

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Yamaha Corporation of America
Petitioner

v.

Black Hills Media, LLC
Patent Owner

Patent No. 8,214,873

Issue Date: July 3, 2012

Title: METHOD, SYSTEM, AND COMPUTER-READABLE MEDIUM FOR
EMPLOYING A FIRST DEVICE TO DIRECT A NETWORKED AUDIO
DEVICE TO RENDER A PLAYLIST

Inter Partes Review No. IPR2013-00598 (PPC)

**PETITIONER YAMAHA CORPORATION OF AMERICA'S
REQUEST FOR REHEARING**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. ARGUMENT	3
A. The Board Incorrectly Stated the Asserted Basis for Obviousness.....	3
B. Dr. Bove Appropriately Relied Upon Common Sense	6
III. CONCLUSION.....	8

Petitioner provides this Request for Rehearing under 37 C.F.R. § 42.71(d) on the Decision of Institution of *Inter Partes* Review (Paper 19) dated March 20, 2014. In the Decision, the Board granted review of claims 1, 2, 6-13, 15-31, 35-42 and 44-46 based on the combination of Bi and Erikson (Ground 5) or Bi, Erikson and Janik '955 (Ground 7). The Board denied review of dependent claims 4, 5, 33 and 34 based on the combination of Bi, Erikson and the Sony Ericsson White Paper (Ground 6). Petitioner requests a limited rehearing as to the combination of Bi, Erikson and the Sony Ericsson White Paper and for an order to include Ground 6 as a basis of invalidating claims 4, 5, 33 and 34.

I. INTRODUCTION

In its Decision, the Board instituted *inter partes* review as to independent claims 1 and 30 based upon Bi (Ex. 1012) and Erikson (Ex. 1013). (Decision at 19.) Exemplary claim 1 provides:

1. A method for facilitating the presentation of media, the method comprising:
displaying, on a first device, at least one device identifier identifying a second device;
receiving user first input selecting the at least one device identifier;
receiving, on the first device, a playlist, the received playlist comprising a plurality of media item identifiers;

receiving user second input selecting at least one media item identifier from the received playlist; and directing, from the first device, the second device to receive a media item identified by the at least one media item identifier from a content server, without user input via the second device.

The Board noted Petitioner's assertion that it would have been obvious to one of ordinary skill in the art to use the handheld device (the above claimed "first device") disclosed in Erekson in the system disclosed in Bi. (*Id.*) The Board also noted Petitioner's position that "[u]sing Erekson's handheld device in Bi's system involves applying a known technique to improve a known device by providing the ability to select and control multiple devices, such as the computing platform and an amplifier used to play audio signals from the platform of Bi, from a single remote." The Board stated that "[f]or purposes of this Decision, we are persuaded by Petitioner's evidence as to claim 1." (*Id.*)

Dependent claims 4 and 33 recite that the claimed "first device" is an MP3 player. Dependent claims 5 and 34 recite that the "first device" is a mobile phone. Regarding these claims, the Board stated that Petitioner's expert opined "without further evidentiary support" that it would have been obvious to add the MP3 player functionality or mobile phone functionality of the Sony Ericsson White Paper (Ex. 1014) into the navigator of Bi and the PDA of Erekson. (*Id.* at 21.) The Board stated:

Dr. Bove's conclusions, however, are unsupported by any evidence as to why a person of ordinary skill in the art would combine Bi, Erekson, and the Sony Ericsson White Paper.

It is respectfully submitted that the Board's conclusion was incorrect for two reasons. First, the Board did not properly characterize Dr. Bove's analysis and thus incorrectly considered the asserted basis of obviousness. Second, Dr. Bove appropriately relied upon common sense, and thus the Board's requirement of other evidence to support a finding of obviousness was also incorrect.

Petitioner notes that claim 5 is one of only two claims (along with claim 1) currently being asserted in the co-pending litigation against Petitioner. The determination whether to institute review as to this claim is therefore critical with respect to the PTO's statement that the purpose of the AIA and the final IPR rules "is to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs." *Rules of Practice*, 77 Fed. Reg. 48,612 (August 14, 2012). For the reasons set forth below, review should be instituted as to claim 5, as well as claims 4, 33 and 34.

II. ARGUMENT

A. The Board Incorrectly Stated the Asserted Basis for Obviousness

Claim 5 recites in its entirety:

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

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