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2014 WL 1604334 (Patent Tr. & App. Bd.)

Patent Trial and Appeal Board
Patent and Trademark Office (P.T.O.)***1 ELECTRONIC FRONTIER FOUNDATION PETITIONER,**
v.
PERSONAL AUDIO, LLC PATENT OWNER.Case IPR2014-00070
Patent 8,112,504

April 18, 2014

For PETITIONER:

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For PATENT OWNER:

Michael Femal
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Administrative Patent Judges
ANDERSON
Administrative Patent Judge

DECISION

Institution of *Inter Partes* Review[37 C.F.R. § 42.108](#)

I. INTRODUCTION

On October 30, 2013, Electronic Frontier Foundation (“Electronic Frontier” or “Petitioner”) filed a revised petition requesting *inter partes* review of claims 31-35 of [U.S. Patent No. 8,112,504 \(Ex. 1001, “the ‘504 patent’\)](#). Paper 6 (“Pet.”). On February 7, 2014, Personal Audio, LLC (“Personal Audio” or “Patent Owner”), filed a preliminary response. Paper 20 (“Prelim. Resp.”). We have jurisdiction under [35 U.S.C. § 314](#).

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD.--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 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons described below, we determine that the present record shows a reasonable likelihood Petitioner will prevail in showing unpatentability of all the challenged claims. Accordingly, pursuant to 35 U.S.C. § 314, we institute an *inter partes* review for claims 31-35 of the '504 patent.

A. Related Proceedings

Petitioner indicates the '504 patent is involved in co-pending proceedings, including: (i) *Personal Audio, LLC v. CBS Corp.*, No. 2:13-cv-270 (E.D. Tex. Apr. 11, 2013); (ii) *Personal Audio, LLC v. NBC Universal Media, LLC*, No. 2:13-cv-271 (E.D. Tex. Apr. 11, 2013); (iii) *Personal Audio, LLC v. Ace Broadcasting Network, LLC*, No. 2:13-cv-14 (E.D. Tex. Jan. 7, 2013); (iv) *Personal Audio, LLC v. Howstuffworks.com*, No. 2:13-cv-15 (E.D. Tex. Apr. 10, 2013); (v) *Personal Audio, LLC v. Togi Entertainment, Inc.*, No. 2:13-cv-13 (E.D. Tex. Jan. 7, 2013); (vi) *Fox Networks Group, Inc. v. Personal Audio, LLC*, No. 1:13-cv-11794 (D. Mass. July 26, 2013); and (vii) *Personal Audio, LLC v. Fox Broadcasting Co.*, No. 2:13-cv-577 (E.D. Tex. Aug. 6, 2013). Pet. 1-2.

B. The '504 patent

*2 The '504 patent broadly relates to a player for audio programming, which includes functions that allow the listener to control many aspects of the playback. Ex. 1001, 2:21-56. As relevant to the claims under consideration, the '504 patent relates to how audio program segments are distributed to client subscriber locations. Ex. 1001, Abstract.

Figure 1 of the '504 patent is reproduced below:

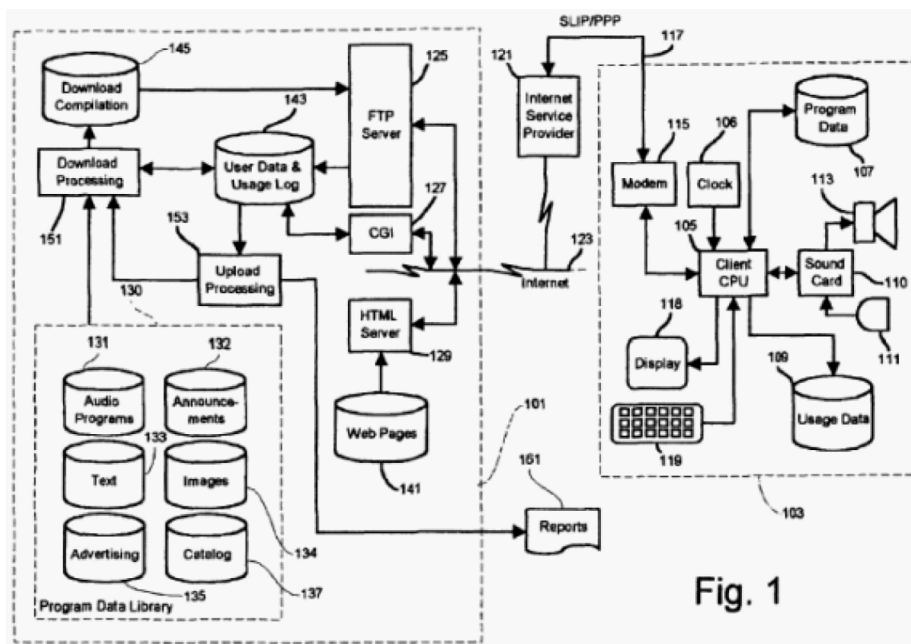


Figure 1 is a block diagram of the invention illustrating the utilization of the Internet to connect host computer 101 to au-

dio player 103. Ex. 1001, 4:39-42. Host server 101 periodically transmits download compilation file 145 upon receiving a request from player 103. *Id.* at 6:60-62. The compilation file extracts data from library 130 based on the selections of the user as specified in the subscriber data and usage log database 143. *Id.* at 7:3-9. The file is placed in a predetermined FTP download file directory and assigned a filename known to the player. *Id.* at 6:62-64. Using clock 106, at a time determined by the player, a dial up connection is established via service provider 121 and Internet to FTP server 125, and the download compilation is transferred to program data store 107 in the player. *Id.* at 6:64-7:1. Once downloaded, the user plays program data 107 using the functionality of the player. *Id.* at 4:44-60.

The invention includes the ability for the user to select a program segment, which may represent an episode in a series. Ex. 1001, 19:35-38. When a serialized sequence is requested, the host may download less than all of the episodes, when all are not yet available. *Id.* at 19:45-49. Episodes that have not issued yet may be selected. *Id.* at 20:64-21:3.

C. Exemplary Claims

Claim 31 is the only independent claim challenged and is reproduced below:

31. Apparatus for disseminating a series of episodes represented by media files via the Internet as said episodes become available, said apparatus comprising:

one or more data storage servers,

one or more communication interfaces connected to the Internet for receiving requests received from remotely located client devices, and for responding to each given one of said requests by downloading a data file identified by a URL specified by said given one of said requests to the requesting client device,

one or more processors coupled to said one or more data storage servers and to said one or more communications interfaces for:

storing one or more media files representing each episode as said one or more media files become available, each of said one or more media files being stored at a storage location specified by a unique episode URL;

*3 from time to time, as new episodes represented in said series of episodes become available, storing an updated version of a compilation file in one of said one or more data storage servers at a storage location identified by a predetermined URL, said updated version of said compilation file containing attribute data describing currently available episodes in said series of episodes, said attribute data for each given one of said currently available episodes including displayable text describing said given one of said currently available episodes and one or more episode URLs specifying the storage locations of one or more corresponding media files representing said given one of said episodes; and

employing one of said one or more communication interfaces to:

(a) receive a request from a requesting client device for the updated version of said compilation file located at said predetermined URL;

(b) download said updated version of said compilation file to said requesting client device; and

(c) thereafter receive and respond to a request from said requesting client device for one or more media files identified by one or more corresponding episode URLs included in the attribute data contained in said updated version of said compilation files.

D. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Abbreviation for Reference(s)	Description	Date	Exhibit(s)
NCSA GotW ^[FN1]	Browser rendering of the web page located at www.ncsa.uiuc.edu/radio/radio.html ^[FN2]	Apr. 22, 1993	Ex. 1019 ^[FN3]
SurfPunk	[surfpunk-0080] BUBBLES: talk radio; _A New Age_; clipper chip	Apr. 22, 1993	Ex. 1020
Geek of the Week Articles	News articles regarding Geek of the Week.	March 31, 1993 through July 15, 1994 ^[FN4]	Exs. 1008-1011 ^[FN5]
Patrick/CBC	Andrew S. Patrick, et al, <i>CBC Radio on the Internet: An Experiment in Convergence</i> , 21 CANADIAN J. OF COMM'N 1, 125-140 (1996)	Jan. 1, 1996 ^[FN6]	Ex. 1012
Compton/CNN	Charles L. Compton, <i>Internet CNN NEWSROOM: The Design of a Digital Video News Magazine</i> , Massachusetts Institute of Technology (Aug. 10, 1995)	Aug. 10, 1995	Ex. 1022

E. The Alleged Grounds of Unpatentability

*4 Petitioner alleges the following grounds of unpatentability.

Claims	Grounds	Reference[s]
31-35	35 U.S.C. § 102(b)	NCSAGotW
31-35	35 U.S.C. § 102(b)	SurfPunk
31-35	35 U.S.C. § 103	NCSAGotW, SurfPunk, and Geek of the Week Articles
31-35	35 U.S.C. § 102(a)	Patrick/CBC
31-35	35 U.S.C. § 103	Compton/CNN

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). If an inventor acts as his or her own lexicographer, the defini-

tion must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). The terms also are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. “episode” (Claims 31-35)

Petitioner proposes “episode” be construed “as a program segment, represented by one or more media files, which is part of a series of related segments, e.g. a radio show or a newscast.”Pet. 11-12. Petitioner notes that the specification describes that an episode is a program segment that is part of a series (i.e. a sequence of related segments).*Id.* at 11, (citing Ex. 1001, 19:35-42). Patent Owner does not propose a construction for the term.

*5 Petitioner's proposed construction is the broadest reasonable interpretation consistent with the specification, and is therefore adopted for this decision.

2. “compilation file” (Claims 31-35)

Petitioner proposes “compilation file” be construed as “any file that contains information about multiple episodes and satisfies the other claim requirements.”Pet. 12-13. Patent Owner does not propose a construction for the term. Petitioner argues that the specification describes the “compilation file” as simply an ordinary file that contains the information required by the claim. *Id.* (citing Ex. 1001, 6:60-64, 7:10-22).

The specification describes the compilation file as “one or more subscriber and session specific files which contain the identification of separately stored sharable files.”Ex. 1001, 7:10-13. Applying the broadest reasonable construction consistent with the specification, compilation file is construed to mean “a file that contains episode information” for the purposes of this decision.

3. “media file” (Claims 31-35)

Petitioner proposes that “media file” be construed as “a file with content that can be reproduced as video, audio, and/or text.”Pet. 13. Petitioner points to claims 32 and 33 as reciting that the media file includes “digital compressed audio” and/or “text data.” *Id.* (citing Ex. 1001, claims 32-33). Patent owner does not propose a meaning for the term.

The specification does not disclose the term “media files” beyond the recitation of the term in the claims. Neither is the term medias described in the specification. The plain and ordinary meaning of media is consistent with Petitioner's proposed construction of “media files.” Petitioner's construction is the broadest reasonable construction and is consistent with the specification and is therefore adopted for this decision.

B. Anticipation by Patrick/CBC (Claims 31-35)

The '504 patent claims priority through a series of divisional applications, the earliest filed of which is U.S. Patent Application Ser. No. 08/724,813, filed October 2, 1996, now [U.S. Patent No. 6,199,076](#). Ex. 1001, 1:8-17. Petitioner's declarant, Mr. Schmandt, uses October 2, 1996, as the effective filing date. Ex. 1002 ¶ 4. Based on Mr. Schmandt's declaration and metadata for the article showing a January 1, 1996 date of publication, Petitioner alleges Patrick/CBC was published January 1, 1996. For purposes of this decision, we therefore assume Exhibit 1012 is prior art dated January 1, 1996. See Ex. 1002, ¶ 59, Ex. 1013.

*6 Petitioner alleges Patrick/CBC is prior art anticipating claims 31-35 of the '504 patent under 35 U.S.C. § 102(a). Pet. 16, 35-45. Petitioner relies, in part, on the testimony of Mr. Schmandt. Ex. 1002 ¶¶ 58-71.

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