs. Accordingly, even if combined, these references would not disclose or suggest these claim elements. In addition, these references refer to different types of systems with different network topologies and the Jeffay Report does not explain why it allegedly would

have been obvious to a person having ordinary skill in the art to combine them nor why there would have been a reasonable expectation of success in doing so.

X. RESPONSE TO HEPPE INVALIDITY REPORT REGARDING THE DRUTMAN PATENT

412. The Samsung and LG Respondents, joined by Intervenor, Google, Inc. have served the Expert Report of Stephen B. Heppe Regarding Invalidity of U.S. Patent No. 6,618,593. The following is my response to the opinions and conclusions regarding the level of ordinary skill in the art pertinent to the Drutman Patent, the priority date of the asserted claims, claim construction, and the validity of the asserted claims of the ‘593 Patent.

A. Priority Date

413. Dr. Heppe contends that there is no earlier priority date. (Heppe, paragraphs 83-100). I disagree. It is my understanding, given the law cited above, that a patentee may predate a 102(e) prior art reference by showing earlier conception and diligent reduction to practice. It is my understanding, as sated above, that conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, where the idea is so clearly defined in the inventor’s mind that only ordinary skill is be necessary to reduce the invention to practice, without extensive research or experimentation.

414. The inventors, notably Charles Drutman, generated documentation showing conception of claim 7 of the '593 patent by about June 4, 2000. This predates the De Vries '179 patent filed on 7/27/00 (Heppe C5) and the provisional applications cited in the Tanaka '749 patent (Heppe C6), the earliest of which was filed on 6/10/2000. Further written materials support additional details and refinements of the conception of the invention by July 17, 2000, predating the De Vries '179 patent.

415. I relied on the following materials in my analysis.

Conception Documents		
Starting Bates No.	**Author/ Date**	**Drutman Exhibit**
BHM-ITC-044543	Charles Drutman May 3, 2000	Drutman 11
BHM-ITC-044468	Charles Drutman June 4, 2000	Drutman 12, pages 042892, 042893
BHM-ITC-044679	C & D Drutman July 11, 2000	Drutman 28.
BHM-ITC-044719	C. Drutman D. Drutman 7/17/2000	Drutman 29
BHM-ITC-044728	C. Drutman D. Drutman 7/17/2000	Drutman 30
BHM-ITC-042888	(Agreement)	Drutman 12, pages 042888-981

416. My analysis of the conception of claim 7 is presented below, for each claim element using the claim constructions posed by the parties and Dr. Heppe.

Patent 6,619,593	**Claim Constructions**	**Analysis**
7. A system for matching users of mobile communications devices comprising:		The inventors disclosed the idea of providing a system that matched users of mobile communications devices by June 4, 2000. See BHM-ITC-044468 "An example is a GPS-enabled wireless device that informs users when they are within a specified distance of other users with characteristics that match their requirements" The delivery system is disclosed as a "a cell phone, pager, hand-held or plamtop computer." (Id.) This was further refined by July 17, 2000. See BHM-ITC-044679 ("Tracking" on page BHM-ITC-044685); BHM-ITC-044719 and BHM-ITc-0044728 ("Matchmaking service")
a first mobile communications device for transmitting information defining a location of the first mobile communication		The inventors disclosed the idea of using a first mobile communications device (cell phone) transmitting its GPS location, by June 4, 2000. See BHM-ITC-044468 "An example is a GPS-enabled wireless device that informs users when they are within a specified distance of other users with characteristics that match their requirements" The delivery system is disclosed as a "a cell phone, pager, hand-held

s device;		or plamtop computer." (Id.) This was further refined by July 17, 2000. See BHM-ITC-044679 ("Tracking" on page BHM-ITC-044685); BHM-ITC-044719 and BHM-ITC-0044728 ("Matchmaking service") The basic idea is a dual spatial location system with an intermediary processing capability that matches people based upon user-specified criteria.
a second mobile communication s device for transmitting information defining a location of the second mobile communication s device and a **user sending status**; and	"User sending status" BHM: Plain and ordinary meaning or Information indicating whether the user has selected, or the device is configured, to send data to or respond to requests from other mobile communication devices or the server Respondents: "information indicating whether the device is currently able to send data or requests to other mobile communications devices or the central server" Staff: Plain and ordinary meaning.	The inventors possessed the idea of providing a system that matched users of a first and second mobile communications device by June 4, 2000. See BHM-ITC-044468 "An example is a GPS-enabled wireless device that informs users when they are within a specified distance of other users with characteristics that match their requirements." The delivery system is disclosed as a "a cell phone, pager, hand-held or plamtop computer." (Id.) Two (or more) mobile devices are confirmed by the relevant documentation. "This idea uses GPS technology to incorporate a real-time spatially-sensitive matching system. The matching is handled by an intermediary processing system that defines potential matches and then tracks the position of users within a match group to determine if they are within some distance sufficient to trigger an alert." (Id.) This was further refined by July 17, 2000. See BHM-ITC-044679 ("Tracking" on page BHM-ITC-044685); BHM-ITC-044719 and BHM-ITc-0044728 ("Matchmaking service") The "sending status" was also conceived by June 4, 2000. See BHM-ITC-044468 ("Users have the option of accepting or rejecting the message. If accepted, then their location is broadcast to potential matches." This was further refined by July 11, 2000. See BHM-ITC-044679 ("Transmission of location" is "On/Off at user's discretion" on page BHM-ITC-044680). It does not matter which construction is adopted, the concept of preventing location

		information from being sent at user discretion was documented in a manner that could have been enabled without undue experimentation, and meets all the claim constructions.
a central unit having a processor coupled to a memory, the central unit capable of communicating with the first mobile communications device over a first wireless communications link and with the second mobile communications device over a second wireless communications link,		The inventors possessed the idea of a central unit having processor/memory in communication with two or more mobile communications devices, by June 4, 2000. See BHM-ITC-044468 "The matching is handled by an intermediary processing system that defines potential matches and then tracks the position of users within a match group to determine if they are within some distance sufficient to trigger an alert.." This "intermediary processing system" must inherently have processor, which inherently needs memory to function. It is disclosed that the system is in communication with the first/second (or more) devices in the citations above, which must use the communications links relevant to those devices (first, second, or more). Moreover a "database" which must be stored in memory is referenced at BHM-ITC-04469. Even earlier documents refer to a "background program on the server matches..." for additional embodiments. See BHM-ITC-04453, 54. The "server" inherently has a processor and memory. This was further refined by July 11, 2000. See BHM-ITC-044679 ("Intemediary computer" on page BHM-ITC-044683) (inherently has processor and memory).
the memory storing a first user profile including information associated with a user of the first mobile communications device **and a second user profile**	"the memory storing a first [second] user profile" BHM: the memory storing profile data about a first [/second] user" Respondents: the memory storing profile data about a first /second] user"	By June 4, 2000, the inventors disclosed the idea of the memory of the "intemediary processing system" storing first and second (and more) user profiles with information about the users. See BHM-ITC-044468 "The matching is handled by an intermediary processing system that defines potential matches" (meaning stores information about matches) and "informs users when they are within a specified distance of other users with characteristics that match their requirements" (meaning requirements (data

including information associated with a user of the second mobile communication s device,	Staff: "user profile"* retained on memory *"user profile" – "characteristics and preferences" of a user	about users) are matched to characteristics (data about users)). See BHM-ITC-044469 ("Additional information about each user can be provided to potential matches based upon what is available in the database" (meaning a database stores information about each user (a profile under the proposed constructions)). A discussion of "Existing Technology" matching using profiles is present on BHM-ITC-044468 and the invention takes those profiles to "real time spatially sensitive matching" which would also use profiles. Under any party's construction, the profiles are verified by the written documentation as of June 4, 2000. By July 17, 2000 the concept of profiles was further explained. See BHM-ITC-044680 ("User Profile"); BHM-ITC-044719 and BHM-ITC-044728 ("Matchmaking Service" has a "profile"). This meets any party's construction.
wherein the central unit receives the user sending status from the second mobile communication s device and the information defining the locations of the first and the second mobile communication s devices and	Plain and ordinary meaning; system claim requires no order of operation; unclear what is intended to be construed. Respondents: Plain and ordinary meaning; receiving must occur before transmitting Staff: A person of ordinary skill in the art would understand that receiving has to happen before transmitting	By June 4, 2000 the inventors had documented that the intermediary processing system receiving the user sending status and the locations of the devices (via GPS.). See BHM-ITC-044468 "The idea uses GPS technology to incorporate a real time spatially-sensitive matching system. The matching is handled by an intermediary processing system that defines potential matches and then tracks the position of users within a match group to determine if they are within some distance sufficient to trigger an alert." The "sending status" is also disclosed "Users have the option of accepting or rejecting the message. If accepted, then their location is broadcast to potential matches." BHM-ITC-044468. The "intermediary processing system" is broadcasting, so must have received the "acceptance." By July 17, 2000, the concept had been further described. See BHM-ITC-044680 ("Transmission of location" is "On/Off at user's discretion.")

		As proposed by the parties, the receiving of sending status occurs prior to the sending of locating information. (See quotes above).
wherein the processor receives the first and the second user profiles to match information of the users and	"Wherein the processor receives" BHM: Plain and ordinary meaning or the processor receives user profiles to match users. Respondents: wherein the processor receives profiles for the first and second users and uses profile data about both users to match information of the users"	By June 4, 2000, the inventors documented the idea of the processor ("intermediary processing system") receiving and matching the user profiles. A processing system is described, that matches characteristics and requirements (as described previously), and maintains a database. The intermediary processor must have received the data to perform matching. See BHM-ITC-044469 "Additional information about each user can be provided to potential matches based on what is available in the database. The user can specify which information is available for broadcast, and which information should only be used by the processor for matching calculations." The processor clearly matches profiles in a database as it incorporates "real-time spatially-sensitive matching" to" Existing Technology" (with users entering information about themself and requirements for others/ profiles in a database) on BHM-ITC-044468. This data must be received by the intermediary processor to be used for the disclosed matching. By July 17, 2000, the ideas had been expanded. See BHM-ITC-044680 (at page 044680 "Matchmaker" and "User Profile"). See BHM-ITC-044719 and BHM-ITC-044728 ("Matchmaking Service" with ""profile" and "inputs").
if there is a match and depending upon the user sending status, effects the transmission to the first mobile communication s device of **locating information**	if there is a match... BHM: If there is a match and the user sending tatus indicates the sending of data or the responding to requests, causes to be transmitted Respondents: if there is a match and depending upon the user sending status: "only if there is a match and	The inventors had documented sending matches only of there was a match and if the "sending status" was met (the user wished to send his information), at least by June 4, 2000. See BHM-ITC-044468 ("Users have the option of accepting or rejecting the message. If accepted, then their location is broadcast to potential matches." This was further refined by July 11, 2000. See BHM-ITC-044679 ("Transmission of location" is "On/Off at user's discretion" on page BHM-ITC-044680).

	only if the user sending status indicates that the second device is currently able to send data or requests from other mobile communications devices or the central server then causes to be transmitted Staff: Requires results from both (1) "match" and (2) determination based on "user receiving status "locating information" BHM and Staff: information usable to arrive at a location Respondents: information that enables a user to contact or find another device or location.	It does not matter which construction is adopted, the concept of requiring both a match and a sending status (user wishing to send his location) was documented and meets all the constructions. The inventors also documented "locating information" under any party's construction, by June 4, 2000, as "directions" and "2-D" and "3-D" maps are documented by this date. See BHM-ITC-044468. This was further refined by July 17, 2000. See BHM-ITC-044679 (at page 044681, "Form of directions important for patent" and "Real-time directions"). See also BHM-ITC-044719 and BHM-ITC-044728 ("Automated Scheduling" has "meeting point" based on both locations).
based upon the information defining the locations of the first and the second mobile communicatio ns devices. "	"based upon the information defining the lcoations of the first and the second mobile communications devices. (Agreed Construction) Derived from the information defining the locations of both mobile communications devices	By June 4, 2000 the inventors documented the idea to send locating information that was based on the locations of both devices, under the agreed construction (derived from the locations of both devices). See BHM-ITC-044469 ("real-time text-based or verbal-based directions (turn left now and walk 2 blocks)"). This was further refined by July 17, 2000. See BHM-ITC-044679 (at page 044681, "Form of directions important for patent" and "Real-time directions"). See also BHM-ITC-044719 and BHM-ITC-044728 ("Automated Scheduling" has "meeting point" based on both locations).

417. My analysis above is supported by the deposition testimony. Charles Drutman explained Exhibit 11 at his deposition (see Drutman, pp. 94-104); Exhibit 12 (pages 042892,

042893 corresponding to BHM-ITC-044468-69 on pages 107-112 of his deposition, Exhibit 28 at pages 149-157; Exhibit 29 at pages 157-161, Exhibit 30 at pages 161-163. This testimony supports my analysis.

418. It is therefore my opinion that '593 claim 7 was conceived on or about June 4, 2000 and thus De Vries '179 and Tanaka '749 do not qualify as prior art against claim 7. Further documentary evidence (cited above) supports conception at least by July 17, 2000, confirming the removal of De Vries as prior art as to claim 7.

419. I understand that the inventor must diligently reduce the invention to practice. The inventors did diligently work on the invention from June 4, 2000 up to the reduction to practice (3 months later), on September 8, 2000, when the '593 patent application was filed.

420. Diligence is evident in that, a few days after the June 4, 2000 conception document (on June 12, 2000), the inventors signed a "Patent Prosecution Agreement" (C. Drutman Exhibit 12, BHM-ITC-042888-91). Pursuant to this agreement, funding for a patent attorney, Ira Shaefer was provided. (C. Drutman, pp. 112-114, Egendorf, p. 54, ll. 10-15; D. Drutman, pp. 34-35). As testified by Andrew Egendorf, things got moving right away after the contract was signed. Egendorf, p. 58, ll. 17-21. It only took about 3 months from the signing of this agreement for Mr. Shaefer to be funded, hired, and file the patent application, indicating that the inventors were diligent. Moreover, Mr. Schaefer also had to determine inventorship under section 7 of the agreement, which was also diligently performed in these three months.

421. Diligence is further evidenced by the testimony of inventor Darlene Drutman, who testified that between June 2000 and September 2000 the inventors met "fairly often" before the patent filing and "less often" after the filing, when they were still trying to get the business going. D. Drutman, pp. 88-89.

422. It took only three months for a patent attorney to be funded, hired, draft a patent application, determine inventorship, and file the application, and in this timeframe the inventors were meeting "fairly often." Dr. Heppe contends that Charles Drutman consulted on another matter during this timeframe, but this fact supports the existence of exceptional diligence, in that notwithstanding his other commitments, the patent application was drafted and filed in a mere three months.

423. It is therefore my opinion that the inventors were diligent, in fact exceptionally diligent.

B. Claim Construction Issues

424. The Heppe report raises a number of claim construction issues as identified below.

1. "Locating Information" that is "Based Upon"

425. The Heppe report does not correctly apply the agreed upon construction of "locating information" which requires that "locating information" is "based upon" ("derived") from the information defining the locations of "both" the first and second device. Dr. Heppe instead equates "locating information" with irrelevant portions of the decision making process governing whether or not to send what is supposed to be the locating information (i.e., he relies on information used in the matching process instead of the content of the information that is sent).

426. The '593 patent describes a decision making process at col. 8, l. 54- col. 9, l. 2. The decision making process checks for a match of profiles in step 301, checks the receives/ transmit status of the devices in step 305, and checks whether the two devices are within range of each other in step 310. (I note that 310 is not claimed in claims 1, 4 and 7 it is claimed in dependent claims 2, 5, and 8.) Only if the decision making process is satisfied is "locating

I declare under penalty of perjury that the foregoing is true and correct.

Ivan Zatkovich
December 6, 2013