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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.; AND
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC
Petitioner

v.

BLACK HILLS MEDIA, LLC
Patent Owner

Case No. IPR2014-00740
Patent 8,045,952

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,045,952**

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

**PRELIMINARY RESPONSE BY PATENT OWNER
UNDER 37 C.F.R. § 42.107**

Patent Owner Black Hills Media, LLC (“Patent Owner”) submits this Preliminary Response to the Petition (Paper 1) filed by Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (“Petitioner” or “Samsung”) seeking *inter partes* review of U.S. Patent No. 8,045,952 (the ’952 Patent). This filing is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, as it is being filed within three months of the Notice of Filing Date Accorded to Petition (Paper 3), mailed May 20, 2014.

I. INTRODUCTION

A trial should not be instituted in this matter because the Petitioner has failed to identify all real parties in interest under 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(a)(1).

The Board should also deny the Petition as none of the references relied upon gives rise to a reasonable likelihood of Samsung prevailing with respect to any challenged claim of the ’952 Patent.

II. THE PETITION FAILS TO IDENTIFY ALL REAL PARTIES IN INTEREST

Samsung’s Petition should be denied because it fails to identify all real parties in interest as required under 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(b).

At a minimum, it appears that Google Inc. (“Google”) should have been identified as a real party in interest in this proceeding.

“A petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest.” 35 U.S.C. § 312(a)(2). The Office Rules also require that a petitioner provide certain mandatory notices, including identifying all real parties in interest. *See* 37 C.F.R. § 42.8(b). This requirement is not a mere formality. Rather, a clear identification of the real party in interest is important to ensure both the proper application of the statutory estoppel provisions of 37 C.F.R. § 42.73(d)(1) and the ability of the judges of the PTAB to recuse themselves in view of any conflict-of-interest. *See Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions*, 77 Fed. Reg. 48612, 48617 (Aug. 14, 2012). A petitioner has the burden to identify all real parties in interest. Failure to do so frustrates the purpose of the proceeding.

Patent Owner has recently discovered the existence of a Mobile Application Distribution Agreement (“Google-Samsung MADA,” Ex. 2001)¹ between

¹The Google-Samsung MADA is a public trial exhibit used in the matter of *Oracle America, Inc. v. Google Inc.*, Case No. CV 10-03561 WHA (N.D. Ca.). *See* Ex.

Samsung and Google that includes indemnification provisions in the event of claims of patent infringement against Samsung arising out of any claim that certain Google Applications infringe any intellectual property right. (Ex. 2001 at Sec. 11).

As noted in its mandatory notices, Patent Owner has made patent infringement claims against Samsung in proceedings before the U.S. District Court for the Eastern District of Texas, in a case styled *Black Hills Media, LLC v. Samsung Elecs. Co., Ltd., et al.*, Civil Case No. 2:13-cv-00379-JRG (E.D. Tex.), and before the International Trade Commission in Proceeding No. 337-TA-882 (the “ITC Action”). (Paper 5, pp. 2-3). These proceedings concern Samsung’s Android devices that employ Google’s products and services, consistent with those covered by the Google-Samsung MADA produced in the matter of *Oracle America, Inc. v. Google Inc.*, Case No. CV 10-03561 WHA (N.D. Ca.).

The Google-Samsung MADA explicitly states that, once notified of an indemnification claim covered by the Google-Samsung MADA, Google “***will defend, or at its option settle, any third party lawsuit or proceeding brought against [Samsung]***” arising out of any claim that the Google Applications infringe any patent. (Ex. 2001 at 11.1). Furthermore, under the Google-Samsung MADA,

2002, Joint Submission of Corrected Exhibit List, Doc. 293 filed on 4/15/2012, referencing MADA as Ex. 2775 at p. 107 and noting no limitations on its use.

Google has “*full control and authority over the defense.*” (Ex. 2001 at 11.3).

Thus, under the Google-Samsung MADA, Google has full control of the defense and settlement of any third-party infringement action implicating Google’s products and services.

Consistent with its indemnity obligations under the Google-Samsung MADA, Google filed a motion to intervene in the ITC Action one month after the ITC Action commenced. (*See* Ex. 2003). Google’s motion was granted by the presiding administrative law judge. (*See* Ex. 2004).

In its motion, Google said that it has a right to intervene because Patent Owner’s complaint named certain Google products and services as infringing patent claims: “*The claim charts that accompanied the Complaint specifically identify certain proprietary Google and YouTube products and services operating on Android devices manufactured by each of the respondents* as allegedly infringing or allegedly providing a portion of the infringing functionality of various patent claims.” (Ex. 2003, pp. 2-3). As an example, Google’s Google Play Music applications operating on Android devices manufactured by Samsung were implicated in Patent Owner’s claim charts that accompanied the complaint in the ITC Action as allegedly providing infringing functionality of claims 1 and 9 of the ’952 Patent, which are challenged by Samsung in this proceeding. *See* Ex. 2005, pp. 2 4, 8, 12, 14, 16, 23, 26, 27, 31, 33, and 34. *See also* Ex. 2006, which is a

redacted version of claim charts supplied during the ITC Action and which references Google Play Music as it relates to all claims challenged in this proceeding.

In support of its motion to intervene, Google further stated that (1) “Google has a compelling interest in this investigation as a result of complainant’s assertion that the alleged infringement is based, in part, on respondents’ devices and their use of proprietary Google products and services, including Google Play Music, Google Maps/Latitude and YouTube” and that (2) “Google also has a business interest in the continued importation and sale of Respondents’ accused products that utilize Google proprietary products and services. Google has invested substantial resources in developing and supporting these products and services and has a strong interest in assuring that Respondents can continue to utilize these products and services by importing their products into the United States.” (Ex. 2003, pp. 5-6 (emphasis added)).

Whether a non-party is a real party in interest for the purposes of an *inter partes* review proceeding is a “highly fact-dependent question.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756 (August 14, 2012). Factors to consider in determining whether a party is a real party in interest may include whether a non-party exercises control over a petitioner’s participation in a proceeding. *Id.* at 48759. Other factors may include whether a non-party is funding the proceeding

or directing the proceeding. *Id.* at 48759-60. To determine whether a party is a real party in interest, the USPTO applies traditional common law principles. *Id.*

In addition to the indemnitee-indemnitor relationship between Samsung and Google and Google's indemnification obligations under MADA, the intervention of Google in the ITC Action creates a presumption of a common-interest or joint-defense relationship between these two parties – and that this Petition was filed at the behest, control, and authority of Google.

As admitted by Google in its motion to intervene, Google has “a business interest” in the continued importation and sale of [Samsung's] accused products that utilize Google's proprietary products and services . . . and has a strong interest in assuring that [Samsung] can continue to utilize these products and services by importing their products into the United States.” (Ex. 2003, p. 6). Google's ability in ensuring Samsung's continued ability to utilize Google's products and services depends, in part, on its ability to establish that the patent claims at issue in this proceeding are invalid.

Besides Google's interest in ensuring Samsung's continued ability to utilize its products and services, Google has an additional interest in the outcome of this proceeding. For example, if the '952 Patent's validity is confirmed, Google could be liable for any damages imposed in the related district court litigations. Google has chosen not to file a petition requesting an *inter partes* review of the '952

Patent, presumably for strategic reasons such as, for example, to avoid any estoppel with regard to the references cited in the present Petition and to have multiple bites at the apple. Instead, Google appears to rely on its indemnitee-customer, Samsung, to challenge the validity of the '952 Patent and pursue their common interests in the present proceeding for them.

For these reasons, the Board should dismiss this Petition on the grounds that Petitioner has failed to identify the real parties in interest. Should the Board decline to deny the Petition at this time, Patent Owner submits that discovery is warranted to determine the additional details concerning the relationship between Petitioner and Google and the extent to which Google has participated in the preparation and funding of the Petition. The Board has allowed such additional discovery when it is in the interests of justice to determine which party or parties are the real parties in interest. *See, e.g., RPX Corp. v. VirnetX, Inc.*, IPR2014-000171 (Paper 25, February 20, 2014).

III. BACKGROUND OF THE '952 PATENT

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

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

A copy of the playlist can then be transmitted from the server to the device, such that the receiving device takes control to obtain audio content of the songs indicated in the playlist from the one or more remote sources and to sequentially

play the songs identified by the playlist. (*See* Ex. 1001, Figures 19B-19C and 27:47-30:18). For example, when an electronic device obtains and plays back the audio content corresponding to a song within a playlist, the audio content can be streamed to, or downloaded by, the electronic device. (Ex. 1001, 21:65-22:4).

The '952 Patent describes various computing environments that enable the network-enabled audio devices to store files, play standard audio CDs and MP3 encoded CDs, record songs from CDs, receive digitized radio broadcasts over the World Wide Web, and/or receive assignments of playlists of songs from other network-enabled audio devices. (Ex. 1001, 2:57-62). Figure 11 of the '952 Patent, which is reproduced below, shows one exemplary embodiment of such a computing environment. The network includes network-enabled electronic 'Device A' (1108), network-enabled electronic 'Device B' (1110), and personal computer (1106). These electronic devices interact with a server (1104) "through the network 1102 (such as the Internet)." (Ex. 1001, 16:56-60).

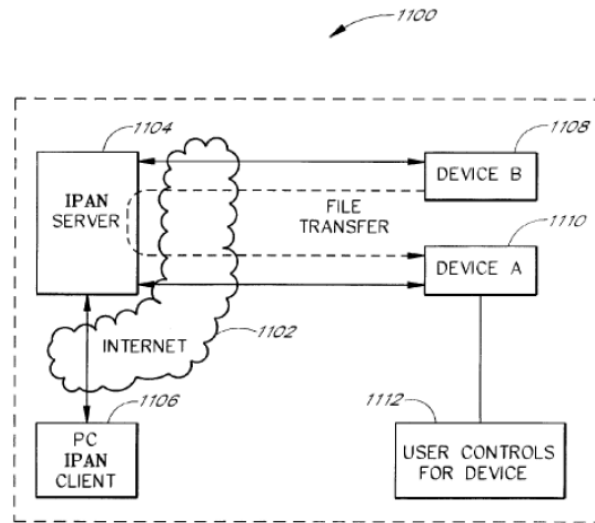


FIG. 11

The electronic devices (e.g., device A (1108) and device B (1110)) are assigned, and can receive, playlists and playlist content over a network (e.g., the Internet or otherwise). (Ex. 1001, 2:37-39 and 22:47-48). For example, when the network is a “home network,” an electronic device within the network “does not need to connect to the Internet and can retrieve the necessary file through the network connection.” (Ex. 1001, 30:19-26). “Optionally, a Local Area Network can be configured in place of, or in addition to, the Internet connection to facilitate assignments of playlists and other features.” (Ex. 1001, 2:65-68).

In another aspect, the '952 Patent provides that a user can select between various modes of operation. For example, in addition to selection of the playlist mode of operation described above, the '952 Patent additionally discloses that the network-enabled device can enable a user to select an “Internet radio” mode such

that the device receives and plays Internet radio broadcasts including, for example, the content of “AM/FM broadcasts” streamed over the web. (*See* Ex. 1001, 3:10-14; 7:28-8:57; and FIG. 18A (option “1814”)).

A. Summary of the Claimed Subject Matter

In every method and system described in the '952 Patent, three distinct pieces of information are received or obtained by the electronic device in order to play the songs indicated by a playlist assigned thereto: **i)** a playlist identifying a plurality of media items (*see e.g.*, Ex. 1001, 4:29-30, “The playlists include *titles of audio* from a variety of audio sources.”); **ii)** information enabling the electronic device to obtain the media items (*see, e.g.*, Ex. 1001, 4:30-31, “The assignments provide information about the location of other web sites containing the audio sources.”); and, **iii)** the media items themselves (*see, e.g.*, Ex. 1001, 4:32-33, “The software module is configured to connect through the ISP to the web sites to download the audio files.”). The '952 Patent thus distinguishes between the information for identifying a song (e.g., a song title), the information for obtaining a song (e.g., a location or source from which a song identified in a playlist may be obtained), and the song itself (e.g., an audio file to be streamed or downloaded). Though these three pieces of information are distinct and can be received independently from one another (*see, e.g.*, Ex. 1001, 4:50-5:3), the '952 Patent also describes embodiments in which the information enabling the electronic device to

obtain the song is received *together with* the information identifying the songs (*see, e.g., Ex. 1001, 21:62-65 and 22:48-50*).

Independent claim 1 recites a method comprising:

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

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

providing the playlist to the electronic device; and

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

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

Independent claim 9 recites a method comprising:

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

receiving, at the electronic device, information enabling the electronic device to obtain the ones of the plurality of songs from at least one remote source; and

obtaining the ones of the plurality of songs from the at least one remote source.”

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

IV. CLAIM CONSTRUCTION AND ORDINARY SKILL IN THE ART

Independent claims 1 and 9 recite a method involving “assigning a playlist to an electronic device” and a “playlist assigned to the electronic device,” respectively. As discussed in detail below, Patent Owner submits that the proper construction for the term “playlist” is “a list referencing media items arranged to be played in a sequence,” the proper construction for “assigning a playlist to the electronic device” is a “directing the playlist to the electronic device,” and the proper construction for a “playlist assigned to the electronic device” is a “playlist directed to the electronic device.”

The Patent Owner’s constructions are consistent with the understanding that one of ordinary skill in the art at the time of the invention of the ’952 Patent would have had in light of the plain language of the claims and the intrinsic evidence provided by the specification.

A. Legal Standard

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of

the patent in which they appear. 37 C.F.R. § 42.100(b); *Office Patent Trial Practice Guide*, 77 Fed. Reg. at 48,766. “The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). . . . [T]he focus of the inquiry regarding the meaning of a claim should be what would be reasonable from the perspective of one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *In re Buszard*, 504 F.3d 1364 (Fed. Cir. 2007).” MPEP § 2111 (9th Ed., March 2014).

B. A Person Having Ordinary Skill In The Art

The Petitioner alleges that a person of ordinary skill in the art would have had “*at least* a B.S. degree in electrical engineering, computer engineering or computer science and approximately two years of professional experience with computer networking and multimedia technologies, or the equivalent.” (Paper 1, p. 7; Ex. 1011, ¶4 (emphasis added)).

Patent Owner objects to this open-ended definition because it includes persons who are overqualified to be considered those of “ordinary skill in the art.” For example, by Petitioner’s definition, a person with a Ph.D. in electrical engineering, computer engineering, or computer science would also be someone of “ordinary” skill in the art. Patent Owner submits that the Petitioner’s definition should be constrained to exclude those of “extraordinary” skill and proposes

instead that the Board adopt a close-ended definition as follows: “*a Bachelor’s degree in computer science or electrical engineering or its equivalent and 1-2 years of practical experience with media file sharing.*”

Patent Owner’s proposed definition is supported by the declaration of Ivan Zatkovich (the “Zatkovich ’593 Declaration”) submitted with the Patent Owner’s Response filed on June 13, 2014 (Paper 34) as Exhibit 2012 in IPR2013-00593 proceeding of the ’952 Patent. The Zatkovich ’593 Declaration is submitted herewith as Exhibit 2007.²

² Submission of the Zatkovich ’593 Declaration is not prohibited by 37 C.F.R. § 42.107(c), which excludes the presentation of “new testimony evidence beyond that already of record” In *Anova Food, LLC v. Leo Sandau and William R. Kowalski* (IPR2013-00114), the Board determined that a declaration previously filed in district court litigation and submitted with the patent owner’s preliminary response was not “new” testimonial evidence and “appropriately submitted with the response.” (Paper 11, p. 3). The Board explained that the prohibition against new testimony under § 42.107(c) “applies only to ‘new’ testimony that was taken specifically for the purpose of the *inter partes* review proceeding at issue, as supported by the discussion and the comments that accompanied the rule.” (*Id.*)

While the Petitioner and its declarant provide no rationale for the Petition's proffered definition, the Zatkovich '593 Declaration takes into account various factors to be considered in determining the hypothetical person of ordinary skill in the art in accordance with MPEP §2141.03(I), such as the type of problems encountered in the art at the time of the invention, the sophistication of the technology, and the education level and professional capabilities of active workers in the field to conclude that "the ordinary level of skill in the art is a Bachelor's degree in computer science or electrical engineering or its equivalent and 1-2 years of experience with media file sharing." (Ex. 2007, ¶¶26-27).

Should a trial be instituted, Patent Owner reserves the right to present additional evidence as to the education and skill level of the hypothetical person having ordinary skill in the art at the time of the invention of the '952 Patent.

C. Construction of "Playlist"

The Petition states that the construction of the term "playlist" as preliminarily determined by the Board in the Institution Decision in IPR2013-00593 should also apply to current proceeding to be "a list of audio files or URLs of where the audio files were retrieved from," albeit with a grammatical correction

As the Zatkovich '593 Declaration was not prepared for the purpose of the instant *inter partes* proceeding, it is thus entitled to be submitted with this response.

that the playlist can also include “URLs of where the audio files *can be* retrieved from.” (Paper 1, pp. 5-6, citing Ex. 1007, 12-14 (emphasis original)).

The Petitioner’s declarant also accepts the Board’s previous preliminary construction, with the same caveat regarding verb tense as noted above. (Ex. 1011, ¶29). Tellingly, the Petitioner’s declarant avoids confirming his agreement with the Board’s preliminary construction in IPR2013-00593, and also does not provide any analysis as to how a person of ordinary skill in the art would understand the term “playlist” based on the remainder of the specification of the ’952 Patent.

Patent Owner respectfully submits that the broadest reasonable interpretation of “playlist” from the vantage point of one of ordinary skill in the art at the time of the invention of the ’952 Patent is “*a list referencing media items arranged to be played in a sequence*” for the following reasons:

1. Plain and Ordinary Meaning of “Playlist” in the Media File Sharing Arts

“Playlist” is a term that was understood in the media file sharing arts at the time of the invention of the ’952 Patent to mean a list referencing media items arranged to be played in a sequence. This customary meaning is exemplified in the publications described below and submitted herewith as Exhibits 2008-2010, which were published around the time of the invention of the ’952 Patent.

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

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

Similarly, in describing the SIREN™ Jukebox, the operator’s manual (published in 2000) indicates that “Siren always performs playback using the songs and sequence displayed in the Current Playlist,” though “users can specify whether

the Current Playlist is generated using the original order, or with a random order . . . [or] whether Current Playlist Playback occurs once, or is looped infinitely.” (Ex. 2009, p. 41, 43 (emphasis added)). In order to playback music from a custom playlist, a user is instructed to “[s]elect the desired playlist. The *playlist’s songs are listed Siren begins playing the first song in the list and continues through the playlist.*” (Ex. 2009, p. 45, (emphasis added)).

As evidenced by these publications, a person of ordinary skill in the art would have understood the plain and ordinary meaning of “playlist” to denote a *list referencing media items arranged to be played in a sequence*. (See also Ex. 2007, ¶73).

a. *The “list” part of “playlist” means a list referencing media items*

These exemplary, contemporaneous publications indicate that the term “playlist” denotes *a list referencing media items* arranged to be played in a sequence. For example, the *TerraTec Manual* provides that “[t]he playlist is a pre-selected sequence of titles you wish the m3po to play.” (Ex. 2008, p. 10 (emphasis added)). Likewise, the *Microsoft Handbook* provides that the term “playlist” “comes from the radio industry and *refers to the list of songs* that a disc jockey plays on a particular radio program.” (Ex. 2010, p. 49 (emphasis added)).

b. *The “play” part of “playlist” means the items are arranged to be played in a sequence*

These exemplary publications also indicate that the term “playlist” denotes that the media items (e.g., songs) are *arranged to be played in a sequence* (i.e., as a group, without having to select individual songs for playback). For example, the *TerraTec Manual* provides that “you can pre-select titles, *which will then be played in the sequence you selected them, basically, it is a mini-playlist* (up to 10 titles). . . . *Playback of the selected song starts automatically after the current one.*” (Ex. 2008, p. 20 (emphasis added)).

As evidenced by these contemporaneous publications, a person having ordinary skill in the art at the time of the invention of the ’952 Patent would have therefore understood the plain and ordinary meaning of “playlist” to denote a list referencing media items arranged to be played in a sequence.

The discussion above regarding the plain and ordinary meaning of the term “playlist” in the media file sharing arts at the time of the invention of the ’952 Patent consistent with and fully supported by the Zatkovich’593 Declaration, which concludes that “[b]ased upon my relevant experience in industry, ‘playlist’ is a term that is generally recognized in the media file sharing arts to mean *a list* referencing media items that is *arranged to be played in a sequence*, i.e., a list of

media items that has been created to be played sequentially, one after another.”

(Ex. 2007, ¶54; *see also* Ex. 2007, ¶¶55-59).

2. The '952 Patent Uses “Playlist” Consistent with its Plain and Ordinary Meaning

The '952 Patent consistently uses the term “playlist” in accordance with its plain and ordinary meaning to one of ordinary skill in the art.

a. *The “list” part of “playlist” means a list referencing media items*

The '952 Patent uses the term “playlist” consistent with its plain and ordinary meaning to indicate a *list referencing media items*. (Ex. 2007, ¶¶74, 77, 83).

The Board preliminarily construed the term “playlist” in IPR2013-00593 to mean “a list of audio files or URLs of where the audio files were retrieved from.” (Ex. 1007, p. 13). Patent Owner respectfully submits that this construction is inaccurate and not reasonable in light of the '952 Patent specification.

First, the Board’s recitation of “a list of audio files or URLs...” suggests that a “playlist” can be either “a list of audio files or a list of URLs of where audio files are retrieved from.” On its face, this interpretation mischaracterizes the passage of the '952 Patent that is apparently relied upon, as the passage instead explicitly indicates that “[e]ach network enabled audio device 1510 has a storage space 1512 for a playlist 1528, which is a list of audio files and associated URL’s of where the

audio files were retrieved from.” (Ex. 1001, 21:62-65 (emphasis added)).

Whereas this passage of the ’952 Patent uses the conjunctive “and” to link the items within the one particular playlist (1528), the Board’s preliminary construction in IPR2013-00593 opts for the disjunctive “or.” The use of “and” in the cited passage should be given weight (i.e., that the particular playlist (1528) includes *both* a list of audio files *and* URLs). (*See also* Ex. 1001, 22:48-50 (“Within the playlist, the URL’s indicate the location from which the audio files associated with *the song titles in the playlist* can be downloaded.”)).

Second, Patent Owner submits that a construction of playlist that implies that URLs are required to be contained within a playlist or sufficient in and of themselves to constitute a playlist is inconsistent with both the disclosure of the ’952 Patent, as well as the customary meaning of the term as evidenced by the exemplary, contemporaneous publications discussed above. That is, a person having ordinary skill in the art would understand that a playlist need not include URLs and that a list of URLs alone is not a playlist. (Ex. 2007, ¶¶70,74).

Though the passage of the ’952 Patent cited by the Board indicates that the particular playlist (1528) *can* include URLs, the ’952 Patent’s continued reference to “playlists (1528), *and associated URL’s*” indicates that URLs are not generally considered to be contained within, or sufficient to constitute, a “playlist” within the meaning of the ’952 Patent. (*See e.g.*, Ex. 2007, ¶¶74-77). Indeed, this passage of

the '952 Patent describes only a single embodiment of a playlist (i.e., playlist (1528)) being appended to include URLs. This passage is not, however, a characterization of every playlist described in the '952 Patent or an attempt to define a playlist as necessarily including URLs contrary to its plain and ordinary meaning. Rather, the '952 Patent specifically contemplates an embodiment in which the playlist is assigned to a device, and only thereafter, is a location or source from which a song identified in the playlist obtained:

Another aspect of the present invention is a method for assigning playlists of music from one electronic device to another. First, a network connection is used for transmitting and receiving digital data over a communication network to an Internet service provider. Next, the process provides a first software module to manage playlists of songs. *The software module allows a user to compose playlists from a variety of audio sources. The software module allows a user to assign a playlist from a first device to a second device.* Next, the process checks the second device's data storage space for songs listed on the assigned playlist. *Next, the process accesses a server site to obtain locations of the web sites the first device downloaded its audio files from. The process then provides a second software module to connect to various web sites to download remaining songs needed for the playlist.* The second software module connects if songs needed to form the playlist are not stored on the second device's data storage space. Finally, the process uploads files to the server from the first device and downloads files [sic] the second device if the

second software module is unable to download a file from said web site.

(Ex. 1001, 4:50-5:3; *see also* 28:11-43 and Figure 19B).

In fact, what is common among the playlists described in the '952 Patent—and is consistent with the common meaning of the term to one of ordinary skill in the art—is that each playlist of the '952 Patent contains *a list referencing the media items to be played* (in a sequence).

As discussed above, the '952 Patent indicates that three distinct pieces of information are received or obtained by the electronic device in order to play songs indicated by an assigned playlist: i) a playlist identifying a plurality of media items (e.g., by song title); ii) information enabling the electronic device to obtain the media items (e.g., a location or source from which a song identified in a playlist may be obtained); and iii) the media items themselves (e.g., an audio file to be streamed or downloaded). The words of claims 1 and 9 track this central feature of the '952 Patent and evidence the customary meaning of the term playlist—both through the explicit recitation of receiving a “playlist *identifying* a plurality of songs,” and the separate indications of “providing information to the electronic device enabling the electronic device to obtain the ones of the plurality of songs that are not stored on the electronic device from at least one remote source,” as in claim 1, or of “receiving, at the electronic device, information enabling the

electronic device to obtain the ones of the plurality of songs from at least one remote source,” as in claim 9. The language of the challenged claims therefore distinguish on their face between the playlist (e.g., identifying a plurality of songs by title), information enabling the electronic device to obtain the song (e.g., URLs), and the song itself. *See* MPEP § 2111 (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir.2005)) (“The ordinary and customary meaning of a term may be evidenced by a variety of sources, *including ‘the words of the claims themselves....’*”).

Moreover, in every embodiment of the ’952 Patent that specifically shows examples of the contents of a playlist, the title of the song is always identified in the ’952 Patent as being included in the playlist (*see* Ex. 1001, Figures 17D, 17E, 17H, 18D, 18E, 18F), whereas there are no embodiments described in in which a URL is used to identify the songs in a playlist.

As such, claims 1 and 9 of the ’952 Patent and the various embodiments described within the ’952 Patent specification consistently distinguish between the information identifying a song (e.g., song titles) as part of a “playlist,” and information for obtaining the song (e.g., URLs), which is distinct from a playlist and can be obtained independently therefrom.

Accordingly, for purposes of this proceeding, the broadest reasonable interpretation of “playlist” should be in accordance with its customary meaning

and include an indication that a playlist is *a list referencing media items* arranged to be played in a sequence.

b. *The “play” part of “playlist” means the items are arranged to be played in a sequence*

The Board’s preliminary construction of the term “playlist” in the Institution Decision in IPR2013-00593 construes the term without any indication that the items are to be played sequentially. This construction is inconsistent with the customary meaning of the term “playlist” and with the specification of the ’952 Patent, as a whole.

The passage relied upon by the Board describes only a single aspect of one embodiment of a “playlist” in accordance with the ’952 Patent. This particular passage, however, speaks to the *contents* of one particular playlist (i.e., playlist (1528)), and not to the *arrangement* of the contents of the playlist. Nor does the passage relied upon by the Board suggest any express intent by the inventor to diverge from the customary definition of playlist as being a list of media items “arranged to be played in a sequence.” *See Teleflex, Inc. v. Ficosa North America Corp.*, 299 F. 3d 1313,1325 (Fed. Cir. 2002) (“In the absence of an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning.”).

The '952 Patent uses the term “playlist” to refer to a list referencing media items *arranged to be played in a sequence* consistent with its plain and ordinary meaning. For example, the '952 Patent provides that a “playlist” will typically start at the beginning of a list and not stop playing until it “runs out of songs to play.” (Ex. 1001, 24:31-43). That is, playing of items in a playlist occurs in a sequence and does not require a user to manually select the next song to play when the current song ends. That the '952 Patent additionally indicates that a user can repeat or skip songs indicated by the playlist, shuffle the order of songs indicated by the playlist, or repeat playback of the playlist (*see, e.g.*, Ex. 1001, 24:31-43) is also fully consistent with the understanding of a person having ordinary skill in the art at the time of the invention that an order of playback of songs indicated by a playlist can be manipulated, as evidenced by the exemplary contemporaneous publications discussed above.

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

The discussion above regarding the use of the term “playlist” in the '952 Patent as being consistent with its plain and ordinary meaning is fully supported by the Zatkovich'593 Declaration, which concludes that “[t]he '952 Patent uses the

term ‘playlist’ consistently according to this well-known meaning to one of ordinary skill in the art.” (Ex. 2007, ¶60; *see also* Ex. 2006, ¶¶61-84).

D. Construction of “Assigning” and “Assigned to the Electronic Device”

With regard to the recitation of a playlist “assigned to the electronic device” in claim 9, the Petition defers to the Board’s construction in the Institution Decision in IPR2013-00593 as a playlist “directed to a particular device *selected by the user*.” (Paper 1, pp. 5-6, citing Ex. 1007 at 12-14). The Petitioner indicates that the recitation of “assigning a playlist to an electronic device” in claim 1 should be similarly construed as “directing to a particular device selected by the user [a playlist]” based on the Board’s preliminary construction in IPR2013-00593 of the parallel language in claim 9. (Paper 1, pp. 5-6).

Patent Owner respectfully submits that the broadest reasonable interpretation from the vantage point of one of ordinary skill in the art at the time of the invention of the ’952 Patent of “assigning a playlist to an electronic device” is “directing a playlist to an electronic device” and of “a playlist assigned to the electronic device” is “a playlist directed to the electronic device.”

Under the Board’s preliminary construction in IPR2013-00593, specific embodiments described in the ’952 Patent of playlists described as being “assigned to an electronic device” without a user selecting a particular playlist to be played

by a particular device would be excluded. For example, in one embodiment, the '952 Patent provides that the device can be configured such that the device can have “new files and updates *automatically downloaded to the device when it is connected to the IPAN 1100.*” (Ex. 1001, 25:53-58, emphasis added). As such, a playlist could be automatically assigned to the electronic device whenever they are created, for example, and could be received (e.g., downloaded) by the electronic device connecting to the IPAN Server (e.g., by logging in from the receiving electronic device).

The '952 Patent also provides that playlists can be assigned to various devices by those devices connecting to the IPAN server:

The user can synchronize with the server site IPAN 1433 by clicking the synchronize button 1718. Playlists are stored on the server site IPAN 1433 in addition to the PC IPAN client 1508 or device 1510. In other words, a playlist may have been updated at the server site IPAN 1433 by adding or deleting some songs in the playlist. The user can choose to have the same playlist with two different songs at the server site 1104 and on the device 1200 or 1300. But, if the user made the playlist at the server site IPAN 1433, the user presses the synchronize button 1718 so that the next time the device 1200 or 1300 connects, an updated playlist will be downloaded.

(Ex. 1001, 24:17-28).

In this instance, playlists at the server can be assigned to any electronic device that can connect to the network, and received by an electronic device by simply connecting to the server (e.g., by logging in from the receiving electronic device).

Thus, as the '952 Patent explicitly contemplates that playlists can be assigned without requiring user selection of a particular device to which the playlist is directed, it would be improper to adopt the Board's preliminary construction from IPR2013-00593 that would exclude such embodiments.

Superguide Corp., v. DirectTV Enters, 358 F.3d 870, 875 (Fed. Cir. 2004). *See also On-Line Techs., Inc. v. Bodenseewerk Perkin-Elmer GmbH*, 386 F.3d 1133, 1138 (Fed. Cir. 2004) (“[A] claim interpretation that excludes a preferred embodiment from the scope of the claim is rarely, if ever, correct.”).

The discussion above regarding Patent Owner's proposed construction of the term “assigned to the electronic device” is fully supported by the Zatkovich '593 Declaration. (*See* Ex. 2007, ¶¶85-89).

Accordingly, for purposes of this proceeding, the broadest reasonable interpretation of “assigning a playlist to an electronic device” (in claim 1) should be “directing a playlist to an electronic device” and the broadest reasonable interpretation of a playlist “assigned to the electronic device” (in claim 9) should be that a playlist is “directed to the electronic device.”

E. Construction of “Wherein Ones of the Plurality of Songs Are Not Stored On The Electronic Device”

At page 6, the Petition cites to the Board’s determination of the term “wherein ones of the plurality of songs are not stored on the electronic device” in the Institution Decision in IPR2013-00593 (Paper 22, pp. 14-15). Petitioner does not disagree with the Board’s construction. (*See* Paper 1, p. 6). Patent Owner agrees with the Board’s preliminary construction in IPR2013-00593 that the broadest reasonable construction of this term is “wherein at least one of the plurality of songs is not stored on the electronic device.”

V. THE PETITION DOES NOT SATISFY THE STATUTORY THRESHOLD FOR INSTITUTING *INTER PARTES* REVIEW

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged. . . .” 35 U.S.C. § 314(a). In order to ultimately prevail in an *inter partes* review, the Petitioner has the burden of proving unpatentability by a preponderance of the evidence. *See* 35 U.S.C. §316(e).

The Board should deny the Petition as none of the grounds as presented in the Petition gives rise to a reasonable likelihood that the Petitioner would prevail in proving unpatentability of the challenged claims by a preponderance of the

evidence. For each claim of the '952 Patent challenged on the basis of obviousness, the Petition fails to establish that the reference(s) relied upon disclose each and every element of the challenged claims, and moreover, fails to provide anything other than conclusory statements in support of its obviousness challenge.

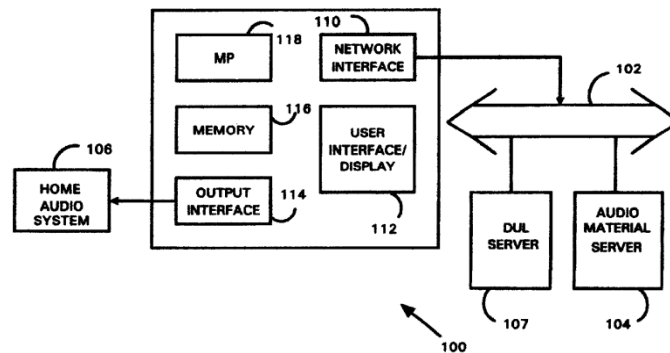
A. There Is No Reasonable Likelihood That Berman Anticipates the Challenged Claims (Ground 1)

In Ground 1, the Petitioner alleges that claims 9, 10, and 14 are anticipated pursuant to 35 U.S.C. § 102(e) by U.S. Patent No. 6,502,194 of Berman *et al.* (hereafter “Berman”).

The information presented in the Petition with regard to Ground 1, however, is insufficient to establish a reasonable likelihood that Berman anticipates any of the challenged claims, as Berman fails to disclose each and every element arranged as recited in the challenged claims.

1. Summary of Berman

U.S. Patent No. 6,502,194 of Berman *et al.* (“Berman”), entitled “System for Playback of Network Audio Material on Demand,” discloses a system for on-demand playback of audio material on a playback apparatus that “retrieves audio data from a remote server and plays them back in real time, using a home audio system, *in response to user selection.*” (Ex. 1003, Abstract (emphasis added)).



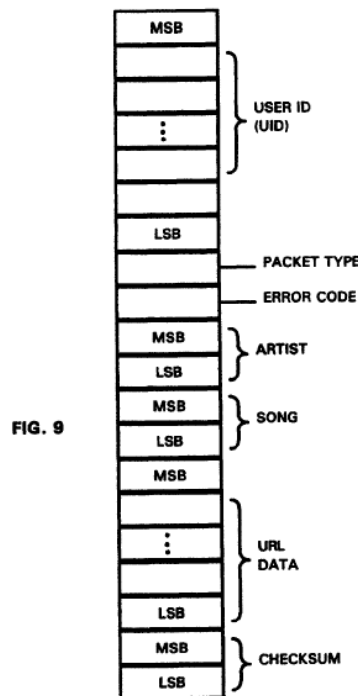
As shown in Figure 1 of Berman, the system includes one or more audio material servers (104) that aggregate digital audio material and a directory and user list (“DUL”) server (107) that provides the “[a]ccess to the audio material and authority for distribution rights.” (Ex. 1003, 4:47-64; *see also* Ex. 2007, ¶93). The DUL server acts as a ‘gatekeeper’ to maintain a catalog of all available songs contained on the audio material server(s) to which a user has rights. This catalog is known as a “Song List.” (*see* Ex. 1003, 7:4-13; *see also* Ex. 2007, ¶93). The system of Berman also includes a playback unit (100) that retrieves selected songs from the audio material server (104) for playback and maintains its own copy of the Song List. (*see* Ex. 1003, FIG. 4 and 7:35-38; *see also* Ex. 2007, ¶93).

Importantly, it is the *playback unit* (100) that Petitioner equates with the “electronic device” of the challenged claims. (*See* Paper 1, p. 24). Accordingly, it is Petitioner’s burden is to show that each and every method step of the challenged claims is performed by playback unit (100).

With reference to Figure 3 of Berman, when the playback unit (100) is powered on, the DUL server (107) synchronizes its Song List with the Song List maintained on the playback unit (100). (Ex. 1003, 6:55-57; *see also* Ex. 2007, ¶94). Thereafter, at step 302, the user selects a music category or type of song desired for playback (by Artist, Title, etc.) on the playback unit (100), and the playback unit (100) sends the “version number” of the playback unit’s Song List to the DUL server in step 304 to confirm that the playback unit has the latest version of the Song List (steps 306 and 308). (Ex. 1003, 9:67-10:2 (“The next two bytes comprise a song list version field that provides the version number of the song list currently stored in the memory of the playback unit”); *see also* Ex. 2007, ¶95). Upon verification of the user’s access rights, the user can then select which song they wish to play (step 310). (*see* Ex. 1003, 7:21-30; *see also* Ex. 2007, ¶96). The playback unit (100) then requests the URL of the selected song from the DUL server in step 312, and the DUL server (107) sends the URL of the selected song back to the playback unit (100) in step 314. (Ex. 1003, 7:30-37 and Figure 7; *see also* Ex. 2007, ¶96).

With reference to Figure 9, which is reproduced below, Berman discloses that the data packet sent from the DUL server contains the URL for a *single*, selected song. (Ex. 1003, 9:49-51; *see also* Ex. 1003, 10:52-6:5 and Ex. 2007, ¶96). That is, in order to playback a selected song, the DUL server receives a

request for a single song (or a portion thereof) (as shown in Figure 7) and responds with a single URL for that selected song (as shown in Figure 9). (See Ex. 2007, ¶96).



With reference now to Figure 4, Berman indicates that “[o]nce the song URL is received, the playback unit initiates communication with the appropriate audio material server to request the song from the appropriate directory.” (Ex. 1003, 7:41-44; *see also* Ex. 2007, ¶ 96). Upon confirming that the user is authorized to receive the requested audio material, in step 412, “the audio material server transmits the audio material (comprising a sound file or streaming audio information) to the playback unit” (Ex. 1003, 8:27-34; *see also* Ex. 2007, ¶97).

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

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

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

As shown in Figure 5, once the track begins streaming, the processor then returns to step 501 to perform any “housekeeping chores” and then step 502 to determine if a “New Track” event has been detected. (See also Ex. 2007, ¶98).

2. Berman does not anticipate claim 9

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

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

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

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

However, Berman’s Song List is not a “playlist” within the broadest reasonable construction of the term. Indeed, the Song List of Berman is not even a list of songs to be played back,³ let alone that songs of Berman’s Song List are arranged to be played in a sequence, as one of ordinary skill in the art would

³ Despite Petitioner’s nominal deference to the Board’s preliminary construction of “playlist” in IPR2013-00593 it must be noted that, in the related ITC Action, the Petitioner and its declarant proposed that a playlist as used in the ’952 Patent should mean “a list of one or more audio files *for playback.*”

understand the term “playlist” in light of the ’952 Patent. Rather, the Song List of Berman is merely a catalog of all available songs to which the user has rights. (*See* Ex. 2007, ¶102). That is, the Song List only identifies those songs for which the user has *authorization for playback*. (Ex. 2007, ¶103).

To a person of ordinary skill in the art at the time of the invention of the ’952 Patent, a playlist was distinct in name and function from other types of media lists. (*See* Ex. 2007, ¶59). For example, though an online music store could offer a “catalog” of songs from which songs could be purchased and played, unless the songs identified in the list were provided for playback one after another in a sequence, the list would *not* be considered a playlist by a person having ordinary skill in the art. (*See* Ex. 2007, ¶59). As summarized above, the ’952 Patent highlights the role of the *playlist* (as opposed to the audio content itself) in the operation of a network-enabled electronic device. (*See* Ex. 2007, ¶31). Specifically, the ’952 Patent provides that the *receipt of an assigned playlist* by a network-enabled electronic device allows the playlist-receiving device to obtain and play the audio content indicated by the playlist. (*See* Ex. 2007, ¶31). The central nature of the playlist to the ’952 Patent is reflected in claim 9, which on its face indicates that three distinct pieces of information are received or obtained by the electronic device in order to play the songs indicated by a playlist assigned thereto: a playlist identifying a plurality of media items; information enabling the

electronic device to obtain the media items; and the media items themselves. (See Ex. 2007, ¶¶77,78).

Berman does not disclose or suggest such a method that includes receiving a playlist assigned to an electronic device to enable the device to obtain and playback the music indicated thereby. Rather, the only audio material that is played by the playback unit of Berman is *selected on the playback unit itself*, and the listing of such audio material remains on the playback unit (100). (See Ex. 2007, ¶110). At no time does the playback unit ever receive a playlist or any other list of selected songs for playback from the servers. (See Ex. 2007, ¶111). Indeed, because Berman indicates that the playback unit requests URLs from the audio material server (104) only one song at a time, the servers would have no knowledge of the plurality of songs selected for playback by the playback unit and thus could not provide an assignment of such songs identified by the user at the playback unit. (See Ex. 2007, ¶¶107,111).

This is clear because *only after* the Song List is updated in step 308, *can the user actually select* one or more songs for playback on the playback unit (100) (step 310). (Ex. 2007, ¶104). The Song List does not therefore identify songs *to be played* by the playback unit (100), sequentially or otherwise, but merely represents a list of possible songs from which a user can select. (Ex. 2007, ¶104).

In fact, until the user makes a particular selection at the playback unit (100), there can be no list of items arranged for playback.

Petitioner fails to identify with particularity any other element in Berman that purportedly meets the recitation of “receiving a playlist assigned to the electronic device” as required under 37 C.F.R. 42.104(b). As such, the Petition’s mere identification of step 308 in Figure 3 (“DUL SENDS UPDATED SONG LIST TO PLAYBACK UNIT”) cannot represent the step of *receiving* a playlist assigned to the electronic device as recited in claim 9. The Petition is therefore deficient.

For at least these reasons, the Board should deny institution with respect to this ground as the information presented in the Petition is insufficient to establish a reasonable likelihood that Berman anticipates independent claim 9. The material distinctions discussed above between claim 9 and Berman also apply equally to dependent claims 10 and 14, which depend therefrom.

In the event that a trial is instituted with respect to Ground 1, Patent Owner reserves the right to provide additional reasoning with regard to patentable distinctions of independent claim 1 and its dependent claims over Berman.

B. There Is No Reasonable Likelihood That Berman Renders Obvious the Challenged Claims (Ground 2)

In Ground 2, the Petitioner alleges that claims 1, 2, and 3 are rendered obvious pursuant to 35 U.S.C. § 103(a) by Berman.

The information presented in the Petition with regard to Ground 2, however, is insufficient to establish a reasonable likelihood that Berman renders obvious any of the challenged claims. The Petitioner fails to establish that Berman, in any combination of its embodiments, discloses each and every element arranged as recited in the challenged claims, and does not articulate any reasonable rationale for modifying Berman to arrive at the claimed invention.

The Petition alleges that the updated Song List provided by the DUL server of Berman meets claim 1's recitation of "providing the playlist to the electronic device," as follows:

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

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

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

The reasoning provided above with regard to Berman's failure to disclose or suggest that a playlist is received by an electronic device as recited in claim 9

applies with equal force to establish the deficiencies of the Petitioner's arguments regarding claim 1.

Simply, the playback unit (100) cannot receive a "playlist" from the DUL server (107) because the DUL server (107) does not provide a "playlist." Rather, the Song List of Berman that is updated by the DUL server (107) is a catalog of all available songs to which the user has rights such that the Song List merely identifies those songs for which the user has *authorization for playback*.⁴ (See Ex. 2007, ¶102). The Song List of Berman is not, however, a list of songs to be played back, let alone a list of songs arranged to be played in a sequence, as one of ordinary skill in the art would understand the term "playlist."

As discussed above, the '952 Patent highlights the role of the playlist (as opposed to the audio content itself) in the operation of a network-enabled electronic device. (See Ex. 2007, ¶31). Specifically, the '952 Patent provides that providing an *assigned playlist* to a network-enabled electronic device allows the

⁴ Even when Berman discusses "selecting an available music category" and "sending a current song list version for the selected music category to a network server and receiving an updated song list if the current song list is in need of updating," (Claim 15), only a catalog of available songs is sent. Since a selection must still be made by the user, no playlist has yet been created, much less received.

playlist-receiving device to obtain and play the audio content indicated by the playlist. (*See* Ex. 2007, ¶31).

Berman does not disclose or suggest such a method. Rather, the only audio material that is played by the playback unit of Berman is *selected on the playback unit itself*, and the listing of such audio material remains on the playback unit (100). (*See* Ex. 2007, ¶110). At no time does the DUL server (107) provide a playlist or any other list of selected songs for playback. (*See* Ex. 2007, ¶111). Petitioner does not, and cannot, identify any other element in Berman that purportedly meets the recitation of “providing a playlist to the electronic device” as required under 37 C.F.R. 42.104(b).

Moreover, the Petition fails to articulate what is missing from Berman relative to the challenged claims and why a person having ordinary skill in the art would have found it obvious to supplement the missing elements. The totality of Petitioner’s arguments as to obviousness are found on page 38:

A POSA would have understood that songs that had already been downloaded could be replayed without downloading the songs again, as long as the playback unit remained on. Jeffay Dec. ¶ 36. . . . A POSA would also have understood that to play such songs, they would need to be downloaded from the audio material servers (remote sources) using URLs provided to the playback unit by the DUL server.

These statements (and the nearly identical statement in the Jeffay declaration) amount to mere argumentation and fail to establish that Berman discloses each and every element arranged as recited in the challenged claims. Moreover the statements do not articulate any reasonable rationale for modifying Berman to arrive at the claimed invention.

For at least these reasons, the Board should deny institution with respect to this ground as the information presented in the Petition is insufficient to establish a reasonable likelihood that Berman renders obvious independent claim 1. The material distinctions discussed above between claim 1 and Berman also apply equally to dependent claims 2 and 3, which depend therefrom.

In the event that a trial is instituted with respect to Ground 2, Patent Owner reserves the right to provide additional reasoning with regard to patentable distinctions of independent claim 1 and its dependent claims over Berman.

C. There Is No Reasonable Likelihood That Berman in View Of Lau Renders Obvious the Challenged Claims (Ground 3)

In Ground 3, the Petitioner alleges that claims 4, 11, and 12 are rendered obvious pursuant to 35 U.S.C. § 103(a) by Berman in view of U.S. Provisional Patent Application No. 60/233,741 of Lau *et al.* (“Lau Provisional”), which was filed on September 19, 2000.

Though the Petitioner asserts that the Lau Provisional is available as prior art under 35 U.S.C. § 102(e), (Paper 1, pp. 3-4, 23), the Lau Provisional is neither an application “published under section 122(b)” nor a granted patent as required to qualify as prior art under 35 U.S.C. § 102(e).

Ex parte Yamaguchi, 88 USPQ2d 1606 (BPAI 2008), which is cited by the Petitioner in support of its arguments on the Lau Provisional, is not applicable to the instant proceeding as *Yamaguchi* indicates that a patent that claims the benefit of an earlier-filed provisional may qualify as prior art as of the filing date of the provisional application. Indeed, in distinguishing *Yamaguchi* in a case in which the Petitioner cited a provisional application as prior art under § 102(e), this Board held that only “two types of documents may be relied upon under § 102(e) to show that claims are unpatentable: ‘(1) an application for patent, published under section 122(b), . . . or (2) a patent granted on an application for patent.’” *See Sequenom, Inc. v. The Board of Trustees of the Leland Stanford University*, IPR2014-00337, (Paper 11, p. 3) (quoting 35 U.S.C. § 102(e)).

Further, there is no reason to deviate from this Board’s clear precedent in *Sequenom*—denial of this ground on this reason alone would not elevate form over substance. Indeed, based on the litigation history between the Petitioner and Patent Owner, the Petition’s identification of the Lau Provisional as a prior art reference

under § 102(e) (as opposed to U.S. Patent No. 8,281,001 of Busam *et al.*

(“Busam”)) appears more akin to gamesmanship than inadvertent error.

During the pre-trial phase of the related ITC Action, the Petitioner (relying on testimony of Petitioner’s same declarant) asserted that Busam anticipated all of the challenged claims of the ’952 Patent under 35 U.S.C. § 102(e) through its claim to the priority date of the Lau Provisional. In response, Patent Owner argued that Busam’s disclosure was not supported by the Lau Provisional within the meaning of 35 U.S.C. § 112, first paragraph, such that Busam should not qualify as a prior art reference under § 102(e).⁵ (*See* Ex. 2012, ¶¶194-199).⁶ Petitioner did not assert Busam during the trial phase of the ITC Action.

⁵ In relevant part, MPEP § 2136.03(III) provides: “The pre-AIA 35 U.S.C. 102(e) critical reference date of a U.S. patent . . . is the filing date of the provisional application with certain exceptions *if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C 112(a)/ pre-AIA 35 U.S.C. 112, first paragraph.*”

⁶ Exhibit 2012 is the redacted, rebuttal expert report of Ivan Zatkovich submitted in the ITC Action (the “Zatkovich ITC Declaration”). The Zatkovich ITC Report contains, in part, a response to the Petitioner-Respondents’ joint expert report of Kevin Jeffay, Ph.D. regarding validity of the ’952 Patent. The Zatkovich ITC

In this proceeding, though the Petitioner notes that Busam claims priority to and incorporates the Lau Provisional by reference, the Petitioner has tellingly avoided making any claims that the passages of Lau that are cited in the Petition provide written description support within the meaning of 35 U.S.C. § 112, first paragraph, for the “corresponding” passages of Busam that are provided in parallel.

Patent Owner additionally notes the differences between the chart entitled “Citation of Prior Art” on pages 3-4 of the instant Petition and the chart similarly named on pages 3-4 of the Petition filed on the same day and by the same counsel for Petitioner in IPR2014-00737 against related U.S. Patent No. 8,050,652. While both charts improperly cite to provisional applications as being prior art under 35 U.S.C. § 102(e), the chart in IPR2014-00737 also explicitly identifies U.S. Patent No. 7,020,704 of Lipscomb *et al.* (hereafter “Lipscomb”) prior to identifying its various priority provisional applications.

Further, the Petition in IPR2014-00737 explicitly alleges that “each of the relevant disclosures of the Lipscomb patent is supported by disclosures in one or more of these provisional applications. . . . As a result, each of the relevant disclosures of Lipscomb cited in this Petition benefits from a Section 102(e) date

Declaration was not prepared for the purpose of this *inter partes* proceeding, and is thus entitled to be submitted herewith. *See* IPR2013-00114 (Paper 11, p. 3).

of at least January 24, 2000, which is the latest filing date among the filing date of the underlying provisional applications.” (IPR2014-00737, Paper 1, pp. 23-24 (emphasis added)). No such statement was made by the Petitioner in the instant Petition.

Finally, in each instance in IPR2014-00737 in which a claim limitation was purportedly met by Lipscomb, the Petitioner first provided a citation to Lipscomb itself, and only then followed this citation with a parallel citation in a priority provisional application. In the instant Petition, however, the Petitioner instead identifies first the relevant disclosure of the Lau Provisional, followed by a “see also” with reference to various portions of Busam. In light of the Petitioner’s previous arguments regarding Busam that were put forth and ultimately dropped by the Petitioner in the related ITC Action, the differences between the manner in which the alleged prior art references and their priority provisional(s) are described in this Petition and that of IPR2014-00737 demonstrate that the Petitioner itself doubts Busam’s viability as a prior art reference under §102(e).

This ambiguity should not be resolved in Petitioner’s favor. The Lau Provisional is not a prior art reference under any statutory provision of 35 U.S.C. § 102, and thus, is unavailable to be used in an obviousness rejection pursuant to §103. The Petitioner has therefore failed to meet its burden of establishing a

reasonable likelihood of proving obviousness of the challenged claims over the combination of Berman and the Lau Provisional.

In the event that a trial is instituted with respect to Ground 3 of the Petition, Patent Owner reserves the right to provide additional reasoning with regard to patentable distinctions of each of claims 1 and 9 and claims which depend therefrom over the proposed combination of Logan and the Lau Provisional.

D. There Is No Reasonable Likelihood That Logan Renders Obvious the Challenged Claims (Ground 4)

In Ground 4, the Petitioner alleges that claims 1-3, 9-11, and 14 are rendered obvious pursuant to 35 U.S.C. § 103(a) by U.S. Patent No. 6,199,076 of Logan *et al.* (hereafter “Logan”).

The information presented in the Petition with regard to Ground 4, however, is insufficient to establish a reasonable likelihood that Logan renders obvious any of the challenged claims. The Petitioner fails to establish that Logan discloses each and every element arranged as recited in the challenged claims, and does not articulate any reasonable rationale for modifying Logan to arrive at the claimed invention.

1. Summary of Logan

Logan describes a content distribution system in which “a host system organizes and transmits program segments” to a player device. (Ex. 1004,

Abstract). The host system also transmits a schedule for playing the program segments to the player device. (Ex. 1004, 2:47-50; *see also* Exhibit 2012, ¶241). “The host organizes the program segments by subject matter and creates the scheduled programming in accordance with preferences of each subscriber.” (Ex. 1004, Abstract; *see also* Ex. 2012, ¶241). For example, Logan provides that the “program compilation for a given subscriber might illustratively consist of seven subjects: world news, national news, local news, computer trade news, email and voice mail messages, country music, classical music. . . .” (Ex. 1004, 30:31-35; *see also* Ex. 2012, ¶242). 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. . . [T]he subscriber may request that the announcements be suppressed during continuous play. . . .” (Ex. 1004, 30:43-51; *see also* Ex. 2012, ¶242).

As described with reference to Figure 1, to allow the player device (103) to access the program schedule and program segments, the contents of the compilation/storage unit (145) of the host server (101) are “placed in a predetermined FTP download file directory and assigned a filename known to the player 103.” (Ex. 1004, 6:53-55; *see also* Ex. 2012, ¶244). Specifically, the host

server (101) assembles and provides to the player device (103) a “download compilation file 145” that includes a schedule file of the program segments to be played. (Ex. 1004, 6:51-7:20; *see also* Ex. 2012, ¶244). The schedule file consists of program segment identification numbers (“ProgramIDs”), which are compiled into a sequencing or selections file (351), as illustrated in Figure 5 that contains detailed information about the sequence of events which occur during playback. (Ex. 1004, 12:3-10). Upon downloading the session schedule file, the player (103) issues download requests for those program segment files which are not already available in the player's local storage unit (107). (Ex. 1004, 7:10-13). “The selections made by and uploaded from the subscriber take the form of a file (sequence) of 32 bit integers, each integer (ProgramID) designating a particular program segment.” (*See* Ex. 1004, 17:10-14).

The predetermined FTP download file directory is also used to provide the content to the user's device: “download file or files containing programming and advertising segments as well as subscriber specific data are . . . moved from storage unit 145 utilizing the FTP server.” (Ex. 1004, 8:29-33; *see also* Ex. 2012, ¶244). (*See also*, Ex. 1004, 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.”).

2. Logan does not disclose providing a playlist to an electronic device or receiving at an electronic device a playlist assigned to the electronic device, the playlist identifying a plurality of songs

Ground 4 should be dismissed at least because the Petitioner fails to establish that Logan teaches a method that includes “providing the playlist to the electronic device,” as recited in claim 1, or “receiving, at an electronic device, a playlist assigned to the electronic device,” as recited in claim 9. (*See* Ex. 2012, ¶245).

In the Petition’s claim chart on page 43 (claim 1) and page 48 (claim 9), the passages of Logan relied upon as allegedly showing these steps of the methods recited in claims 1 and 9 merely describe that in Logan’s system, the host server (101) provides the player (103) with a compilation file (145) having a schedule file containing a plurality of ProgramIDs for program segments. (Ex. 2012, ¶246).

Logan does not disclose or suggest that these program segments are songs. (Ex. 2012, ¶247). Rather, Logan describes these program segments are “compressed audio files and/or text,” (Ex. 1004, 4:46-47), on subjects including “world news, national news, local news, computer trade news, email and voice mail messages, country music, classical music. . . .” (Ex. 1004, 30:31-35; *see also* Ex. 2012, ¶247). Indeed, when Logan refers to program segments that correspond to “country music” and “classical music,” Logan states that the music selections

correspond to “topics.” (Ex. 1004, 30:43-45, “the music selections (‘topics’) within each of the two music subjects, ‘country music’ and ‘classical music’.” *See also* Ex. 2012, ¶247). This reference to music “topics” indicates that the music-related program segments referred to in Logan are not songs themselves, but rather genre-based radio broadcasts, such as programs of a country music station or a classical music station that have been recorded and stored. (Ex. 2012, ¶247). In fact, Logan refers to a music program segment as “an audio recording of a broadcast radio program. . . .” (Ex. 1004, 40:20-22; Ex. 2012, ¶247). Whereas claims 1 and 9 recite that the playlist identifies a plurality of songs, each of Logan’s “segments” is instead a recording of a broadcast radio program, which itself contains talk radio, DJ intros, advertisements, and music, and thus is not a “song.” (*See* Ex. 2012, ¶247). Indeed, the ’952 Patent explicitly distinguishes between songs and recordings of a broadcast radio program in differentiating between the Internet radio and playlist modes of operation. (*See* Ex. 2012, ¶248).

Moreover, Logan merely describes that the schedule file containing ProgramIDs and that is provided to the player device (103) (and which is alleged by the Petition as meeting the recitation of a playlist), is simply a list of “numbers” or “key value[s].” (*See* Ex. 1004, 12:5-7 and 17:54; *see also* Ex. 2012, ¶250). The ProgramIDs do not include the titles of the program segments. (Ex. 2012, ¶250). Thus, even assuming *arguendo* that the ProgramIDs correspond to program

segments the underlying contents of which are songs, the ProgramIDs are not a “playlist identifying a plurality of songs” as recited in the challenged claims. (Ex. 2012, ¶250). In fact, Logan describes that music selections “are preceded with a brief announcement identifying the musical selection which follows,” thus using audio clips to tell the user what the content is rather than titles within a playlist (Ex. 1004, 30:45-46; *see also* Ex. 2012, ¶250).

The Petition’s reliance on Logan as rendering obvious claims 1 and 9 of the ’952 Patent is therefore deficient at least because Logan does not disclose or suggest material limitations of these claims. In fact, in confirming the validity of claims 1 and 9 of the ’952 Patent over Logan, the ITC determined that Logan “does not disclose the claimed ‘playlist,’” and also that “Logan does not disclose that the program segments are songs.” (Ex. 2010, p. 368). It is also noteworthy that, when the Petitioner-Respondent argued this same point at the ITC (relying upon the testimony of the same declarant), Administrative Law Judge Shaw of the ITC determined that Logan fails to disclose a method that includes an electronic device “receiving a playlist” or “providing the playlist to the electronic device,” as recited in the challenged claims of the ’952 Patent. (*See* Ex. 2010, p. 367).

For at least these reasons, the Board should deny institution with respect to this ground as the information presented in the Petition is insufficient to establish a reasonable likelihood that Logan, in any single embodiment or in any combination

of its embodiments, renders obvious independent claims 1 and 9. The material distinctions discussed above between the independent claims and White also apply equally to dependent claims 2, 3, 10, 11, and 14, which depend from one of claims 1 and 9.

In the event that a trial is instituted with respect to Ground 4 of the Petition, the Patent Owner reserves the right to provide additional reasoning with regard to patentable distinctions of each of independent claims 1 and 9 and claims which depend therefrom over Logan.

E. There Is No Reasonable Likelihood That Logan in View of Lau Renders Obvious the Challenged Claims (Ground 5)

In Ground 5, the Petitioner alleges that claims 4 and 12 are rendered obvious pursuant to 35 U.S.C. § 103(a) by Logan in view of the Lau Provisional.

This ground should be denied. As discussed above with respect to Ground 3, the Lau Provisional is not a prior art reference under any statutory provision of 35 U.S.C. § 102, and thus, is unavailable to be used in an obviousness rejection pursuant to §103. The Petitioner has therefore failed to meet its burden of establishing a reasonable likelihood of proving obviousness of the challenged claims over the combination of Logan and the Lau Provisional.

In the event that a trial is instituted with respect to Ground 5 of the Petition, the Patent Owner reserves the right to provide additional reasoning with regard to

patentable distinctions of each of claims 1 and 9 and claims which depend therefrom over the combination of Logan and the Lau Provisional.

VI. REDUNDANT GROUNDS PRESENTED IN THE PETITION SHOULD BE DISMISSED

Part 42 of Title 37, Code of Federal Regulations, governs proceedings before the Board and 37 C.F.R. § 42.1(b) provides that “[t]his part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” In the case of *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00003, the Board addressed the issue of horizontal redundancy:

[Horizontal Redundancy] involves a plurality of prior art references applied not in combination to complement each other but as distinct and separate alternatives. All of the myriad references relied on provide essentially the same teaching to meet the same claim limitation, and the associated arguments do not explain why one reference more closely satisfies the claim limitation at issue in some respects than another reference, **and** vice versa. Because the references are not identical, each reference has to be better in some respect or else the references are collectively horizontally redundant.

(*Id.* (emphasis original)).

Petitioner’s assertion of Berman (Grounds 1 and 2) and Logan (Ground 4 and 5) as anticipating or rendering obvious the challenged independent claims is a classic case of horizontal redundancy. Petitioner provides no explanation as to

“why one reference more closely satisfies the claim limitation at issue in some respects than another reference, and vice versa.” Accordingly, in the interest of timely and efficient administration of justice, Petitioner’s horizontally redundant grounds are not entitled to consideration and should be denied.

VII. CONCLUSION

For all the reasons above, a trial should not be instituted in this matter. Indeed, the Board should terminate this proceeding without otherwise considering the substance of the Petition because the Petitioner fails to identify all real parties in interest pursuant to 35 U.S.C. § 312(a)(2).

Should the Board find that the Petitioner has complied with the statutory requirements of 35 U.S.C. § 312(a)(2), the Board should nonetheless deny the Petition as none of grounds presented in the Petition gives rise to a reasonable likelihood of the Petitioner prevailing with respect to any of the challenged claims of the ’952 Patent.

Dated: August 20, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on August 20, 2014, a true and accurate copy of this paper, PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,045,952 and its Exhibits, were served on the following counsel for Petitioner via email:

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