UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREE STREAM MEDIA CORP.
D/B/A SAMBA TV,
Petitioner

v.

GRACENOTE, INC.,
Patent Owner

Inter Partes Review Case No. IPR2020-00216
U.S. Patent No. 9,066,114

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY REGARDING DISCRETIONARY DENIAL UNDER § 325(d)

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TABLE OF AUTHORITIES

I. THE BOARD SHOULD DENY INSTITUTION UNDER § 325(d)

The Board should exercise its discretion to deny review because the Petition does not satisfy the two-part test of *Advanced Bionics*. *Advanced Bionics, LLC v. Med-el Elektromedizinische Geräte GmbH,* IPR2019-01469, Paper 6 at 8-9 (Feb. 13, 2020). In evaluating a related child application, the Office reviewed Murphy (Petitioner's primary reference), Brunk (Petitioner's secondary reference), as well as the present Petition and its supporting evidence, and determined Murphy does not teach the time-based actions Petitioner now argues. Petitioner's Reply (Paper 17) does not address this child application at all, even though it was discussed in the POPR (Paper 12). In addition, Petitioner's cited art is substantially the same as art considered during examination of the '114 Patent itself, and Petitioner does not show any error in the Office's previous evaluation. Institution should be denied.

A. Petitioner's Art Was Already Considered by the Office

Petitioner contends Murphy is "materially different" and thus non-cumulative because Murphy allegedly teaches a time point at which actions are taken. (Paper 17, at 4, 2). Murphy's alleged teaching of a time-based action was previously considered and rejected by the Office. In a later child application, Patent Owner reopened prosecution after allowance to cite this Petition and evidence, including Murphy and Brunk. (Ex. 2008, at 182-212). In response, the Examiner provided a

thorough explanation of the Office's opinions regarding Murphy and Brunk, including finding Murphy lacked teaching a time point at which an action is taken:

> **The body of art has been carefully considered, including** art cited in the Information Disclosure Statement and found in an updated search & consideration of the art: **Murphy**…**Brunk**…. [¶] While a person of ordinary skill in the art (POSITA) can trigger an action at the beginning of a particular piece of content, end of a particular piece of content or at some point in between, **the claim requires the action be executed in association with a time point which indicates when in the multimedia content such action is to be executed; this explicit mapping is silent in the references and the fact that the art provides for execution of an action requires speculation as to the time point as recited.** The Examiner is constrained by what the reference explicitly recites. The Examiner would be resorting to speculation as to applying art to the entirety of the claims…. For the Examiner **to fit the separate pieces of the reference together to render the claim obvious would be resorting to a clear hindsight reconstruction….**

Id. at 226-227 (emphases added). Notably, the Examiner made these comments rejecting Petitioner's reliance on Murphy and Brunk in the Reasons for Allowance without any input or argument from the applicant (the Patent Owner in this IPR).

Thus, the Office already addressed the teachings of Murphy and reached a different conclusion than now urged by Petitioner. The Office found the art teaches execution of an action, but that this is insufficient and "requires speculation" as to the time point at which the action is taken. *Id.* The Office also fully recognizes the

art "trigger[s] an action at the beginning of a particular piece of content, end of a particular piece of content or at some point in between" but found this insufficient to teach executing an action at a time point in the multimedia content. *Id.*, *cf.* Paper 17, at 2-3 (Petitioner arguing Murphy teaches a time point to start or end recording or detecting a traffic announcement that occurs in the middle of a program). The Examiner independently came to the conclusion Murphy does not teach a time point at which time-based actions are taken, contrary to Petitioner's contention. To reach a different conclusion in this IPR would undermine the work already input by the Office and create inefficiencies and inconsistencies in the merits evaluation of patents. *Advanced Bionics*, at 9 ("this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown"). Again, Petitioner has not attempted to rebut the Examiner's comments.

The Office's findings regarding Murphy should be given weight in the § 325(d) analysis even though not specifically made for the '114 Patent. The end of examination is not the end of the analysis: "although *Becton, Dickinson* factors (a) and (b) pertain to art evaluated 'during examination,' these factors more broadly provide guidance as to whether the art presented in the petition is the 'same or substantially the same' as the prior art previously presented to the Office during *any* proceeding, including prior AIA proceedings." *Advanced Bionics*, at 10.

B. Murphy Is "Substantially the Same" as Haitsma, Rhoads, and Levy

Murphy presents substantially the same information as Haitsma, Rhoads, and Levy, all of which were considered by the Office during examination of the '114 Patent and its parent. Murphy teaches identifying an entire item of content based on a small portion of the content so that it can take actions that relate to the entire program (such as recording it or displaying accurate program data). (Ex. 1011, at 4:10-14 ("Preferably **the identification of the programme from the programme cue** is performed by detecting a match between the frequency content of a portion of the signal with the frequency content of the programme cue associated with **a given programme of interest**.…")). Likewise, each of Haitsma, Rhoads, and Levy teaches identifying content to perform actions that relate to the entire content based on a small segment of the content. *See* Ex. 1016, Haitsma, at ¶ [0025] ("Even if we only have a short piece of audio (of the order of seconds), we would like to determine which song it is."); Ex. 2004, Rhoads, at Abst. ("Fingerprint data derived from audio or other content is used as an identifier, to trigger machine responses corresponding to the content."); 3:7-8 ("[Other fingerprinting techniques] work on much shorter windows—a few seconds, or fractions of seconds."), 3:17-21 (operating on live streaming content); Ex. 2007, Levy, Abst. (using a fingerprint to link an audio signal to actions); ¶ [0051] (using, as does Murphy, the first few seconds of the signal to generates the fingerprint for the signal).

C. *Advanced Bionics* Part 1: The Art Is Substantially the Same

Determining "substantially the same art" analyzes *Becton, Dickinson* factors (a), (b), and (d). *Advanced Bionics*, at 10. For (a), Petitioner relies on Murphy to teach the same "time point at which actions are to be taken" for which the Examiner relied upon Rhoads/Haitsma during prosecution of the '114 family. (Ex. 2005, at 376-380; Ex. 2009, at 205-207). For (b)/(d), the Office found the '114 Patent patentable after Applicant distinguished Haitsma's actions responsive to identifying the content from the '114 Patent's actions corresponding to a time point. (Ex. 2009, at 238, 292 (Reasons for Allowance citing Applicant's arguments)). Murphy also takes action responsive to identifying content, rather than action corresponding to a time point and is cumulative with Rhoads, Haitsma, and Levy. Petitioner's arguments add nothing new to what was considered by the Office.

D. *Advanced Bionics* Part 2: Petitioner Has Demonstrated No Error

Demonstrating material error analyzes *Becton, Dickinson* factors (c), (e), and (f). *Advanced Bionics*, at 10. Petitioner offers no explanation why the Office's findings on Murphy erred. Petitioner's argument Murphy was not "considered during prior examination" (Paper 17, at 4) fails to acknowledge that Murphy *was* considered in a proceeding involving a child application of the '114 Patent, and does not rebut the Examiner's "carefully considered" findings (Ex. 2008, at 226). Petitioner offers no "additional evidence and facts" warranting reconsideration.

Respectfully submitted,

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APPENDIX OF EXHIBITS

Exhibit 2001	Declaration of Dr. Pierre Moulin
Exhibit 2002	Memorandum Opinion, *Gracenote, Inc. v. Free Stream Media Corp.,* No 1:18-cv-01608-RGA (D. Del. Dec. 11, 2019), ECF No. 25
Exhibit 2003	Report and Recommendation, *Gracenote, Inc. v. Free Stream Media Corp., d/b/a Samba TV, No.* 1:18-cv-01608-RGA (D. Del. Nov. 1, 2019), ECF No. 22
Exhibit 2004	U.S. Patent No. 7,185,201 to Rhoads, et al.
Exhibit 2005	Prosecution History for U.S. Patent No. 8,020,000
Exhibit 2006	U.S. Patent No. 8,020,000 Patent to Oostveen, et al.
Exhibit 2007	U.S. Patent Application Publication No. 2003/0021441 to Levy, et al.
Exhibit 2008	Prosecution History for U.S. Patent Application 16/264,134
Exhibit 2009	Prosecution History for U.S. Patent 9,066,114

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY REGARDING DISCRETIONARY DENIAL UNDER § 325(D) was served on May 11, 2020, by email on the following counsel of record for Petitioner:

Don Daybell at D2DPTABDocket@orrick.com
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Dated: May 11, 2020

Respectfully submitted,

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