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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,263	11/13/2009	7486926	AFF.0004B6US	6721
21906	7590	04/11/2014	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			LAROSE, COLIN M	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			04/11/2014	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLC
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

APR 11 2014

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001263
PATENT NO. : 7486926
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



Trop, Pruner, & Hu, P.C.
1616 S. Voss Road, Suite 750
Houston, TX 77057 - 2631

(For Patent Owner)

MAILED

APR 11 2014

Novak, Druce, & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester) **CENTRAL REEXAMINATION UNIT**

Inter Partes Reexamination Proceeding : **DECISION DISMISSING**
Control No: 95/001,263 : **PETITION TO**
Filing Date: November 13, 2009 : **TERMINATE *INTER PARTES***
For: U.S. Patent No.: 7,486,926 : **REEXAMINATION PROCEEDING**

This is a decision on patent owner's December 7, 2012 petition entitled "Patent Owner's Petition to Terminate *Inter Partes* Reexamination Proceeding under 35 U.S.C. §317(b) & 37 C.F.R. §1.182" (patent owner's December 7, 2012 petition).

Patent Owner's December 7, 2012 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's December 7, 2012 petition to terminate the present *inter partes* reexamination proceeding is **dismissed**.

DECISION

Jurisdiction

The Office has jurisdiction over the present proceeding, as evidenced by the mandate issued on March 3, 2014 by the United States Court of Appeals for the Federal Circuit (CAFC), which is attached to the present decision.

Analysis

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,263 (the ‘1263 proceeding) is required by pre-AIA 35 U.S.C. § 317(b),¹ which provides, in pertinent part (emphasis added):

Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office . . . This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

The Office analyzes whether a reexamination proceeding must be terminated pursuant to pre-AIA 35 U.S.C. 317(b) by determining whether:

1. The third party requester was a party to the litigation;
2. The decision is final, i.e., after all appeals;
3. The court decided that the requester/party had not sustained its burden of proving the invalidity of any claim of the patent in suit, which claim is also under reexamination; and
4. The issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent No. 7,486,926 (the ‘926 patent), was the subject of a civil action styled *Affinity Labs of Texas, LLC, v. Apple Inc.*, Civil Action No. 4:09-cv-04436-cw (N.D. Cal.) (the litigation). The patent owner submits a copy of an order by the district court dated September 23, 2011 and entitled “Stipulation and Joint Motion Dismiss; Order” (order), which lists, as a defendant in the litigation, the requester and real party in interest in the instant proceeding, Apple, Inc. (Apple). The patent owner has provided sufficient evidence that the third party requester was a party to the litigation. For this reason, element 1 has been shown to have been satisfied.

Elements 2, 3, and 4, however, have not been shown to have been satisfied.

¹ Congress, when enacting the America Invents Act (AIA), replaced the provisions for *inter partes* reexamination with provisions for a new procedure, *inter partes* review. Congress amended the provisions of 35 U.S.C. 317 to only apply to *inter partes* review proceedings, which, by definition, are filed on or after September 16, 2012 (post-AIA 35 U.S.C. 317). Congress also specified that the provisions of the *inter partes* reexamination statute which were in effect prior to September 16, 2012, including the provisions of 35 U.S.C. 317(b) (pre-AIA 35 U.S.C. 317(b)), remain applicable to *inter partes* reexamination proceedings, which were only permitted to be filed before September 16, 2012.

Regarding element 2, the district court, in its order, dismissed all counterclaims by the defendant/requester Apple *without* prejudice.² The patent owner argues that the requester “counterclaimed that the claims of the ‘926 Patent were invalid”, and provided a copy of requester’s invalidity contentions as supporting evidence.³ However, because the court dismissed all of requester’s counterclaims, which would include requester’s counterclaims of invalidity, *without* prejudice, the court’s order does not bar the requester from raising its invalidity assertions against the patent owner in future litigation. Thus, the court’s order is not a final decision within the meaning of pre-AIA 35 U.S.C. 317(b). For this reason, the patent owner has not shown that element 2 has been satisfied.

Regarding element 3, the patent owner has not provided any evidence of a *decision by the court* that the requester Apple did not sustain its burden of proving the invalidity of the ‘926 patent claims *in suit*. In addition, the patent owner has not provided evidence that all of the ‘926 patent claims under reexamination were *in suit*, i.e., were before the court at the time of the court’s judgment.

Pre-AIA 35 U.S.C. 317(b) specifically requires a decision on the issue of “the invalidity of any patent claim *in suit*” (emphasis added). It is not clear which claims of the ‘926 patent subject to reexamination were in suit *at the time of the court’s judgment*. Office records reveal that original claims 1-20 and newly added claims 21-37 are under reexamination in the present proceeding. The patent owner, however, has provided evidence that not all of the claims under reexamination were ultimately asserted in the litigation. See, for example, page 2 of requester’s invalidity contentions, which refers to “‘926 Patent: Claims 1-6, 8, and 10-20” as the “Asserted Claims”. Thus, dependent claims 7, 9, and 21-37, which are under reexamination, may not have been in suit at the time of the court’s judgment. The patent owner has not provided evidence of which claims were in suit at the time of the court’s order.⁴ In fact, the patent owner has provided evidence that not all of the ‘926 patent claims under reexamination were ultimately litigated in the civil action.

If a claim under reexamination was not the subject of the litigation at the time of the judgment, then the estoppel provisions of pre-AIA 35 U.S.C. 317(b) do not apply to the final outcome of the litigation as to that patent claim, because there is no “final decision that the party has not sustained its burden of proving the invalidity” of that patent claim. Thus, prosecution of the non-litigated claims would not be “terminated” in the reexamination proceeding.

² See ¶ 2 of the court’s order.

³ See the court document dated January 5, 2011 and entitled “Apple Inc.’s First Amended Invalidity Contentions Pursuant to Patent Local Rule 3-3” (requester’s invalidity contentions).

⁴ For example, if the civil suit proceeded to trial, the patent owner must provide evidence of which claims were before the court at the time of trial, such as a copy of the jury verdict form. If no trial was held, a copy of the court’s docket, and any court document providing evidence of which claims were asserted at the time of the judgment, should be submitted. Furthermore, the patent owner should also submit, in addition to a copy of the court’s docket, an explanation, for each court document (such as requester’s invalidity contentions) submitted as evidence to show that the provisions of pre-AIA 35 U.S.C. 317(b) have been met, showing where in the court’s docket the document appears. The court’s docket would provide evidence of the stage of the litigation at which the document was submitted, the stage of the litigation at which the court’s “Order of Dismissal” was rendered, whether a trial was held (and when), whether the court’s judgment had been appealed, etc.

The patent owner essentially argues that the court's dismissal with prejudice operates as a final determination on the merits of requester's counterclaim of invalidity. The patent owner further states that the parties have entered into an agreement and that the requester Apple has withdrawn from participating in the present proceeding.⁵

However, pre-AIA 35 U.S.C. 317(b) *specifically requires* a "final **decision** . . . that the party has not sustained its burden of proving the invalidity of any patent claim in suit" (emphasis added). Congress, when enacting the provisions of *post*-AIA 35 U.S.C. 317(a), amended the statute to permit the termination of an *inter partes* review proceeding upon joint request of the petitioner and the patent owner. Congress, however, did not similarly amend the *inter partes* reexamination statute to permit the termination of an *inter partes* reexamination proceeding under the same conditions. In fact, Congress specified that the provisions of the *pre*-AIA *inter partes* reexamination statute, which includes pre-AIA 35 U.S.C. 317(b), remain applicable to *inter partes* reexamination proceedings. Thus, Congress did not intend to permit a mere settlement between the parties to trigger the estoppel provisions of pre-AIA 35 U.S.C. 317(b). Pre-AIA 35 U.S.C. 317(b), however, requires more. It *specifically requires* a final decision *by the court* that the requester/party failed to sustain its burden of proving the invalidity of any patent claim in suit.

There is no language in the court's order that suggests that *the court* decided any invalidity issue, let alone the issue that defendant/requester Apple failed to sustain its burden of proving the invalidity of the '926 patent claims in suit. In fact, the litigation appears to have been dismissed without there ever being an assessment *by the court* of whether the defendant/requester Apple sustained its burden of proving claim invalidity. The patent owner has not provided any evidence of any decision *by the court* that Apple failed to sustain its burden of proving the invalidity of the '926 patent claims in suit, as the patent owner asserts.

If the invalidity issue had been litigated, i.e., asserted at trial, prior to the issuance of the court's order, which does not appear to be the case here, then the court's dismissal could have been interpreted by the Office in light of the court's holding on the invalidity issue. If the invalidity issue has not been litigated (i.e., if no trial was held), which appears to be the case here, the patent owner must provide evidence to show that the provisions of pre-AIA 35 U.S.C. 317(b) have been met, including a showing that the court rendered a decision *by the court* that the requester did not sustain its burden of proving the invalidity of the patent claims. The patent owner has not done so.

In summary, the court's order merely provides evidence that the litigation was dismissed due to the parties' settlement. Thus, the patent owner has not provided sufficient evidence of a *decision by the court* that the requester Apple did not sustain its burden of proving the invalidity of the '926 patent claims in suit. Furthermore, the patent owner has not provided evidence of that all of

⁵ Requester's October 3, 2011 paper, notifying the Office that it will no longer participate in the present reexamination proceeding, is appreciated. However, the agreement of the parties, while appreciated, does not mandate termination. Evidence, which shows that the above-identified four elements have been satisfied, is required.

the '926 patent claims under reexamination were before the court at the time of the court's judgment.

For these reasons, element 3 has not been shown to have been satisfied.

Regarding element 4, the patent owner asserts that the requester was aware of all prior art at issue in the present proceeding, and could have raised any issue with respect to this prior art in the litigation. The patent owner points to requester's invalidity contentions as supporting evidence.

As an initial matter, note that the issue of which claims were in suit is separate and distinct from the issue of whether any issues with respect to the claims in suit could have been raised by the requester in the litigation. Pre-AIA 35 U.S.C. 317(b) specifies that its estoppel applies where a party has not sustained its burden of proving the invalidity of "any patent claim *in suit*" (emphasis added). The statute does not refer, for example, to any patent claim that "could have been" in suit. Pursuant to the statute, the patent claims that were actually in suit must initially be determined. Further, each claim in suit must have a corresponding *final decision* of non-invalidity. Then, once the claims in suit have been identified and once the "final decision has been entered . . .," the statute then prohibits the Office from maintaining an *inter partes* reexamination "of *any such patent claim*" (i.e., the patent claim in suit), "on the basis of issues which . . . [the requester] raised or could have raised" in the litigation. (Emphasis added). Accordingly, the phrase "raised or could have raised" applies only to patent claims that were in suit and for which a final decision has been entered. The issue is not whether the requester "could have raised" claims that were not in suit. Rather, once the claims that were actually litigated are determined, the issue is whether any issues raised in the reexamination proceeding with respect to the litigated claims either were raised or could have been raised by the requester in the litigation.

Until it is clear which claims of the '926 patent were before the court at the time of the court's judgment, a determination cannot be made whether the issues raised in the reexamination proceeding were raised or could have been raised by the requester in the civil action. For example, if certain claims, which are under reexamination, were not before the court at the time of the court's judgment, then any issues regarding those claims which were raised in the reexamination proceeding could not have been raised by the requester in the litigation.

Furthermore, the patent owner has not provided evidence that *all* of the issues raised in the present reexamination proceeding could have been raised by the requester in the litigation at the time of the court's judgment.

The last sentence of pre-AIA 35 U.S.C. 317(b) permits "the assertion of invalidity [in an *inter partes* reexamination] based on newly discovered prior art unavailable to the third party requester". See the legislative history of pre-AIA 35 U.S.C. 317(b), which provides the meaning of the word "unavailable", as it appears in the statute (emphasis added in bold):⁶

⁶ 106 Cong. Rec. S14720, Nov. 17, 1999. See also 106 Cong. Rec. H11805, Nov. 9, 1999.

Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity . . . after any appeals, that third-party requester cannot thereafter request inter partes reexamination on the basis of issues which were or which could have been raised. However, the third-party requester may assert invalidity based on **newly discovered prior art unavailable at the time of the civil action** or inter partes reexamination. **Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action** or inter partes reexamination proceeding on behalf of the third-party requester and the USPTO.

Thus, to show that a reference is “available”, the patent owner must provide evidence that the reference was known to the requester at a time when it could have been raised in the civil action. In the present case, it is not clear whether a trial was held and whether there was a time, before the court’s order, when the requester could not have raised, at that stage of the litigation, issues that were raised in the reexamination proceeding. For example, it is not clear whether many of the references which were raised in the present reexamination proceeding, such as, for example, the references cited in the August 17, 2011 action closing prosecution (ACP) (e.g., Leeke, Kumar, Rhoads, Kaplan, Naim, Dwyer, Gioscia, Naughton, etc.),⁷ but which do not appear to be included in requester’s invalidity contentions, could have been raised by the requester in the litigation. The patent owner has not, for example, shown that at the time of the court’s judgment, the civil action was at an early stage, such that all of the issues raised in the reexamination proceeding could have been raised in the litigation. Thus, the patent owner has not provided sufficient evidence that the requester was aware of all of the issues raised in the reexamination proceeding at a time when those issues could have been raised in the litigation.⁸

Thus, element 4 has not been shown to have been satisfied because the patent owner has not provided sufficient evidence that 1) all of the claims under reexamination were in suit at the time of the district court’s order; and 2) all of the issues raised in the present reexamination proceeding either were raised or could have been raised in the litigation.

In summary, the present *inter partes* reexamination proceeding **will not be terminated**, because patent owner has failed to provide a sufficient showing that all of the requirements of pre-AIA 35 U.S.C. 317(b) have been met. In the absence of such a showing, the Office is required by statute to continue prosecution of the ‘1263 reexamination proceeding. *See* 35 U.S.C. 313 (requiring reexamination “for resolution of the question” of patentability). Even if the patent owner later provides sufficient evidence of which patent claims were in suit, and sufficient evidence that all of the issues raised in the reexamination proceeding could have been raised in the litigation, the patent owner must also provide specific evidence of a final decision by the court that the requester Apple did not sustain its burden of providing the invalidity of the ‘926 patent claims in suit.


⁷ This list is merely a sample list, and is not all-inclusive. The patent owner should review the entire proceeding to determine *all* of the prior art *raised* in the proceeding (and not merely which references were used in adopted rejections).

⁸ For example, if no trial was held, the patent owner may provide evidence, such as a copy of the court’s docket, and an explanation discussing the court’s docket, requester’s invalidity contentions, and the other prior art cited in the present proceeding, showing that the requester was aware of *all* of the issues raised in the reexamination proceeding prior to trial, at a time when the requester could have raised, in the litigation, *any* of the issues raised in the reexamination proceeding.

Accordingly, patent owner's December 7, 2012 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

CONCLUSION

- Patent owner's December 7, 2012 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination is **dismissed**.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.


Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

Attachments: Two court documents in *In re Affinity Labs of Texas, LLC*, Appeal No. 2013-1393 (CAFC 2014), entitled:

- 1) "Judgment", dated January 9, 2014; and
- 2) "Mandate", dated March 3, 2014.

4/11/2014

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

IN RE AFFINITY LABS OF TEXAS, LLC

2013-1393

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Reexamination
No. 95/001,263.

JUDGMENT

CYRUS A. MORTON, Robins, Kaplan, Miller, and Ciresi,
L.L.P., of Minneapolis, Minnesota, argued for appellant.
Of counsel on the brief was TIMOTHY G. NEWMAN, Larson
Newman, LLP, of Austin, Texas.

SCOTT C. WEIDENFELLER, Associate Solicitor, Office of
the Solicitor, United States Patent and Trademark Office,
of Alexandria, Virginia, argued for intervenor Commis-
sioner for Patents. With him on the brief were NATHAN K.
KELLEY, Acting Solicitor, and STACY B. MARGOLIES, Asso-
ciate Solicitor.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (LOURIE, DYK, and WALLACH, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

January 9, 2014
Date

/s/ Daniel E. O'Toole
Daniel E. O'Toole
Clerk of Court

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

13-1393

IN RE AFFINITY LABS OF TEXAS, LLC

Appeal from the United States Patent and Trademark Office in case no. 95/001,263

MANDATE

In accordance with the judgment of this Court, entered January 09, 2014, and pursuant to Rule 41(a) of the Federal Rules of Appellate Procedure, the formal mandate is hereby issued.

FOR THE COURT

/s/ Daniel E. O'Toole

Daniel E. O'Toole
Clerk of Court

cc: Nathan K. Kelley
Stacy Beth Margolies
Cyrus Alcorn Morton
Timothy G. Newman
United States Patent and Trademark Office
Scott Weidenfeller

CERTIFICATE OF SERVICE

Pursuant to M.P.E.P. § 2683 and 37 C.F.R. §§ 1.248 and 1.983(b)(3), the undersigned attorney for Appellants certifies that a copy of the NOTICE OF APPEAL was served, via United States Postal Service First Class Mail, on March 25th, 2013 on the counsel for Third Party Requester at the following address:

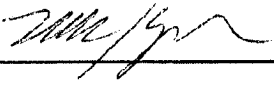
Novak Druce & Quigg, LLP
NDQ Reexamination Group
1000 Louisiana Street, 53rd Floor
Houston, TX 77002



David L. McCombs

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

AUTHORIZATION TO ACT IN A REPRESENTATIVE CAPACITY

In re Application of: Inter Partes Reexamination of United States Patent No. 7,486,926													
Application No.	Proceeding No. 95/001,263												
Filed:	November 13, 2009												
Title:	CONTENT DELIVERY SYSTEM AND METHOD												
Attorney Docket No. 8157.022.926	Art Unit: 3992												
<p>The practitioner named below is authorized to conduct interviews and has the authority to bind the principal concerned. (Note: pursuant to 37 CFR 10.57(c), a practitioner cannot authorize other registered practitioners to conduct interviews without consent of the client after full disclosure.) Furthermore, the practitioner is authorized to file correspondence in the above-identified application pursuant to 37 CFR 1.34:</p> <table border="1"> <thead> <tr> <th>Name</th> <th>Registration Number</th> </tr> </thead> <tbody> <tr> <td>David L. McCombs</td> <td>32,271</td> </tr> <tr> <td>Theodore M. Foster</td> <td>57,456</td> </tr> <tr> <td>Gregory Huh</td> <td>70,480</td> </tr> <tr> <td></td> <td></td> </tr> <tr> <td></td> <td></td> </tr> </tbody> </table>		Name	Registration Number	David L. McCombs	32,271	Theodore M. Foster	57,456	Gregory Huh	70,480				
Name	Registration Number												
David L. McCombs	32,271												
Theodore M. Foster	57,456												
Gregory Huh	70,480												
<p>This is not a Power of Attorney to the above-named practitioner. Accordingly, the practitioner named above does not have authority to sign a request to change the correspondence address, a request for an express abandonment, a disclaimer, a power of attorney, or other document requiring the signature of the applicant, assignee of the entire interest or an attorney of record. If appropriate, a separate Power of Attorney to the above-named practitioner should be executed and filed in the United States Patent and Trademark Office.</p>													
SIGNATURE of Practitioner of Record													
Signature	 Date 03/14/2013												
Name	Mark J. Rozman Registration No., if applicable 42,117												
Telephone	512-418-9944												

This collection of information is required by 1.31, 1.32 and 1.34. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Electronic Acknowledgement Receipt

EFS ID:	15345513
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	David L. McCombs/Lydia Epps-Hilliard
Filer Authorized By:	David L. McCombs
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	25-MAR-2013
Filing Date:	13-NOV-2009
Time Stamp:	16:03:25
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		NOA_COS_Authorization.pdf	113614 <small>7ef568ff4d6ace3fe98279b2db25891d544ae88a</small>	yes	3

Multipart Description/PDF files in .zip description			
Document Description		Start	End
Requester Appeal to the Federal Circuit		1	1
Reexam Certificate of Service		2	2
Reexam Miscellaneous Incoming Letter		3	3

Warnings:

Information:

Total Files Size (in bytes):	113614
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



UNITED STATES PATENT AND TRADEMARK OFFICE

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21906 7590 02/15/2013
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EXAMINER

LAROSE, COLIN M

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MAIL DATE	DELIVERY MODE
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02/15/2013

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UNITED STATES PATENT AND TRADEMARK OFFICE

THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Third Party Requester

v.

AFFINITY LABS OF TEXAS, LLC
Patent Owner and Appellant

Appeal 2012-010420
Reexamination Control No. 95/001,263
U.S. Patent No. 7,486,926 B2
Technology Center 3900

Before HOWARD B. BLANKENSHIP, MICHAEL R. ZECHER, and
THOMAS L. GIANNETTI, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

On November 28, 2012, Patent Owner Affinity Labs of Texas, LLC (hereinafter “Appellant”) filed a Request for Rehearing (“Request”) under 37 C.F.R. § 41.79 directed to our determination to adopt, adopt-in-part, or maintain the Examiner’s obviousness rejections of claims 1-37 of U.S. Patent No. 7,486,926 B2 (“the ’926 patent”) in our Decision on Appeal (“Decision”) mailed November 1, 2012. In the Decision, we affirmed the Examiner’s rejections of: (1) claims 1-10 and 21-27 under 35 U.S.C. § 103(a) based in whole or in part on Rio 500 and Kumar; and (2) claims 1-37 under 35 U.S.C. § 103(a) based in whole or in part on Lau, Naim, and Lee. Our affirmance of those obviousness rejections made it unnecessary to reach the Examiner’s obviousness rejections of the same claims on a different basis. Decision at 26-27.

We grant-in-part and deny-in-part Appellant’s Request to modify the Decision.

Prior Art Relied Upon

Naim	US 6,694,200 B1	Feb. 17, 2004 (filed Nov. 16, 1999)
Lau	US 6,772,212 B1	Aug. 3, 2004 (filed Mar. 8, 2000)
Lee	US 6,728,531 B1	Apr. 27, 2004 (effectively filed Sept. 22, 1999)
Kumar	US 7,120,462 B2	Oct. 10, 2006 (PCT filed Apr. 7, 2000)

Rio 500, “*Getting Started Guide for Windows® 98 and Macintosh® OS 8.6,*” (1999) (“Rio 500”).

Appellant's Contentions

First, Appellant alleges that the Board did not consider the controlling version of 35 U.S.C. § 102(e) when determining the benefit date that should be accorded to Kumar. Request at 2-5. Appellant contends that the earliest benefit date that should be accorded to the '926 patent is March 28, 2000. *Id.* at 2. Appellant contends that under the controlling version of 35 U.S.C. § 102(e), the earliest benefit date that should be accorded to Kumar is December 7, 2000. *Id.* at 3. Given the roughly eight month gap between the benefit date of the '926 patent—March 28, 2000—and the benefit date of Kumar—December 7, 2000—Appellant asserts that Kumar does not qualify as prior art to the '926 patent. *Id.* at 2-4.

Second, Appellant alleges that the Board modified the Examiner's obviousness rejections based in whole or in part on Lau in such a way that Lau fails to account for the "different electronic device," as recited in independent claims 1 and 11 of the '926 patent. Request at 5-7. Appellant contends that the Board combined Lau's trunk-mounted music server and corresponding head unit into a single device that accounts for the claimed "portable audio file player," and fails to point to a textual portion in Lau that properly accounts for the claimed "different electronic device." *Id.* at 6 (citing to Decision at 21-22). Appellant also asserts that the Decision includes an alternative rejection based on the collective teachings of Lau and Naim that does not properly account for the claimed "different electronic device." *Id.* at 7 (citing to Decision at 22).

II. ISSUES

1. Did the Board misapprehend or overlook the controlling version of 35 U.S.C. § 102(e) when determining the benefit date that should be accorded to Kumar?

2. Did the Board modify the Examiner's obviousness rejections based in whole or in part on Lau in such a way that Lau does not properly account for the "different electronic device," as recited in independent claims 1 and 11 of the '926 patent?

III. ANALYSIS

We have carefully reviewed the Decision in light of Appellant's allegations that the Board misapprehended or overlooked particular points initially raised by Appellant in their Brief. In particular, we will address Appellant's allegations in the order in which they are presented in the Request, and as outlined above.

Issue #1

Appellant's first allegation that the Board misapprehended or overlooked the controlling version of 35 U.S.C. § 102(e) when determining the benefit date that should be accorded to Kumar has merit. Request at 2-5. According to the Manual of Patent Examining Procedure § 2136, a reference based on the national stage of an international application that was filed prior to November 29, 2000 is subject to the former (pre-American Inventors Protection Act of 1999) version of 35 U.S.C. § 102(e). In this case, Kumar claims priority to application No. 09/719,290, which was filed as application No. PCT/US00/09188 on April 7, 2000. Because PCT/US00/09188 was

filed prior to November 29, 2000, Kumar is subject to the former version of 35 U.S.C. § 102(e). That version of 35 U.S.C. § 102(e) is reproduced below:

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Emphasis added.

Under the former version of 35 U.S.C. § 102(e) reproduced above, the earliest benefit date that can be accorded to Kumar is the date that the PCT/US00/09188 application satisfies the requirements of paragraphs (1), (2), and (4) of section 371(c). A review of Office records confirms that the PCT/US00/09188 application satisfied the requirements of paragraphs (1), (2), and (4) of section 371(c) on December 7, 2000. The '926 patent is a continuation of patent application 09/537, 812 ("the '812 application"), filed March 28, 2000—now U.S. Patent No. 7,187,947 B1. Therefore, even if we were to accord the '926 patent the benefit date of the '812 application—March 28, 2000—Kumar does not qualify as prior art to the '926 patent because the earliest benefit date that can be accorded to Kumar under the former version of 35 U.S.C. § 102(e) is December 7, 2000.

Given that Kumar does not qualify as prior art to the '926 patent even if we were to accord the '926 patent the benefit date of the '812 application—March 28, 2000—the issue now turns to whether the '926 patent can be properly accorded that benefit date. As we already noted in

our Decision, there is nothing in the statutes that governs reexamination proceedings that prohibit “the Examiner [from] consider[ing] whether the ’926 patent should be accorded the benefit date of the ’812 application, which in turn encompasses considering both the ’926 patent and the ’812 application on the basis of written description.” Decision at 13.

In the Right of Notice of Appeal (“RAN”), which is incorporated by reference in the Answer, the Examiner finds that the ’926 patent is not entitled to the benefit date of the ’812 application—March 28, 2000. RAN at 3-4. In particular, the Examiner finds that the specification of the ’812 application does not provide sufficient written description support for the following claim limitation recited in independent claim 1 of the ’926 patent, and similarly recited in independent claim 11 of the ’926 patent:

the collection of instructions operable to direct the processor . . .
. . . to communicate data to a different electronics device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display.

Id.

In response, Appellant contends that the specification of the ’812 application provides full written description support for independent claims 1 and 11 of the ’926 patent. App. Br. at 25-28. Appellant directs us to multiple disclosures in the specification of the ’812 application that support the disputed claim limitation—namely spec. 9:21-35, 58-60; 9:63-10:4; and 19:39-42, 45-50. *Id.* Appellant also directs us to multiple disclosures in the

specification of the '926 patent that appear verbatim in the '812 application. *Id.* For instance, Appellant directs us to the specification of the '926 patent at page 12, lines 1-18 (App. Br. at 26), which can be found verbatim in the '812 application at page 13, lines 30-47.

We agree with Appellant that the cited disclosures in the specification of the '812 application provide sufficient written description support for the disputed claim limitation recited in independent claims 1 and 11 of the '926 patent. First, we note that because the '926 patent is a continuation of the '812 application, the '926 patent and the '812 application share a common specification. Second, the cited disclosures in both the '926 patent and the '812 application reasonably convey to one with ordinary skill in the art that Appellant possessed the ability to transfer data from a portable audio player to a different electronic device, which in turn allowed the different electronic device to present a selectable representation of an audio file on a display associated therewith, when the '812 application was filed. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Accordingly, the Examiner erred in finding that independent claims 1 and 11 of the '926 patent are not entitled to the benefit date of the '812 application—March 28, 2000.

Because Kumar does not qualify as prior art to the '926 patent, we vacate the portion of the Decision beginning with the last partial paragraph on page 13 through the last full paragraph on page 19, and modify the Decision to include our new analysis set forth above. We also reverse the Examiner's decision to adopt, adopt-in-part, and maintain the obviousness rejections of claims 1-10 and 21-27 based in whole or in part on Rio 500 and

Kumar. Nonetheless, our determination not to maintain the Examiner's obviousness rejections of claims 1-10 and 21-27 based in whole or in part on Rio 500 and Kumar is moot because, as our analysis below will reflect, we are maintaining the Examiner's obviousness rejection of claims 1-37 based in whole or in part on Lau, Naim, and Lee.

Issue #2

Appellant's second allegation that the Board modified the Examiner's obviousness rejections based in whole or in part on Lau in such a way that Lau does not properly account for the claimed "different electronic device" is without merit. Request 5-7. Contrary to Appellant's arguments, our Decision properly accounts for the claimed "different electronic device." In the Decision, we state that:

we agree with the Examiner's determination that Lau's music server amounts to the claimed "portable audio player." Moreover, Lau's Figure 1 illustrates that the head unit amounts to a standard car stereo head unit that works in conjunction with the car's audio system. Col. 4, ll. 27-39. *Therefore, we find that Lau's car audio system constitutes the claimed "different electronic device."*

Decision at 23-24 (emphasis added). In the Request, it appears that Appellant ignores our citation to Lau at column 4, lines 27-39, and our ultimate determination that Lau's car audio system constitutes the claimed "different electronic device." Given that determination, Appellant's assertion that we improperly mapped Lau's music server and corresponding head unit to both the claimed "portable audio player" and "different electronic device" is misplaced. Request at 6. Accordingly, we maintain our initial position that Lau's car audio system properly accounts for the

“different electronic device,” as recited in independent claims 1 and 11 of the '926 patent. Decision 23-24.

IV. CONCLUSIONS

The first allegation set forth in the Request has persuaded us that we erred in adopting, adopting-in-part, and maintaining the Examiner’s rejections of claims 1-10 and 21-27 under 35 U.S.C. § 103(a) based in whole or in part on Rio 500 and Kumar. However, the second allegation set forth in the Request has not persuaded us that we erred in adopting, adopting-in-part, and maintaining the Examiner’s rejections of claims 1-37 under 35 U.S.C. § 103(a) based on Lau, Naim, and Lee.

V. DECISION

We grant Appellant’s Request and modify the Decision to the following extent: the Examiner’s rejections of claims 1-10 and 21-27 under 35 U.S.C. § 103(a) based in whole or in part on Rio 500 and Kumar is reversed. However, we deny Appellant’s Request to make any modification to the Decision regarding the Examiner’s rejections of claims 1-37 under 35 U.S.C. § 103(a) based on Lau, Naim, and Lee.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (1) (iv).

REQUEST FOR REHEARING—GRANTED-IN-PART AND
DENIED-IN-PART

Appeal 2012-010420
Reexamination Control 95/001,263
U.S. Patent No. 7,486,926 B2

cu

Patent Owner:

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Third Party Requester:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Confirmation No.:	6721
		§		
Reexamination Control No.:	95/001,263	§	Examiner:	Colin M. LaRose
		§		
Filed:	November 13, 2009	§	Art Unit:	3992
		§		
For:	U.S. Patent 7,486,926	§	Atty. Dkt. No.:	AFF.004B6US

Mail Stop *Inter Partes* Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PATENT OWNER'S PETITION TO TERMINATE INTER PARTES
REEXAMINATION PROCEEDING UNDER 35 U.S.C. §317(b) & 37 C.F.R. §1.182**

Sir:

Affinity Labs of Texas, LLC (Patent Owner) petitions to terminate this *inter partes* reexamination proceeding under 35 U.S.C. §317(b) and 37 C.F.R §1.182. This is so as a final decision has been entered adverse to third party requester Apple, Inc. (Requester) in a federal court action. In that concurrent federal district court action Requester asserted that all asserted claims of U.S. Patent No. 7,486,926 (the '926 Patent) were invalid, and the final and unappealable decision of the district court did not find any claim of the '926 Patent invalid. All the prior patents and publications raised and considered in this reexamination were art that Requester raised or could have raised in the now finally concluded civil action.

The District Court decision against Requester is "final," because Requester failed to appeal to the Court of Appeals for the Federal Circuit in the time allowed to challenge the District Court's final decision. The District Court did not find any claim of the '926 Patent invalid, and Requester is now bound by that final decision.

Date of Deposit: December 7, 2012 I hereby certify under 37 CFR § 1.8 this correspondence is being deposited via EFS on the date indicated above. /Stephanie Petreas/ Stephanie Petreas
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Requester has filed a notice paper that it will no longer participate in this reexamination, because it no longer has any economic or legal reason for maintaining this reexamination. Accordingly, the Office should terminate this reexamination.

FACTUAL BACKGROUND

1. Patent Owner commenced a patent infringement action against Requester on March 24, 2009 in the United States District Court, Eastern District of Texas. That case was transferred to the Northern District of California as *Affinity Labs of Texas, LLC v. Apple, Inc.*, Case No. 4:09-cv-04436-cw. Patent Owner asserted Requester infringed the '926 Patent (among other patents). The case was proceeding before District Court Judge Claudia Wilken.

2. Requester counterclaimed that the claims of the '926 Patent were invalid over a number of references, including many of the references relied upon by the Patent Office in this reexamination (Ex. A).

3. On November 13, 2009, Requester filed a request for *inter partes* reexamination of the '926 Patent. The Office granted Requester's request for *inter partes* reexamination on February 5, 2010.

4. After the reexamination was granted, Judge Wilken dismissed Requester's invalidity counterclaim in the co-pending litigation without prejudice (Ex. B). Requester failed to appeal this decision to dismiss its invalidity counterclaims, and the decision of the District Court became final.

5. Ultimately, Patent Owner and Requester resolved their differences in September 2011. As part of the resolution between Patent Owner and Requester, Requester entered into a fully paid-up licensing agreement with Patent Owner to secure the necessary rights to sell its products and services that practice the '926 Patent. Declaration of Harlie D. Frost (Ex. C), ¶4.

6. On October 3, 2011, Requester filed a Notice of non-participation in this *inter partes* reexamination (Ex. D).

ARGUMENT

This Reexamination Should Be Terminated Because The District Court's Final Decision That No Claim Was Proven to be Invalid Is No Longer Appealable.

The Office must terminate an ongoing *inter partes* reexamination of a patent after a final decision against Requester's invalidity claims of the same patent in litigation:

Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit... then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action... *and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office.*

35 U.S.C. §317(b) (emphasis added). The Office interprets the phrase "final decision" in §317(b) to mean a decision "after all appeals." *See, e.g., In re Knotts, inter partes* control number 95/000,353 (Jan. 26, 2011) ("The Office interprets the term 'final decision' for [civil actions] as 'after all appeals'"). Requester failed to file an appeal. As such, the decision of the trial Court has become "final."

The Manual of Patent Examining Procedure sets out the appropriate inquiry for determining whether an *inter partes* reexamination should be terminated under §317(b):

When the examiner is aware that the third party requester was a party to previous Federal Court litigation as to the patent for which *inter partes* reexamination has been requested, the examiner must determine:

- (1) Was the Federal Court decision adverse to the third party requester as to at least one claim of the patent?
- (2) Was the Federal Court decision a final decision, after all appeals?
- (3) Is the issue being raised in the reexamination request the same issue as was raised in the Federal Court during the civil action, or an issue that the third party requester could have raised in Federal Court during the civil action?

MPEP §2686.04.

The *inter partes* reexamination should be terminated if the answers to these three questions are "yes". *Id.*; 35 U.S.C. §317(b).

In the present case, all three requirements for termination have been satisfied.

First, a District Court issued a decision dismissing all of Requester's counterclaims of invalidity related to the '926 Patent, as described above (Ex. B).

Second, the District Court's judgment also constitutes a "final decision after all appeals" within the meaning of 35 U.S.C. §317(b), as the Requester failed to file an appeal.

Finally, all prior art references that Requester asserted in this reexamination were asserted, or could have been asserted, in the district court litigation. Specifically here, almost all of the references used in the adopted rejections (as identified in the Action Closing Prosecution mailed August 17, 2011, pp. 23-38) were identified in Requester's invalidity contentions in the litigation. *See* Ex. A, p. 7-15. The remaining references, Kaplan, Dwyer, Chen, Leeke, and Gioscia, all could have been asserted, at least because Requester's attorneys in this reexamination were aware of these references (having requested reexamination in part in light of every one of these references). As such, all combinations of prior art asserted in the reexamination were known to the Requester at the time of the litigation, and could have been raised in the court case.

All of the requirements of 35 U.S.C. §317(b) have been met. The District Court has issued an Order dismissing all of Requester's invalidity contentions, and that Order is now a final decision after all appeals. Requester raised or at least had the opportunity to raise all of the issues presented in this reexamination in the district court litigation. Accordingly this *inter partes* reexamination must be terminated under 35 U.S.C. §317(b).

In addition, Requester has now entered into an agreement with Patent Owner to obtain a fully paid up license to secure the necessary rights to sell products and services that practice the claimed subject matter of the '926 Patent (Ex. C, Frost Declaration, ¶4). In light of the final decision and the fully paid up agreement, Requester no longer has any economic or legal incentive to continue prosecuting this reexamination. As a result, Requester has withdrawn from participating in this reexamination (Ex. D).

Congress made clear that 35 U.S.C. §317(b) was intended to protect patent owners from harassment. *See* Conference Report On HR 1554, 145 Cong. Rec. H11769, 11805 (Nov. 9, 1999) ("Subtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder."). The Office has explained that an *inter partes* reexamination becomes harassment of the patent owner "when there is no longer any economic or legal incentive available to a third party [requester]" and it is

this type of harassment that termination under section 317 is intended to stop. *In re Campana, Jr. et al., inter partes* control number 95/000,020 (Petition Decision, p. 8, June 2, 2004). The Office's stated position on harassment, Congress' stated intent with regard to §317, and Requester's complete loss of any economic or legal incentive to maintain this reexamination further justify termination under 35 U.S.C. §317(b).

CONCLUSION

Patent Owner respectfully petitions the Office to terminate the above reexamination under the authority of 35 U.S.C. §317(b) and 37 C.F.R. §1.182.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (AFF.0004B6).

Respectfully submitted,

Date: December 7, 2012

/Mark J. Rozman/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§	Examiner:	Colin M. LaRose
Filed:	November 13, 2009	§		
		§		
For:	Content Delivery System And Method	§	Atty. Dkt. No.:	AFF.004B6US
		§		

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ATTN: Central Reexamination Unit
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P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF SERVICE

I hereby certify that a copy of the Request To Terminate *Inter Partes* Reexamination filed with the USPTO via EFS on December 7, 2012 has been sent by first class mail to the following attorney of record for third party requester as provided for in 37 C.F.R. §1.248(a):

NOVAK DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
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Houston, TX 77002

Respectfully submitted,

Date: December 7, 2012

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§	Examiner:	Colin M. LaRose
Filed:	November 13, 2009	§		
		§		
For:	U.S. Patent No. 7,486,926	§	Atty. Dkt. No.:	AFF.004B6US
		§		

DECLARATION OF HARLIE D. FROST UNDER 37 C.F.R. §1.132

I, Harlie D. Frost hereby declare:

1. I, Harlie D. Frost, willfully make the following Declaration for entry into the above reexamination regarding U.S. Patent 7,486,926 (the “926 Patent”).
2. I am an attorney licensed to practice in the states of Missouri and Texas, and I presently serve as the President of Affinity Labs of Texas, LLC (“Affinity Labs”), the assignee of the ‘926 Patent. Before co-founding Affinity Labs, I spent over twenty years with Southwestern Bell (later known as SBC Communications and AT&T). During my tenure with the phone company, I worked with technologists to foster innovation and to create new businesses and opportunities based upon those innovations.
3. I am familiar with the business operations of Affinity Labs as I am involved in the day-to-day operation of the company.
4. As part of resolution of litigation between Affinity Labs and Third Party Requester Apple, Inc., Requester entered into a fully paid-up licensing agreement with Affinity Labs to secure the necessary rights to sell its products and services that practice the claimed subject matter of the ‘926 Patent.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 12/17/2012



Harlie D. Frost, President

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted today via the Office electronic filing system (EFS-Web) in accordance with 37 CFR §1.6 (a)(4).

EXHIBIT D

Date: October 3, 2011

Signature: /Lance A. Smith/

Printed Name: Lance A. Smith

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Reexamination of:

Inventors: Russell W. White

Patent No.: 7,486,926

Filed: November 13, 2009

For: CONTENT DELIVERY SYSTEM AND
METHOD

Control No.: 95/001,263

Confirmation No.: 6721

Art Unit: 3992

Examiner: Colin M. LaRose

Mail Stop *Inter Partes* Reexamination
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**THIRD PARTY REQUESTER'S NOTICE OF CONCURRENT PROCEEDINGS AND
NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION**

Third Party Requester Apple Inc. ("Requester") in the above-captioned *inter partes* reexamination hereby gives notice that the parties to the proceedings have reached an agreement and Requester will no longer participate in the present reexamination.

Respectfully submitted,

/Tracy W. Druce/
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Electronic Patent Application Fee Transmittal

Application Number:	95001263
Filing Date:	13-Nov-2009
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Filer:	Mark J. Rozman/Stephanie Petreas
Attorney Docket Number:	AFF.0004B6US

Filed as Large Entity

inter partes reexam Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
PETITION IN REEXAM PROCEEDING	1824	1	1930	1930

Patent-Appeals-and-Interference:

Post-Allowance-and-Post-Issuance:

Extension-of-Time:

Samsung Ex. 1321 p. 38

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				1930

Electronic Acknowledgement Receipt

EFS ID:	14414802
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	Mark J. Rozman/Stephanie Petreas
Filer Authorized By:	Mark J. Rozman
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	07-DEC-2012
Filing Date:	13-NOV-2009
Time Stamp:	16:15:07
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$1930
RAM confirmation Number	3076
Deposit Account	201504
Authorized User	ROZMAN, MARK J.

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.19 (Document supply fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

Samsung Ex. 1321 p. 40

File Listing:					
Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Petition for review by the Office of Petitions.	AFF004B6USPetitiontoTerminate.pdf	33922 0254f762ee895b6dc75023063ef1564c082324d2	no	5
Warnings:					
Information:					
2	Reexam Certificate of Service	AFF004B6USCOSforPetitiontoTerminate.pdf	6920 66dcfd6428860d1ad6b5383778dad17ba2d61fff	no	1
Warnings:					
Information:					
3	Miscellaneous Incoming Letter	ExhibitA.pdf	287106 fed75c1f068362e39455f68fdb4699cfc370894e	no	25
Warnings:					
Information:					
4	Miscellaneous Incoming Letter	ExhibitB.pdf	143227 0ce3cc837dfe2529da17b845ddd2eb4b9b092bc3	no	3
Warnings:					
Information:					
5	Miscellaneous Incoming Letter	AFF004B6ExhibitC.pdf	903952 e36d06c72a5ff13620734fe6d390354ce871bbc	no	2
Warnings:					
Information:					
6	Miscellaneous Incoming Letter	AFF004B6ExhibitD.pdf	104690 214c2456b60df063aeda1087d19178314963eb27	no	1
Warnings:					
Information:					
7	Fee Worksheet (SB06)	fee-info.pdf	30463 b6338520e590dc2fed6aeb9967c52abaaa53838e	no	2
Warnings:					
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Total Files Size (in bytes):			1510280		

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reexamination Control No.: 95/001,263	§	Group Art Unit: 3992
	§	
Patent No.: 7,486,926	§	Appeal No.: 2012-010420
	§	
For: CONTENT DELIVERY SYSTEM AND METHOD	§	Real Parties In Interest:
	§	Affinity Labs of Texas, LLC
	§	
Examiner: Colin M. LaRose	§	Atty. Docket No: AFF.004B6US

Patent Trial and Appeal Board
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING

Appellant Affinity Labs of Texas, LLC, the owner of U.S. Patent No. 7,486,926 (“the ‘926 patent”), submits this Request For Rehearing in response to the Board’s November 1, 2012 Decision on Appeal (“Decision”) in the above-identified reexamination proceeding.

Under 37 C.F.R. § 41.79, a “request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board’s opinion reflecting its decision.” The Board misapprehended or overlooked two items in rendering the Decision rejecting the claims. Since these two items address all of the rejections in the Decision, the claims should be allowed.

Date of Deposit: <u>November 28, 2012</u> I hereby certify under 37 CFR § 1.8 this correspondence is being deposited via EFS on the date indicated above. /Stephanie Petreas/ Stephanie Petreas

I. Kumar is Not Prior Art Because It Does Not Have a Priority Date Before March 28, 2000, Under the Controlling Version of 35 U.S.C. § 102(e)

35 U.S.C. § 102(e) has gone through revisions, including amendment on November 29, 2000 under the American Inventors Protection Act, or AIPA. The Board relied on the wrong version of § 102(e) in finding that U.S. Patent No. 7,120,462 (Kumar) pre-dates March 28, 2000 (the earliest priority date of the '926 patent). The Board ruled: "Kumar claims priority to provisional application 60/128,138, filed April 7, 1999, and is therefore prior art to the '926 patent." Decision at 14.¹ However under the controlling version of § 102(e), the earliest priority date for Kumar is after March 28, 2000 and accordingly does not qualify as prior art to the '926 patent.

Kumar was filed on December 19, 2005, and is a continuation of an application filed on December 7, 2000 (which was subsequently abandoned). This abandoned application was a § 371 filing for a PCT application filed on April 7, 2000. Both the December 2000 and April 2000 filings occurred after the priority date of the '926 patent.

This PCT application claimed priority to a provisional application filed on April 7, 1999, as noted in the Decision. However, Kumar does not receive the benefit of the filing date of either the international application or the earlier provisional application for § 102(e) purposes because *the international application was filed before Nov. 29, 2000*. That is, the law and Patent Office rules governing the priority dates of references (like Kumar) that are based on international applications filed before November 29, 2000 (the effective date of the AIPA) establish that such references are only prior art as of their completion date of formal

¹ This issue was addressed during the reexamination prosecution, and the Examiner correctly found that Kumar was not entitled to a priority date prior to March 28, 2000. Action Closing Prosecution mailed August 17, 2011, p. 2.

requirements for U.S. nationalization (i.e., there is no priority date benefit from the filing date of the international application for purposes of § 102(e)). MPEP § 2136. Thus MPEP §2136 states that an international application filing date may be a prior art date under ¶102(e) only “*if the international filing date was on or after November 29, 2000*”, among other requirements. As the Kumar international application filed before this date, it cannot be a ¶102(e) reference.

In relevant part, the controlling version of § 102(e) for references like Kumar specified that a patent can be granted unless:

(e) the invention was described in a patent granted . . . on an international application by another who has fulfilled the requirement of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Thus no filing in the Kumar chain was a § 371 filing before the invention date of the ‘926 patent. Accordingly, the earliest §102(e) date for Kumar is the date that the §371 paragraph (1), (2), and (4) requirements were met. In this case, that date is at earliest December 7, 2000.

The PCT application itself has no § 102(e) date. Nor can the provisional application constitute art, as there was no U.S. filing made within a year of the provisional filing date. MPEP § 2127 (“An abandoned patent application becomes available as prior art only as of the date the public gains access to it.”) As such, Kumar is not granted the filing date of the international application or the provisional application for purposes of being eligible as a prior art reference under § 102(e).

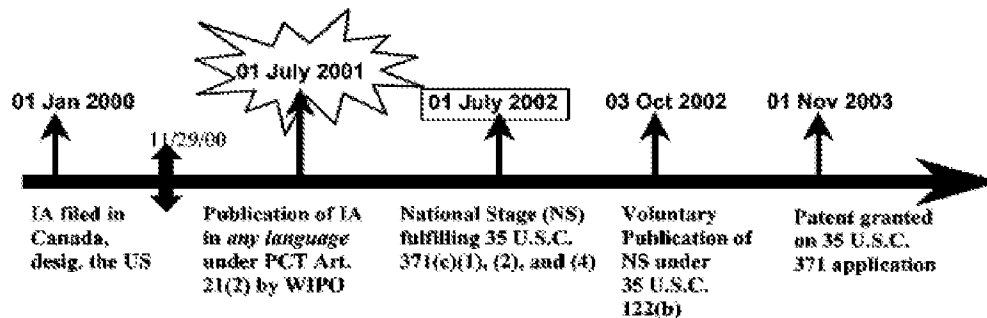
In fact, this very filing pattern is set forth as an example in the MPEP. *See* MPEP § 706.02(f)(1) Example 6, set forth below:

EXAMINATION OF APPLICATIONS

706.02(f)(1)

Example 6: References based on the national stage (35 U.S.C. 371) of an **International Application filed prior to November 29, 2000** (language of the publication under PCT Article 21(2) is not relevant).

The reference U.S. patent issued from an international application (IA) that was filed prior to November 29, 2000 has a 35 U.S.C. 102(e) prior art date of the date of fulfillment of the requirements of 35 U.S.C. 371(c)(1), (2) and (4). This is the pre-AIPA 35 U.S.C. 102(e). The application publications, both the WIPO publication and the U.S. publication, published from an international application that was filed prior to November 29, 2000, do not have any 35 U.S.C. 102(e) prior art date. According to the effective date provisions as amended by Pub. L. 107-273, the amendments to 35 U.S.C. 102(e) and 374 are not applicable to international applications having international filing dates prior to November 29, 2000. The application publications can be applied under 35 U.S.C. 102(a) or (b) as of their publication dates.



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None.
 The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None.
 The 35 U.S.C. 102(e)⁸ date for the Patent is: 01 July 2002.

The IA publication by WIPO can be applied under 35 U.S.C. 102(a) or (b) as of its publication date (01 July 2001).

Additional Priority/Benefit Claims:

If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e)(1) date for the U.S. and WIPO application publications, and the 35 U.S.C. 102(e) date for the patent will still be 01 July 2002 (the date of fulfillment of the requirements under 35 U.S.C. 371(c)(1), (2) and (4)).

If a later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the IA in the example above, the 35 U.S.C. 102(e)(1) date of the application publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application, and the 35 U.S.C. 102(e) date of the patent of the later-filed U.S. application would be 01 July 2002 (the date that the earlier-filed IA fulfilled the requirements of 35 U.S.C. 371(c)(1), (2) and (4)).

In this MPEP example, as here, the international application (and any earlier filed U.S. application to which priority is claimed in the international application) does not qualify as prior art under § 102(e).

Of course, Kumar also does not constitute prior art under § 102(a) or (b), as there was no printed publication or patent arising from any filing in this chain until well after the priority date of the '926 patent. Therefore, Kumar does not qualify as prior art to the '926 patent.

The Board should therefore withdraw all rejections in the Decision based on Kumar. *See* Decision at 19.

II. The Board's Modified Rejections Based on Lau Omit a Claim Element

The claims were rejected by the Examiner under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,772,212 (Lau) and one or more additional references. The Appellant appealed these rejections, and the Board modified the Examiner's rejections in such a way that at least one claim element, the claimed "different electronic device" (which appears in all claims), is totally missing from the prior art. The Board's rejections based on Lau are fatally flawed, and the claims should be allowed over Lau.

Claim 1 of the '926 patent recites a "portable audio file player having a ... display" and "a different electronic device that has an associated display." Further, the claim recites that the display on the portable audio file player shows "a menu of selectable icons," and the display on the different electronic device shows a "selectable representation of the particular selectable icon." To be clear, the portable audio file player and the different electronic device must be different devices (the claim says "different"), and each shows different things on its corresponding display.

The rejection proposed by the Requester and adopted by the Examiner maps Lau's trunk-mounted music server to the claimed "portable audio file player" and Lau's head unit mounted in the dashboard of the car to the claimed "different electronic device."² In the appeal, Appellant argued that there is no reason why Lau's music server mounted in the trunk of a car would have a display with a menu of selectable icons. App. Br. at 14; *see also*, Decision at 21.

In response to this argument, the Board modified the Examiner's rejections by combining Lau's trunk-mounted music server with Lau's head end into a single device:

Lau discloses that the music server is in communication with a head unit mounted in the dashboard of the car. Col. 5, ll. 8-13. Further, Lau discloses that a perspective user operates the head unit, which in turns sends commands to the music server requesting music desired by the user. Col. 8, ll. 49-52. We conclude that an ordinarily skilled artisan would have understood that Lau's music server works in conjunction with the head unit to communicate a menu of icons or equivalent visual representations (e.g., song titles and artists) to the user for operating purposes. Therefore, we find that Lau's music server already has a user interface with a menu of selectable icons associated therewith, as required by claims 1 and 11. Decision at 21-22.

However, by combining Lau's trunk-mounted music server with the head unit into a single device to read on the claimed "portable audio file player having a ... display," nothing corresponds to the claimed "different electronic device" with its own display. Furthermore, the two claimed devices cannot map to the same device because the claim states that the two devices are "different." '926 patent at 18:35. This flaw is fatal because "all claim limitations must be considered." MPEP §2143.03, citing *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Board should therefore withdraw the rejections based on this analysis, specifically the rejections based on Lau discussed in the Decision at pages 21-22.

² See Request, Exhibit EE. These proposed rejections were adopted by the Examiner. Office Action mailed July 9, 2010 at 11-12.

The Decision also recites an alternative rejection, in which the teachings of U.S. Patent No. 6,694,200 (Naim) that describes a portable audio device with a display are combined with the trunk-mounted unit of Lau. Decision at 22. However, this still does not cure the deficiency that the prior art does not teach the claimed “different electronic device.” The Board “conclude[d] that an ordinarily skilled artisan would have understood that Lau’s music server works in conjunction with the head unit to communicate a menu of icons or equivalent visual representations (e.g., song titles and artist) to the user for operating purposes.” Decision at 22. Thus, according to the Board’s conclusion, the display on Lau’s head unit will show a menu of selectable icons. Likewise, the Board found that the display on Lau’s trunk-mounted music server (as modified by Naim) will also show a menu of selectable icons. Decision at 22. There is nothing in the rejection to read on the claimed “different electronic device” that shows “a selectable representation of the particular selectable icon.” This flaw is fatal because “all claim limitations must be considered.” MPEP §2143.03.

The Board should therefore withdraw the rejections based on this analysis, specifically the “alternative[.]” rejections based on Lau discussed in the Decision at 22.

III. Conclusion

With the withdrawal of the above-identified rejections in the Decision, all of the claims are in condition for allowance. The Director is hereby authorized to charge Deposit Account No. 20-1504 (AFF.0004B6) any required fees. As identified in the attached Certificate of Service, a copy of the present Request for Rehearing, in its entirety, is being served to the address of the attorney or agent of record for the Third Party Requester.

Respectfully submitted,

Date: November 28, 2012

/Mark J. Rozman/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reexamination Control No.: 95/001,263	§	Group Art Unit: 3992
	§	
Patent No.: 7,486,926	§	Appeal No.: 2012-010420
	§	
For: CONTENT DELIVERY SYSTEM AND METHOD	§	Real Parties In Interest:
	§	Affinity Labs of Texas, LLC
	§	
Examiner: Colin M. LaRose	§	Atty. Docket No.: AFF.004B6US

Patent Trial and Appeal Board
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF SERVICE

I hereby certify that a copy of the attached Request for Rehearing filed with the USPTO via EFS on November 28, 2012, has been sent by First Class Mail to the following attorney of record for third party requester as provided for in 37 C.F.R. §1.248(a):

NOVAK DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
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Respectfully submitted,

Date: November 28, 2012

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Customer No.: 21906

Electronic Acknowledgement Receipt

EFS ID:	14330661
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	Mark J. Rozman/Stephanie Petreas
Filer Authorized By:	Mark J. Rozman
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	28-NOV-2012
Filing Date:	13-NOV-2009
Time Stamp:	16:43:40
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Request for Rehearing of Patent Board Decision	AFF004B6USRequestforRehearingandCertofService.pdf	154697 <small>34c1b672fda8b4cb953287fd821932a012847230</small>	no	9

Warnings:

Information:

Samsung Ex. 1321 p. 52

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

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New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,263	11/13/2009	7486926	AFF.0004B6US	6721
21906	7590	11/01/2012	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			LAROSE, COLIN M	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			11/01/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Third Party Requester

v.

AFFINITY LABS OF TEXAS, LLC
Patent Owner and Appellant

Appeal 2012-010420
Reexamination Control No. 95/001,263
U.S. Patent No. 7,486,926 B2
Technology Center 3900

Before HOWARD B. BLANKENSHIP, MICHAEL R. ZECHER, and
THOMAS L. GIANNETTI, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION ON APPEAL

Patent Owner Affinity Labs of Texas, LLC, (hereinafter “Appellant”)¹
appeals under 35 U.S.C. §§ 134(b) and 315(a)(1) from the Examiner’s rejection of
original claims 1-20 of U.S. Patent No. 7,486,926 B2 (hereinafter “the ‘926

¹ Appellant’s “Appeal Brief” (hereinafter “App. Br.”) filed March 5, 2012, at 2.

patent”) and newly added claims 21-37, proposed and entered during this reexamination proceeding.² Third Party Requester Apple Inc. has not filed any briefs with respect to this appeal.

We have jurisdiction under 35 U.S.C. §§ 6, 134, and 315.

We AFFIRM.

I. STATEMENT OF THE CASE

A. Related litigation

The following civil action has been identified as related to this reexamination proceeding: *Affinity Labs of Texas LLC v. Apple Inc.*, Case No. cv-09-44-36-CW. App. Br. at 2.

B. This Reexamination Proceeding

1. This proceeding arose from a “Request for *Inter Partes* Reexamination of U.S. Patent 7,486,926” (hereinafter “Request”), filed November 13, 2009. The ‘926 patent issued on February 3, 2009, with claims 1-20. The Request proposed fifty-five grounds of rejection of claims 1-20 under 35 U.S.C. § 103(a), which are designated as obviousness rejections A-CCC. Request at 23-380.

2. Reexamination was ordered in an “Order Granting/Denying Request for *Inter Partes* Reexamination” (hereinafter “Order”), filed February 5, 2010. The Order was followed by a first, Non-final Office action (hereinafter “Non-final Action”), mailed July 9, 2010, in which the Examiner:

² The ‘926 patent issued to inventors Russell W. White and Kevin R. Imes on February 3, 2009, is based on patent application 11/681,452, filed March 2, 2007. The ‘926 patent is a continuation of patent application 09/537,812 (“the ‘812 application”), filed March 28, 2000—now U.S. Patent No. 7,187,947 B1.

- (a) designated the obviousness rejections proposed in the Request as rejections A-CCC (*see* Non-final Action at 3-15); and
- (b) adopted and entered obviousness rejections A-F for claims 1-10 (*id.* at 3-4);
- (c) refused to adopt obviousness rejections B, G, H, I, J, K for claims 11-20 (*id.* at 5);
- (d) adopted and entered obviousness rejections L-P for claims 1-10 (*id.* at 6-7);
- (e) refused to adopt obviousness rejections L and N-R for claims 11-20 (*id.* at 8);
- (f) adopted and entered obviousness rejections S-X for claims 1-10 (*id.* at 9-10);
- (g) refused to adopt obviousness rejections Y-DD for claims 11-20 (*id.* at 10-11);
- (h) adopted and entered obviousness rejections EE-MM for claims 1-20 (*id.* at 11-12);
- (i) adopted and entered obviousness rejections NN-TT for claims 1-20 (*id.* at 13-14); and
- (j) adopted and entered obviousness rejections UU-CCC for claims 1-20 (*id.* at 14-15).

All of the above entered obviousness rejections are before us, plus some obviousness rejections of new claims 21-37 discussed below.

3. In the Arguments/Remarks filed September 9, 2010, Appellant presented arguments directed to the obviousness rejections adopted and entered by the Examiner listed above. In the Claims filed concurrently, Appellant added new

dependent claims 21-37. In addition, Appellant filed a Declaration of Russell W. White—the first-named inventor in the ‘926 patent, in addition to Founder and Vice President of the assignee—on September 9, 2010, as evidence to support their argument pertaining to secondary considerations of nonobviousness.

4. In response to Appellant’s Reply filed September 9, 2010, the Third Party Requester submitted comments (“Third Party Requester Comments”) on October 12, 2010, addressing Appellant’s arguments/remarks and arguing that newly added dependent claims 21-37 are unpatentable under 35 U.S.C. § 103(a) in light of the proposed obviousness rejections initially discussed in the Request.

5. In the “Action Closing Prosecution” (hereinafter “ACP”), mailed August 17, 2011, the Examiner:

(a) repeated the obviousness rejections of claims 1-20 adopted, adopted-in-part, and entered in the Non-final Action (ACP at 23-35); and

(b) entered the following new obviousness rejections:

(i) claims 21-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Rio 500 and Kumar (*id.* at 36);

(ii) claims 21-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of SoundJam, Rio 500, and Kumar (*id.*);

(iii) claims 22, 23, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of SoundJam, Rio 500, and Naughton (*id.*);

(iv) claims 21-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of SoundJam, Rio 500, Naughton, and Abecassis (*id.* at 37);

(v) claims 21-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Lau, Naim, and Lee (*id.* at 38);

(vi) claims 21-27 and 32-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Looney, Dwyer, and Kumar (*id.*);
and

(vii) claims 28, 29, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Looney, Dwyer, Kumar, and Leeke or Kaplan. *Id.*

6. In the Patent Owner's Response filed on September 16, 2011, Appellant presented arguments directed to the obviousness rejections adopted, adopted-in-part, and entered by the Examiner with respect to claims 1-37, all the claims now pending in this reexamination proceeding.

7. Shortly thereafter the Third Party Requestor filed a Miscellaneous document on October 3, 2011, indicating that they reached an agreement with Appellant and they would no longer be participating in this reexamination proceeding.

8. In the "Right of Notice of Appeal" (hereinafter "RAN") filed December 6, 2011, the Examiner repeated all of the obviousness rejections adopted, adopted-in-part, and entered with respect to claims 1-37 from the ACP. RAN at 6-38.

9. Appellant timely filed a "Notice of Appeal" on January 5, 2012.

10. Appellant's timely filed the Appeal Brief on March 5, 2011, accompanied with an additional copy of the White Declaration.

11. The Examiner timely mailed an Answer (hereinafter "Ans.") on May 15, 2012, that incorporates by reference the RAN. Ans. at 4.

C. The '926 Patent

The invention at issue in the '926 patent generally relates to a content delivery system and method. Spec. 1: 13-15. In particular, the invention includes communicating selective information to an electronic device, such as an audio player, MP3 player, personal digital assistant ("PDA") device, etc. Spec. 2: 44-46; *see also* spec. 7: 65-spec. 8: 10. The invention uses a general system—commonly referred to as personal computer—to format, segment, compress, and modify several songs or titles into an audio file (spec. 3: 14-63), and communicate the audio file to the electronic device (spec. 7: 8-10). The electronic device receives the audio file and communicates the file to a different electronic device, such as an automobile sound system, home stereo, etc. Spec. 8, ll. 16-20.

Figure 9 of the '926 patent is reproduced below.

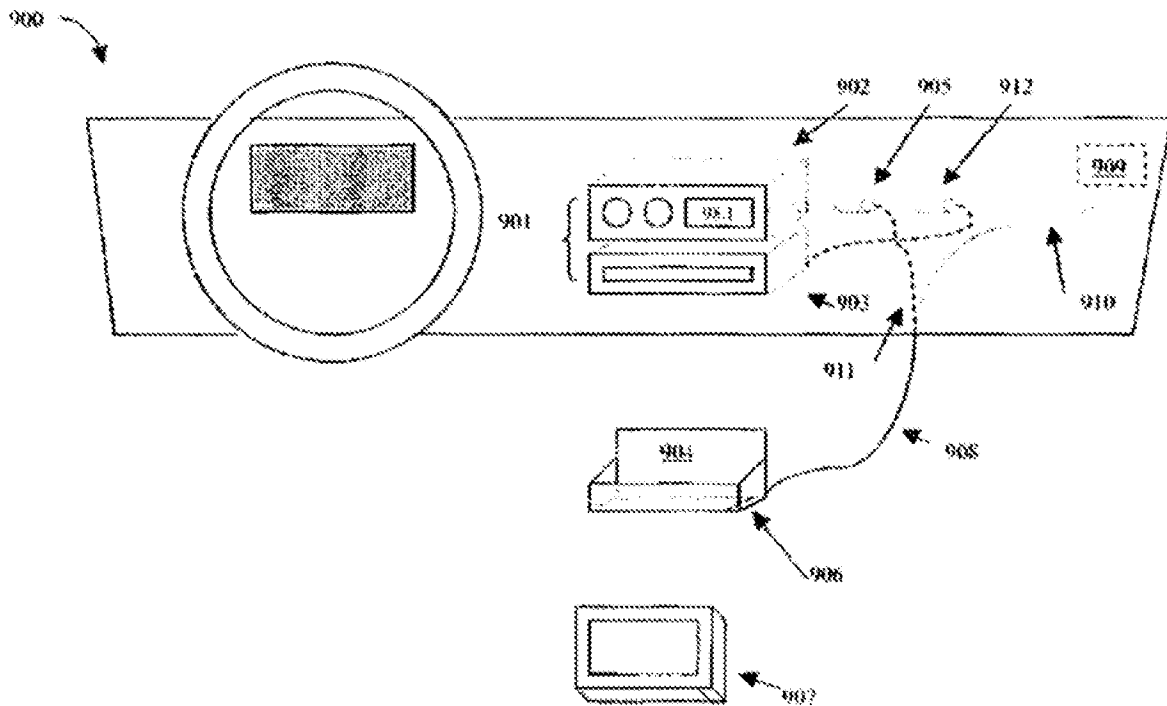


FIG. 9

Figure 9 illustrates an automobile console 900 connected to interface 904 and contact 906—otherwise considered a mount—for electronic device 907. Spec. 17: 10-22. Electronic device 907 communicates selected audio information, such as the audio file discussed above, to the automobile audio system via interface 901, thereby allowing a prospective user to listen to selected audio information. *Id.* at 31-34.

D. Claims on Appeal

The original independent claims on appeal are claims 1 and 11, which read as follows:

1. A content delivery system, comprising:

a software application configured for storage on a storage medium of *a personal computer*, the software application further configured to maintain a collection of audio files saved locally to the personal computer, to allow a user to create a playlist, to initiate a downloading of an audio file included in the playlist from the personal computer to *a portable audio file player*, to initiate sending a request for a different audio file to a network based resource, to receive the different audio file, to locally save the different audio file at the personal computer, and to initiate presentation of a graphical user interface (GUI) at the personal computer, wherein the GUI is configured to operate as a user interface for the network based resource, further wherein the GUI is configured to present a collection of selectable functions associated with audio information;

the portable audio file player having a processor, a display, and a memory configured to store a plurality of audio files; and

a collection of instructions saved locally at the portable audio file player, the collection of instructions operable to direct the processor to maintain an updateable user interface comprising a menu of selectable icons, to modify the updateable user interface in connection with receiving a particular audio file from the personal computer such that a particular selectable icon is linked to the particular audio file, to initiate presentation of the menu on the display, to communicate data to *a different electronic device* that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display.

Claims Appendix—App. Br. at 31 (emphasis added).

11. A content delivery system, comprising:

a network based resource accessible by *a user computer system*, the network based resource maintaining a plurality of selectable songs formatted in a digital format;

an application configured to execute at the user computer system, the application operable to direct the user computer system to communicatively couple with the network based resource to allow user selection of an audio file from the network based resource, to receive the audio file, to locally save the audio file, and to initiate presentation of a graphical user interface (GUI) at the user computer system; the GUI configured to present a collection of selectable functions associated with audio information, the selectable functions comprising: a song purchase function;

a song search function, a playlist creation function; and

a naming function that allows a user to assign a user-defined name to a given playlist; and a different application configured to execute at a *portable media player*, the different application operable to direct the portable media player to receive the user-defined name, to associate the user-defined name with at least one audio file, and to communicate data representing the user-defined name to a *different audio system* to allow the different audio system to present a soft button comprising the user-defined name on an associated display of the different audio system.

Id. at 32-33.

Appellant acknowledges the similarity of the limitations at issue in claim 1 (e.g., “a personal computer,” “a portable audio file player,” and “a different electronic device”) to recitations in claim 11 (e.g., “a user computer system,” “a portable media player,” and “a different audio system”). App. Br. 5 at FN 1. Similar to Appellant, our analysis will use the terminology of claim 1. *Id.*

E. Prior Art Relied Upon

Naughton	US 6,160,551	Dec. 12, 2000 (filed Mar. 20, 1995)
Looney	US 6,232,539 B1	May 15, 2001 (filed Oct. 18, 1999)
Gioscia	US 6,407,750 B1	June 18, 2002

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Van Zoest	US 6,609,105 B2	(filed Jan. 8, 1999) Aug. 19, 2003 (effectively filed Jan. 7, 2000)
Dwyer	US 6,671,567 B1	Dec. 30, 2003 (filed Nov. 12, 1998)
Naim	US 6,694,200 B1	Feb. 17, 2004 (filed Nov. 16, 1999)
Lau	US 6,772,212 B1	Aug. 3, 2004 (filed Mar. 8, 2000)
Lee	US 6,728,531 B1	Apr. 27, 2004 (effectively filed Sept. 22, 1999)
Kumar	US 7,120,462 B2	Oct. 10, 2006 (effectively filed Apr. 7, 1999)

Rio 500, “*Getting Started Guide for Windows® 98 and Macintosh® OS 8.6,*” (1999) (“Rio 500”).

Jeffery Robbin and Bill Kincaid, “*SoundJam™ MP Digital Audio System,*” (Casady & Greene, Inc. 1999) (“SoundJam”).

F. The Rejections

Appellant contends in the Appeal Brief that the Examiner erred in rejecting claims 1-37 under 35 U.S.C. § 103(a) for a number reasons. In particular, Appellant presents multiple allegations of error for the following obviousness rejections of independent claims 1 and 11:

1. Obviousness rejection A—claim 1 was rejected under 35 U.S.C. § 103(a) over the combination of Rio 500 and Kumar (App. Br. at 6-10);
2. Obviousness rejection L— claim 1 was rejected under 35 U.S.C. § 103(a) over combination of SoundJam, Rio 500, and Kumar (*id.* at 10-11);
3. Obviousness rejection S— claim 1 was rejected under 35 U.S.C. § 103(a) over combination of SoundJam, Rio 500, and Naughton (*id.* at 11-13);

4. Obviousness rejection EE— claims 1 and 11 were rejected under 35 U.S.C. § 103(a) over combination of Lau, Naim, and Lee (*id.* at 13-17);

5. Obviousness rejection NN— claims 1 and 11 were rejected under 35 U.S.C. §103(a) over combination of Van Zoest, Gioscia, and the knowledge of an ordinarily skilled artisan (*id.* at 17-19); and

6. Obviousness rejection UU— claims 1 and 11 were rejected under 35 U.S.C. § 103(a) over the combination of Looney, Dwyer, and Kumar (*id.* at 19-23).

In addition, Appellant contends that claims 1-37 of the '926 patent should be accorded the benefit date of March 28, 2000, the filing date of the '812 application. *Id.* at 23, 25-29. Appellants also asserts that the Examiner is not authorized to consider the issue of written description in this reexamination proceeding. *Id.* at 23-25. Finally, Appellant argues that secondary considerations of nonobviousness—namely commercial success—provide strong evidence to rebut the obviousness rejections adopted, adopted-in-part, or maintained by the Examiner. *Id.* at 29-30.

We begin our analysis by addressing the threshold 35 U.S.C. § 120 priority issue and corresponding written description issue. Next, because the resolution of obviousness rejection A—based on the combination of Rio 500 and Kumar—and obvious rejection EE—based on the combination of Lau, Naim, and Lee—are dispositive with respect to all the claims now pending on appeal, we will address those rejections in turn. Finally, we will address Appellant's argument that secondary considerations such as commercial success provide strong evidence of nonobviousness with respect to the invention claimed in the '926 patent.

II. ANALYSIS

A. 35 U.S.C. § 120 Priority With Respect To The '926 Patent

Appellant asserts that the '926 patent should be accorded the benefit date of March 28, 2000, because the '926 patent is a continuation of the '812 application. App. Br. at 23. Based on the accorded benefit date of March 28, 2000, Appellant further argues that both Kumar and Van Zoest do not qualify as prior art. *Id.* Moreover, Appellant contends that an Examiner in an inter partes reexamination is not permitted to reexamine original patent claims for compliance with the written description requirement under 35 U.S.C. § 112. App. Br. at 23-24. In particular, Appellant argues that because no new subject matter has been added to or deleted from original claims 1-20, these original claims can only be examined in a reexamination proceeding on the basis of prior art patents and printed publications. *Id.* We do not agree with Appellant.

Generally, substantial new questions of patentability in a reexamination proceeding must be based on prior art patents or printed publications. *See Manual of Patent Examining Procedure* ("MPEP") § 2617, 8th ed., Rev. 8, July 2010. Other patentability issues, such as prior public use or sale, inventorship, compliance with 35 U.S.C. § 101, 35 U.S.C. § 112, etc., normally should not be considered when making the determination on the reexamination request and should not be presented in the request. *See id.* However, there are exceptions. For example, where appropriate, an Examiner may need to reach the issue of whether the claims in a patent subject to reexamination are only entitled to the filing date of an earlier foreign or U.S. patent application. *See id.* In this reexamination proceeding, the Examiner concluded that the claims in the '926 patent are only

entitled to the filing date of March 2, 2007, because such claims are not fully supported by the '812 patent application filed on March 28, 2000. RAN at 2-5.

In other words, in order to be entitled to the benefit of the '812 application, one requirement is that the invention claimed in the '926 patent must have been disclosed in the '812 application in the manner provided by 35 U.S.C. § 112, first paragraph. *See* 35 U.S.C. § 120; *In re Lukach*, 442 F.2d 967, 968-69 (CCPA 1971). The Federal Circuit has held that there is no statutory prohibition from conducting such a priority analysis in a reexamination proceeding. *In re NTP, Inc.*, 654 F.3d 1268, 1277 (Fed. Cir. 2011). That is, nothing in 35 U.S.C. §§ 301 et seq., the statutes which govern reexamination proceedings, prohibits the Examiner from determining whether or not a priority date was properly claimed during the original examination of the '926 patent. *See id.* As a result, the Examiner may consider whether the '926 patent should be accorded the benefit date of the '812 application, which in turn encompasses considering both the '926 patent and the '812 application on the basis of written description.

Next, Appellant contends that the written description of the '812 application fully supports the claims of the '926 patent—specifically the following claim limitations recited in claim 1, and similarly recited in claim 11:

the collection of instructions operable to direct the processor . . . to communicate data to a different electronics device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display.

App. Br. at 25-28. Based on that written description analysis, Appellant argues that the '926 patent should be accorded the benefit date of March 28, 2000, and the

obviousness rejections based on Kumar and Van Zoest should be withdrawn because those references do not qualify as prior art. App. Br. at 28-29. We do not agree with Appellant.

Even assuming that the written description of the ‘812 application fully supports the disputed claim limitations recited in claim 1, and similarly recited in claim 11, the ‘926 patent would only be accorded the benefit date of March 28, 2000. However, both Kumar and Van Zoest have effective filing dates that pre-date March 28, 2000—(1) Kumar claims priority to provisional application 60/128,138, filed April 7, 1999 (“the ‘138 provisional application”); and (2) Van Zoest claims priority to provisional application 60/175,159, filed January 7, 2000 (“the ‘159 provisional application”). We note that the Examiner may rely on the effective filing dates of the ‘138 provisional application and the ‘159 provisional application unless Appellant demonstrates that those provisional applications fail to support Kumar and Van Zoest in accordance with 35 U.S.C. § 112, first paragraph. *See In re Giacomini*, 612 F.3d 1380, 1383-85 (Fed. Cir. 2010); *see also Ex parte Yamaguchi*, 88 USPQ2d 1606, 1609 (BPAI 2008) (precedential); MPEP §§ 2136.03(III), 706.02(VI)(D). In this case, Appellant does not assert that it would have been improper for the Examiner to rely upon the effective filing dates of the ‘138 provisional application and the ‘159 provisional application because those provisional applications do not reasonably support the subject matter relied upon by the Examiner in Kumar and Van Zoest.

Nonetheless, we find that the ‘138 provisional application and the ‘159 provisional application reasonably support the subject matter relied upon by the Examiner in Kumar and Van Zoest, respectively. With respect to the ‘138 provisional application, Figures 1, 2, and 5, and the corresponding description at

pages 3 and 4, illustrate and disclose a docking display unit. Therefore, we conclude that the cited disclosure in the ‘138 provisional application reasonably supports the Examiner’s reliance upon Kumar’s docking display unit. RAN at 7. With respect to the ‘159 provisional application, we agree with the Examiner’s position that the ‘159 provisional application reasonably supports the subject matter relied upon by the Examiner in Van Zoest. RAN at 21; *see also* Third Party Requestor Comments at 25-33. As a result, the obviousness rejections based in part on Kumar and Van Zoest that were adopted, adopted-in-part, or maintained by the Examiner should not be withdrawn because these references would qualify as prior art even if we were to accord the ‘926 patent the benefit date of March 28, 2000.

B. 35 U.S.C. § 103(a) Rejection of Claim 1—Combination of Rio 500 and Kumar

First, Appellant contends that both Rio 500 and Kumar are only directed to two-device systems, whereas the invention claimed in the ‘926 patent describes three devices: (1) “a personal computer;” (2) “a portable audio file;” and (3) “a different electronic device.” App. Br. at 7. Appellant argues that Rio 500 describes two devices: (1) a personal computer; and (2) a digital audio player—a simple device that is controlled by the RioPort Audio Manager running on the personal computer. *Id.* Appellant also argues that Kumar discloses a handset unit, which is a stand-alone computer that connects to a network resource. *Id.* In contrast, Appellant asserts that the claimed “portable audio file player” is an intermediate device of mid-level complexity that is neither a simple device like Rio 500’s digital audio player nor a stand-alone computer like Kumar’s handset unit. App. Br. at 8. Appellant alleges that neither Rio 500 nor Kumar teaches a device similar to the claimed “portable audio file player”—an intermediate device that

interfaces with two other devices—the claimed “personal computer” and “different electronic device”. *Id.* We do not agree with Appellant.

The Examiner relies upon Rio 500’s disclosure of connecting the digital audio player to a personal computer (Rio 500 at 1) to teach both the claimed “portable audio file” and “personal computer.” RAN at 23-24. In addition, the Examiner relies upon Kumar’s docking display unit (col. 2, ll. 44-51) to teach the claimed “different electronic device.” *Id.* Therefore, the Examiner’s adoption of this obviousness rejection is based on the combination of Rio 500 and Kumar, not Rio 500 or Kumar individually. We note that the test for obviousness is what the combined teachings of Rio 500 and Kumar would have suggested to an ordinarily skilled artisan. Accordingly, Appellant cannot show nonobviousness by attacking Rio 500 and Kumar individually where the rejection is predicated on the combination. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Consequently, we find no error in the Examiner reliance upon the Rio 500’s audio digital player and personal computer, in conjunction with Kumar’s docking display unit, because the Examiner’s analysis properly accounts for the three claimed devices—(1) “a personal computer;” (2) “a portable audio file;” and (3) “a different electronic device.”

Moreover, we note that Kumar acknowledges that Rio’s digital audio player fulfills the portable entertainment needs of consumers by playing MP3 compatible audio content downloaded from the Internet. Col. 2, ll. 9-13. Further, Kumar discloses docking a detachable handset unit or portable device into the docking display unit. Col. 2, ll. 31-51. Because Kumar’s detachable handset unit is a portable device similar to Rio 500’s digital audio player, we conclude that an ordinarily skilled artisan would have readily appreciated that the Rio 500’s digital

audio player not only possesses the capability to interface with Rio 500's personal computer, but also possesses the capability to interface with Kumar's docking display unit. Therefore, contrary to Appellant's argument, we find that Rio 500's digital audio player meets the claimed "portable audio player" limitation because it amounts to an intermediate device that possesses the capability to interface with two other devices—(1) Rio 500's personal computer; and (2) Kumar's docking display unit.

Second, Appellant contends that Kumar does not teach presenting "a selectable representation of the particular selectable icon on the [portable audio file player's] display" recited in claim 1 because Kumar's docking display unit does nothing more than replicate the display of the handset unit being docked. App. Br. at 8. We do not agree with Appellant.

Kumar's Figure 3 illustrates that when the detachable handset unit is docked into the docking display unit, the video interface of the detachable handset unit connects to the auxiliary display of the docking display unit. Col. 4, ll. 26-51. Kumar also disclose that the detachable handset unit becomes the controller for the entire portable device (i.e., the combined detachable handset unit and docking display unit). Col. 5, ll. 16-19. In light of our analysis above, we conclude that an ordinarily skilled artisan would have recognized that the Rio 500's digital audio player may also become the controller for Kumar's docking display unit. Moreover, we conclude that an ordinarily skilled artisan would have understood that Rio's digital audio player could present the selectable icons or equivalent visual representations associated with song/book titles and artists (Rio 500 at 1—Liquid Crystal Display) while docked into Kumar's docking display unit. Therefore, we find that the combination of Rio 500 and Kumar teaches "a

selectable representation of the particular selectable icon on the [portable audio file player's] display," as recited in claim 1.

Third, Appellant contends that even if Rio 500 and Kumar were successfully combined, the functionality of the combined system would be performed in the wrong device. App. Br. at 9. That is, Appellant argues that the claimed functionalities of "maintain[ing] an updatable user interface" and "modify[ing] the updatable user interface" are performed by the claimed "portable audio file player" and not the RioPort Audio Manager stored and run on Rio 500's personal computer. *Id.* We do not agree with Appellant.

Rio 500 discloses that the RioPort Audio Manager is software uploaded to the personal computer. Rio 500 at 1. We find that the RioPort Audio Manager maintains and modifies the display on Rio 500's digital audio player (*id.*), such that a prospective user can maintain menus of song/book titles and artists, and modify such menus in connection to receiving or downloading a new audio file from Rio 500's personal computer. Therefore, we find that that Rio 500's digital audio player performs the claimed functionalities of "maintain[ing] an updatable user interface" and "modify[ing] the updatable user interface."

Fourth, Appellant contends that Kumar teaches away from the proffered combination. App. Br. at 9. In particular, Appellant argues that there is no reason to add Kumar's docking display unit to Rio 500's digital audio player to make it behave like a personal computer because the Rio 500 system already has a personal computer associated therewith. *Id.* We do not agree with Appellant.

As explained above, the Examiner identifies Rio 500's digital audio player and personal computer (Rio 500 at 1) as the claimed "portable audio file" and "personal computer," respectively. In addition, the Examiner identifies Kumar's

docking display unit (col. 2, ll. 44-51) as the claimed “different electronic device.” The Examiner’s obviousness rejection adds Kumar’s docking display unit to Rio 500’s digital audio player and personal computer in order to communicate data to a “different electronic device,” as required by claim 1. RAN at 23-24. We note that Appellant has not pointed to an explicit disclosure within Kumar that acts to “criticize, discredit, or otherwise discourage” docking a digital audio player, such as Rio 500’s digital audio player, into Kumar’s docking display unit. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Conversely, Appellant has not pointed to an explicit disclosure within Rio 500 that acts to “criticize, discredit, or otherwise discourage” docking Rio 500’s digital audio player into a docking station, such as Kumar’s docking display unit. *Id.* Therefore, we are not convinced that Kumar teaches away from the proffered combination just because Rio 500’s digital audio player is already associated with a personal computer.

For the foregoing reasons, we see no error in the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a) over the combination of Rio 500 and Kumar, or in the obviousness rejections based in whole or in part on Rio 500 and Kumar over claims 2-10 and 21-27, which are not separately argued. App. Br. at 9-10. *See* 37 C.F.R. § 41.67(c)(1)(vii) (“When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.”).

C. 35 U.S.C. § 103(a) Rejection of Claims 1 and 11—Combination of Lau, Naim, and Lee

First, Appellant contends that Lau’s mounted music server does not constitute the claimed “portable audio file player” recited in claim 1, and similarly recited in claim 11. App. Br. at 14. In particular, Appellant argues that the Examiner contradicts his own definition of portable (i.e., a portable item is generally recognized as something that is capable of being carried or moved about) when the Examiner takes the position that Lau’s music server constitutes a “portable audio file player” that is small enough to be mounted in the trunk of an automobile. *Id.* (citing to the RAN at 14-15). Appellant asserts that mounting Lau’s music server in the trunk of an automobile negates any size considerations and, therefore, the music server is not portable. *Id.* We do not agree with Appellant.

We begin our analysis by first considering the scope and meaning of the claim term “portable,” which must be given its broadest reasonable interpretation consistent with Appellant’s disclosure in the ‘926 patent. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating that during examination “claims must be interpreted as broadly as their terms reasonably allow”). Upon reviewing Appellant’s disclosure, we fail to find an explicit definition for the claim term “portable.” Therefore, we look to its ordinary and customary meaning. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (claim terms are “generally given their ordinary and customary meaning”). The Examiner indicates that the ordinary and customary meaning of the claim term “portable” is something that is capable of being carried or moved about. RAN at 14. Appellant does not provide a definition of the claim

term “portable” that is contrary to the Examiner’s definition. We agree with the Examiner’s broadest reasonable interpretation of the claim term “portable.” With this claim construction in mind, we turn to the merits of Appellant’s argument that Lau’s mounted music server is not a “portable audio file player.”

We are not persuaded that because Lau’s music server is mounted in the trunk of a car, it negates any size considerations and, therefore, renders the music server not portable. Lau does in fact disclose mounting the music server in the trunk of a car. Col. 5, ll. 8-13. However, we conclude that an ordinarily skilled artisan would have recognized that mounting Lau’s music server in the trunk of the car necessarily involves carrying or moving the music server to the trunk of the car before mounting it. Alternatively, we conclude that an ordinarily skilled artisan would have appreciated that because the car carries and moves about passengers, the car carries and moves about Lau’s music server mounted in the trunk. Therefore, consistent with the claim construction above, we find that the Examiner was correct in identifying Lau’s music server as the claimed “portable audio file player.”

Second, Appellant contends that Lau’s music server lacks many of the elements of the claimed “portable audio file player,” including “an updateable user interface comprising a menu of selectable icons.” App. Br. at 14. In particular, Appellant argues that there is no reason why Lau’s music server mounted in the trunk of a car would have a display with a menu of selectable icons. *Id.* We do not agree with Appellant.

Lau discloses that the music server is in communication with a head unit mounted in the dashboard of the car. Col. 5, ll. 8-13. Further, Lau discloses that a prospective user operates the head unit, which in turn sends commands to the

music server requesting music desired by the user. Col. 8, ll. 49-52. We conclude that an ordinarily skilled artisan would have understood that Lau's music server works in conjunction with the head unit to communicate a menu of icons or equivalent visual representations (e.g., song titles and artists) to the user for operating purposes. Therefore, we find that Lau's music server already has a user interface with a menu of selectable icons associated therewith, as required by claims 1 and 11.

Alternatively, the Examiner indicates that Naim's Figure 1A illustrates a portable device with a corresponding on-board display. RAN at 17. We agree with the Examiner that an ordinarily skilled artisan would have appreciated incorporating the on-board display in Naim's portable device into Lau's music server, thereby allowing a prospective user to operate the music server using the on-board display. *See id.* Moreover, we conclude that an ordinarily skilled artisan would have appreciated that operating Lau's music server using Naim's on-board display necessarily encompasses displaying a menu of icons or equivalent visual representations of song titles or artists so that the user may select a desired song title or artist. Such a creative application of display functionality for a menu of selectable icons is well within the level of an ordinarily skilled artisan. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007) ("A person of ordinary skill is also a person of ordinary creativity, not an automaton."). Therefore, we agree with the Examiner that the combination of Lau and Naim also teaches the claimed "portable audio file player" that includes "an updateable user interface comprising a menu of selectable icons." RAN at 16-17.

Third, Appellant contends that the '926 patent distinguishes a Compact Disc ("CD") player mounted in a conventional audio system of a car from the claimed

“portable audio player.” App. Br. at 14. Appellant argues that in light of the ’926 specification, the broadest reasonable interpretation of that term excludes a mounted CD player, like Lau’s music server. *Id.* at 14-15. We do not agree with Appellant.

As discussed above, we agree with the broadest reasonable interpretation of the claim term “portable” proffered by the Examiner, and therefore, agree with the Examiner’s determination that Lau’s music server amounts to the claimed “portable audio player.” Moreover, we note that Appellant’s reference to a mounted CD player in the ’926 specification does not distinguish Lau’s music server from the claimed “portable audio file player.” While Lau discloses that the music server emulates a disc changer—commonly referred to as a CD player—Lau explicitly discloses that the “music server [] is not an actual disk changer.” Col. 4, ll. 30-34. Therefore, contrary to Appellant’s argument, we find Lau’s music server and a CD player amount to separate and distinct audio players.

Fourth, Appellant contends that Lau is only directed to a two-device system, whereas the invention claimed in the ’926 patent describes three devices: (1) “a personal computer;” (2) “a portable audio file;” and (3) “a different electronic device.” App. Br. at 15. In particular, Appellant argues because Lau’s car audio system includes both the music server and head unit, the car audio system amounts to a single device. *Id.* Therefore, Appellant asserts that Lau does not teach the intermediate device—the portable audio file player that includes a display, as required by claims 1 and 11. We do not agree with Appellant.

As discussed above, we agree with the Examiner’s determination that Lau’s music server amounts to the claimed “portable audio player.” Moreover, Lau’s Figure 1 illustrates that the head unit amounts to a standard car stereo head unit

that works in conjunction with the car's audio system. Col. 4, ll. 27-39. Therefore, we find that Lau's car audio system constitutes the claimed "different electronic device." Further, Lau's Figure 13 illustrates software operating on a personal computer that allows a prospective user to create playlists, add or remove tracks from the playlist, and configure the music server accordingly. Col. 12, l. 64-col. 13, l. 1. As such, we find that Lau teaches the claimed "personal computer." Therefore, contrary to Appellant's argument, Lau is directed to a three-device system—(1) a personal computer that connects to (2) the music server, which in turn connects to (3) an automobile audio system via a head unit—similar to the three-device system required by claims 1 and 11.

Fifth, Appellant contends that even if Lau, Naim, and Lee were combined, the functionality of the combined system is performed in the wrong device. App. Br. at 15. That is, Appellant argues that the claimed functionalities of "maintain[ing] an updatable user interface" and "modify[ing] the updatable user interface" are performed by the claimed "portable audio file player" and not the Lau's music server or Graphical User Interface ("GUI") 1200. App. Br. at 15-16. We do not agree with Appellant.

Lau discloses that the technology for creating and updating playlists on a personal computer is capable of being implemented on the music server. Col. 18, ll. 12-18. Based on that disclosure, and in light of our analysis above, we conclude that an ordinarily skilled artisan would have understood that Lau's music server and corresponding head unit are capable of maintaining menus of song titles and artists, and modifying such menus in connection with receiving playlists from Lau's personal computer. Therefore, Lau's music server and corresponding head

unit perform the claimed functionalities of “maintain[ing] an updatable user interface” and “modify[ing] the updatable user interface.”

Alternatively, we conclude that an ordinarily skilled artisan would have appreciated that Naim’s on-board display incorporated within Lau’s music server is also capable of maintaining menus of song titles and artists, and modifying such menus in connection with receiving playlists from Lau’s personal computer. Therefore, we conclude that an ordinarily skilled artisan would have recognized that Naim’s on-board display incorporated within Lau’s music server also performs the claimed functionalities of “maintain[ing] an updatable user interface” and “modify[ing] the updatable user interface.”

For the foregoing reasons, we are not persuaded of error in the Examiner’s rejection of claims 1 and 11 under 35 U.S.C. § 103(a) over the combination of Lau, Naim, and Lee , or in the obviousness rejections based in whole or in part on Lau, Naim, and Lee over claims 2-10 and 12-37, which are not separately argued. App. Br. at 16-17. *See* 37 C.F.R. § 41.67(c)(1)(vii).

D. Secondary Considerations of Nonobviousness—Commercial Success

We are not persuaded by Appellant’s argument that the White Declaration provides objective evidence of nonobviousness because the “ecosystem” provided by Apple iTunes and iPod environment is commercially successful. App. Br. at 29-30. When commercial success is asserted to support nonobviousness, there must be a nexus (i.e., a legally and factually sufficient relationship) between the commercial success and the claimed invention. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). Such evidence, however, “must be commensurate in scope with the claims which the evidence is offered to support.” *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971).

The White Declaration falls short of establishing the required nexus in several respects. First, the Declaration fails to establish that the commercial success of Apple’s “ecosystem” is directly attributable or even infringes claims 1 and 11 in the ‘926 patent. Even assuming, as Mr. White asserts, that Apple’s ecosystem is covered by the scope of the claims 1 and 11 in the ‘926 patent, there is insufficient evidence on the record that Apple’s commercial success is based on the claim limitations explicitly recited in claim 1 and similarly recited in claim 11—namely (1) “a personal computer;” (2) “a portable audio file;” and (3) “a different electronic device.” Second, we note that Mr. White does not discuss any advertising, promotion, or other factors that may contribute to the commercial success of Apple’s “ecosystem.” For instance, Mr. White references Exhibit K in the Declaration at ¶ 13. Exhibit K is a magazine article that attributes the commercial success of Apple’s ecosystem at least in part to “striking new deals with copyright holders and leveraging the tight integration with iTunes.” Exhibit K at 2. Based on the totality of the record before us, we conclude that the objective evidence of nonobviousness presented by Appellant does not outweigh the evidence of obviousness relied upon by the Examiner. Therefore, we will sustain the obviousness rejections of claims 1-37 discussed above.

E. Remaining Obviousness Rejections

Our affirmance of the obviousness rejections of claims 1-10 and 21-27 based in whole or in part on Rio 500 and Kumar, and claims 1-37 based in whole or in part on Lau, Naim, and Lee, renders it unnecessary to reach the Examiner’s obviousness rejections of the same claims on a different basis. *Cf. In re Gleave*, 560 F.3d at 1338 (not reaching other rejections after affirming an anticipation

rejection). Therefore, we do not reach the merits of the remaining obviousness rejections of claims 1-37 adopted, adopted-in-part, or maintained by the Examiner.

III. CONCLUSIONS

The Examiner did not err in adopting, adopting-in-part, or maintaining the rejection of claims 1-10 and 21-27 under 35 U.S.C. § 103(a) based in whole or in part on Rio 500 and Kumar. The Examiner did not err in adopting, adopting-in-part, or maintaining the rejection of claims 1-37 under 35 U.S.C. § 103(a) based in whole or in part on Lau, Naim, and Lee.

IV. DECISION

The Examiner's decision to adopt, adopt-in-part, or maintain the obviousness rejections of claims 1-37 of the '926 patent is affirmed.

Requests for extensions of time in *inter partes* reexamination proceedings are governed by 37 C.F.R. § 1.956. *See also* 37 C.F.R. § 41.79(e) ("The times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.").

AFFIRMED

Appeal 2012-010420
Reexamination Control 95/001,263
U.S. Patent No. 7,486,926 B2

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263
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U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	5724407		1998-03-03	Bruno et al.	
	2	5918013		1999-06-29	Mighdoll et al.	
	3	5953506		1999-09-14	Kalra et al.	
	4	5966714		1999-10-12	Huang et al.	
	5	6035339		2000-03-07	Agraharam et al.	
	6	6072598		2000-06-06	Tso	
	7	6073168		2000-06-06	Mighdoll et al.	
	8	6185625		2001-02-06	Tso et al.	

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**
(Not for submission under 37 CFR 1.99)

Application Number	95001263
Filing Date	2009-11-13
First Named Inventor	Russell W. White
Art Unit	3992
Examiner Name	LAROSE, COLIN M
Attorney Docket Number	AFF.004B6US

9	6262978		2001-06-17	Bruno et al.	
10	6311215		2001-10-30	Bakshi et al.	
11	6484212		2002-11-19	Markowitz et al.	
12	6804825		2004-10-12	White et al.	
13	6892226		2005-05-10	Tso et al.	
14	6957260		2005-10-18	Mighdoll et al.	
15	5978567		1999-11-02	Rebane, et al.	
16	6012100		2000-01-04	Frailong, et al.	
17	6292834		2001-09-18	Ravi, et al.	

If you wish to add additional U.S. Patent citation information please click the Add button.

U.S.PATENT APPLICATION PUBLICATIONS

Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White		
	Art Unit		3992	
	Examiner Name	LAROSE, COLIN M		
	Attorney Docket Number	AFF.004B6US		

1							
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If you wish to add additional U.S. Published Application citation information please click the Add button.

FOREIGN PATENT DOCUMENTS

Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							<input type="checkbox"/>

If you wish to add additional Foreign Patent Document citation information please click the Add button

NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1		<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature	Date Considered	
--------------------	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95001263
	Filing Date	2009-11-13
	First Named Inventor	Russell W. White
	Art Unit	3992
	Examiner Name	LAROSE, COLIN M
	Attorney Docket Number	AFF.004B6US

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

None

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Mark J. Rozman/	Date (YYYY-MM-DD)	2012-10-04
Name/Print	Mark J. Rozman	Registration Number	42117

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§	Examiner:	Colin M. LaRose
Filed:	November 13, 2009	§		
		§		
For:	Content Delivery System And Method	§	Atty. Dkt. No.:	AFF.004B6US
		§		

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ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF SERVICE

I hereby certify that a copy of the Information Disclosure Statement filed with the USPTO via EFS on October 3, 2012 has been sent by first class mail to the following attorney of record for third party requester as provided for in 37 C.F.R. §1.248(a):

NOVAK DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd
Houston, TX 77002

Respectfully submitted,

Date: October 4, 2012

/Mark J. Rozman/
Mark J. Rozman
Registration No. 42,117
TROP, PRUNER & HU, P.C.
1616 S. Voss Road, Suite 750
Houston, Texas 77057-2631
(512) 418-9944 [Phone]
(713) 468-8883 [Fax]
Customer No.: 21906

Electronic Acknowledgement Receipt

EFS ID:	13904345
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	Mark J. Rozman/Stephanie Petreas
Filer Authorized By:	Mark J. Rozman
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	04-OCT-2012
Filing Date:	13-NOV-2009
Time Stamp:	13:04:22
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Information Disclosure Statement (IDS) Form (SB08)	AFF004B6IDSToFile.pdf	71929 <small>c2784427c7d8e3748e5817fa44f455684f912c62</small>	no	5

Warnings:

Information:

Samsung Ex. 1321 p. 89

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2	Reexam Certificate of Service	AFF004B6USCOS.pdf	6785	no	1
			eef896505f7de66320da3789d26e76f7e655b9cd		

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Total Files Size (in bytes): 78714

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White		
	Art Unit		3992	
	Examiner Name	Colin M. LaRose		
	Attorney Docket Number		AFF.004B6US	

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	6681120		2004-01-20	Kim	
	2	7610597		2009-10-27	Johnson, et al.	

If you wish to add additional U.S. Patent citation information please click the Add button.

U.S.PATENT APPLICATION PUBLICATIONS						
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	20020112078		2002-08-15	Yach	

If you wish to add additional U.S. Published Application citation information please click the Add button.

FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							<input type="checkbox"/>

If you wish to add additional Foreign Patent Document citation information please click the Add button

NON-PATENT LITERATURE DOCUMENTS								
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95001263
	Filing Date	2009-11-13
	First Named Inventor	Russell W. White
	Art Unit	3992
	Examiner Name	Colin M. LaRose
	Attorney Docket Number	AFF.004B6US

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1		<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature	Date Considered
--------------------	-----------------

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95001263
	Filing Date	2009-11-13
	First Named Inventor	Russell W. White
	Art Unit	3992
	Examiner Name	Colin M. LaRose
	Attorney Docket Number	AFF.004B6US

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

- See attached certification statement.
- Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.
- None

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Mark J. Rozman/	Date (YYYY-MM-DD)	2012-08-28
Name/Print	Mark J. Rozman	Registration Number	42117

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
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8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§	Examiner:	Colin M. LaRose
Filed:	November 13, 2009	§		
		§		
For:	Content Delivery System And Method	§	Atty. Dkt. No.:	AFF.004B6US
		§		

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ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF SERVICE

I hereby certify that a copy of the Information Disclosure Statement filed with the USPTO via EFS on August 28, 2012 has been sent by first class mail to the following attorney of record for third party requester as provided for in 37 C.F.R. §1.248(a):

NOVAK DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd
Houston, TX 77002

Respectfully submitted,

Date: August 28, 2012

/Mark J. Rozman/
Mark J. Rozman
Registration No. 42,117
TROP, PRUNER & HU, P.C.
1616 S. Voss Road, Suite 750
Houston, Texas 77057-2631
(512) 418-9944 [Phone]
(713) 468-8883 [Fax]
Customer No.: 21906

Electronic Acknowledgement Receipt

EFS ID:	13604068
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	Mark J. Rozman/Stephanie Petreas
Filer Authorized By:	Mark J. Rozman
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	28-AUG-2012
Filing Date:	13-NOV-2009
Time Stamp:	13:06:55
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Information Disclosure Statement (IDS) Form (SB08)	AFF004B6IDSToFile.pdf	67132 a35eba876541087215b681ba467cdc55525a39ba	no	4

Warnings:

Information:

Samsung Ex. 1321 p. 96

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2	Reexam Certificate of Service	AFF004B6COSforIDS.pdf	6572	no	1
			cfaf18b6c324576ff56b1e1bf0fc226c1c310177		

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Information:

Total Files Size (in bytes): 73704

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



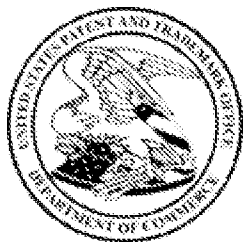
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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,263	11/13/2009	7486926	AFF.0004B6US	6721
21906	7590	07/19/2012	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			LAROSE, COLIN M	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			07/19/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



United States Patent and Trademark Office

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

Appeal No: 2012-010420
Inter Partes Reexamination Control No: 95/001,263
Appellant: Russell W. White, et al.

Board of Patent Appeals and Interferences Docketing Notice

Inter Partes Reexamination Control No. 95/001,263 was received from the Technology Center at the Board on July 18, 2012 and has been assigned Appeal No: 2012-010420.

In all future communications regarding this appeal, please include both the *Inter Partes* Reexamination Control Number and the appeal number.

The mailing address for the Board is:

BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

The facsimile number of the Board is 571-273-0052. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 571-272-9797 and referencing the appeal number listed above.

By order of the Board of Patent Appeals and Interferences.

cc: Third Party Requester

NOVAK DRUCE & QUIGG, LLC
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,263	11/13/2009	7486926	AFF.0004B6US	6721
21906	7590	05/15/2012	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			LAROSE, COLIN M	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			05/15/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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NOVAK DRUCE & QUIGG, LLC
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED
MAY 15 2012
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001263
PATENT NO. : 7486926
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No.	Patent Under Reexamination
	95/001,263	7486926
	Examiner	Art Unit
	COLIN LAROSE	3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Inter Partes Reexamination Examiner's Answer	Application No.	Applicant(s)	
	95/001,263	7486926	
	Examiner	Art Unit	
	COLIN LAROSE	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Incorporation by Reference of the Right of Appeal Notice

The Right of Appeal Notice (RAN) mailed on 12/6/2011, including all of the grounds of rejection, determinations of patentability, and explanations set forth in the RAN is incorporated by reference. Every ground of rejection and every determination not to make a proposed rejection set forth in the RAN are being maintained by the examiner.

This examiner's answer does not contain any new ground of rejection and any new determination not to make a proposed rejection.

Status of Amendment After Action Closing Prosecution

The amendment(s) filed on _____ has/have been entered.
The amendment(s) filed on _____ has/have not been entered.

Period for providing a Rebuttal Brief

Appellant(s) is/are given a period of ONE MONTH from the mailing date of this examiner's answer within which to file a rebuttal brief in response to the examiner's answer. Prosecution otherwise remains closed.

The rebuttal brief of the patent owner may be directed to the examiner's answer and/or any respondent's brief. The rebuttal brief of the third party requester(s) may be directed to the examiner's answer and/or the respondent's brief of the patent owner. The rebuttal brief must (1) clearly identify each issue, and (2) point out *where* the issue was raised in the examiner's answer and/or in the respondent's brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in the respondent's brief. The time for filing the rebuttal brief may not be extended. No further submission (other than the rebuttal brief(s)) will be considered, and any such submission will be treated in accordance with 37 CFR 1.939 and MPEP 2667.

- Attachment(s)
SB/08
- Other:
No respondent brief from the Requester has been received.

/Fred Ferris/


All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at one of the following addresses:

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Please FAX any communications to: (571) 273-9900

/Colin LaRose/
CRU
A.U. 3992

ANDREW J. FISCHER 
Supervisory Patent Reexamination Specialist
CRU -- Art Unit 3992

Receipt date: 08/10/2011

95001263 - GAI: 3992

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White, et al.		
	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	6526335			Treyz, et al.	
	2	6314094			Boys	
	3	6192340			Abecassis	
	4	7123936			Rydbeck	

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U.S.PATENT APPLICATION PUBLICATIONS

Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
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FOREIGN PATENT DOCUMENTS

Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T ⁵

Receipt date: 08/10/2011 INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	95001263 - GAU: 3992
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White, et al.		
	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

1	WO 0060450	WO		2000-10-12	Kumar	<input type="checkbox"/>
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NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1	VAN ZOEST, ALEXANDER, ET AL., "System and Method for Enabling Global Access and Instantaneous Listening to Digital Audio," U.S. Provisional Application No. 60/175,159, filed Jan. 7, 2000, 54 pages.	<input type="checkbox"/>
	2	ROLF, DEVON A., "System, Method, and Device For Playing Recorded Music on a Wireless Communications Device," U.S. Provisional Application No. 60/167,179, filed Nov. 23, 1999, 50 pages.	<input type="checkbox"/>
	3	CREATIVE TECHNOLOGY, LTD., "Creative NOMAD II, Getting Started," 1999, 2000, 38 pages.	<input type="checkbox"/>
	4	DIAMOND MULTIMEDIA SYSTEMS, LTD., "Rio 500 Getting Started Guide for Windows 98 and Macintosh OS 8.6," 1999, 2 pages.	<input type="checkbox"/>
	5	NOKIA MOBILE PHONES, "Application Guide," 1999-2000, 76 pages.	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature	/Colin LaRose/	Date Considered	08/16/2011
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¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

Receipt date: 02/09/2012

95001263 - GAI-3992

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

Approved for use through 07/31/2012. OMB 0651-0031

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	
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	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

U.S.PATENTS

Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	6647257		2003-11-11	Owensby	
	2	7376586		2008-05-20	Partovi et al.	

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U.S.PATENT APPLICATION PUBLICATIONS

Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	20020174013		2002-11-21	Freeman et al.	

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FOREIGN PATENT DOCUMENTS

Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²ⁱ	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							<input type="checkbox"/>

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NON-PATENT LITERATURE DOCUMENTS

Receipt date: 02/09/2012 INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	95001263 - GAU: 3992
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White, et al.		
	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1		<input type="checkbox"/>

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EXAMINER SIGNATURE

Examiner Signature	/Colin LaRose/	Date Considered	05/09/2012
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§		
Filed:	November 13, 2009	§	Examiner:	Colin M. LaRose
		§		
For:	Content Delivery System And Method	§	Atty. Dkt. No.:	AFF.004B6US
		§		

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Alexandria, VA 22313-1450

Certificate Under 37 C.F.R. §1.943(C)

The undersigned certifies that the brief does not exceed 14000 words in length, excluding appendices and reference materials, as set forth in 37 C.F.R. §1.943(C).

Respectfully submitted,

Date: March 5, 2012

/Mark J. Rozman/
Mark J. Rozman
Registration No. 42,117
TROP, PRUNER & HU, P.C.
1616 S. Voss Road, Suite 750
Houston, Texas 77057-2631
(512) 418-9944 [Phone]
(713) 468-8883 [Fax]
Customer No.: 21906

Date of Deposit: <u>March 5, 2012</u> I hereby certify under 37 CFR § 1.8 this correspondence is being deposited via EFS on the date indicated above. <u>/Stephanie Petreas/</u> Stephanie Petreas

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§	Examiner:	Colin M. LaRose
Filed:	November 13, 2009	§		
		§		
For:	Content Delivery System And Method	§	Atty. Dkt. No.:	AFF.004B6US
		§		

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Alexandria, VA 22313-1450

CERTIFICATE OF SERVICE

I hereby certify that a copy of the Certificate Under 37 C.F.R. §1.943(C) filed with the USPTO via EFS on March 5, 2012 has been sent by first class mail to the following attorney of record for third party requester as provided for in 37 C.F.R. §1.248(a):

NOVAK DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd
Houston, TX 77002

Respectfully submitted,

Date: March 5, 2012

/Mark J. Rozman/
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(713) 468-8883 [Fax]
Customer No.: 21906

EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Confirmation No.:	6721
		§		
Reexamination Control No.:	95/001,263	§	Examiner:	Colin M. LaRose
		§		
Filed:	November 1, 2009	§	Art Unit:	3992
		§		
For:	U.S. Patent No. 7,486,926	§	Atty. Dkt. No.:	AFF.004B6US

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Alexandria, VA 22313-1450

DECLARATION OF RUSSELL W. WHITE UNDER 37 C.F.R. §1.132

I, Russell W. White, hereby declare:

1. I am the first named inventor of U.S. Patent No. 7,486,926 (the '926 Patent) and additional related patents. I suffer from no disability that would disqualify me from testifying under oath. I am a Founder and Vice President of Affinity Labs of Texas, LLC, the assignee of the '926 Patent. This Declaration is made on my own personal knowledge and is submitted in conjunction with Affinity's Response to the Inter Partes Reexamination Office Action dated July 9, 2010.

2. I have been interested in technology and innovation for over 25 years. I am a named inventor on 17 issued patents – ten of which are owned by Affinity Labs and seven of which are owned by AT&T. The AT&T owned patents range from mechanical systems for tracing in-service phone lines to next generation network architectures for greatly expanding video delivery and bandwidth to the home. I began writing simple software programs and working with computers in grade school. In junior high school, I developed a simple software

application that was used by the school library to track the check out and return of books. My continued focus on technology, math, and science helped me earn a full academic scholarship to study engineering at Texas A&M University, where I received a degree in Mechanical Engineering. I then spent four years working full-time as an engineer for the Lincoln Electric Company. During this time, I put myself through law school at night at Temple University.

3. I am now an attorney licensed to practice in the State of Texas and a licensed member of the United States Patent Bar. My registration number is 45,691.

4. It is my understanding that objective evidence of non-obviousness can include any one of several things, such as commercial success, long-felt need, and failure of others. Based on the factual evidence presented below, at least commercial success of the invention is shown along with a clear and sufficient nexus between this commercial success and the merits of the claimed invention. The following facts establish that the claims of the '926 Patent are not obvious and were properly allowed by Examiner Jean Gelin.

EVIDENCE OF COMMERCIAL SUCCESS

5. At Affinity Labs, we create innovations to transfer or license to other companies capable of manufacturing, marketing, distributing, etc. We do not have the people or the capital to conceive, build, and market products and services; so, we often conceive for others – allowing those “others” to build and market our inventions. As explained on the Affinity Labs website, one of our business models is to provide product development services. In doing so, we “make our own developments available to existing companies and entrepreneurs. When offering our own developments to others, we are looking to foster new business creation within a client company or to enhance an existing business line of a client company.” The companies that

actually make and sell our inventions are not owned and controlled by Affinity, which is why revenue numbers generated from the sale of our inventions are reported as income to organizations other than Affinity Labs. With that said, Affinity does receive royalty payments from companies who have been given the right to make and sale our inventions. See portions of Affinity Labs website attached as Exhibit A.

6. Occasionally, companies correspond with Affinity Labs, learn about our patented inventions, and choose to knowingly infringe Affinity Labs' patents by making and selling our inventions without the legal right to do so. Apple is one such company. As a result, Affinity Labs has filed a lawsuit against Apple, claiming infringement of the '926 Patent and other patents related to the '926 Patent. Although originally filed in the Eastern District of Texas, the lawsuit is now pending in the Northern District of California, Oakland Division. In light of the many communications between Affinity and Apple, Affinity has asserted that Apple's infringement is willful. See Sample Correspondence attached as Exhibit B and Complaint attached as Exhibit C.

7. In accordance with the scheduling order in the Oakland case (attached as Exhibit D), Affinity has served preliminary infringement contentions on Apple. A copy of the infringement contentions for the '926 Patent are attached hereto as Exhibit E. As seen, Apple is contended to infringe at least claims 1-6, 8, and 10-20 of the '926 Patent.

8. I have independently performed a thorough analysis of various portions of Apple's multimedia ecosystem (a slide depicting the ecosystem is attached as Slide 9 of the Presentation attached as Exhibit F). My review focused on the iTunes system and software, the iPhone and iPod devices and software, iPod-ready secondary devices (e.g., car stereos), and the interplay between these component parts. I have compared this ecosystem against claims in the

'926 Patent. I concur with the Infringement Contentions and Associated Chart attached as Exhibit G, and I agree that Apple's multimedia ecosystem practices at least Claims 1-6, 8, and 10-20 of the '926 Patent.

9. As shown in Exhibits E and G, the iTunes client application is a software application that is stored on a personal computer (as recited, for example, in independent claims 1 and 11 of the '926 Patent). As further detailed in the Exhibits, the iTunes application downloads songs, creates playlists, requests other audio files from the iTunes Store, presents a GUI and so forth. The iTunes Store, with which the iTunes application works, embodies and is coextensive with the network based resource as claimed in the '926 Patent. Similarly, the iPod (as implemented in Apple's iPod classic, iPod nano, iPod touch, and iPhone) is a portable audio file player with a processor, a display, a memory and software that maintains a user interface and modifies the user interface in connection with receiving a new song from iTunes. In addition, each of the Apple iPod devices is specifically designed to seamlessly integrate with other systems (e.g., car stereos) (see portions of Apple website attached as Exhibit H). For example, a driver can see an icon on the car stereo display and can "tell" the iPod to begin playing a song by selecting the icon. Thus, the iTunes software and Store in combination with an iPod device (i.e., the Apple multimedia ecosystem) is co-extensive with the elements of claim 1 and 11 (and various dependent claims as shown in Exhibit G).

10. In light of the preceding paragraphs and the exhibits, the Apple multimedia ecosystem and its commercial success (highlighted in the remaining paragraphs) establish the commercial success of the '926 Patent claims that are practiced by the ecosystem. Those practiced claims are, at least, claims 1-6, 8, and 10-20. In addition, a direct nexus between the claimed features and this commercial success exists, as evidenced by the many commentators

who describe that Apple's huge market share lead in this space is due to the combination and interaction of the claimed features.

11. On or about October 23, 2001, Rob Malda, the Founder of the Slashdot website, introduced the very first iPod with the following statement: "No wireless. Less space than a nomad. Lame." Despite this less than flattering introduction, the iPod now holds approximately 75% of the market for digital music players. See Exhibit H(<http://apple.slashdot.org/article.pl?sid=01/10/23/1816257>) and Exhibit I(http://www.ondisruption.com/photos/uncategorized/ipod_market_share.jpg).

12. I have reviewed various published reports explaining that the criticisms of the iPod (like those of Mr. Malda) focused "on the shortcomings of the device." The iPod was and remains successful because of "the power of the ecosystem that Apple managed to put together. Or as is often said, the power of the whole was greater than the sum of its parts." See Exhibit J(<http://www.isights.org/2007/11/no-wireless-les.html>).

13. In other words, "the iPod's integration with the iTunes music application and the iTunes Music Store has made the device a favorite among music listeners" and the "iPod is a single component of Apple's larger music platform. The hub of the platform is the iTunes desktop digital music player." In sum, "Apple released the iPod [in 2001]. The device differed from other portable digital music players because of the tight integration with iTunes." See Exhibit K(<http://www.freesoftwaremagazine.com/articles/itunes?page=0%2C0>).

14. I have reviewed and used the Apple multimedia ecosystem for several years. I concur with the viewpoints quoted in the preceding paragraph. I am unaware of additional and unclaimed features that account for the ecosystem's success relative to Apple competitors. For

example, other brands of portable MP3 players have similar form factors, have similar displays, have similar input mechanisms, have similar audio performance, have similar storage capacity, and have similar marketing campaigns. The iPod was not the first MP3 player, but it now controls 75% of the market (as seen in Exhibit I, above).

15. In an article dated September 13, 2006, a research note from Needham and Co. analyst Charles Wolf explained that: "software has been the secret sauce of Apple's success in conquering the legal online music market where it has an 88 percent share in the U.S." Mr. Wolf went on to state: "In our opinion, iTunes represents the greatest barrier to competitors ever catching up with Apple's multimedia ecosystem." (emphasis added) See iTunes article attached as Exhibit L.

16. Thus, the commercial success of this ecosystem has been tied to, and is co-extensive with the claimed elements of at least the independent claims. This commercial success is staggering, and is described in the following paragraphs.

17. According to recent published reports, Apple has used the Apple multimedia ecosystem to sell over 270 million iPods to date. Assuming the average iPod sold for \$200, Apple has used its multimedia ecosystem to generate over \$54 billion in revenue. See Exhibit M(<http://www.huliq.com/10180/apple-sold-270-million-ipods>).

18. According to a 2006 study of over 5000 Apple ecosystem users, the average ecosystem user had purchased 72 songs from iTunes at approximately \$1 per song. Extrapolating the study results suggests that Apple has made approximately \$19.5 billion in revenue from song sales with the claimed invention. This nearly \$20 billion is in addition to the \$54 billion made selling iPods – suggesting that Apple has made almost \$75 billion from the claimed invention. See Exhibit N(http://blogs.sun.com/plamere/entry/what_s_on_your_ipod).

19. In an Apple press release dated April 3, 2008, Apple's Vice President of iTunes, Eddy Cue, stated: "We launched iTunes less than five years ago, and it has now become the number one music retailer in the world." See Exhibit O(<http://www.apple.com/pr/library/2008/04/03itunes.html>).

20. On or about February 25, 2010, Apple's multimedia ecosystem downloaded its 10 billionth song since launching. See Exhibit P(<http://www.apple.com/itunes/10-billion-song-countdown/>).

21. According to published numbers, the Apple multimedia system now downloads one billion songs every 100 or so days – that is to say Apple's multimedia ecosystem downloads approximately 10 million songs a day. See Exhibit Q(http://en.wikipedia.org/wiki/File:ITunes_Store_Songs_Sales.jpg).

22. According to recently published reports, Apple CEO Steve Jobs provided additional information about the Apple multimedia ecosystem and its remarkable commercial success: "People have downloaded over 11.7 billion songs from iTunes, and we're just about to cross 12b. Over 450 million TV episodes, 100 million movies, 35 million books, and over 160 million accounts with credit cards and 1-click shopping in 23 countries" says Steve Jobs. See Exhibit R(<http://www.huliq.com/10180/apple-sold-270-million-ipods>).

23. According to CNET columnist, Greg Sandoval (citing a report from the NPD Group), Apple multimedia ecosystem accounted for 28 percent of all music purchased by U.S. consumers in the first quarter of 2010. See Exhibit S(<http://www.cnn.com/2010/TECH/biztech/05/27/cnet.itunes.apple/index.html>).

24. According to ARS Technica columnist Justin Berka (citing Billboard analysis) media sales from the Apple multimedia ecosystem brought in \$570 million in gross profit for

Apple in 2007. Exhibit T(<http://arstechnica.com/apple/news/2008/03/billboard-looks-at-the-profitability-of-itunes.ars>).

25. The objective evidence of non-obviousness detailed above and in the exhibits shows, at a minimum, the commercial success of the claimed inventions (as practiced by the Apple multimedia ecosystem). As provided, a clear nexus has been established between the merits of the claims and this objective evidence of commercial success. For at least these reasons, the claims of the '926 Patent are not obvious.

I declare under penalty of perjury under the laws of the United States of America that the following is true and correct.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date:

9/5/10



Russell W. White, V.P., Affinity Labs of Texas, LLC

EXHIBIT A



HOME

Unlock your future—let us provide the key.

ABOUT US

Affinity Labs is an innovation company. We believe innovation can be the key to your future.

SERVICES

Many executives know that product and service innovation can be a top driver of company success. They do not, however, know how to innovate.

PROJECTS

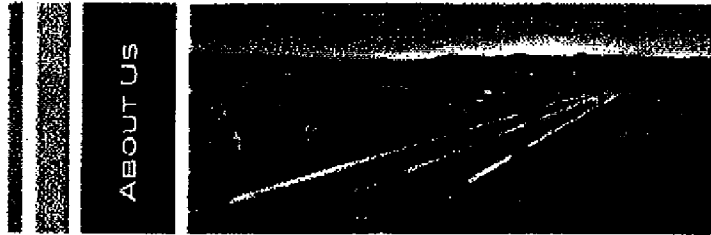
Affinity Labs is an innovation company. We generate new product and business ideas and consult on intellectual property matters to help protect those ideas. And while we love the role of innovator, our most valuable service may lie in fostering the innovation skills of others.

NEWS

We are creative, timely, cost effective, and flexible. We provide the innovation. We provide the key.

CONTACT US

If you would like more information about our work and how we can help you, contact us at 512-241-1985 or email us at contact@afflabstx.com.



- HOME
- ABOUT US
- SERVICES
- PROJECTS
- NEWS
- CONTACT US



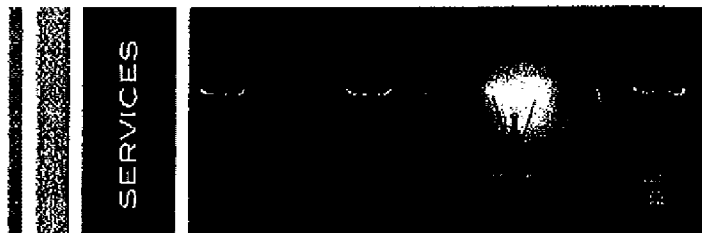
Russell W. White, J.D.

For the past decade, Mr. White has focused on innovation. He's been a prolific inventor, a patent attorney, a partner in a prominent law firm, and an adjunct professor at the University of Texas School of Law. He's spent countless hours teaching people and companies to innovate and co-founded SBC Knowledge Ventures, an entity within AT&T that was committed to developing and commercializing innovation. He can help make Affinity Labs your key to successful innovation.



Harlie D. Frost, J.D.

Mr. Frost was an intellectual property, business organization, and tax attorney. He was the long time Vice-President and General Counsel of AT&T Labs and was a cofounder and first president of SBC Knowledge Ventures. With over twenty five years of experience in commercializing intellectual property, Mr. Frost has successfully implemented and refined the techniques and practices that can make Affinity Labs your key to successful innovation.



HOME

Affinity Labs® Product Development Services

ABOUT US

Affinity Labs of Texas provides product development services in several different ways. We frequently make our own developments available to existing companies and entrepreneurs. [Click here to read more about our Product Development Services.](#)

SERVICES

PROJECTS

Affinity Labs® Intellectual Property Consulting Services

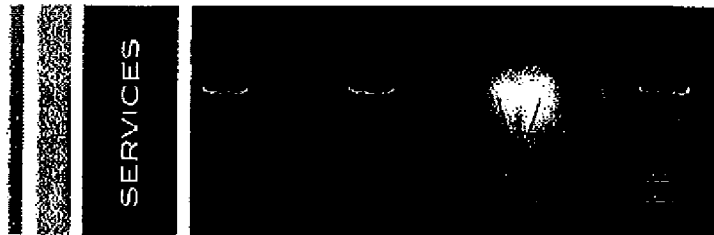
NEWS

Affinity Labs is committed to helping others develop, use, and protect intellectual property. [Click here to read more about our Intellectual Property Consulting Services.](#)

CONTACT US

Affinity Labs® Intellectual Property Licensing

Affinity Labs has a growing portfolio available for licensing. [Click here to read more about our Intellectual Property Licensing.](#)



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Affinity Labs® Product Development Services

Affinity Labs of Texas provides product development services in several different ways. We frequently make our own developments available to existing companies and entrepreneurs. When offering our own developments to others, we are looking to foster new business creation within a client company or to enhance an existing business line of a client company. We can also "start from scratch" and provide product development services for hire.

Affinity Labs seeks to develop practical solutions that solve real world problems or address unmet needs. Our ideas are typically refined and developed into protectable intellectual properties for sale or lease. We want interested entrepreneurs or existing businesses to take our ideas and create or expand their own businesses. To help make this happen, we make ourselves available for business consultation and technical assistance.

Our goal is to create new opportunities with the attendant new jobs and community growth. In certain circumstances, we are also willing to license our intellectual property for a fixed or running royalty.

[<< Back to Services.](#)



HOME

Affinity Labs is constantly exploring projects and opportunities. Some of its recent projects include:

ABOUT US

Affinity Labs Digital Media project

This project involves improved techniques for interacting with digital media. Our innovations make digital media much more accessible, flexible, and enjoyable.

SERVICES

PROJECTS

Affinity Labs Sport+Music project

This project involves using digital media to improve athletic activities. The project makes developing and tracking your work outs much simpler and more enjoyable.

NEWS

CONTACT US

Affinity Labs Roof Rack project

This project is aimed at making the process of loading objects, primarily sports related, onto roof racks easier at lower costs.

« Older



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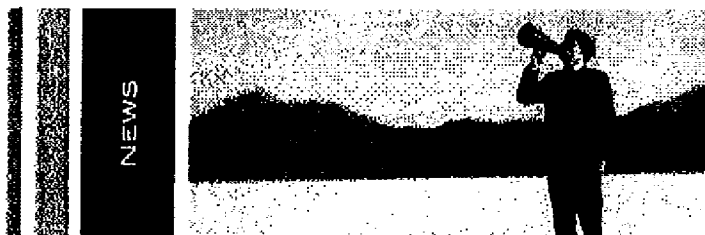
NEWS

CONTACT US

Affinity Labs Digital Media project

This project involves improved techniques for interacting with digital media. Our innovations make digital media much more accessible, flexible, and enjoyable. We are expanding our portfolio in this area. Entrepreneurs and entrepreneurial business organizations may capitalize on some of the business opportunities that result from these innovations.

[« Go Back](#)



HOME

Affinity Labs and jWin Electronics Corp.

ABOUT US

Affinity Labs and jWin Electronics Corp. enter into an innovation and licensing agreement related to the Affinity Labs Digital Media project effective January 1, 2009.

SERVICES

Affinity Labs and Alpine Electronics

PROJECTS

Alpine Electronics of America, Inc. and Alpine Electronics, Inc. join others by contracting with Affinity Labs to make use of the Affinity Labs Digital Media project.

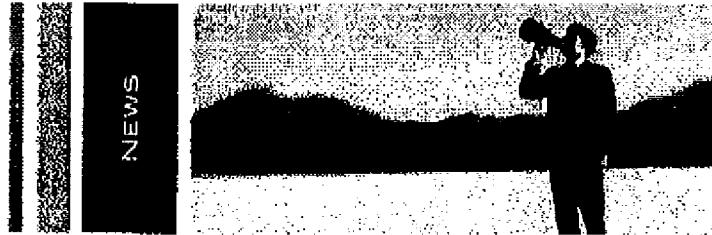
NEWS

Affinity Labs and Vais Technology

CONTACT US

Vais Technology, LTD enters into a license agreement for Affinity Labs of Texas U.S. patent number 7,324,833 effective March 17, 2009.

« Older



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More News . . .

ABOUT US

Affinity Labs and Fujitsu

Fujitsu Ten Limited and Fujitsu Ten Corp. of America reach agreement with Affinity Labs. The agreement is related to the Affinity Labs Digital Media project.

SERVICES

Affinity Labs and Pioneer Corporation

Pioneer Corporation enters into a license agreement for Affinity Labs of Texas U.S. patent numbers 7,187,947, 7,324,833, 7,440,772 and 7,486,926 and any related patents effective March 31, 2009.

PROJECTS

NEWS

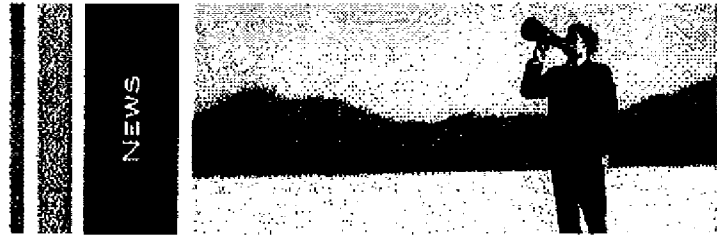
Affinity Labs and Dice Electronics

Dice Electronics, Inc. enters into a license agreement for Affinity Labs of Texas U.S. Patent number 7,324,833 effective April 2, 2009.

CONTACT US

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Newer »



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ABOUT US

Affinity Labs and Clarion

Affinity Labs enters into an agreement with Clarion Co. Ltd and Clarion Corporation of America. The agreement relates to the Affinity Labs Digital Media project and is effective April 28, 2009.

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EXHIBIT B



rwhite@AffLabs.com

June 14, 2006

Tony Fadell
Senior Vice President, iPod Division
Apple Computer, Inc.
1 Infinite Loop
Cupertino, CA 95014

Curtis S. Roberts
Vice President & General Manager
Timing, Vision & Tech Ventures
Nike, Inc.
One Bowerman Drive
Beaverton, OR 97005-6453

RE: Nike+iPod and U.S. Patent NO. 7,062,225

Dear Messrs. Fadell and Roberts:

Congratulations on the exciting launch of the "Nike+iPod" marriage. I have believed for a long time that the combination of sport and music represented a compelling business opportunity for the right companies. I suppose it should come as no surprise that Apple and Nike appear to be the "right companies."

My company, Affinity Labs, is a product and service development company. We originate and refine new ideas and protect these ideas with tactical intellectual property ("IP") portfolios.

We hope to be a good resource for companies like Apple and Nike. We work in the white space. We start from a blank sheet of paper, and we attempt to develop a given concept to a point at which larger companies can take the concept and run with it. Our goal is to eventually transfer our ideas along with their corresponding IP portfolios to companies like yours.

To that end, I write to let you know that Affinity Labs has developed an idea and a portfolio that track the "Nike+iPod" offering very closely, and carry the sport/music theme through additional offerings. I have enclosed a copy of United States Patent No. 7,062,225 for your review, along with the pending claims for the continuation applications on file with the Patent and Trademark Office that seek to cover other and broader aspects of the '225 Patent disclosure.

RE: Nike+iPod
June 14, 2006

I understand that your companies have already developed and launched one product. And, I assume that you are seeking IP protection on your own. With that said, the attached patent and pending applications may assist you in protecting the emerging sport and music market that you are pursuing.

Please, let me know if either of your companies has an interest in acquiring the '225 Patent and its continuations (the Portfolio). Likewise, please let me know if your companies have no interest in the Portfolio, as there are other organizations in your respective markets that I would approach. Thank you for your consideration and congratulations again on your exciting new marriage.

Warm regards,



Russell W. White

RWW/la

Encl. U.S. Patent No. 7,062,225
pending claims for '225 patent continuations



rwhite@AffLabs.com

March 6, 2007

Jayna R. Witt
Patent Counsel
Apple Computer, Inc.
1 Infinite Loop, M/S 3 - Pat
Cupertino, CA 95014

**RE: Nike+iPod and U.S. Patent No. 7,062,225 &
Apple iPhone and U.S. Patent No. 7,187,947**

Dear Ms Witt:

Thank you for responding to my letter of August 25, 2006. I apologize if my sending that letter to Dr. Alten was improper. I sent the letter in response to a telephone call from Dr. Alten, and I assumed he was the appointed contact person for Apple.

Apple infringes the '225 Patent:

Unless I have misinterpreted your letter, Apple contends that its products do not literally infringe the '225 Patent (a copy of which is included at Tab 1). More specifically, your letter states that Apple's products avoid literal infringement, because the products do not make use of the Bluetooth communication standard. With that said, it appears that your products do make use of Nordic Semiconductor components that function as short range wireless transceivers operating at or around 2.4 GHz – very much like Bluetooth (see teardown image included at Tab 2). Moreover, Apple's documentation indicates that the sensor and the receiver "link" with one another – very much like Bluetooth pairing (see example Apple Inc. document included at Tab 3).

In other words, it seems your current offerings do infringe the '225 Patent. Moreover, there are multiple pending *sport+music* applications with claims that are highly relevant to Apple and the burgeoning *sport+music* market.

Purchasing the *sport+music* Portfolio from Affinity Labs remains the most attractive option for your company.

Apple infringes the '947 Patent:

I am very proud to report that Affinity Labs recently received another patent from the United States Patent and Trademark Office – US Patent No. 7,187,947. The '947 Patent was filed in early 2000 and enjoys a remarkably rich specification. I have attached the '947 Patent at Tab 4. There are currently three pending continuation applications that claim priority to the '947 Patent with more to come. The '947 Patent and its continuations make up what we call the *digital content* Portfolio. Each of the assets in the Portfolio is relevant to Apple products and services.



I recently watched a video in which Mr. Steve Jobs introduced the iPhone. After reviewing the '947 Patent, I think you will agree that the iPhone (as described in the video) appears to directly and literally infringe several claims. We will know more about the infringement when the phone becomes publicly available.

Conclusion:

I do not pretend to know how Apple makes its IP-related business decisions. I do not even know if Apple respects the IP rights of others. I hope that it does.

I remain willing to sell the *sport+music* Portfolio outright. With regard to the *digital content* Portfolio, I am willing to discuss several different and creative business relationships between Apple and Affinity Labs.

As you may know, I have retained Roger Fulghum of Baker Botts to assist Affinity Labs with its IP matters. Mr. Fulghum and I will make ourselves available to meet at your facility during the second or third week of April. We are now at a crossroad, and I believe our best option is to meet and engage in good faith negotiations. Please, let me know if you are willing to meet and what days are good for your and your team.

Warm regards,

A handwritten signature in black ink, appearing to read "R. White".

Russell W. White

Enc.



April 5, 2007

Via Facsimile and U.S. Mail
512-439-7199

Russell W. White
Larson, Newman, Abel, Polansky & White, LLP
5914 West Courtyard Drive, Suite 200
Austin, TX 78730

Re: Affinity Labs Patents

Dear Mr. White:

I write in response to your letter of March 6, 2007. With respect to U.S. Patent No. 7,062,225, Apple does not believe the patent reads on the Nike + iPod Sport Kit either literally or under the doctrine of equivalents. During prosecution of the '225 patent, arguments were made to distinguish the type of wireless communication disclosed in the Chen reference from the Bluetooth limitation in the pending claims. Thus, prosecution history estoppel precludes coverage of wireless communication protocols other than Bluetooth. See, e.g., *Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1458 (Fed. Cir. 1998) (arguments made during prosecution may form the basis for prosecution history estoppel). Additionally, application of the doctrine of equivalents is precluded because it would vitiate the Bluetooth limitation altogether. See *Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1358-62 (Fed. Cir. 2005) (doctrine of equivalents unavailable where limitation would be written out of claim).

With respect to U.S. Patent No. 7,187,947, we do not believe that the iPhone will infringe the patent. However, to facilitate further review and help us understand your apparent conclusion to the contrary, please provide us with claim charts to explain how you believe the claims read on the iPhone.

Very truly yours,

Jayna R. Whitt
Patent Counsel

JRW:mib

Apple Inc.
1 Infinite Loop, MS 3-PAT
Cupertino, CA 95014
T (408) 974-4262
F (408) 974-5436
jwhitt@apple.com

TOTAL P.02

Samsung Ex. 1321 p. 134
AFLB0001012

EXHIBIT C

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
LUFKIN DIVISION

AFFINITY LABS OF TEXAS, LLC,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. _____
)	
APPLE, INC.,)	
)	
Defendant.)	
)	JURY TRIAL DEMANDED
)	
)	

COMPLAINT

Now comes Plaintiff Affinity Labs of Texas, LLC before this Court and alleges as its complaint and petition for relief against Defendant Apple, Inc. for infringement of U.S. Patent No. 7,187,947, U.S. Patent No. 7,440,772, and U.S. Patent No. 7,486,926 (collectively, the "Patents-in-Suit") as follows:

PARTIES

1. Plaintiff Affinity Labs of Texas, LLC ("Affinity") is a Texas limited liability corporation having offices at 3838 River Place Blvd., Austin, Texas 78730.
2. Upon information and belief, Defendant Apple, Inc. ("Apple") is a California corporation having its principal place of business located at 1 Infinite Loop, Cupertino, CA 95014.
3. Apple designs, manufactures, offers to sell, markets, and/or sells the iPod, iPod Touch and iPhone lines of consumer electronics products, mobile software applications, and

digital media content through retailers, Apple's website (www.apple.com) and its online music store which is accessible through the iTunes application and the iTunes mobile application.

JURISDICTION AND VENUE

4. These claims arise under the Patent Laws of the United States, 35 U.S.C. §101 *et seq.*, in that each is a claim for infringement of a United States patent. The jurisdiction of this Court is founded upon 28 U.S.C. §§ 1331 and 1338(a).

5. This Court has personal jurisdiction over Apple. Upon information and belief, Apple has transacted business in this judicial district and/or has committed, contributed to, and/or induced acts of patent infringement in this judicial district.

6. Venue within this District is proper under 28 U.S.C. §§ 1391(b) and (c) and 1400(b).

COUNT 1: PATENT INFRINGEMENT OF THE '947 PATENT

7. The allegations of paragraphs 1-6 are incorporated herein by reference.

8. Plaintiff Affinity is the sole owner by assignment of United States Patent No. 7,187,947 ("the '947 Patent"), which issued on March 6, 2007 and is entitled "System and Method for Communicating Selected Information to an Electronic Device." A copy of the '947 Patent is attached hereto as Exhibit A.

9. On or about March 6, 2007, Affinity placed Apple on notice of the '947 Patent and the pendency of additional related patent applications covering Apple's activities.

10. Upon information and belief, Apple has infringed and, if not enjoined, will continue to infringe one or more claims of the '947 Patent by performing, without authority, one or more of the following acts: (a) making, using, offering for sale, or selling within the United States hardware and software products that infringe one or more claims of the '947 Patent, in

violation of 35 U.S.C. § 271(a); (b) importing into the United States hardware and software products that infringe one or more claims of the '947 Patent, in violation of 35 U.S.C. § 271(a); (c) inducing infringement of one or more claims of the '947 Patent, in violation of 35 U.S.C. § 271(b); and/or (d) contributing to the infringement of one or more claims of the '947 Patent, in violation of 35 U.S.C. § 271(c) (the "acts of infringement of the '947 Patent").

11. Apple's acts of infringement of the '947 Patent include the manufacturing, using, marketing, offering for sale, and/or selling of the iPhone line of products and developing, maintaining, using, marketing, making available, offering to sell and selling software applications for the iPhone line of products through Apple's App Store mobile software application.

12. Upon information and belief, Apple's acts of infringement have been willful.

13. Upon information and belief, Apple will continue to infringe the '947 Patent unless enjoined by this Court.

14. As a result of Apple's infringement, Affinity has suffered and will suffer damages.

15. Affinity is entitled to recover from Apple the damages sustained by Affinity as a result of Apple's wrongful acts in an amount subject to proof at trial.

COUNT 2: PATENT INFRINGEMENT OF THE '772 PATENT

16. The allegations of paragraphs 1-15 are incorporated herein by reference.

17. Plaintiff Affinity is the sole owner by assignment of United States Patent No. 7,440,772 ("the '772 Patent"), which issued on October 21, 2008 and is entitled "Audio System and Method." A copy of the '772 Patent is attached hereto as Exhibit B.

18. Upon information and belief, Apple has infringed and, if not enjoined, will continue to infringe one or more claims of the '772 Patent by performing, without authority, one or more of the following acts: (a) making, using, offering for sale, or selling within the United States hardware and software products that infringe one or more claims of the '772 Patent, in violation of 35 U.S.C. § 271(a); (b) importing into the United States hardware and software products that infringe one or more claims of the '772 Patent, in violation of 35 U.S.C. § 271(a); (c) inducing infringement of one or more claims of the '772 Patent, in violation of 35 U.S.C. § 271(b); and/or (d) contributing to the infringement of one or more claims of the '772 Patent, in violation of 35 U.S.C. § 271(c) (the "acts of infringement of the '772 Patent").

19. Apple's acts of infringement of the '772 Patent include the manufacturing, using, marketing, offering for sale, and/or selling of the iPhone and iPod Touch line of products and developing, maintaining, using, marketing, making available, offering to sell and selling digital audio through the iTunes software application on a personal computer and through the iTunes mobile software application on the iPhone and iPod Touch line of products.

20. Upon information and belief, Apple's acts of infringement have been willful.

21. Upon information and belief, Apple will continue to infringe the '772 Patent unless enjoined by this Court.

22. As a result of Apple's infringement, Affinity has suffered and will suffer damages.

23. Affinity is entitled to recover from Apple the damages sustained by Affinity as a result of Apple's wrongful acts in an amount subject to proof at trial.

COUNT 3: PATENT INFRINGEMENT OF THE '926 PATENT

24. The allegations of paragraphs 1-23 are incorporated herein by reference.

25. Plaintiff Affinity is the sole owner by assignment of United States Patent No. 7,486,926 (“the ‘926 Patent”), which issued on February 3, 2009 and is entitled “Content Delivery System and Method.” A copy of the ‘926 Patent is attached hereto as Exhibit C.

26. Upon information and belief, Apple has infringed and, if not enjoined, will continue to infringe one or more claims of the ‘926 Patent by performing, without authority, one or more of the following acts: (a) making, using, offering for sale, or selling within the United States hardware and software products that infringe one or more claims of the ‘926 Patent, in violation of 35 U.S.C. § 271(a); (b) importing into the United States hardware and software products that infringe one or more claims of the ‘926 Patent, in violation of 35 U.S.C. § 271(a); (c) inducing infringement of one or more claims of the ‘926 Patent, in violation of 35 U.S.C. § 271(b); and/or (d) contributing to the infringement of one or more claims of the ‘926 Patent, in violation of 35 U.S.C. § 271(c) (the “acts of infringement of the ‘926 Patent”).

27. Apple’s acts of infringement of the ‘926 Patent include manufacturing, using, marketing, offering for sale, and/or selling of the iPod, iPhone and iPod Touch line of products that can be integrated with a separate sound system and developing, maintaining, using, marketing, making available, offering to sell and selling digital audio through the iTunes software application on a personal computer that can be transferred to the iPod, iPhone and iPod Touch line of products.

28. Upon information and belief, Apple’s acts of infringement have been willful.

29. Upon information and belief, Apple will continue to infringe the ‘926 Patent unless enjoined by this Court.

30. As a result of Apple’s infringement, Affinity has suffered and will suffer damages.

31. Affinity is entitled to recover from Apple the damages sustained by Affinity as a result of Apple's wrongful acts in an amount subject to proof at trial.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38 and the Seventh Amendment of the United States Constitution, Affinity hereby demands a jury trial on all issues triable to a jury.

REQUEST FOR RELIEF

WHEREFORE, Affinity petitions this Court and requests that a judgment be entered and relief be granted as follows:

- A. Declaring that Apple has infringed the Patents-in-Suit as alleged herein (directly, by inducement, and/or contributorily);
- B. Declaring that Apple's acts of infringement of the Patents-in-Suit have been willful;
- C. Permanently enjoining, restraining, and prohibiting Apple, and any party acting through, for, or in concert with Apple from further infringing (directly, by inducement, or contributorily) any claim of the Patents-in-Suit;
- D. Awarding to Affinity such monetary or compensatory damages as may be found or deemed adequate to fully compensate Affinity for each of Apple's acts of infringement of the Patents-in-Suit and/or any other injury suffered by Affinity due to Apple's acts of infringement of the Patents-in-Suit, including treble damages for Apple's willful infringement;
- D. Awarding to Affinity its costs; and
- E. Awarding to Affinity such other, further, or general relief as this Court may deem proper.

Respectfully submitted,

Dated: March 24, 2009

By: /s/ Thomas W. Sankey
Thomas W. Sankey
Lead Attorney
TX Bar No. 17635670
twosankey@duanemorris.com

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Fax: 212.692.1020

ATTORNEYS FOR PLAINTIFF
AFFINITY LABS OF TEXAS

EXHIBIT D

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

AFFINITY LABS OF TEXAS, No. C 09-04436 CW

Plaintiff,

MINUTE ORDER AND
CASE MANAGEMENT
ORDER

v.

APPLE INC,

Defendant:

Clerk: Nikki D. Riley Reporter: Raynee Mercado
Plaintiff Attorney: Woody Jameson/George D. Niespolo
Defendant Attorney: Darin J. Glasser/George A. Riley

A case management conference was held on: April 29, 2010. The Case Management Statement and Proposed Order filed by the parties is hereby adopted by the Court as the Case Management Order for the case, except as may be noted below. The Court's standard Order for Pretrial Preparation also applies.

The case is hereby referred to the following ADR process:

Non-binding Arbitration: () Early Neutral Evaluation: ()

Court-connected mediation: () Private mediation: (x)

Magistrate Judge settlement conference: ()

ADR session to be held by: (6/23/10)

(or as soon thereafter as is convenient to the mediator's schedule)

Deadline to add additional parties: (6/28/10)

Deadline to add additional claims: (10/10)

Date of next case management conference: (6/9/11)

Completion of Fact Discovery: (2/1/11)

Disclosure of identities and reports of expert witnesses: (2/15/11)

Rebuttal: (3/15/11)

Completion of Expert Discovery: (4/12/11)

All case-dispositive motions to be heard at 2:00 P.M.

on or before: (6/9/11)

Final Pretrial Conference at 2:00 P.M. on: (9/6/11)

A 9 day Jury Trial will begin at 8:30 A.M. on: (9/19/11)

Additional Matters: Copy of Court's Order for Pretrial Preparation given to attys in court. Plaintiff's claim construction and case dispositive motion (contained in a single brief) due by 4/26/11; Defendant's reply, claim construction and case dispositive motion (contained in a single brief) due by 5/10/11; Plaintiff's reply and opposition due by 5/17/11; Defendant's reply due 5/24/11. **A Further Case Management Conference will be held on June 9, 2011 whether or not dispositive motions are filed (or on whatever date dispositive motions are set).**

United States District Court
For the Northern District of California

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IT IS SO ORDERED.

Dated: 4/29/2010



CLAUDIA WILKEN
United States District Judge

Copies to: Chambers; ADR

United States District Court
For the Northern District of California

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3 NOTICE

4 **Case Management Conferences and Pretrial Conferences** are
5 conducted on **Tuesdays** at 2:00 p.m. **Criminal Law and Motion** calendar
6 is conducted on **Wednesdays** at 2:00 p.m. for defendants in custody and
7 2:30 p.m. for defendants not in custody. **Civil Law and Motion**
8 calendar is conducted on **Thursdays** at 2:00 p.m. Order of call is
9 determined by the Court. Counsel need not reserve a hearing date for
10 civil motions; however, counsel are advised to check the legal
11 newspapers or the Court's website at www.cand.uscourts.gov for
12 unavailable dates.

13 **Motions for Summary Judgment:** All issues shall be contained
14 within one motion of 25 pages or less, made on 35 days notice. (See
15 Civil L.R. 7-2). Separate statements of undisputed facts in support
16 of or in opposition to motions for summary judgment will not be
17 considered by the Court. (See Civil Local Rule 56-2(a)). The motion
18 and opposition should include a statement of facts supported by
19 citations to the declarations filed with respect to the motion.
20 Evidentiary and procedural objections shall be contained within the
21 motion, opposition or reply; separate motions to strike will not be
22 considered by the Court. Any cross-motion shall be contained within
23 the opposition to any motion for summary judgment, shall contain 25
24 pages or less, and shall be filed 21 days before the hearing. The
25 reply to a motion may contain up to 15 pages, shall include the
26 opposition to any cross-motion, and shall be filed 14 days before the
27 hearing. (See Civil Local Rule 7-3). The Court may, *sua sponte* or
28 pursuant to a motion under Civil L.R. 6-3, reschedule the hearing so
as to give a moving party time to file a reply to any cross-motion.

17 All discovery motions are referred to a Magistrate Judge to be
18 heard and considered at the convenience of his/her calendar. All such
19 matters shall be noticed by the moving party for hearing on the
20 assigned Magistrate Judge's regular law and motion calendar, or
21 pursuant to that Judge's procedures.

22 Pursuant to General Order 45, § VI.G, "In all cases subject to
23 ECF, in addition to filing papers electronically, the parties are
24 required to lodge for chambers **no later than noon on the business day**
25 **following the day that the papers are filed electronically**, one paper
26 copy of each document that is filed electronically."

27
28 (rev. 10/10/07)

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ORDER FOR PRETRIAL PREPARATION

PRETRIAL CONFERENCE

1. Not less than 30 days prior to the pretrial conference, counsel shall exchange (but not file or lodge) the papers described in Civil L.R. 16-10(b) (7), (8), (9), and (10), and their motions in limine.

2. At least 20 days before the final pretrial conference, lead counsel who will try the case shall meet and confer with respect to:

(a) Preparation and content of the joint pretrial conference statement;

(b) Resolution of any differences between the parties regarding the preparation and content of the joint pretrial conference statement and the preparation and exchange of pretrial materials to be served and lodged pursuant to this Order for Pretrial Preparation. To the extent such differences are not resolved, parties will present the issues in the pretrial conference statement so that the judge may rule on the matter during the pretrial conference; and

(c) Settlement of the action.

3. Not less than 10 days prior to the pretrial conference, counsel shall submit the following.

(a) Pretrial Conference Statement. The parties shall file a joint pretrial conference statement containing the following information:

(1) The Action.

(A) Substance of the Action. A brief description of the substance of claims and defenses which remain to be decided.

(B) Relief Prayed. A detailed statement of all the relief claimed, particularly itemizing all elements of damages claimed.

(2) The Factual Basis of the Action.

- 1 (A) Undisputed Facts. A plain and concise statement
2 of all relevant facts not reasonably disputed.
- 3 (B) Disputed Factual Issues. A plain and concise
4 statement of all disputed factual issues which remain to be
5 decided.
- 6 (C) Agreed Statement. A statement assessing whether
7 all or part of the action may be presented upon an agreed
8 statement of facts.
- 9 (D) Stipulations. A statement of stipulations
10 requested or proposed for pretrial or trial purposes.
- 11 (3) Disputed Legal Issues. Without extended legal
12 argument, a concise statement of each disputed point of law
13 concerning liability or relief.
- 14 (4) Further Discovery or Motions. A statement of all
15 remaining discovery or motions.
- 16 (5) Trial Alternatives and Options.
- 17 (A) Settlement Discussion. A statement summarizing
18 the status of settlement negotiations and indicating
19 whether further negotiations are likely to be productive.
- 20 (B) Consent to Trial Before a Magistrate Judge. A
21 statement whether the parties consent to a court or jury
22 trial before a magistrate judge, with appeal directly to
23 the Ninth Circuit.
- 24 (C) Bifurcation, Separate Trial of Issues. A
25 statement of whether bifurcation or a separate trial of
26 specific issues is feasible and desired.
- 27 (6) Miscellaneous. Any other subjects relevant to
28 the trial of the action, or material to its just, speedy
and inexpensive determination.
- (b) Exhibit List and Objections. The exhibit list
shall list each proposed exhibit by its number (see Civil L.R.
30-2(b)), description, and sponsoring witness, followed by
blanks to accommodate the date on which it is marked for
identification and the date on which it is admitted into

1 evidence. **No party shall be permitted to offer any exhibit in**
2 **its case-in-chief that is not disclosed in its exhibit list**
3 **without leave of the Court for good cause shown.** Parties shall
4 also deliver a set of premarked exhibits to the Courtroom
5 Deputy. The exhibit markers shall each contain the name and
6 number of the case, the number of the exhibit, and blanks to
7 accommodate the date admitted and the Deputy Clerk's initials.
8 (Appropriate sample forms are available on the Court's website
9 at www.cand.uscourts.gov). Any objections to exhibits which
10 remain after the pretrial meeting shall be indicated in the
11 pretrial statement.

12 (c) Witness List. In addition to the requirements of
13 FR Civ P 26(a)(3)(A), a brief statement describing the substance
14 of the testimony to be given by each witness who may be called
15 at trial. **No party shall be permitted to call any witness in**
16 **its case-in-chief that is not disclosed in its pretrial**
17 **statement without leave of Court for good cause shown.**

18 (d) Use of Discovery Responses. In addition to the
19 requirements of FR Civ P 26(a)(3)(B), a designation of any
20 excerpts from interrogatory answers or from responses for
21 admissions intended to be offered at trial. Counsel shall
22 indicate any objections to use of these materials and that
23 counsel have conferred respecting such objections.

24 (e) Trial briefs. Briefs on all significant disputed
25 issues of law, including foreseeable procedural and evidentiary
26 issues, which remain after the pretrial meeting.

27 (f) Motions in Limine. Any motions in limine that
28 could not be settled at the pretrial meeting shall be filed with

1 the pretrial statement. All motions in limine shall be
2 contained within one document, limited to 25 pages pursuant to
3 Civil L.R. 7-2(b), with each motion listed as a subheading.
4 Opposition to the motions in limine shall be contained within
5 one document, limited to 25 pages, with corresponding
6 subheadings, and filed five (5) days thereafter.

7 (g) Joint Proposed Voir Dire. The attached voir dire
8 questionnaire will be given to the venire members, and copies of
9 the responses will be made available to counsel at the beginning
10 of voir dire. Counsel may submit a set of additional requested
11 voir dire, to be posed by the Court, to which they have agreed
12 at the pretrial meeting. Any voir dire questions on which
13 counsel cannot agree shall be submitted separately. Counsel may
14 be allowed brief follow-up voir dire after the Court's
15 questioning.

16 (h) Joint Proposed Jury Instructions. As applicable,
17 jury instructions \$1.1A, \$1.1C, \$1.2 through \$1.17, \$1.19, \$2.1
18 through \$2.13, \$3.1 through \$3.3 from the Manual of Model Civil
19 Jury Instructions for the Ninth Circuit (2007 Edition) will be
20 given absent objection. Counsel shall jointly submit one set of
21 additional proposed jury instructions, to which they have agreed
22 at the pretrial meeting. The instructions shall be ordered in
23 a logical sequence, together with a table of contents. Any
24 instruction on which counsel cannot agree shall be marked as
25 "disputed," and shall be included within the jointly submitted
26 instructions and accompanying table of contents, in the place
27 where the party proposing the instruction believes it should be
28 given. Argument and authority for and against each disputed

1 instruction shall be included as part of the joint submission,
2 on separate sheets directly following the disputed instruction.

3 Whenever possible, counsel shall deliver to the
4 Courtroom Deputy a copy of their joint proposed jury
5 instructions on a computer disk in WordPerfect or ASCII format.
6 The disk label should include the name of the parties, the case
7 number and a description of the document.

8 (i) Proposed Verdict Forms, Joint or Separate.

9 (j) Proposed Findings of Fact and Conclusions of Law
10 (Court Trial only). Whenever possible, counsel shall deliver to
11 the Courtroom Deputy a copy of their proposed findings of fact
12 and conclusions of law on a computer disk in WordPerfect or
13 ASCII format. The disk label should include the name of the
14 parties, the case number and a description of the document.

15 JURY SELECTION

16 The Jury Commissioner will summon 20 to 25 prospective
17 jurors. The Courtroom Deputy will select their names at random
18 and seat them in the courtroom in the order in which their names
19 are called.

20 Voir dire will be asked of sufficient venire persons so
21 that eight (or more for a lengthy trial) will remain after all
22 peremptory challenges and an anticipated number of hardship
23 dismissals and cause challenges have been made.

24 The Court will then take cause challenges, and discuss
25 hardship claims from the individual jurors, outside the presence
26 of the venire. The Court will inform the attorneys which
27 hardship claims and cause challenges will be granted, but will
28 not announce those dismissals until the process is completed.

United States District Court
For the Northern District of California

1 Each side may then list in writing up to three peremptory
2 challenges. The attorneys will review each other's lists and
3 then submit them to the Courtroom Deputy.

4 Then, from the list of jurors in numerical order, the Court
5 will strike the persons with meritorious hardships, those
6 excused for cause, and those challenged peremptorily, and call
7 the first eight people in numerical sequence remaining. Those
8 people will be the jury.

9 All jurors remaining at the close of the case will
10 deliberate. There are no alternates.

11 SANCTIONS

12 Failure to comply with this Order is cause for sanctions
13 under Federal Rule of Civil Procedure 16(f).

14 IT IS SO ORDERED.

15
16 Dated: _____



CLAUDIA WILKEN
UNITED STATES DISTRICT JUDGE

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JUROR QUESTIONNAIRE

Please fill out this form as completely as possible and print clearly. Since we want to make copies for the attorneys and the Court, do not write on the back of any page. If you need more room, continue at the bottom of the page. Thank you for your cooperation.

1. Your name: _____

2. Your age: _____

3. The city where you live: _____

How long have you lived there: _____

4. Your place of birth: _____

5. Do you rent or own your own home? _____

6. Your marital status: (circle one)

single married live with partner separated divorced widowed

7. What is your occupation, and how long have you worked in it? (If you are retired, please describe your main occupation when you were working).

8. Who is (or was) your employer?

9. How long have you worked for this employer? _____

10. Please list the occupations of any adults with whom you live.

11. If you have children, please list their ages and sex and, if they are employed, please give their occupations.

United States District Court
For the Northern District of California

United States District Court
For the Northern District of California

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12. Please describe your educational background:
Highest grade completed: _____
College and/or vocational schools you have attended:

Major areas of study: _____

13. Have you ever served on a jury before? _____ How many
times? _____
If yes: State/County Court _____ Federal Court _____
When? _____

Was it a civil or criminal case? _____

Did the jury(ies) reach a verdict? _____

14. Attached is a list of the parties in this case, the law
firms representing the parties, attorneys in this case, and
persons who are potential witnesses in this case. Do you
know, or think you know, any of the persons listed?

Yes: _____ No: _____

If so, make a check next to their name.

EXHIBIT E

1 Richard L. Seabolt, Esq. (SBN 67469)
2 DUANE MORRIS LLP
3 Spear Tower
4 One Market Plaza, Suite 2200
5 San Francisco, CA 94105-1127
6 Telephone: 415.957.3000
7 Facsimile: 415.957.3001

8 L. Norwood Jameson, Esq. (admitted *pro hac vice*)
9 Matthew C. Gaudet, Esq. (admitted *pro hac vice*)
10 DUANE MORRIS LLP
11 1180 West Peachtree Street
12 Suite 700
13 Atlanta, GA 30309
14 Telephone: 404.253.6900
15 Facsimile: 404.253.6900

16 Attorneys for Plaintiff,
17 AFFINITY LABS OF TEXAS, LLC

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

17 AFFINITY LABS OF TEXAS, LLC, a
18 Texas Limited Liability Company,

19 Plaintiff and
20 Counterclaim-Defendant,

21 v.

22 APPLE INC., a California Corporation,

23 Defendant and
24 Counterclaim-Plaintiff.

CASE NO. CV 09-4436-CW

**PLAINTIFF AFFINITY LABS OF TEXAS,
LLC'S FIRST AMENDED DISCLOSURE
OF ASSERTED CLAIMS AND
INFRINGEMENT CONTENTIONS**

(Patent L.R. 3 -1)

1 Pursuant to an agreement of the parties to be memorialized in a joint motion for leave to
2 amend, and in accordance with Rule 3-1 of the Patent Local Rules of the United States District
3 Court for the Northern District of California, Plaintiff Affinity Labs of Texas, LLC (“Affinity”)
4 hereby provide their “First Amended Disclosure of Asserted Claims and Infringement
5 Contentions” as follows:

6
7 **Disclosure Under Patent Local Rule 3-1(a)**

8 Claims 1-4, 6-9, 11-13, 15, 17 and 20-28 of U.S. Patent No. 7,187,947 (“the ‘947 Patent”)
9 are infringed by Defendant, Apple Inc. (“Apple”) under 35 U.S.C. §271(a). Claims 1-4, 6-9, 11-
10 13, 15, 17, 20-32, 34-36 and 39-42 of the ‘947 Patent are infringed by Apple under 35 U.S.C.
11 §271(b). Claims 1-4, 6-9, 11-13, 15 and 17 of the ‘947 Patent are infringed by Apple under 35
12 U.S.C. §271(c).

13 Claims 1, 4, 11, 12 and 13 of U.S. Patent No. 7,440,772 (“the ‘772 Patent”) are infringed
14 by Apple under 35 U.S.C. §271(a).

15 Claims 1-6, 8 and 10-20 of U.S. Patent No. 7,486,926 (“the ‘926 Patent”) are infringed by
16 Apple under 35 U.S.C. §271(a),(b) and (c).

17 **Disclosure Under Patent Local Rule 3-1(b)**

18 Each accused apparatus, product, device, process, method, act or other instrumentality
19 (“Accused Instrumentality”) of Apple – of which Affinity is currently aware – is identified,
20 separately for each asserted claim, in the respective claim charts for each of the Asserted Patents
21 which is attached hereto as Amended Exhibit A and previously served Exhibits B and C. These
22 exhibits are incorporated herein by reference. In this First Amended Disclosure of Asserted
23 Claims and Infringement Contentions, only Exhibit A has been amended, not Exhibits B or C.

24 This disclosure is based on the present state of Affinity’s knowledge, without the benefit
25 of any discovery from Apple or any other parties. Affinity accordingly reserves the right to
26 support its infringement action with additional allegations of infringement of other
27 instrumentalities and of other claims, and with additional facts. Affinity also reserves the right to
28

1 modify the positions taken in these initial disclosures, based on later obtained materials, and/or
2 based on information currently available, which Affinity has not yet identified as significant.

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Disclosure Under Patent Local Rule 3-1(c)

5 Amended Exhibit A (the '947 Patent) and previously served Exhibits B (the '772 Patent)
6 and C (the '926 Patent) identify specifically where each element of each asserted claim is found
7 within each Accused Instrumentality.

8 This disclosure is based on the present state of Affinity's knowledge, without the benefit
9 of any discovery from Apple or any other parties. Affinity accordingly reserves the right to
10 support its infringement action with additional allegations of infringement of other
11 instrumentalities and of other claims, and with additional facts. Affinity also reserves the right to
12 modify the positions taken in these initial disclosures, based on later obtained materials, and/or
13 based on the information currently available which Affinity has not yet identified as significant.

14
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Disclosure Under Patent Local Rule 3-1(d)

16 **The '947 Patent**

17 By offering to sell and selling in the United States at least the original iPhone, iPhone 3G
18 and iPhone 3GS with knowledge of the '947 Patent and actively encouraging and instructing
19 purchasers of the original iPhone, iPhone 3G and iPhone 3GS to use the cellular communication
20 devices in such a manner as to directly infringe claims 1-4, 6-9, 11-13, 15, 17, 20-32, 34-36 and
21 39-42, including by advertising and marketing the claimed features and by providing instructions
22 on-line and in user manuals explaining how to use the original iPhone, iPhone 3G and iPhone
23 3GS so as to infringe claims 1-4, 6-9, 11-13, 15, 17, 20-32, 34-36 and 39-42 of the '947 Patent,
24 Apple actively induces infringement of claims 1-4, 6-9, 11-13, 15, 17, 20-32, 34-36 and 39-42 of
25 the '947 Patent under 35 U.S.C. §271(b) and is, therefore, liable as an infringer.

26 By offering to sell and selling in the United States at least the original iPhone, iPhone 3G
27 and iPhone 3GS which have components that constitute material parts of and are especially
28 designed for use in the inventions claimed in claims 1-4, 6-9, 11-13, 15 and 17 of the '947 Patent,

1 including software specifically design to permit a user to practice the inventions claimed in
2 claims 1-4, 6-9, 11-13, 15 and 17 of the '947 Patent, Apple is liable for contributory infringement
3 of claims 1-4, 6-9, 11-13, 15 and 17 of the '947 Patent under 35 U.S.C. §271(c).

4 **The '926 Patent**

5 By making available the iTunes application, including the iTunes Store, and offering to
6 sell and selling in the United States at least the iPod, iPod Touch and iPhone product lines with
7 knowledge of the '926 Patent and actively encouraging and instructing user s of the iTunes
8 application and purchasers of the iPod, iPod Touch and iPhone product lines to use the portable
9 devices in such a manner as to directly infringe claims 1-6, 8 and 10-20, including by advertising
10 and marketing the claimed features and by providing instructions on-line and in user manuals
11 explaining how to use the iTunes application and the iPod, iPod Touch and iPhone product lines
12 so as to infringe claims 1-6, 8 and 10-20 of the '926 Patent, Apple actively induces infringement
13 of claims 1-6, 8 and 10-20 of the '926 Patent under 35 U.S.C. §271(b) and is, therefore, liable as
14 an infringer.

15 By making available the iTunes application, including the iTunes Store, and offering to
16 sell and selling in the United States at least the iPod, iPod Touch and iPhone product lines which
17 have components that constitute material parts of and are especially designed for use in the
18 inventions claimed in claims 1-6, 8 and 10-20 of the '926 Patent, including software specifically
19 design to permit a user to practice the inventions claimed in 1-6, 8 and 10-20 of the '926 Patent,
20 Apple is liable for contributory infringement of claims 1-6, 8 and 10-20 of the '926 Patent under
21 35 U.S.C. §271(c).

22
23 **Disclosure Under Patent Local Rule 3-1(e)**

24 Each element of each claim as set forth in Exhibits A, B and C is literally present. In the
25 event that further discovery or a claim construction ruling necessitates contentions under the
26 doctrine of equivalents, Affinity reserves the right to timely amend these contentions.

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Disclosure Under Patent Local Rule 3-1(f)

All the asserted claims of the '947, '772 and '926 Patents (collectively, the "Asserted Patents") are entitled to the priority date of March 28, 2000, the filing date of U.S. Application No. 09/537,812, now U.S. Patent No. 7,187,947.

Disclosure Under Patent Local Rule 3-1(g)

At this time, Affinity is not relying on its own apparatus, product, device, process, method, act, or other instrumentality that practice the claimed inventions identified in the Asserted Patents.

Disclosure Under Patent Local Rule 3-1(h)

The facts relating to Affinity's claim of willfulness are detailed on pages 6-7 of Affinity's Memorandum in Opposition to Apple's Motion to Stay this case, and the referenced declarations, which are incorporated herein by reference. Specifically, those pleadings detail Affinity's efforts to put Apple on notice and Apple's indifference towards Affinity's patent rights. In addition, after Apple became aware of Affinity's patents, and even after Affinity filed the Complaint in this case, Apple has continued to launch new versions of infringing products.

Undersigned counsel hereby certifies that to the best of his knowledge, information and belief, formed after an inquiry that is reasonable under the circumstances, the information contained in this Disclosure and the attached Exhibits and the production of documents pursuant to Patent L.R. 3-2 is complete and correct at the time of certification.

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Dated: June 17, 2010

RICHARD L. SEABOLT
L. NORWOOD JAMESON
MATTHEW C. GAUDET

DUANE MORRIS LLP

By: /s/ Mathew C. Gaudet
Mathew C. Gaudet

Attorneys for Plaintiff AFFINITY LABS OF
TEXAS, LLC

EXHIBIT F

Capturing Value in a Global Innovation Network: Comparing the iPod and Notebook PCs

Kenneth L. Kraemer, Jason Dedrick, Greg Linden
Personal Computing Industry Center
University of California, Irvine

ITIF Forum on Mapping IT Supply Chains: Does the U.S.
Benefit from U.S. IT Products Made Overseas?
Cannon House Office Building
Washington DC, October 3, 2007

Supported by a grant from the Alfred P. Sloan Foundation

Personal Computing Industry Center
University of California, Irvine

Agenda

- Overview: global innovation networks
- Incremental innovation in PCs
- Radical innovation in the iPod
- Capturing value from innovation
 - Methods, data, results
- Implications for competition
- Implications for the U.S.

Global innovation networks: Who benefits?

- Innovation is believed to be a key driver of economic growth and source of national competitiveness.
 - Academic literature supports this view
 - National policies reflect this belief
- But what happens when innovation and production are distributed across many countries?
 - Multinationals operate multiple R&D centers around the world
 - Industries becoming more modular, with production and product development outsourced to specialists in many countries
- Where is value created, and who captures that value?

How does innovation occur?

- Locus of innovation
 - Core technologies: e.g. semiconductors, hard drives, optical drives, displays, software, battery, materials
 - System integration: Brand name vendors incorporate core technologies in new products to meet market demand.
- Incremental vs. radical innovation
 - Incremental: improvements within existing product architectures, e.g., faster computers, bigger TVs
 - Radical: disruptive changes in core technologies or creation of new architectures, e.g., from CRT to flat-panel TVs

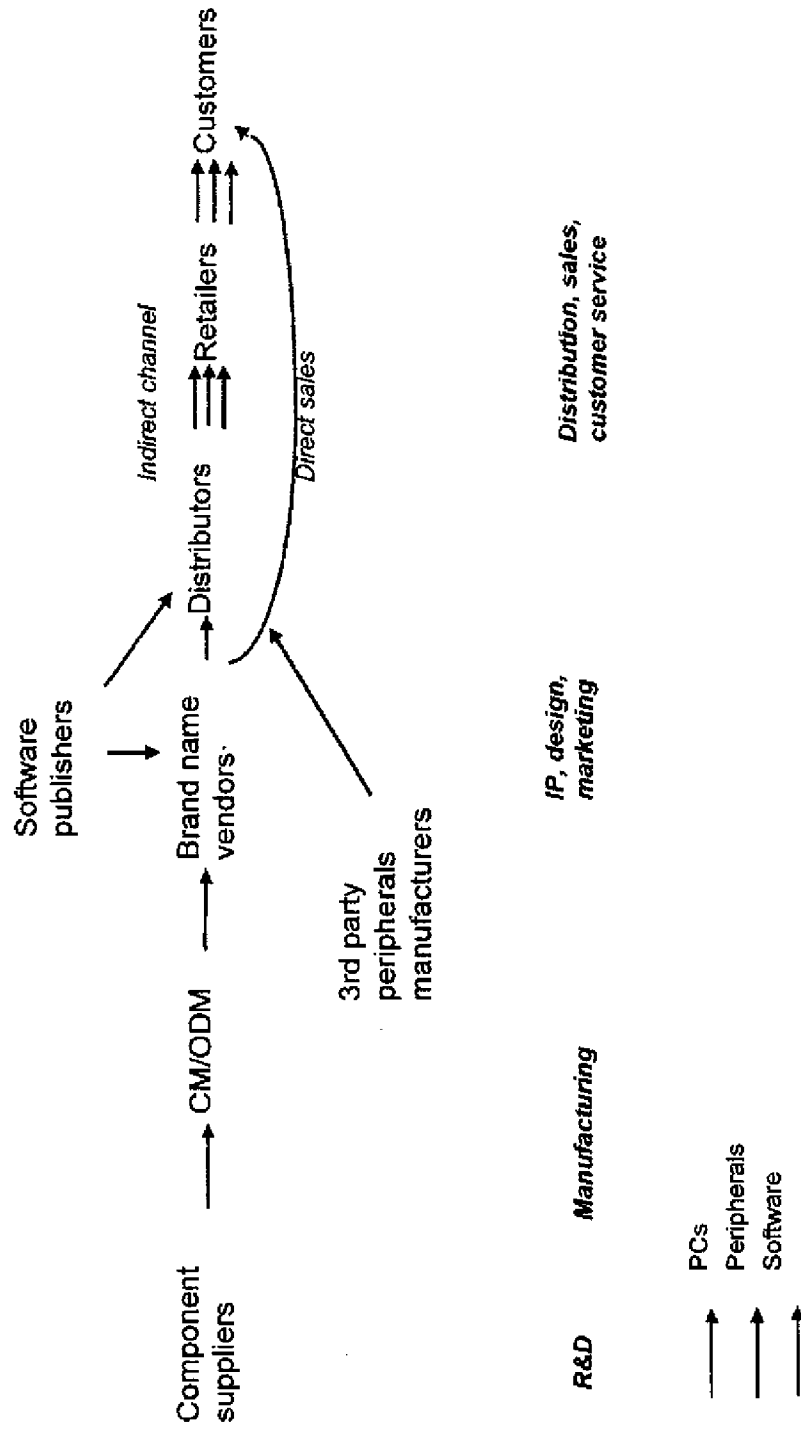
Case studies: iPods and notebooks

- Global innovation networks that incorporate these distinctions found in many industries
- We study two products built on a global supply and innovation network—iPods and notebook PCs
 - Similar technologies involved (chips, storage, software, displays), mostly the same suppliers
 - One is radical, one incremental
 - Do they tell similar or different stories about value capture?
- We focus on a few products in one industry to do a very detailed analysis of value capture in global networks

Incremental innovation in the PC industry

- PC a mature product with established dominant design
- Modular product architecture with defined interfaces.
- Allows innovation to proceed independently in all layers of the industry
- Microsoft and Intel define key standards and shape innovation decisions of component and system makers
- Branded PC makers decide which innovations to incorporate. Most innovations available to everyone

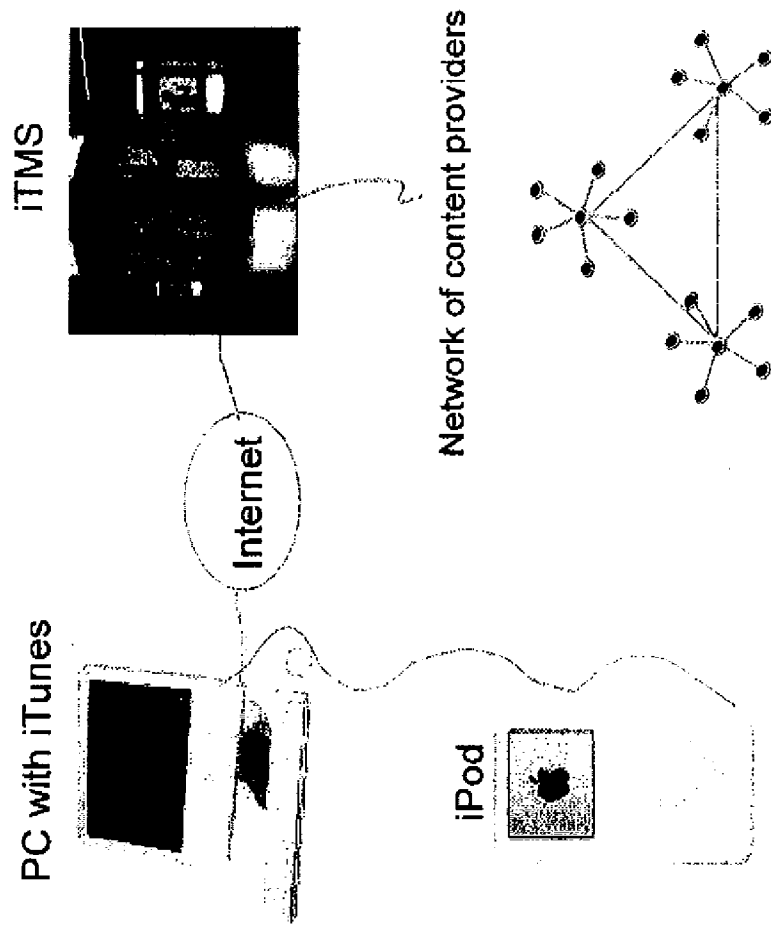
PC industry value network



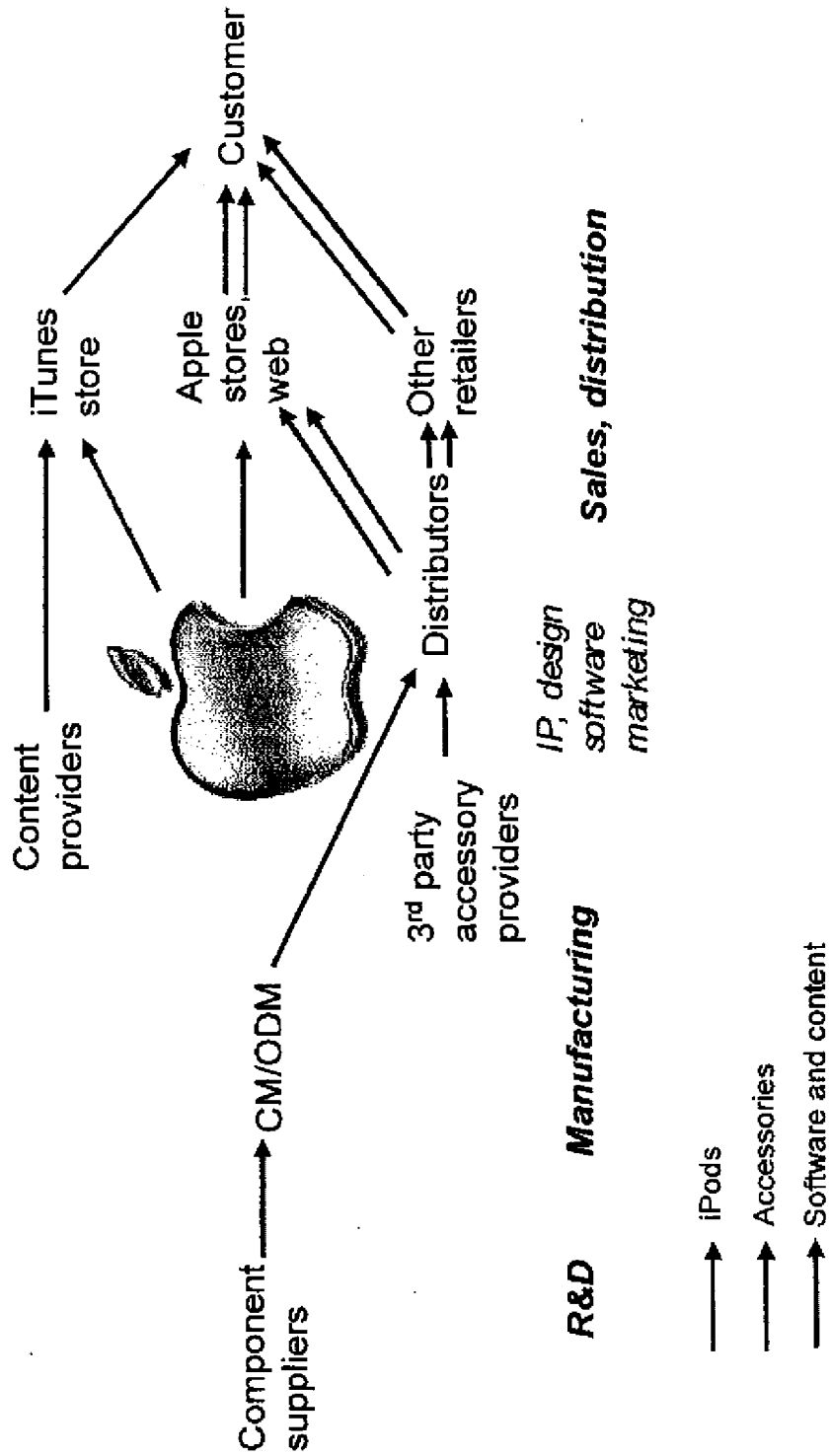
Radical innovation in the iPod

- Emerging product category, no dominant design
- Innovation aided by advances in core technologies: hard drive, flash memory, audio compression (MP3), batteries
- Apple created complete system of hardware, software, services.
 - Worked with suppliers to customize key components
 - Created an ecosystem that includes iPod, iTunes software for PCs, iTunes store, content
 - Success based on design, ease of use, integration of product and services to satisfy consumers

The iPod ecosystem



The iPod value network



Comparing PDA's and notebooks

- **Similarities**
 - Components are supplied globally by mostly the same U.S. and Asia-Pacific firms
 - Assembly is in China
 - Distribution and retail is local or regional around the world.
- **Differences**
 - Whose brand is on the label: Apple vs. various U.S., Japanese, Taiwanese, Chinese notebook vendors
 - Who controls the standards: Apple vs. Microsoft and Intel

Who captures the value of innovation?

- Critical issue for companies and countries.
- Companies need to know
 - how much to invest and where to focus their own efforts
 - when and how to leverage global networks
 - where to retain control to capture value.
- U.S. needs to know
 - real facts about globalization
 - how to capture more value from participating in global networks
 - how to prepare their people to compete globally
 - how to create an environment for innovation

Research approach

- Need a framework to measure value creation and capture.
 - Use value chain analysis.
 - Identify who captures value along the supply chain
- Need a methodology to measure value at the firm and country level.
 - We break down individual products, identify who makes the major components, who assembles the product, who sells it
 - Estimate the value captured by each party.
 - Firm level data is then aggregated to country level

Accounting methodology

- Value added = sale price - purchased inputs = direct labor + gross profit
- Value capture = gross profit = value added - direct labor

Sales price	- purchased inputs			- cost of goods sold
	- direct labor			
	- SG&A	Value added Gross profit		- SG&A
	- R&D			- R&D
	- Depreciation			- Depreciation
	- Net profit			- Net profit

Product level estimation

- Obtained teardown data from Portelligent, Inc.
 - 30 GB iPod, 2003 - HP nc6230 notebook, 2005
 - 30 GB Video iPod, 2005 - Lenovo T43 notebook, 2005
 - 8GB iPod Nano, 2005
- Break down cost and identify manufacturers of major inputs
 - For each input, estimate gross margin using company and comparative data.
 - Multiply cost by margin to get value capture by firm
 - Direct labor costs are not broken out in firm financial reports, so we cannot measure value added. Possible future research.

Key Inputs in the 30GB 5th-Generation iPod (Video iPod), 2005

Type	Input	Supplier	Supplier HQ Country	Estimated Input Price	Price as % of Factory Cost	Supplier Gross Profit Rate	Est'd. Value Capture
Storage	Hard Drive	Toshiba	Japan	\$73.39	50%	26.50%	\$19.45
Display	Display Assembly	Toshiba-Matsushita	Japan	\$23.27	16%	28.70%	\$6.68
Processors	Video/Multimedia Processor	Broadcom	US	\$8.36	6%	52.5%	\$4.39
Processors	Controller chip	PortalPlayer	US	\$4.94	3%	44.8%	\$2.21
Battery	Battery Pack	Unknown	Japan*	\$2.89	2%	30.0%*	\$0.87
Memory	Mobile SDRAM Memory - 32 MB	Samsung	Korea	\$2.37	2%	28.2%	\$0.67
Memory	Mobile RAM - 8 MBytes	Elpida	Japan	\$1.85	1%	24.0%	\$0.46
Memory	NOR Flash Memory - 1 MB	Spansion	US	\$0.84	1%	10.0%	\$0.08
			Sub-Total	\$117.91	80%		
			Other parts	\$22.79	15%		
			Estimated assembly and test	\$7.40	5%		\$3.70
			Estimated factory cost	\$148.10	100%		\$38.50

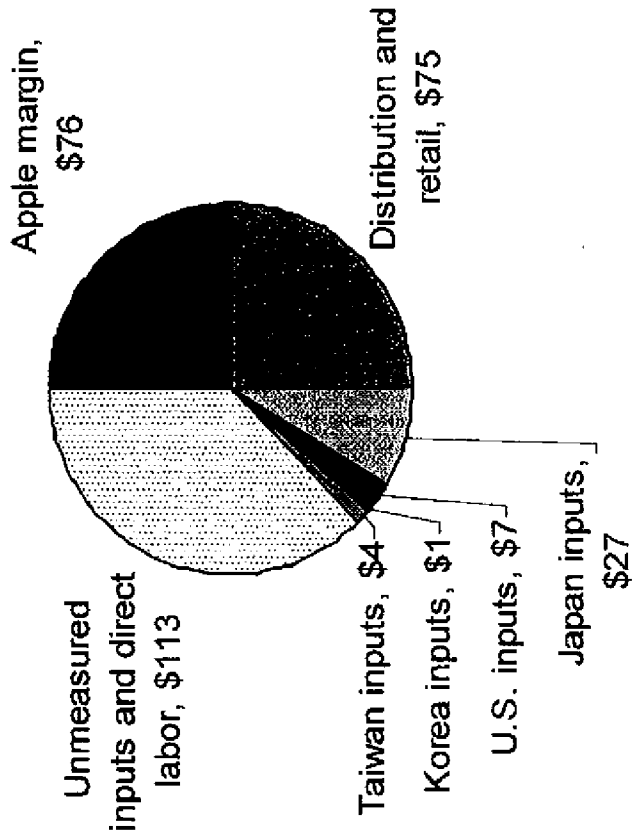
Video iPod and notebook PC input values

Purchased inputs as percentage of factory cost

	Video iPod	HP nc6230 notebook
Software	Developed inhouse	11%
Storage	50%	12%
Display	16%	16%
Processors	9%	27%
Assembly	5%	5%
Battery	2%	5%
Memory	2%	4%
PCBs	2%	2%
Enclosure	2%	1%
Input Device(s)	1%	2%
	89%	85%
Total Parts	451	2,196

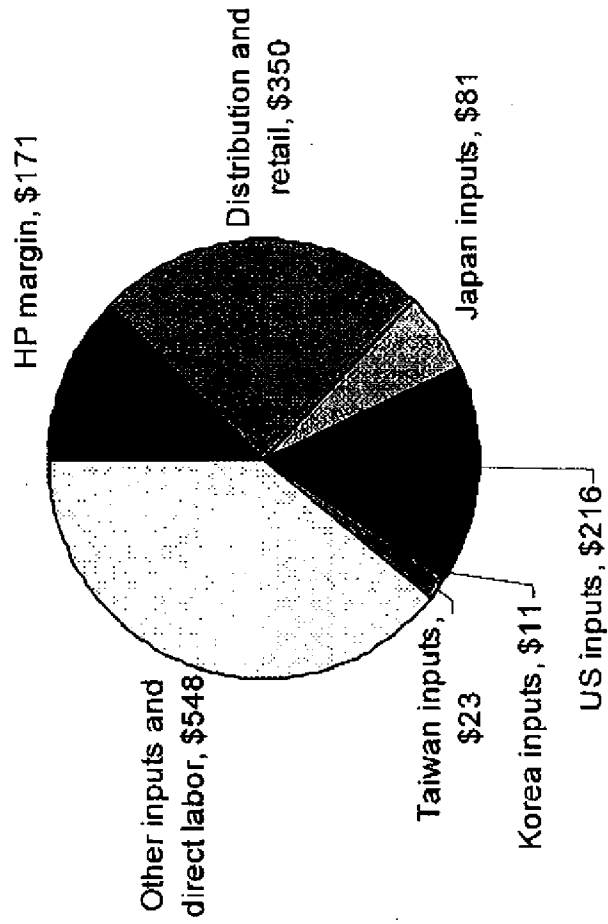
Distribution of value capture iPod

Value capture for \$299 iPod



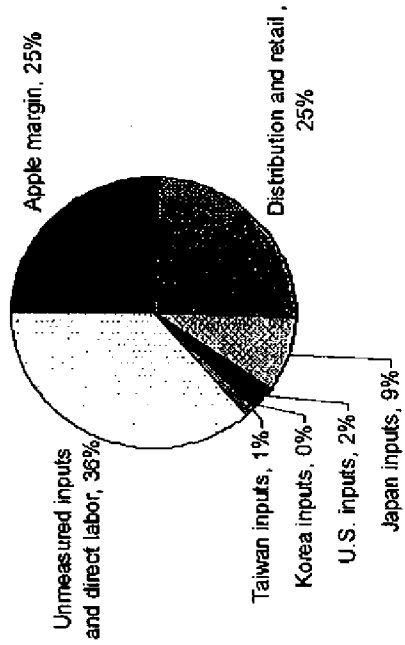
Distribution of value capture: notebook PC

Value capture for \$1400 HP notebook

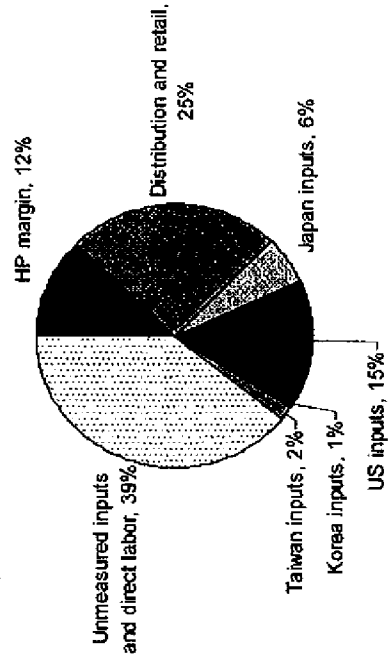


Comparison of value capture

Share of value capture, \$299 iPod



Share of value capture, \$1400 HP notebook

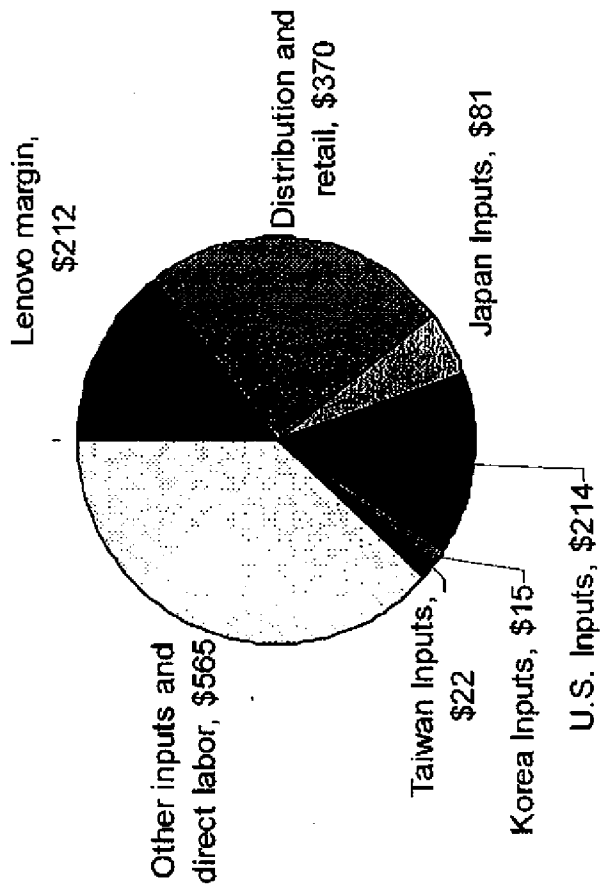


Where's China?

- Value added
 - All products studied assembled in China
 - Value added from final assembly a few dollars of direct labor
 - Additional assembly of components and subassemblies in China
 - Total less than 5% of final value
- Value capture
 - No Chinese firms in major suppliers
 - Assembly done by Taiwanese and multinational companies in China, who capture value in gross profit
- For Lenovo laptop, China's share is bigger

China capturing value: Lenovo

Value capture for \$1479 Lenovo notebook



Innovation and competition

- Key distinction in who captures value is not between radical and incremental innovation. It's who defines the market and controls standards
 - Apple for iPod
 - Microsoft and Intel for PCs
- “Wintel” is not the model for the rest of the electronics industry.
 - Even Microsoft doesn't use it outside of PCs (XBox and Zune)
 - Lead firms in other segments don't want suppliers to capture most of the value.

Value of innovation to the U.S.

- Value captured by countries depends mostly on success of domestically-owned firms
 - Electronics industry dominated by U.S. and Japanese brands
 - U.S. continues to generate new innovations and set standards
- Innovation by domestic companies creates value for shareholders, who are mostly in the U.S.
- Creates employment in the U.S. in management, R&D, design, sales, marketing, accounting etc.
- As technologies mature, activities move offshore. Constant innovation creates new opportunities.

Electronic Patent Application Fee Transmittal

Application Number:	95001263
Filing Date:	13-Nov-2009
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Filer:	Mark J. Rozman/Stephanie Petreas
Attorney Docket Number:	AFF.0004B6US

Filed as Large Entity

inter partes reexam Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Filing a brief in support of an appeal	1402	1	620	620

Post-Allowance-and-Post-Issuance:

Extension-of-Time:

Samsung Ex. 1321 p. 191

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				620

Electronic Acknowledgement Receipt

EFS ID:	12226651
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	Mark J. Rozman/Stephanie Petreas
Filer Authorized By:	Mark J. Rozman
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	05-MAR-2012
Filing Date:	13-NOV-2009
Time Stamp:	16:39:26
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$620
RAM confirmation Number	3511
Deposit Account	201504
Authorized User	

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Samsung Ex. 1321 p. 193

File Listing:					
Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Appeal Brief-Owner	AFF004B6USAppealBriefwithCOS.pdf	628911 5adbb09b834c9c5abd4bc162b9c22ced72374387	no	39
Warnings:					
Information:					
2	Miscellaneous Incoming Letter	AFF004B6USPageNumberCertwithAppealBrief.pdf	33519 d617852356d86c2e158c5aacafc55e12b4ea71a5	no	1
Warnings:					
Information:					
3	Reexam Certificate of Service	AFF004B6USCOSPgNumbCertwithAppealBrief.pdf	15517 a8da854f1e91409ffc99b5c9e5f5ec9c37fe4583	no	1
Warnings:					
Information:					
4	Miscellaneous Incoming Letter	AFF004B6Exhibit1part1of2.pdf	5111513 40a571a24ed75d765d8106ffe856c5c484b09867	no	81
Warnings:					
Information:					
5	Miscellaneous Incoming Letter	AFF004B6Exhibit1part2of2.pdf	3931980 9c8adf1e43df226bb697b9c091e539023a1a2642	no	64
Warnings:					
Information:					
6	Miscellaneous Incoming Letter	AFF004B6Exhibit2.pdf	575537 112e58affff5a93e3bba681eb384a980d968d50e	no	17
Warnings:					
Information:					
7	Miscellaneous Incoming Letter	AFF004B6Exhibit3.pdf	224030 6edebce2a99308a28487aa080610adc9d501aab7	no	5
Warnings:					
Information:					
8	Fee Worksheet (SB06)	fee-info.pdf	30467 c2fc1a6ffeeb2b7fd8d32c978e2a88be27d065f0	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			10551124		

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reexamination Control No.: 95/001,263	§	Attorney Docket No.: AFF.004B6US
	§	
Patent No.: 7,486,926	§	Customer No.: 21906
	§	
For: CONTENT DELIVERY SYSTEM AND METHOD	§	Real Parties In Interest:
	§	Affinity Labs of Texas, LLC
	§	
Examiner: Colin M. LaRose	§	Conf. No.: 6721
	§	
	§	

Mail Stop: *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S APPEAL BRIEF
IN INTER PARTES REEXAMINATION

Date of Deposit: <u>March 5, 2012</u> I hereby certify under 37 CFR § 1.8 this correspondence is being deposited via EFS on the date indicated above. /Stephanie Petreas/ Stephanie Petreas

I. Real Party in Interest

The real party in interest to the present appeal is Affinity Labs of Texas, LLC.

II. Related Appeals and Interferences

The following proceedings for the following patents which are currently under reexamination may be deemed related within the meaning of 37 C.F.R. § 41.67(C)(1)(II):

- U.S. Pat. No. 7,440,772 (the '772 patent); Reexam Cntrl. No. 95/001,266;
- U.S. Pat. No. 7,187,947 (the '947 patent); Reexam Cntrl. No. 95/001,262;
- U.S. Pat. No. 7,324,833 (the '833 patent); Reexam Cntrl. No. 95/001,264;
- U.S. Pat. No. 7,634,228 (the '228 patent); Reexam Cntrl. No. 95/001,281 (now on appeal to the Board of Patent Appeals and Interferences); and
- U.S. Pat. No. 7,778,595 (the '595 patent); Reexam Cntrl. No. 95/001,782.

Certain of these patents were/are subject to the following litigations:

- Affinity Labs of Texas, LLC v. BMW North America, LLC*, et al., Case No. 08-cv-00164-RC ('228 and '833 patents) (jury verdict in favor of Patent Owner, now on appeal to Federal Circuit);
- Affinity Labs of Texas, LLC v. Alpine Electronics of America, Inc. et al.*, Case No. 08-cv-00171-RC ('228 and '833 patents) (now settled);
- Affinity Labs of Texas, LLC v. DICE Electronics, LLC, et al.*, Case No. 08-cv-00163-RC ('833 patent) (now settled);
- Affinity Labs of Texas, LLC v. Volkswagen Group of America, Inc. and Volkswagen Group of America Chattanooga Operations, LLC*, Case No. 11-cv-00036 ('228, '833 and '595 patents) (pending); and
- Affinity Labs of Texas, LLC v. Apple Inc. and AAMP of Florida, Inc.*, Case No. 11-cv-00349 ('228 and '595 patents) (now settled).

U.S. Patent No. 7,486,926 ("the '926 patent") and the '947 and '772 patents were previously subject to the following litigation, which has now settled:

- Affinity Labs of Texas LLC v. Apple, Inc.*, Case No. cv-09-4436-CW.

III. Status of Claims

Claims 1-37 are the subject of the present *Inter Partes* Reexamination and are the subject of the present appeal. Claims 1-37 currently stand rejected.

IV. Status of Amendments

There are no outstanding or un-entered new claims or amendments. The '926 patent originally included 20 claims, none of which were amended during the reexamination. New claims 21-37 were proposed and entered during the reexamination. No amendments were proposed after the new claims were entered.

V. Summary of the Claimed Subject Matter

There are two independent claims: 1 and 11. Claim 1 is reproduced below.

1. A content delivery system [Figs. 1, 5A, 5B, and 9; 2:62-3:5], comprising:

a software application configured for storage on a storage medium of a personal computer [Figs. 1, 2, 4 and 6; 6:18-20], the software application further configured to maintain a collection of audio files saved locally to the personal computer [Fig. 2, #203; 6:30-40], to allow a user to create a playlist [Fig. 4; 3:64-4:2, 10:7-14], to initiate a downloading of an audio file included in the playlist from the personal computer to a portable audio file player [Fig. 2, #204; 6:41-65] to initiate sending a request for a different audio file to a network based resource [Fig. 2, #202, Fig. 6, #604; 6:26-29], to receive the different audio file [Fig. 2, #203; 6:50-53], to locally save the different audio file at the personal computer [Fig. 1, #105; 3:26-33], and to initiate presentation of a graphical user interface (GUI) at the personal computer [Fig. 4; 9:52-67], wherein the GUI is configured to operate as a user interface for the network based resource, further wherein the GUI is configured to present a collection of selectable functions associated with audio information [Fig. 4, #411-412; 10:34-11:26];

the portable audio file player having a processor [Fig. 3, #302; 7:37-39], a display [Fig. 5A, #502; 8:66-9:11], and a memory configured to store a plurality of audio files [Fig. 3, #303; 7:59-62]; and a collection of instructions saved locally at the portable audio file player [7:47-48], the collection of instructions operable to direct the processor to maintain an updateable user interface comprising a menu of selectable icons [8:66-9:11], to modify the updateable user interface in connection with receiving a particular audio file from the personal computer such that a particular selectable icon is linked to the particular audio file [11:15-21], to initiate presentation of the menu on the display [9:6-11], to

communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display [Figs. 5A, 5B, and 9; 3:1-5 and 8:23-9:20], and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display [17:10-17].

'926 patent at 18:7-43. Independent claim 11 is similar to independent claim 1, except that instead of communicating data to "present a selectable representation of a particular selectable icon on the associated display" of the different electronic device, claim 11 provides a "soft button comprising the user-defined name on an associated display" of the different audio system [8:29-9:5, 11:11-26].

VI. Issues to be Reviewed on Appeal

Listed below are the issues to be reviewed on appeal:

1. Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Rio 500 in view of Kumar (RAN Ground A, p. 23)
2. Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Kumar (RAN Ground L, p. 26)
3. Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Naughton (RAN Ground S, p. 29)
4. Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Naim, and further in view of Lee (RAN Ground EE, p. 31)
5. Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, and further in view of a person of ordinary skill in the art (RAN Ground NN, p. 33)
6. Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, and further in view of Kumar (RAN Ground UU, p. 34)
7. Claims 1-37 of the '926 patent are not entitled to the priority date of Mar. 28, 2000, the filing date of parent U.S. Pat. No. 7,187,947.
8. Secondary considerations of non-obviousness do not overcome the above-listed rejections.

It is noted that there are only two independent claims, claims 1 and 11. The rest are dependent claims. Appellant requests that the dependent claims stand or fall with their associated base claim. That is, once the independent claims have been found to be allowable over the prior art, as discussed below, the dependent claims are deemed to further limit their

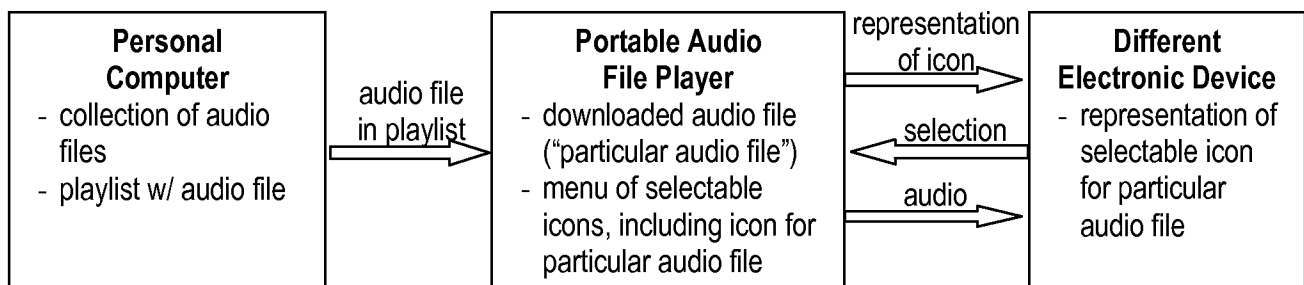
respective base claim, and for the same reasons as discussed with respect to the base claims, should also be considered allowable.

It is also noted that if the Board rules that claims 1 and 11 are patentable over the prior art as identified in the first six appeal issues, the latter two appeal issues are moot and do not require consideration.

VII. Argument

In addition to the summary provided above pursuant to 37 CFR 41.67(c)(1)(v), Appellant would like to emphasize and expand on some of the key claim elements that will be discussed in the following analysis.

Claim 1 refers to three different devices: a "personal computer," a "portable audio file player," and a "different electronic device."¹ The personal computer maintains "a collection of audio files." As recited in claim 1, a user can create a "playlist" and download audio files from the playlist to the portable audio file player. The portable audio file player has a "menu of selectable icons," where a particular icon is "linked to the particular audio file." The portable audio file player also includes instructions to provide a "selectable representation of the particular selectable icon" to the different electronic device. A user can select the icon on the different electronic device, which will cause the portable audio file player to begin playing the particular audio file. This is shown graphically, below.



¹ Claim 11 similarly refers to three devices: a "user computer system," a "portable media player," and a "different audio system." The two claims are similar in this regards, and the claim elements emphasized in this discussion will use the terminology of claim 1. In the following analysis, if/when there are significant differences between the claims, such difference will be separately discussed.

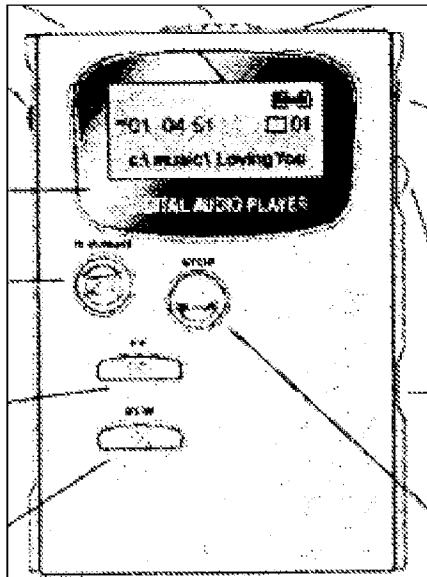
This three-device system presents a unique ecosystem, so to speak, by which a user can transfer an audio file from the personal computer to the different electronic device using the portable audio file player as an intermediary. Even further, the portable audio file player is a standalone device, in that it has a display and can present a menu of selectable icons to the user. The content on each device can be different. The personal computer can include a relatively large collection of audio files that it obtains from a network resource. The collection of audio files includes a particular audio file (from a playlist) that is downloaded to and stored on the portable audio file player. The portable audio file player includes a menu of selectable icons, including a selectable icon for the particular audio file downloaded from the personal computer, so that a user can select the particular audio file. The portable audio file player also provides a representation of this selectable icon to the different electronic device, which when selected by a user on the different electronic device, causes the portable audio player to start playing the audio.

As will be discussed below, none of the cited prior art shows a three device system, much less a three-device ecosystem as recited in claims 1 and 11 of the '926 patent. Instead, the pending rejections try to piece together general references to a personal computer, a personal music player (for the portable audio player), and a docking station or remote control (for the different electronic device) in an attempt to read on the claimed system. Said differently, the pending rejections do not modify the prior art by replacing one device with another equivalent device. Instead, the pending rejections use the claims of the '926 patent as a roadmap to piece together several prior art devices, including adding functionality to the devices not previously described, in an attempt to present an obviousness rejection. As the Board is well aware, this is not an appropriate basis for rejection and the claims should be found patentable over the prior art. The specific proposed rejections for the independent claims are discussed below.

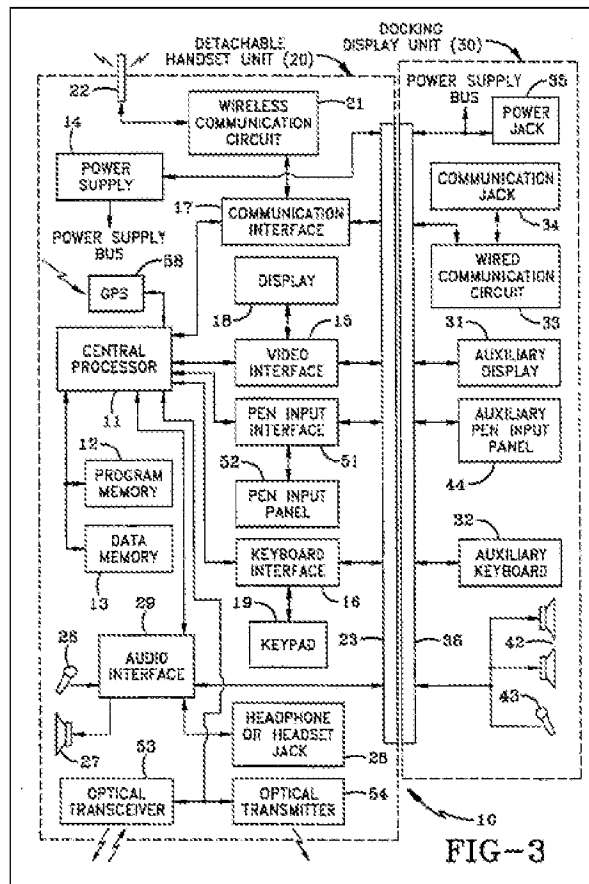
1. Claim 1 is patentable over Rio 500 in view of Kumar

Independent claim 1 stands rejected over Rio 500 in view of Kumar. Rio 500 is a "Getting Started Guide" for a system that includes a digital audio player and computer software. The software, called the RioPort Audio Manager, runs on a personal computer and downloads audio files to the digital audio player. The digital audio player is a relatively small and simple device that plays audio files through a headphone jack, and includes an LCD display that shows song/book title, artist, and time. Rio 500 at 1. Kumar describes a docking unit in which a detachable handset unit (like a laptop computer) can be docked. Kumar at Fig. 3 and 2:39. "For

applications requiring larger display and keyboard, the detachable handset unit is docked into the main unit, the docking display unit." Kumar at 2:44-45. Kumar's handset is a relatively sophisticated device, with enough computing power to both interface with network components on its own, drive a user interface display, and drive a secondary display on the docking unit. Kumar at 5:23-28. The combination of Rio 500 and Kumar fails for several reasons discussed below.



Rio 500, p. 1



Kumar, Fig. 3

Both Rio 500 and Kumar are only directed to two-device systems. As stated above, claim 1 of the '926 patent describes three devices: a "personal computer," a "portable audio file player," and a "different electronic device." Rio 500 describes two devices: a personal computer and a digital audio player. The digital audio player is described as a simple device that is controlled by the RioPort Audio Manager running on the personal computer. The handset unit in Kumar (which the Examiner compares to the claimed portable audio file player) is described as a stand-alone computer that connects to a network resource. Kumar at Fig. 3, #21, 22; 4:37-40. Kumar states: "The central processor, carried in the detachable handset unit, and being used to

operate the docking display unit, must have enough processing power to adequately perform functions of an entire portable computing, communication and entertainment device, and not just the functions of a wireless phone.” Kumar at 5:23-28.

In contrast, the claimed portable audio file player is an intermediate device of mid-level complexity. That is, the claimed portable audio file player is neither a simple device like the digital audio player of Rio 500, nor a stand-alone computer like the handset unit of Kumar. The claimed portable audio file player is not like the handset unit of Kumar because of its reliance on a personal computer. It receives audio files from the personal computer (claim 1 recites that the personal computer is to: “maintain a collection of audio files,” “initiate sending a request for a different audio file to a network based resource,” and “download an audio file included in the playlist from the personal computer to a portable audio file player.”). The claimed portable audio file player is also not like the digital audio player of Rio 500 because it includes the necessary processing and software power to drive a display of a different electronic device (claim 1 recites that the portable audio file player “communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon.”). That is, the only output of the Rio 500 is an audio output. Neither Rio 500 nor Kumar teaches a device like the claimed portable audio file player – an intermediate device that interfaces with two other devices (a personal computer and a different electronic device). Thus for this reason, claim 1 is patentable over these references.

Kumar does not teach presenting “a selectable representation of the particular selectable icon” from the handset to the docking station. Even further, the display on Kumar’s docking station is driven by the handset unit, and does nothing more than replicate the display of the handset unit being docked. Kumar at 4:31-32, 41-46; 5:16-28. In contrast, the claimed displays of the portable audio file player and the different electronic device present different items to the user. As stated in the claims, the display on the portable audio file player presents “an updateable user interface comprising a menu of selectable icons,” while the display on the different electronic device presents “a selectable representation of the particular selectable icon on the [portable audio file player’s] display.” Thus for this additional reason, claim 1 is patentable over these references.

Even if combined, the functionality of the combined system is performed in the wrong device. Claim 1 of the '926 patent recites that the portable audio file player perform local instructions to “maintain an updateable user interface comprising a menu of selectable icons” and “to modify the updateable user interface in connection with receiving a particular audio file from the personal computer such that a particular selectable icon is linked to the particular audio file.” The Examiner compares these claim elements to functionality of the RioPort Audio Manager, which is a program that is stored and runs on the personal computer, not the digital audio player. Thus for this additional reason, claim 1 is patentable over these references.

Kumar teaches away from their combination. Kumar recognizes that the display screen on handheld devices is too small. “[I]n order to allow handheld grasping these units had to be kept small, thereby limiting their display to a size that is too small for practical use in conventional computing such as Web browsing, word processing, etc. Also, to keep the cost of such devices low, their designers employed central processors that have just enough power to carry out smart phone functions, and not enough power to handle general computing requirements.” Kumar at 1:49-56. In response to this problem, Kumar teaches two things: (1) a docking station with a larger screen and keyboard than are on the handset (2:44-46); and (2) a handset with relatively large computing power to operate as a personal computer (2:31-34). As discussed above, the Rio 500 handset is intended to work with a separate personal computer. Accordingly, there is no reason to add a docking station to the Rio 500 digital audio player to make it behave like a personal computer because the Rio 500 system already has a personal computer. Thus for this additional reason, claim 1 is patentable over these references.

Relief Requested. In light of the arguments above, Appellant requests that the Board reverse the following rejections based on the combination of Rio 500 and Kumar:

- Claims 1-3, 5, 7, and 21-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rio 500 in view of Kumar.
- Claims 4 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rio 500 in view of Kumar, and further in view of RealJukeBox.
- Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rio 500 in view of Kumar, and further in view of Kaplan.

- Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of RealJukeBox, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of SoundJam, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of Chen, and further in view of the knowledge of a person of ordinary skill in the art.

2. Claim 1 is patentable over SoundJam in view of Rio 500 and Kumar

Independent claim 1 also stands rejected over SoundJam in view of Rio 500, in further view of Kumar. This rejection is essentially the same as the rejection discussed above, except SoundJam is provided to describe a software application that runs on a personal computer. SoundJam is similar to the RioPort Audio Manager on Rio 500, except that the reference provides more details of how the audio files are stored and maintained on the computer. SoundJam has nothing to do with any of the deficiencies discussed above. That is, the rejection still relies on Rio 500's digital audio player and Kumar's docking station. Thus for the same reasons discussed above with reference to Rio 500 and Kumar, claim 1 is patentable over SoundJam, Rio 500, and Kumar.

Relief Requested. In light of the arguments above, Appellant requests that the Board reverse the following rejections based on the combination of SoundJam, Rio 500, and Kumar:

- Claims 1-5, 7, and 21-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Kumar.
- Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, further in view of RealJukeBox, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view Kaplan.

- Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of RealJukeBox.

3. Claim 1 is patentable over SoundJam in view of Rio 500 and Naughton

Independent claim 1 also stands rejected over SoundJam in view of Rio 500, in further view of Naughton. SoundJam and Rio 500 are discussed above, and Naughton is used in place of Kumar. Naughton describes a universal remote control that includes a touch screen display “designed to control any compatible remote device such as thermostat 150, video cassette recorder 39, and stereo system 152.” Naughton at 7:18-20. The combination of SoundJam, Rio 500 and Naughton fails for several reasons discussed below, including many reasons similar to those discussed above with reference to Kumar.

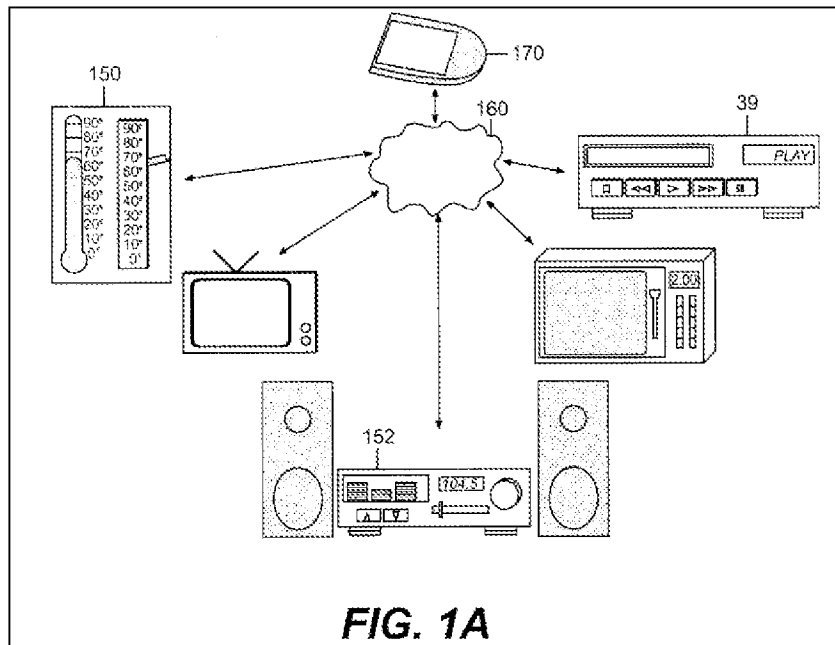


FIG. 1A
Naughton, Fig. 1A

Naughton, like Rio 500 and SoundJam, is only directed to a two-device system. As stated above, claim 1 of the ‘926 patent describes three devices: a "personal computer," a "portable audio file player," and a "different electronic device." The portable audio file player acts as an intermediate device between the personal computer and the different electronic device, thereby making a three-device system. In contrast, Naughton teaches a two-device system, in

that the hand-held display device 170 (remote control) controls an end device like a stereo system 152. There is no personal computer that also communicates with the stereo system so that an audio file will be transferred from it to the stereo. Thus, Naughton fails to teach a three-device system as recited in claim 1, and for this reason, the claim is patentable over these references.

Even if combined, the functionality of the combined system is performed in the wrong device. This is so, for the same reasoning as discussed above with reference to Rio 500. Claim 1 of the '926 patent recites that the portable audio file player perform local instructions to “maintain an updateable user interface comprising a menu of selectable icons” and “to modify the updateable user interface in connection with receiving a particular audio file from the personal computer such that a particular selectable icon is linked to the particular audio file.” The Examiner compares these claim elements to functionality of the RioPort Audio Manager, which is a program that is stored and runs on the personal computer, not the digital audio player. Thus for this additional reason, claim 1 is patentable over these references.

Naughton teaches away from their combination. As shown in Fig. 1a of Naughton reproduced above, the hand-held display device 170 of Naughton is used to remotely control relatively large or fixed devices, like a television or stereo system. There is no reason to remotely control the digital audio player of Rio 500, because it is already a hand-held device (that is, both devices, Naughton and Rio 500, are handheld devices). Also, the Rio 500 digital audio player uses headphones, which means that a user must already have the device handy. Instead, it would make more sense for the Naughton device to remotely control a personal computer such as described in Rio 500 or SoundJam, totally bypassing the digital audio player.² Thus for this additional reason, claim 1 is patentable over these references.

Relief Requested. In light of the arguments above, Appellant requests that the Board reverse the following rejections based on the combination of SoundJam, Rio 500, and Naughton:

- Claims 1, 2, 4, 5, 7, 22, 23, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Naughton.
- Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, further in view of

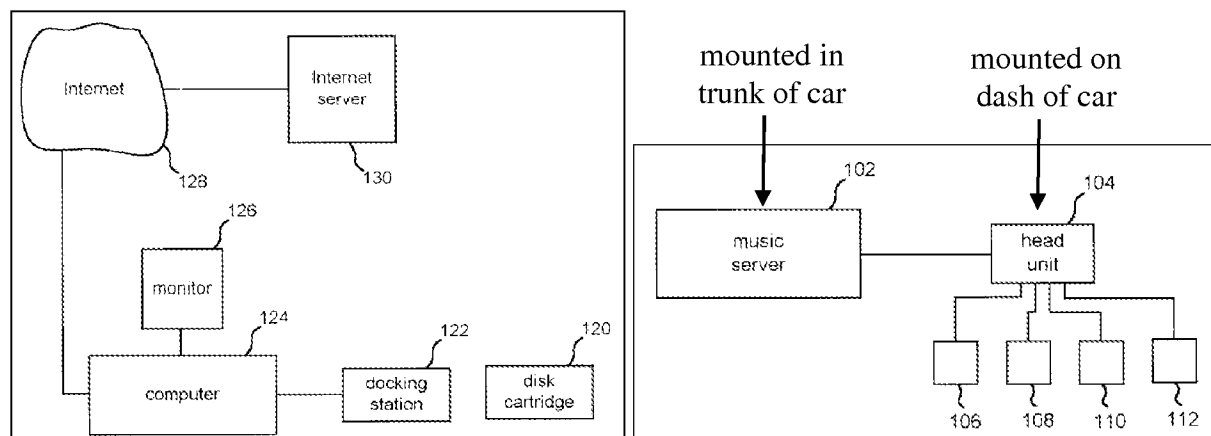
² Which, of course, would fail to read on the claims for other reasons.

RealJukeBox, and further in view of the knowledge of a person of ordinary skill in the art.

- Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of Kaplan.
- Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of RealJukeBox.
- Claims 3 and 21-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of Abecassis.

4. Claims 1 and 11 are patentable over Lau in view of Naim and Lee

Independent claims 1 and 11 stand rejected over Lau in view of Naim, in further view of Lee. Lau describes two devices: (1) a computer 124 that is able to obtain and download audio data over the Internet 128 and store it onto a group of CDs (a “disk cartridge”) 120; and (2) a car audio/video system that includes a “music server” 102 which operates as a CD player/changer mounted in the trunk of a car, and a “head end unit” 104 that is mounted inside the dashboard of the car. Lau at Fig. 1; and 5:1-15. The Examiner uses Naim and Lee for additional claim elements directed to the claimed portable audio file player and different device, respectively. The combination of Lau, Naim, and Lee fails for several reasons discussed below.



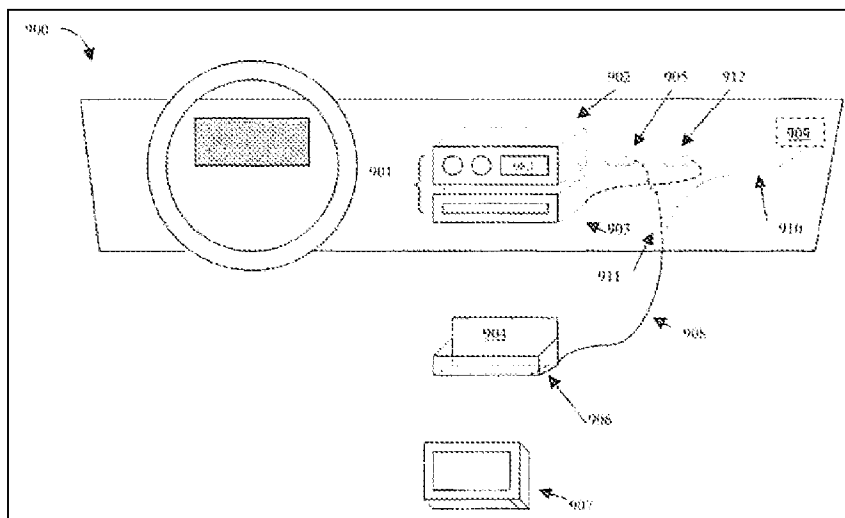
Lau, Fig. 1

Lau’s music server is not a portable audio file player. There are several reasons why Lau’s music server 102, which operates as a CD changer for the head unit 104, is not a portable audio file player. For one, it is not portable. The Examiner states: “An item that is ‘portable’ is generally recognized as something that is capable of being carried or moved about.” RAN at 14. The Examiner then appears to contradict his own definition when he states: “Lau’s music server 102, by all accounts, constitutes a ‘portable audio file player’ since it is small enough to be mounted in the trunk of an automobile.” RAN at 15, emphasis added. However, the fact that the unit is mounted negates any size considerations--the music server 102 is not portable. That is, a mounted music server is not a portable audio file player, and for this reason, claims 1 and 11 are patentable over these references.

Secondly, the music server 102 lacks many of the elements of the portable audio file player recited in the claim, such as “an updateable user interface comprising a menu of selectable icons.” The Examiner recognizes that Lau’s music server 102 is missing these elements, but states such would be obvious to add them in view of Naim. RAN at 16-17. The Examiner’s position is unreasonable. There is no reason why a music server mounted in the trunk of an automobile would have a display with a menu of selectable icons. Further, Lau never describes any user interaction with the music server. Thus, there is no reason to modify Lau’s music server to include a display for a menu of icons, and for this additional reason, claims 1 and 11 are patentable over these references.

Thirdly, the ‘926 patent distinguishes a mounted CD player device from a portable audio file player. As shown in Fig. 9 from the patent, reproduced below, an automobile “[c]onsole 900 includes a conventional audio system 901 comprised of a receiver 902 and CD player 903.” ‘926

patent at 17:13-14. The CD player 903, which is like Lau’s music server, is distinguished from the portable audio file player 907, which connects to the receiver 902 via interface 904, because the CD player is mounted in the car. Thus, the broadest reasonable interpretation in light of the specification³ requires that a mounted CD player, like Lau’s music server, is not a portable digital audio player, and for this additional reason, claims 1 and 11 are patentable over these references.



‘926 patent, Fig. 9

Lau is only directed to a two-device system. As stated above, claims 1 and 11 of the ‘926 patent describe three devices: a personal/user computer, a portable audio file/media player, and a different electronic/audio device (claims 1/11, respectively). Lau teaches a car audio system that includes a “music server” 102 which operates as a CD player/changer mounted in the trunk of a car, and a “head end unit” 104 that is mounted inside the dashboard of the car. Lau at Fig. 1; and 5:1-15. This car audio system is a single device, just like the separate receiver and CD player of the ‘926 patent is a single device. Thus, Lau is missing the intermediate device – the portable audio file player that includes a display and for this reason, claims 1 and 11 are patentable over these references.

Even if combined, the functionality of the combined system is performed in the wrong device. This is so, as discussed above with reference to Rio 500. Claim 1 of the ‘926 patent recites that the portable audio file player perform local instructions to “maintain an updateable user interface comprising a menu of selectable icons” and “to modify the updateable user

³ MPEP 2111, citing *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

interface in connection with receiving a particular audio file from the personal computer such that a particular selectable icon is linked to the particular audio file.” Claim 11 includes similar elements. The Examiner compares these claim elements to functionality that runs on the personal computer, not the digital audio player. Specifically, this functionality is compared to GUI 1200 of Lau, which is presented on the personal computer and not the music server.⁴ Thus for this additional reason, claim 1 is patentable over these references.

Relief Requested. In light of the arguments above, Appellant requests that the Board reverse the following rejections based on the combination of Lau, Naim, and Lee:

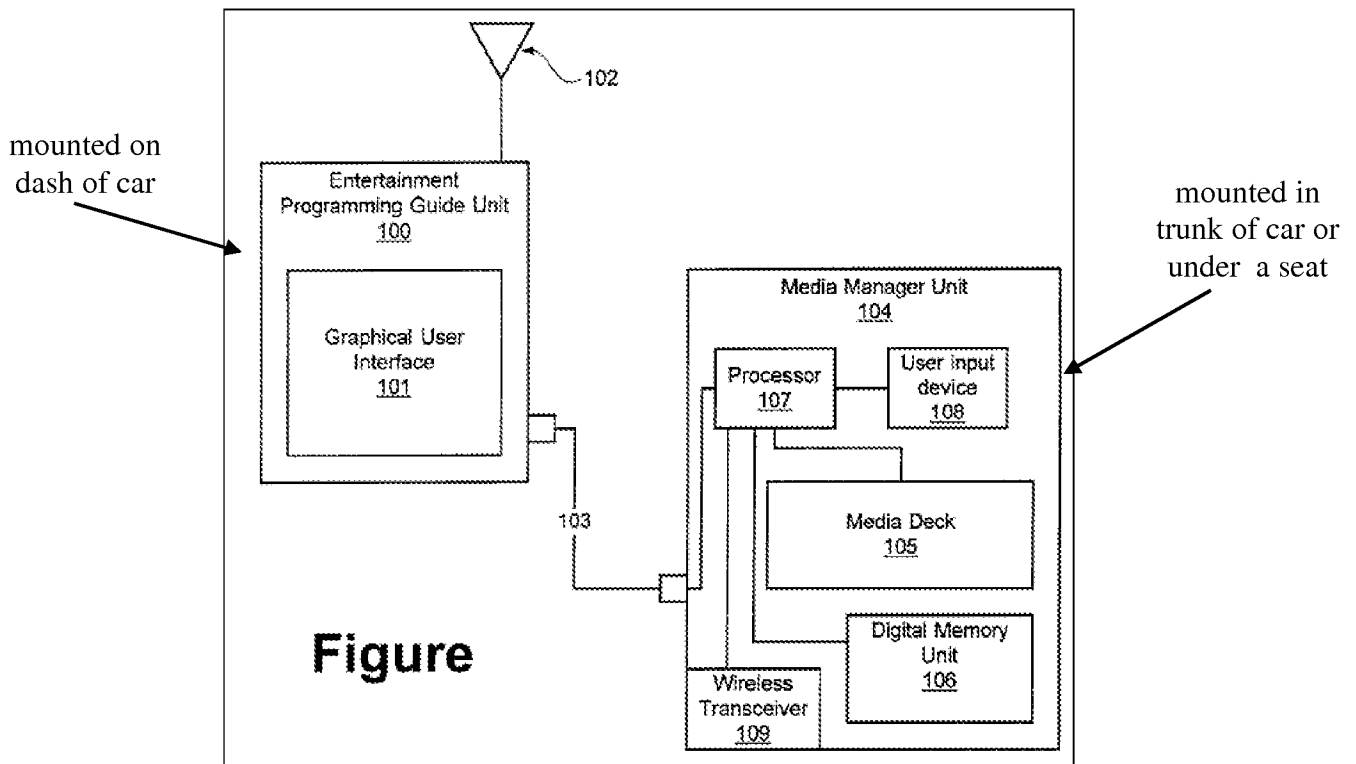
- Claims 1-5, 7, 10-12, 16, 18, and 21-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Naim, and further in view of Lee.
- Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Lau in view of Naim, further in view of Lee, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over SoundJam in view of Lau in view of Naim, further in view of Lee, further in view of Dwyer, and further in view of the knowledge of a person of ordinary skill in the art.
- Claims 8, 14, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, and further in view Kaplan.
- Claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of Chen, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of Van Zoest.
- Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of Dimenstein.

⁴ RAN at 31-33, cites to the Request Exhibit CC-EE. For the “menu of selectable icons” claim element, Exhibit CC-EE refers to a GUI 1200 that runs on the personal computer, not the music server. Exhibit CC-EE at 11-12. It is noted that Lau mentions that “playlists” can be created on the personal computer or the music server (18:11-18), but playlists are not the same as the menu of selectable icons. Claim 1 refers to both playlists and a menu of selectable icons, the former being on the personal computer and the latter on the portable audio file player.

- Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of Leeke, and further in view of Kumar.

5. Claims 1 and 11 are patentable over Van Zoest in view of Gioscia and the knowledge of a person of ordinary skill in the art

Independent claims 1 and 11 stand rejected over Van Zoest in view of Gioscia, in further view of the knowledge of a person of ordinary skill in the art. Van Zoest is like SoundJam discussed previously, in that it describes a user interface on a computer capable of downloading and managing audio files. Gioscia is like Lau, discussed earlier, in that it describes a car audio system that includes a “media management unit” 104 which stores music and is “placed in a less visible location where more space is available such as in the car’s trunk or under a seat,” and a “programming guide unit” 100 that “might be incorporated into the automobile’s control console or dashboard, or placed where the driver/listener can access it.” Gioscia at Fig.; and 3:5-15. The combination of Van Zoest and Gioscia fails for several reasons discussed below, which are similar to those discussed above with reference to Lau.



Gioscia, Figure

Gioscia's media manager unit is not a portable audio file player. There are several reasons why the media manager unit 104, which stores CDs, MDs, or cassette tapes (3:64) is not a portable audio file player. For one, it is not portable. The media manager unit is placed in the car's trunk or under a seat. 3:15. It is noted that Gioscia does mention a portable "boom box" embodiment, but in this embodiment, the media manager unit 104 and the programming guide unit 100 are combined "into a single unitary housing." 3:19. The boom box embodiment emphasizes the fact that this is a single, unitary system. In the car embodiment, the two components are in separate housings "so that they can be physically displaced from each other." 3:9-10. In both embodiments, Gioscia describes a single audio system, and for this reason, claims 1 and 11 are patentable over these references.

Also, and as previously discussed above, the '926 patent distinguishes an audio system with a receiver and a separately mounted CD player device from a portable audio file player. Specifically and as shown in Fig. 9 from the '926 patent reproduced above, an automobile "[c]onsole 900 includes a conventional audio system 901 comprised of a receiver 902 and CD player 903." '926 patent at 17:13-14. That is, the console 900 with the separate receiver and CD player is still the "different electronic device" as cited in the claim. Thus, the broadest reasonable interpretation in light of the specification requires that a mounted CD player, like Gioscia's media manager unit, is not a portable digital audio player, and for this additional reason, claims 1 and 11 are patentable over these references.

Gioscia's media manager unit 104 lacks many of the elements of the claimed portable audio file player. The media manager unit lacks such things as a "display" and "an updateable user interface comprising a menu of selectable icons." For these claim elements, the Examiner refers to the programming guide unit 100, which the Examiner compares to the claimed different electronic device.⁵ This is the wrong device – the claims recite these elements to be on the portable audio file player. Further, there is no reason to add these elements to Gioscia's media manager unit because it is mounted in the trunk or under the seat of a car.⁶ Thus, this element is

⁵ RAN at 31-33, cites to the Request Exhibit CC-NN. For the "menu of selectable icons" claim element, Exhibit CC-NN refers to the graphical user interface 101 that runs on the programming guide unit 100. Exhibit CC-NN at 40.

⁶ As mentioned above, Gioscia also mentions a boombox embodiment, but there would be no reason to have two displays on such embodiment.

missing altogether, and for this additional reason, claims 1 and 11 are patentable over these references.

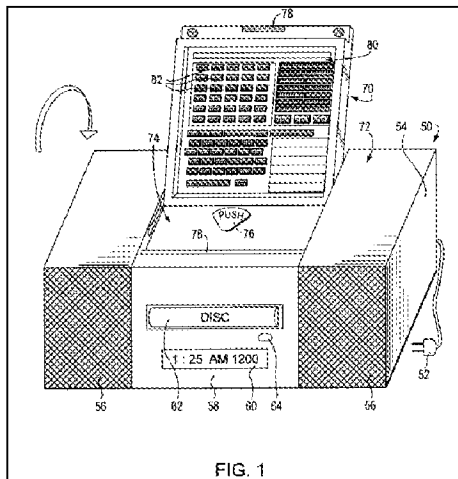
Relief Requested. In light of the arguments above, Appellant requests that the Board reverse the following rejections based on the combination of Van Zoest, Gioscia and the knowledge of a person of ordinary skill in the art:

- Claims 1, 2, 4-8, 10-14, 17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Kumar.
- Claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of SoundJam.
- Claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Chen.
- Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Rio 500.
- Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Leeke.
- Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Dimenstein.

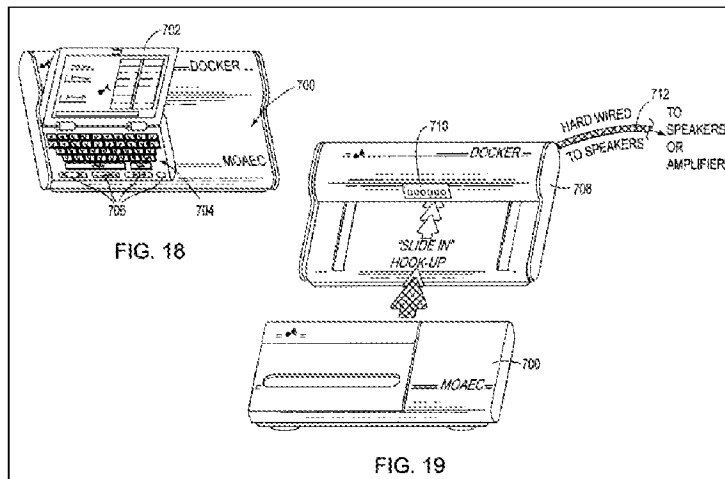
6. Claims 1 and 11 are patentable over Looney in view of Dwyer and Kumar

Independent claims 1 and 11 stand rejected over Looney in view of Dwyer, in further view of Kumar. Looney describes several alternate embodiments of a “music organizer and entertainment center.” The embodiments include a “personal computer” (4:42-43), a “laptop” computer (5:13-14), and a dockable “main data unit” device “that can include the music data for

the system and can be moved from location to location” (12:44-58). In this manner, Looney is like SoundJam discussed above, in that it describes a computer that can download and organize music, and provide a graphical user interface. Dwyer describes a “portable digital voice recorder” for the storing and playback of voice recordings. Dwyer at 3:18-24 and 49-53. Kumar, as discussed above, provides a docking station for a detachable handset unit, like a laptop computer. Kumar at 2:39-45. The combination of Looney, Dwyer, and Kumar fails for several reasons discussed below.



Looney, Fig. 1



Looney, Figs. 18-19

Looney does not teach a portable audio file player. The present rejection compares Looney’s music organizer and entertainment center device, as shown in FIG. 1 above, to the claimed personal computer, stating that it maintains a collection of audio files, allows a user to create a play list, and provides a graphical user interface (GUI) for the user.⁷ The rejection also compares Looney’s music organizer and entertainment center device to the claimed portable audio file player, stating that it maintains an updateable user interface comprising a menu of selectable icons.⁸ It appears that the proposed rejection is using the different embodiments of Looney’s same device to read on different devices in the claims. That is, Looney describes one embodiment of the device as part of a personal computer, which the rejection maps to the claimed personal computer; and Looney describes an alternate embodiment of the same device as a dockable unit, which the rejection maps to the portable audio file player. To be clear, these

⁷ RAN at 34-35, cites to the Request Exhibit CC-UU. See Exhibit CC-UU at 2 and 5-9.

⁸ *Id.*, See Request Exhibit CC-UU at 9-15.

are not two separate devices, but instead Looney states that these are different, alternative embodiments of the same device.⁹

It is noted that the rejection relies on Looney in the section of the claim directed to the portable audio file player. However, the rejection does mention Dwyer of the portion of the claim describing downloading the audio file from the personal computer to the portable audio file player.¹⁰ At most, Dwyer is similar to the digital audio player of Rio 500, and fails to meet the majority of claim element directed to the portable audio file player, such as maintaining a menu of selectable icons. Thus for this reason, claims 1 and 11 are patentable over these references.

There is still no prior art reference that teaches a three-device system. As stated above, claims 1 and 11 of the '926 patent describes three devices: a personal/user computer, a portable audio file/media player, and a different electronic/audio device (claims 1/11, respectively). Looney teaches a single music organizer and entertainment center device. Dwyer teaches a single voice recorder. Kumar (which is discussed extensively above) teaches a docking station for an intelligent handheld device. None of these references teach a three-device system, and combining and modifying these units, nor is there any reason to make such combination. For example, if Dwyer's device is considered the portable audio file player, there is no reason for it to be dockable with both Looney's music organizer and entertainment center device and Kumar's docking station. For this additional reason, claims 1 and 11 are patentable over these references.

Even if combined, the functionality of the combined system is performed in the wrong device. This is a similar argument as discussed above with reference to Rio 500. Claim 1 of the '926 patent recites that the portable audio file player perform local instructions to "maintain an updateable user interface comprising a menu of selectable icons" and "to modify the updateable user interface in connection with receiving a particular audio file from the personal computer such that a particular selectable icon is linked to the particular audio file." Claim 11 includes

⁹ "FIG. 1 is a perspective view of an exemplary music organizer and entertainment center according to an embodiment of this invention; ... FIGS. 18 and 19 are perspective views of an exemplary music organizer and entertainment center according to an alternate embodiment of this invention utilizing a base unit and docking principle." Looney at 3:21-23 and 4:3-7, emphasis added.

¹⁰ Request Exhibit CC-UU at 4.

similar elements. The Examiner compares these claim elements to functionality that runs on Looney's music organizer and entertainment center device – which as discussed above is also being compared to the claimed personal computer. That is, there is only one device in the proposed combination that presents a playlist or icons to the user – Looney's device. To the extent the Examiner argues that one would put all of Looney's functionality onto Dwyer's personal voice recorder, the voice recorder ends up being the same thing as Looney's device. Thus for this additional reason, claims 1 and 11 are patentable over these references.

Relief Requested. In light of the arguments above, Appellant requests that the Board reverse the following rejections based on the combination of Looney, Dwyer, and Kumar:

- Claims 1-5, 10-12, 16, 21-27, and 32-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, and further in view of Kumar.
- Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of the knowledge of a person of ordinary skill in the art.
- Claims 8, 14, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Kaplan.
- Claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, further in view of SoundJam, and further in view of the knowledge of a person of ordinary skill in the art.
- Claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, further in view of Chen, and further in view of the knowledge of a person of ordinary skill in the art.
- Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Van Zoest.
- Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Rio 500.
- Claims 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Leeke.

- Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Dimenstein.
- Claims 28, 29 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Looney in view of Dwyer, and further in view of Kumar, and further in view of Leeke or Kaplan.

7. Claims 1-37 of the '926 patent are entitled to the priority date of Mar. 28, 2000, the filing date of parent U.S. Pat. No. 7,187,947.

Upon a finding of validity of the claims in view of the above-listed prior art, a determination of the priority date of the claims of the '926 patent is moot. If one or more of the above-listed rejections are affirmed, then the priority date of the claims should be addressed. Specifically, both Kumar and Van Zoest do not qualify as prior art when the claims of the '926 patent are given their appropriate priority date, and all rejections based on these references should be withdrawn.

a. The Examiner is not authorized to consider the written description issue in this reexamination.

The '926 patent is a continuation of U.S. Pat. No. 7,187,947 ("parent '947 patent"), which has a filing date of March 28, 2000. As codified in 37 C.F.R. §1.906, an examiner in an *inter partes* reexamination is not permitted to reexamine original patent claims on the basis of 35 U.S.C. §112.

§1.906 Scope of reexamination in *inter partes* reexamination proceeding.

(a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with *respect to subject matter added or deleted in the reexamination proceeding*, on the basis of the requirements of 35 U.S.C. 112. ...

(c) *Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an inter partes reexamination proceeding.* If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

(37 C.F.R. §1.906, emphasis added)

In the present *inter partes* reexamination as to original claims 1-20, no subject matter has been added or deleted that could prompt an examination under 35 U.S.C. §112. The claims at issue in this include original claims which may only be reexamined on the basis of prior art

patents and printed publications (and there was no analysis undertaken as to dependent claims 21-37 in the RAN).

With improper reliance on MPEP 2617, the Examiner has conducted a §112, first paragraph analysis that is impermissible under the circumstances of the present reexamination. The only two cases cited in MPEP 2617 as support for allowing consideration of later references deal with continuation-in-part applications. In these cases, priority was a question because the continuation-in-part applications had specifications that clearly included new subject matter that was added at the time of the filing of the continuation-in-part application. Therefore, an investigation into with whether the claims at issue were supported by the original filing date or by the filing date of the new subject matter was proper. In contrast, the **'926 patent did not issue from a continuation-in-part application**. The specification of the '926 patent is substantially identical to the specification originally filed on March 28, 2000 so there is no question of priority. The Office has previously determined that with respect to “a continuation patent containing essentially the identical disclosure set forth in each of the parent patent(s),” reassessment of priority claims in a reexamination is “precluded by statute.” *In re Fischell*, 90/007,355, Decision on Petition dated June 30, 2005, p. 4; see also *In re Rheault et al.*, 95/000,179, Decision on Petition dated March 8, 2007, p. 5-6; *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 37 (D.D.C. 1988).

Thus, as a matter of law, the Examiner is precluded from reassessing the priority date of the '926 patent and all prior art determinations must be based upon the March 28, 2000 filing date of the parent application. Consequently, many of the current rejections that rely upon at least one reference that is not prior art to the March 28, 2000 priority date, should be withdrawn.

b. §112 Compliance was determined during the original prosecution.

It is impermissible for a reexamination Examiner to reconsider an issue that was decided by the original Examiner. “[M]atters that were decided in the original examination [are] barred from reexamination: [This] requirement [protects] patentees . . . [and acts] to bar reconsideration of any argument already decided by the Office, whether during the original examination or an earlier reexamination.” *In re Recreative Technologies Corp.*, 83 F.3d 1394 (Fed. Cir. 1996)(citing H.R. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6466)).

Furthermore, MPEP §2642 prohibits the finding of a substantial new question of patentability where “[t]he same question of patentability as to the claim has . . . been decided by the Office in a previous examination.” The Examiner in the original prosecution of the ’926 patent necessarily considered §112 written description support – one of the threshold statutory requirements in determining claim allowance. This written description consideration was especially necessary in the original prosecution of the ’926 patent because the issued claims were not the original claims of the patent application. Rather, the claims of the ’926 patent resulted from a prosecution in which claims were amended several times. Thus, §112 was a necessary part of the original prosecution and cannot be reconsidered here.

c. The written description of the ’812 application fully supports the claims of the ’926 patent.

As explained above, the law clearly establishes that only pre-March 28, 2000 references are permissible prior art patents or publications. At pages 4-6 of the RAN, the Examiner argues that the following claim element is not supported by the specification of the parent ’947 patent, and as a result thereof, the claims of the ’926 patent are not entitled to priority to the parent ’947 patent.

the processor [of the portable audio file player] to communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display

Claim 1 of the ’926 patent at 18:27-38.¹¹ The parent ’947 patent supports this claim element, as discussed below.

The claims of the parent ’947 patent are directed to a “cellular communication device” which is similar to the claimed “portable audio file player” of the ’926 patent. Issued claim 1 of the parent ’947 patent recites that the cellular communication device include:

a processor ... configured to ... output a digital representation of the audio information; ...and an interface configured to releasable engage with a docking mechanism of a separate sound system such that ... the digital representation can be communicated to the separate sound system via the interface.

Claim 1 of the parent ’947 patent at 19:39-42, 45-50. Thus, both patents describe the device communicating a “digital representation of the audio information” or a “selectable representation

¹¹ The Examiner states that “[s]ubstantially the same reasoning and analysis for claim 1, above, applies to claim 11 with respect to the issue of priority.” RAN at 6

of the particular selectable icon” to a different device, and accordingly, the parent ‘947 patent supports this claim element of the ‘926 patent.

Likewise, the specification of the parent ‘947 patent describes this claim element.

In another embodiment, electronic device 300 may be operable as a PDA and/or a cellular phone that may be mounted to an automobile's console. Electronic device 300 may then integrate with a user's automobile to provide an all-encompassing communications device. For example, electronic device 300 configured as a PDA and cellular phone may allow for communication with a user's email account, voice mail account, the Internet, as well as allowing for the receipt of selected audio information via wireless communication. Electronic device 300 may be operable in a hands-free mode allowing a user to maintain safe driving fundamentals. During use, electronic device 300 may be processing selective audio information for communicating with an automobile audio system and may further be operating to receive incoming cellular calls.

’926 patent, 9:21-35 The portable audio file player and the different electronic device are configured such that a user of the different electronic device (e.g., user of an automobile stereo) can connect the portable electronic device to the different electronic device. Examples of such a connection are described:

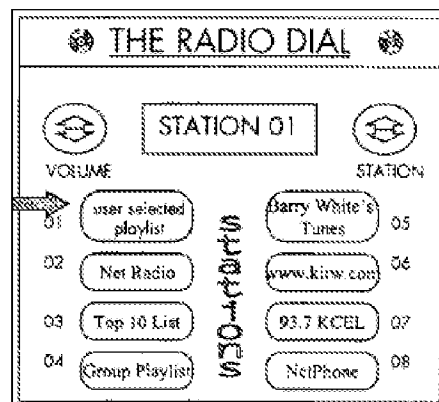
FIG. 5B illustrates automobile console having a mount for coupling an electronic device according to one aspect of the present invention. Console 510 includes mount 511 operable to receive electronic device 512. Mount 511 may be located in many different locations within an automobile such as coupled to a sun visor, center console, dashboard, floorboard, etc. Mount 511 allows the user to couple electronic device 512 to the automobile and provide an interface for communication between electronic device 512 and the automobile audio system. Mount 511 may also include a power connection that allows electronic device 512 to use the automobiles power during use. The power connection may also be used in association with a recharging circuit operable to recharge a power supply within the electronic device. During operation, electronic device 512 coupled to mount 511 may receive selected audio information via wireless communication and communicate the selective information to the automobile audio system.

’926 patent, 12:1-18. Once the portable audio file player and the different electronic device are connected, the different device can display a menu of descriptive information associated with audio files on the portable hand-held device. This menu is presented on the different electronic device (e.g., the automobile stereo) as a graphical user interface (GUI), and the user can navigate through the GUI. The use of GUIs is introduced by the specification as follows:

FIG. 4 illustrates a graphical user interface (GUI) for displaying selectable audio information according to one aspect of the present invention. The GUI may be operable with a computer system, cellular device, PDA, or other electronic devices or systems operable to display the GUI of FIG. 4.

'926 patent, 9:52-56.

The patent refers to the operation of an “electronic device,” which corresponds with the claimed “portable audio file player.” The electronic device can display a “radio dial” which corresponds with the claimed “menu of selectable icons.” '947 patent at 12:40-48; see also, Fig. 4, below.

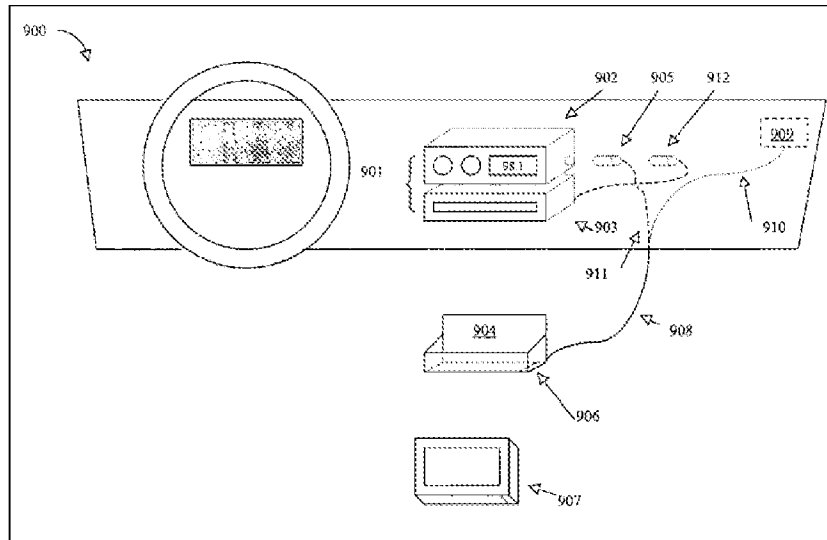


Parent '947 patent, Fig. 4 (partial)

The parent '947 patent further teaches that the electronic device can communicate information to a conventional radio receiver (which corresponds to the claimed “different electronic device”). '947 patent at 9:58-60.

Electronic device 300 communication of the wirelessly received information allows a conventional receiver to receive the selected audio information. In one embodiment, the conventional receiver may be configured to receive a digital sub-carrier, on-carrier, or other within a specified frequency. Therefore, electronic device 300 may be operable to locally transmit the signal at a specific frequency thereby allowing the conventional receiver to receive the information.

Parent '947 patent at 9:63-10:4. Fig. 9 from the patent, reproduced below, shows the electronic device (labeled #907 in this figure) providing a “selectable representation of the particular selectable icon.”



Parent '947 patent, Fig. 9

The specification further describes how the Radio Dial may be used by multiple different devices:

Radio dial 412 may also be displayed as a separate user interface and in some embodiments, does not require a "browsing" environment to view radio dial 412. For example, an electronic device, such as a PDA, having a display may graphically present radio dial 412 to a user. One example may be using electronic device in association with an automobile audio system. Electronic device may display radio dial 412 and may allow a user to navigate, modify, select, adjust volume, access daytimer, access phone lists, etc. or perform other functions while the electronic device is used in association with an automobile sound system. Therefore, radio dial 412 may be operable as an application for use with several different types of electronic devices (i.e., computer systems, portable computing devices, cellular phones, etc.) operable to display radio dial 412 and in come [sic] embodiments may be wirelessly communicated to an electronic device.

'926 patent, 11:11-26. Thus, in view of this and other related disclosure found in both the '926 patent and the original '812 application specification (which issued as the parent '947 patent), the inventors were clearly in possession of the claim limitation in which at least some of an information collection is communicated from a portable hand-held device to a different electronic device to allow a user to view a soft button including a name. For the reasons provided, the current rejections that rely upon a reference that is not prior art to the March 28, 2000 priority date of the '926 patent, should be withdrawn.

Thus, the claims of the '926 patent should have a priority date of March 28, 2000, the filing date of the parent '947 patent, and accordingly, the claim rejections based on Kumar and/or Van Zoest, including those of issues 1, 2, 5 and 6, above should be withdrawn.

8. Secondary considerations provide strong evidence of non-obviousness.

The above discussion establishes that the claims of the '926 patent are indeed nonobvious. As further support for the continued patentability of the claims, the Appellant provided significant evidence of secondary considerations of nonobviousness during the reexamination proceeding.

As stated several times above, the claims describe a three-device system, where the interface on each of the devices is different from each other. Synergistically, these claimed devices establish an entire ecosystem that is built around a portable music player (e.g., a standalone Apple iPod device or as incorporated into an Apple iPhone cellular phone), a software application for execution on a personal computer (e.g., the well known Apple iTunes application) and a network resource (e.g., the Apple iTunes Store) for downloading music and other content.

This is thus same ecosystem that was adopted by the Apple iTunes and iPod environment -- which the evidence established clearly infringes at least the independent claims of the '926 patent, White Decl. ¶¶7-10, Exs. E and G. It is also undisputed that these devices and the ecosystem that supports them have been wildly successful. As of September 2010, over 270 million iPods have been sold, and over 10 billion songs have been downloaded from the iTunes Store. White Decl. ¶¶ 17, 20-22; Exs. M, P, Q, R. This unprecedented success is directly attributable to the features described and claimed in the '926 patent, including the applications for execution both on a personal computer and a portable device to provide for updatable user interfaces, and the interface with the different electronic device.

The iPod was not the earliest portable music player, nor does it distinguish over other players in terms of performance, form factor and so forth. White Decl. ¶14. Instead, it is the "tight integration" between the iPod and the iTunes ecosystem (by way of the iTunes application for personal computer and iTunes Store) that drives sales. White Decl., ¶13, Ex. K. In other words, it is "the power of the ecosystem that Apple managed to put together. Or as is often said, the power of the whole was greater than the sum of its parts." White Dec., ¶12, Ex. J.

These synergistic effects provided by the integration of all three devices described in claims 1 and 11 of the '926 patent lead to the commercial success and thus a clear nexus exists. MPEP 716.02(a)(1). By the interaction of the elements of the independent claims, this ecosystem has been realized. Accordingly, this evidence of secondary considerations of nonobviousness is overwhelming and further supports the continued patentability of the claims of the '926 patent.

Conclusion

In accordance with 37 C.F.R. § 41.20(b)(2) the Appeal Brief fee of \$620.00 is being paid by Deposit Account No. 20-1504. The Commissioner is hereby authorized to charge any additional fees deemed necessary for this Respondent Brief to Deposit Account No. 20-1504 (AFF.0004B6).

Respectfully submitted,

/Mark J. Rozman/

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VIII. CLAIMS APPENDIX

The following claims are to be reviewed on appeal:

1. A content delivery system, comprising: a software application configured for storage on a storage medium of a personal computer, the software application further configured to maintain a collection of audio files saved locally to the personal computer, to allow a user to create a playlist, to initiate a downloading of an audio file included in the playlist from the personal computer to a portable audio file player, to initiate sending a request for a different audio file to a network based resource, to receive the different audio file, to locally save the different audio file at the personal computer, and to initiate presentation of a graphical user interface (GUI) at the personal computer, wherein the GUI is configured to operate as a user interface for the network based resource, further wherein the GUI is configured to present a collection of selectable functions associated with audio information; the portable audio file player having a processor, a display, and a memory configured to store a plurality of audio files; and a collection of instructions saved locally at the portable audio file player, the collection of instructions operable to direct the processor to maintain an updateable user interface comprising a menu of selectable icons, to modify the updateable user interface in connection with receiving a particular audio file from the personal computer such that a particular selectable icon is linked to the particular audio file, to initiate presentation of the menu on the display, to communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display.
2. The system of claim 1, wherein the portable audio file player comprises a physical interface through which: (1) the portable audio file player communicates the data used to create the selectable representation; and (2) the different electronic device communicates a signal to begin playing the particular audio file at the portable audio file player in connection with the user selecting the selectable representation from the associated display.
3. The system of claim 1, wherein the portable audio file player is operable as a wireless telephone.

4. The system of claim 1, wherein the software application is a non-browser application.
5. The system of claim 1, wherein the network based resource is accessible via an Internet website.
6. The system of claim 1, wherein the software application is further operable to direct the personal computer to communicate a playlist created at the personal computer to the network based resource such that the playlist is available to a plurality of remote computers having access to the network based resource.
7. The system of claim 1, wherein a web browser is utilized by the personal computer to access the network based resource.
8. The system of claim 1, wherein the GUI is further configured to present a selectable link including the word "store", wherein a selection of the selectable link navigates a user to a portion of the network based resource that allows the user to purchase a song file.
9. The system of claim 1, wherein the GUI is further configured to present a selectable link for sending a song file to a friend, wherein a selection of the selectable link by a first user allows the first user to allow a second user to listen to the song file.
10. The system of claim 1, wherein the GUI is configured to operate as the user interface for the network based resource without an active browsing environment.
11. A content delivery system, comprising: a network based resource accessible by a user computer system, the network based resource maintaining a plurality of selectable songs formatted in a digital format; an application configured to execute at the user computer system, the application operable to direct the user computer system to communicatively couple with the network based resource to allow user selection of an audio file from the network based resource, to receive the audio file, to locally save the audio file, and to initiate presentation of a graphical user interface (GUI) at the user computer system; the GUI configured to present a collection of selectable functions associated with audio information, the selectable functions comprising: a song purchase function; a song search function, a playlist creation function; and a naming function that allows a user to assign a user-defined name to a given playlist; and a different

application configured to execute at a portable media player, the different application operable to direct the portable media player to receive the user-defined name, to associate the user-defined name with at least one audio file, and to communicate data representing the user-defined name to a different audio system to allow the different audio system to present a soft button comprising the user-defined name on an associated display of the different audio system.

12. The system of claim 11, further comprising: the user computer system configured to execute the application; a display coupled to the user computer system and operable to present the GUI; and a portable device mount coupled to the user computer system, the portable device mount configured to mate with the portable media player and to communicatively couple the portable media player and the user computer system such that the a digital representation of the locally saved audio file can be communicated to the portable media player from the user computer system.

13. The system of claim 11, wherein the application comprises a library portion that utilizes an XML-based format.

14. The system of claim 11, wherein the GUI comprises a store link such that a user can utilize the application to purchase items via the network based resource.

15. The system of claim 11, wherein the GUI comprises a send a friend a link icon.

16. The system of claim 11, wherein the application comprises a search engine that allows a user to search for a specific audio file by at least one of an artist criteria and a song title criteria, further wherein a portion of firmware comprises the different application.

17. The system of claim 11, wherein the GUI comprises a top ten portion presenting a series of top ten lists based on different polls.

18. The system of claim 11, wherein the application comprises an online radio broadcast portion that allows a user to select a specific online radio station stream to be communicated to the user computer system.

19. The system of claim 11, wherein the application comprises a file delivering feature that allows a user to receive a second version of a selected audio file having a specific format in

connection with a receipt by a wireless device of the user of a first version of the selected audio file, wherein the first version has a format that differs from the specific format.

20. The system of claim 11, wherein the different application is further operable to direct the portable media player to associate a name with a video file saved at the portable media player, and to communicate data representing the name to a different device to allow the different device to present a soft button comprising the name on an associated display of the different device, and to begin playing the video file after a selection of the name made via the different device.

21. The system of claim 3 wherein the wireless telephone is operable to allow at least a portion of a cellular telephone call to be heard via an output device of the different electronic device.

22. The system of claim 2, wherein the physical interface has a size and shape configured to engage a single non-circular contacting interface of a docking mechanism in order to communicatively connect the portable audio file player to the different electronic device.

23. The system of claim 22, further comprising the docking mechanism, wherein the docking mechanism comprises a cable including multiple conductive elements.

24. The system of claim 2, wherein the physical interface further is configured to releasably engage with a docking mechanism of the different electronic device such that a power source of the different electronic device can recharge a power supply of the portable audio file player device via the physical interface.

25. The system of claim 24, further comprising the docking mechanism, wherein the docking mechanism comprises a non-circular physical interface configured to releasably engage with the physical interface and a cable having multiple conductive elements.

26. The system of claim 3, wherein the wireless telephone is operable in a hands-free mode.

27. The system of claim 26, wherein the wireless telephone is configured to be used with an automobile and to facilitate operation in the hands-free mode during use with the automobile.

28. The system of claim 3, wherein the network based resource is operable to:

access demographic information of a user of the wireless telephone; and provide at least one advertisement to the user.

29. The system of claim 3, wherein the network based resource is operable to send a targeted advertisement to the wireless telephone, wherein the targeted advertisement is based at least partially on information about a user of the wireless telephone.

30. The system of claim 1, wherein the portable audio file player is configured to switch between a set of communication rates at which the portable audio file player can wirelessly receive a first portion and a second portion of an audio file from the network based resource, wherein the set of communication rates comprises at least a first data rate and a second data rate that is slower than the first data rate.

31. The system of claim 30, wherein the portable audio file player is to receive at least one portion of the audio file in a compressed format and to process the at least one portion.

32. The system of claim 11, wherein the portable media player has a physical interface having a size and shape configured to engage a single non-circular contacting interface of a docking mechanism in order to communicatively couple the portable media player to the different audio system.

33. The system of claim 32, wherein the physical interface further is configured to releasably engage with a docking mechanism of the different audio system such that a power source of the different audio system can recharge a power supply of the portable media player via the physical interface.

34. The system of claim 11, wherein the portable media player further comprises a wireless telephone, and wherein the different audio system is of an automobile, and the wireless telephone is operable in a hands-free mode during use with the automobile.

35. The system of claim 34, wherein the network based resource is operable to send a targeted advertisement to the wireless telephone, wherein the targeted advertisement is based at least partially on information about a user of the wireless telephone.

36. The system of claim 11, wherein the portable media player is configured to switch between a set of communication rates at which the portable media player can wirelessly receive a first portion and a second portion of an audio file from the network based resource, wherein the set of communication rates comprises at least a first data rate and a second data rate that is slower than the first data rate.

37. The system of claim 36, wherein the portable media player is to receive at least one portion of the audio file in a compressed format and to process the at least one portion.

IX. EVIDENCE APPENDIX

The following evidence pursuant to 37 C.F.R. § 41.67 are submitted:

Exhibit	Description	Comments
1	Declaration of Russell W. White Under 37 C.F.R. § 1.132, including Exhibits A-T	Submitted by Patent Owner on September 9, 2010 and entered by the Examiner in the Action Closing Prosecution (ACP) mailed August 17, 2011

X. Related Proceedings Appendix

Exhibit No.	Description
2	Civil Action No. 9:08-CV-164, Jury Verdict dated October 28, 2010
3	Civil Action No. 9:08-CV-164, Final Judgment ordered April 12, 2011

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the following:

Patent Owner's Appeal Brief in Inter Partes Reexamination Pursuant to 37 C.F.R. §41.68
was served on:

NOVAK DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd
Houston, TX 77002

the attorney of record for the Third Party Requester in accordance with 37 CFR §§1.248 and
1.903, on the March 5, 2012.

/Mark J. Rozman/
Mark J. Rozman

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White, et al.		
	Art Unit		3992	
	Examiner Name	Colin M. Larose		
	Attorney Docket Number		AFF.004B6US	

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	6647257		2003-11-11	Owensby	
	2	7376586		2008-05-20	Partovi et al.	

If you wish to add additional U.S. Patent citation information please click the Add button.

U.S.PATENT APPLICATION PUBLICATIONS						
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	20020174013		2002-11-21	Freeman et al.	

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95001263
	Filing Date	2009-11-13
	First Named Inventor	Russell W. White, et al.
	Art Unit	3992
	Examiner Name	Colin M. Larose
	Attorney Docket Number	AFF.004B6US

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95001263
	Filing Date	2009-11-13
	First Named Inventor	Russell W. White, et al.
	Art Unit	3992
	Examiner Name	Colin M. Larose
	Attorney Docket Number	AFF.004B6US

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

- See attached certification statement.
- Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.
- None

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Mark J. Rozman/	Date (YYYY-MM-DD)	2012-02-09
Name/Print	Mark J. Rozman	Registration Number	42117

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Acknowledgement Receipt

EFS ID:	12038269
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	Mark J. Rozman/Stephanie Petreas
Filer Authorized By:	Mark J. Rozman
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	09-FEB-2012
Filing Date:	13-NOV-2009
Time Stamp:	13:53:20
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reexam Certificate of Service	cosAFF004B6.pdf	24327 <small>6b61981e83de7c1f2a5ca368595037cd4967a348</small>	no	1

Warnings:

Information:

Samsung Ex. 1321 p. 239

2	Information Disclosure Statement (IDS) Form (SB08)	AFF004B6USids.pdf	36806	no	4
			1dddad8b6b6d86e0647e3239c22541557f 8870f		

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If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

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If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§		
Filed:	November 13, 2009	§	Examiner:	Colin M. LaRose
		§		
For:	Content Delivery System And Method	§	Atty. Dkt. No.:	AFF.004B6US
		§		

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the attached Information Disclosure Statements filed with the USPTO via EFS on February 9, 2012, has been sent by First Class Mail to the following attorney of record for third party requester as provided for in 37 C.F.R. §1.248(a):

NOVAK DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
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Houston, TX 77002

Respectfully submitted,

Date: February 9, 2012

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Date of Deposit: <u>February 9, 2012</u> I hereby certify that this petition is being transmitted via EF S, on the date indicated above. <u>/Stephanie Petreas/</u> Stephanie Petreas
--

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner: Affinity Labs of Texas, LLC § Confirmation No.: 6721
§
Reexamination 95/001,263 § Examiner: Colin M. LaRose
Control No.: §
§
Filed: November 13, 2009 § Art Unit: 3992
§
For: U.S. Patent No. 7,486,926 § Atty. Dkt. No.: AFF.004B6US

Mail Stop Inter Partes Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**NOTICE OF APPEAL TO THE BOARD OF
PATENT APPEALS AND INTERFERENCES**

Patent Owner hereby appeals to the Board of Patent Appeals and Interferences the rejection of claims 1-37 in the Right of Appeal Notice dated December 6, 2011.

The fee for this Notice of Appeal is \$620.00. The Commissioner is authorized to charge this fee, and any additional fees or credit any overpayment to Deposit Account No. 20-1504.

Respectfully submitted,

Date: January 5, 2012

/Mark J. Rozman/
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Date of Deposit: January 5, 2012
I hereby certify under 37 CFR § 1.8 this correspondence is being deposited **via EFS** on the date indicated above.
/Stephanie Petreas/
Stephanie Petreas

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
		§		
Reexamination Control No:	95/001,263	§		
		§	Examiner:	Colin M. LaRose
Filed:	November 13, 2009	§		
		§		
For:	Content Delivery System And Method	§	Atty. Dkt. No.:	AFF.004B6US
		§		

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ATTN: Central Reexamination Unit
Commissioner for Patents
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Alexandria, VA 22313-1450

CERTIFICATE OF SERVICE

I hereby certify that a copy of the Notice of Appeal filed with the USPTO via EFS on January 5, 2012 has been sent by first class mail to the following attorney of record for third party requester as provided for in 37 C.F.R. §1.248(a):

NOVAK DRUCE & QUIGG, LLP
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1000 Louisiana Street, 53rd
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Respectfully submitted,

Date: January 5, 2012

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Electronic Patent Application Fee Transmittal

Application Number:	95001263
Filing Date:	13-Nov-2009
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Filer:	Mark J. Rozman/Stephanie Petreas
Attorney Docket Number:	AFF.0004B6US

Filed as Large Entity

inter partes reexam Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Notice of appeal	1401	1	620	620

Post-Allowance-and-Post-Issuance:

Extension-of-Time:

Samsung Ex. 1321 p. 244

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				620

Electronic Acknowledgement Receipt

EFS ID:	11763929
Application Number:	95001263
International Application Number:	
Confirmation Number:	6721
Title of Invention:	CONTENT DELIVERY SYSTEM AND METHOD
First Named Inventor/Applicant Name:	7486926
Customer Number:	21906
Filer:	Mark J. Rozman/Stephanie Petreas
Filer Authorized By:	Mark J. Rozman
Attorney Docket Number:	AFF.0004B6US
Receipt Date:	05-JAN-2012
Filing Date:	13-NOV-2009
Time Stamp:	11:39:07
Application Type:	inter partes reexam

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Payment Type	Credit Card
Payment was successfully received in RAM	\$620
RAM confirmation Number	9460
Deposit Account	201504
Authorized User	ROZMAN,MARK J.

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.19 (Document supply fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

Samsung Ex. 1321 p. 246

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Notice of Appeal Filed	AFF004B6USNoticeofAppeal.pdf	32019 d5054125300905ce139109def920ee4e98b85111	no	1
Warnings:					
Information:					
2	Reexam Certificate of Service	AFF004B6USCOSforNoticeofAppeal.pdf	15423 dd03911b1bdd067868afe0123933f4010f20b730	no	1
Warnings:					
Information:					
3	Fee Worksheet (SB06)	fee-info.pdf	30345 8c631b65977dcd0ed7f4b651d9e0d7d85eecaacf3	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			77787		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,263	11/13/2009	7486926	AFF.0004B6US	6721
21906	7590	12/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			LAROSE, COLIN M	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			12/06/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

DEC 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001263
PATENT NO. : 7486926
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Right of Appeal Notice
(37 CFR 1.953)**

Control No.	Patent Under Reexamination
95/001,263	7486926
Examiner	Art Unit
COLIN LAROSE	3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:
Patent Owner on 16 September, 2011
Third Party(ies) on _____

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed 16 September, 2011 will be entered will not be entered*

*Reasons for non-entry are given in the body of this notice.

- 1a. Claims 1-37 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been cancelled.
3. Claims _____ are confirmed. [Unamended patent claims].
4. Claims _____ are patentable. [Amended or new claims].
5. Claims 1-37 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable. are not acceptable.
8. The drawing correction request filed on _____ is approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
 been received. not been received. been filed in Application/Control No. _____.
10. Other _____

Attachments

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No.	Patent Under Reexamination
	95/001,263	7486926
	Examiner	Art Unit
	COLIN LAROSE	3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

RIGHT OF APPEAL NOTICE

Receipt of Remarks

1. Patent Owner's amendments and remarks dated 9/16/2011, have been entered and made of record. Third Party remarks in response to Patent Owner's submission have not been received.

Response to Arguments

2. Section 120 Priority Issues

(see Patent Owner remarks, pp. 9-16)

Patent Owner argues that "the Office is prohibited from re-considering the priority date issue, which is really a §112 issue, by both statute and the Federal Circuit case law" (P.O. Remarks, p. 9). However, the CAFC has recently held that there is no such prohibition. See *In re NTP*, 2010-1277, 1 August 2011, (Slip Op. at 14-15):

Nothing in 35 U.S.C. §§ 301 et seq. entitles a patentee to a claim of right to its earliest priority date. Under § 120, a patent is entitled to the priority date of an earlier filed application if (1) the written description of the earlier filed application discloses the invention claimed in the later filed application sufficient to satisfy the requirements of § 112; (2) the applications have at least one common inventor; (3) the later application is filed before the issuance or abandonment of the earlier filed application; and (4) the later application contains a reference to the earlier filed application. In addition, if the later filed application claims priority through the heredity of a chain of applications, each application in the chain must satisfy § 112. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997).

Thus, when a patentee argues that its claims are entitled to the priority date of an earlier filed application, the examiner must

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undertake a priority analysis to determine if the patentee meets the requirements of § 120. There is no statutory limitation during a reexamination proceeding prohibiting the examiner from conducting a priority analysis. Otherwise, the examiner would be stripped of a critical legal tool needed in performing a proper reexamination. Nothing in §§ 301 et seq. prohibits an examiner from determining whether or not a priority date was properly claimed during the original examination of the application.

Also, neither the Section 120 priority requirements nor the Section 112 written description requirements were considered by the Examiner during the previous examination of the '926 patent, therefore, reexamination with respect to the Section 120 priority issues is not improper. See *NTP* at 15-19.

Patent Owner argues that "there is complete support for the claimed subject matter in the '812 parent application, which is also present verbatim in the '926 Specification" (P.O. remarks, p. 12). Specifically, Patent Owner asserts that there is sufficient support in the parent patent 7,187,947 for the following limitations:

Claim 1

the collection of instructions operable to direct the processor ... to communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display

Claim 11

the different application operable to direct the portable media player ... to communicate data representing the user-defined name

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to a different audio system to allow the different audio system to present a soft button comprising the user-defined name on an associated display of the different audio system

Several passages in the '947 patent are identified by the Patent Owner as putatively providing the requisite support, including:

In another embodiment, electronic device 300 may be operable as a PDA and/or a cellular phone that may be mounted to an automobile's console. *Electronic device 300 may then integrate with a user's automobile to provide an all-encompassing communications device.* For example, electronic device 300 configured as a PDA and cellular phone may allow for communication with a user's email account, voice mail account, the Internet, as well as allowing for the receipt of selected audio information via wireless communication. *Electronic device 300 may be operable in a hands-free mode* allowing a user to maintain safe driving fundamentals. During use, *electronic device 300 may be processing selective audio information for communicating with an automobile audio system* and may further be operating to receive incoming cellular calls.

'926 Patent, column 9, lines 21-35 (emphasis added) (*see also*, '947 Patent, column 10, lines 43-57).

FIG. 4 illustrates a graphical user interface (GUI) for displaying selectable audio information according to one aspect of the present invention. *The GUI may be operable with a computer system, cellular device, PDA, or other electronic devices or systems operable to display the GUI of FIG. 4.*

'926 Patent, column 9, lines 52-56 (emphasis added) (*see also*, '947 Patent, column 11, lines 6-11).

A user may also use a select a device feature that allows a user to select a destination device for communicating selected audio information. For example, a user may want to communicate a playlist to several different devices such as a PDA, a home computer system, a work computer system. etc.

'926 Patent, column 10, lines 43-48 (*see also*, '947 Patent, column 11, line 66 – column 12, line 4).

However, the above passages and others cited by the Patent Owner do not teach or otherwise suggest what is claimed in claim 1. For instance, disclosing that an “electronic device 300 may then integrate with a user’s automobile to provide an all-encompassing communications device” does give rise to “communicat[ing] data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display.” Similarly, the teachings that the electronic device 300 operates in “hands-free mode” and processes “selective audio information for communicating with an automobile system” do not correspond to what is claimed; and the fact that “[t]he GUI may be operable with [various devices]” does not constitute communicating data such that a different electronic device can display selectable icons, as claimed.

At best, the '947 patent teaches that a portable audio file player may be connected to the audio system of a boombox (figure 5A) or an automobile (figures 5B and 9) so that audio information can be transferred to the different device (i.e., the boombox or the car stereo system) for listening by a user (see e.g., U.S. Patent 7,187,947, column 18:64-66). However, there appears to be no teaching that any data transferred from the portable audio file player to the different electronic device allows the different electronic device to display selectable representations of an audio file in the portable audio file player. Since no selectable representation is displayed on the different electronic device, there can be no selection thereof (or playing of a file in response to the selection thereof).

Accordingly, claim 1 is not entitled to benefit of the filing date of the '812 application and is given an effective date of **3/2/2007**, the non-provisional filing date of the '926 patent. See MPEP §§ 2258(I)(C) and 2658(I).

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Claim 11 recites a system that is analogous to that of claim 1: a portable media player receives audio information relating to the name of a playlist from a user computer system. The name information is then communicated from the portable media player to a "different audio system" so that the different audio system can display a soft button associated with the name.

Substantially the same reasoning and analysis for claim 1, above, applies to claim 11 with respect to the issue of priority. Accordingly, claim 11 is also given an effective date of **3/2/2007**.

[Patent Owner asserts that the same § 112 written description issues were addressed in a different patent, however, since such consideration was not given for the '926 patent, Patent Owner's argument is moot.]

3. Rejections based in-part on Kumar (Grounds A—R, MM, OO, and UU—CCC)

(see Patent Owner remarks, pp. 17-18)

Patent Owner argues that Grounds A—R, MM, OO, and UU—CCC should be withdrawn because these grounds of rejection are based in-part on Kumar, which allegedly does not qualify as prior art. Patent Owner is correct in the assertion that Kumar's effective date corresponds to the filing of the national stage U.S. application (12/19/2005). Accordingly, Kumar does not antedate the filing date of the parent application of the '926 patent—i.e., the 09/537,812 application filed on 3/28/2000.

However, as explained above, the claims are not entitled to such a priority date because they do not meet all of the requirements of 35 U.S.C. § 120.

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Patent Owner also argues that the rejections involving Kumar should be withdrawn because Kumar does not teach or suggest “data communication to the docking display unit to enable that unit to present a selectable representation of an icon and to begin playing an audio file in the audio file player in connection with the user selecting the selectable representation from the display” (P.O. Remarks, p. 17). Examiner disagrees with this characterization of Kumar.

As explained in Kumar's disclosure, and as shown in figure 3, a communication interface 17 of Kumar's detachable handset unit interfaces with a wired communication circuit 33 of the docking display unit. Such a connection between the handset unit and the docking display unit is for communicating data between the two devices. Likewise, the auxiliary display 31 of the docking unit communicates with the video interface 15 of the handset unit in order to display information pertaining to the handset unit on the larger auxiliary display 31. In addition, the auxiliary keyboard 32 of the docking display unit is in communication with the keyboard interface 16 of the handset unit; this allows a user to enter commands via the auxiliary keyboard 32 of the docking unit rather than the keypad 19 of the handset. Accordingly, Kumar discloses that data, GUI, and keyboard information are all communicated to the docking station so that a user can utilize the docking station to select and play audio files when the handset is docked thereon.

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4. Other Prior Art Rejections

Patent Owner incorporates by reference the previous remarks with respect to the remaining prior art rejections made in Patent Owner's remarks dated 9/9/2010. These remarks are not persuasive for the same reasons as previously given in the ACP dated 8/17/2011 (repeated below):

Rejections based on SoundJam, Rio 500, and Naughton (Grounds S—DD)

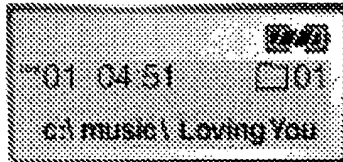
(see Patent Owner remarks, 9/9/2010, pp. 15-20; Requester remarks, 10/12/2010, pp. 9-16)

First, Patent Owner asserts that the combination of SoundJam and Rio 500 does not teach a collection of instructions, saved locally at the portable player, that is operable to direct a processor of the player to "maintain an updateable user interface, and to modify such in connection with receiving an audio file from a personal computer so that the selectable icon is linked with the file" (see P.O. remarks, p. 16, first paragraph). Patent Owner asserts that such limitations are not taught by SoundJam and Rio 500 because "all of [the] contended support [identified at Exhibit CC-SS, pp. 14-16] regards the Rio Port audio manager, which is stored on the PC and operates only in the PC" (rather than in the portable audio file player, as required by the claims).

Requester successfully rebuts Patent Owner's assertion on pp. 10-12 of Requester's remarks. Specifically, Requester notes that the Rio 500 portable audio player is operative to download audio files from a PC and then display such files on its interface. That is, the Rio 500's interface is updated as new files are downloaded to the device; textual information pertaining to

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a given file is displayed, and a user can select the displayed file for playback or scroll to a different file:



Rio 500 at p. 1

The maintaining and modifying of the updateable user interface necessarily require a "collection of instructions" that directs the player's processor to execute these interface operations (i.e., the presence of software or the like pertaining to the execution of the interface is inherent). Furthermore, Requester notes that the claimed "selectable icon" can constitute textual information regarding an audio file or the like, such as shown above for the Rio 500 player.

Second, Patent Owner asserts that the combination of SoundJam and Rio 500 with Naughton does not render the claims obvious because: (1) "even when combined these three references fail to lead to the claimed subject matter"; (2) "there is no reason to combine the references since the proposed combination would add additional complexity, rendering the claims nonobvious" (see P.O. remarks, p. 16).

As identified in the previous Office action, SoundJam and Rio 500 teach all of the limitations of claim 1 except the portable audio file player's collection of instructions being operable to cause the processor to:

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—communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display; and

—begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display.

Naughton, however, was relied upon as teaching these limitations.

Patent Owner argues (p.16) that the rejection of claim 1 is improper because the Rio 500 portable MP3 player is not capable of outputting data to another device in order to present a selectable representation or enable control of the Rio 500 player. The Rio 500 is equipped with a USB port connector that "connects the Rio 50 device to your computer using the supplied cable; USB allows for fast file transfers" (see Rio 500, p. 1). Accordingly, the Rio 500 is capable of communicating with a computer, but Patent Owner appears to be correct in noting that there is nothing in Rio 500 that teaches or suggests communicating data regarding the Rio 500 such that it can be controlled by another device in the claimed manner.

Requester, however, points out that Naughton cures such a deficiency by providing a "device driver object" for a device to be connected to Naughton's hand-held display and that Naughton's hand-held display is designed to control "any compatible remote device" (see Requester remarks, p. 13). Naughton identifies three types of devices that can be connected to and controlled by a hand-held display device 170 (figures 1A and 1B):

- (1) an intelligent remote device (figure 1C);
- (2) a simple remote device (figure 1D); and

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(3) a conventional electronic device (figure 1E).

The "conventional electronic device" is characterized as a device that can be controlled by transmitted signals, such as infrared signals (see column 9/45-58; 30/6-29). The Rio 500 does not appear to constitute such a "conventional electronic device" because it is not controlled by transmitted signals—that is, it is not controlled by a remote control or the like.

The "intelligent remote device" is characterized as a device having a microprocessor, a communication system, and a memory (column 9/2-4). The Rio 500 includes a communication system (i.e., USB interface) and memory (i.e., 64 MB onboard memory); it also necessarily includes a microprocessor of sorts in order to receive and process audio files and display graphical information regarding the audio files. Therefore, the Rio 500 can be considered to constitute an "intelligent remote device."

Alternatively, the Rio 500 can be considered a "simple remote device," which is characterized as not having a microprocessor or as having a "primitive processor" (column 9/21-26).

Patent Owner asserts that to modify the Rio 500 player so that it can communicate with and be controlled by Naughton's display device "would add considerable complexity to this basic MP3 player" (Patent Owner remarks, p. 17). Allegedly, "[t]his unnecessarily complicates the Rio 500 and would require much additional work beyond that taught by the references" (*id.*).

As described by Naughton, both the intelligent and simple remote devices are equipped with a user interface object (303/353) and a device driver object (301/351) that are used to present interface information to a display device 170 and allow the display device 170 to control the remote device—see columns 25/52-64 and 29/10-16. The flowcharts of figures 20 and 24

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outline the methods by which the intelligent and simple remote devices communicate with and are controlled by the display device 170 using the user interface object and the device driver object.

As the Rio 500 already contains the requisite hardware (i.e., memory, processor, communication means) to enable operability with Naughton's display device, all that is potentially absent are the "device driver object" and the "user interface object" stored in the memory of the player. Arguably, these two components are necessarily contained in the Rio 500 as inherent components for executing commands and displaying objects. However, to the extent that such components are either not inherently present or not configured to handle interaction with a display device such as disclosed in Naughton, it would have been obvious to include/configure such components for interoperability with Naughton's display/control device.

Patent Owner's "undue complexity" argument is unpersuasive since the only modifications to the Rio 500 player would be to install or update a device driver object and a user interface object for compatibility with Naughton's external display/control device. Such a task would have been well within the knowledge and capabilities of a person of ordinary skill in the art at the time of the invention. In addition, Naughton provides details (summarized by the flowcharts of figures 20 and 24) as to how the remote device and the display device should interact (see also columns 25-29). Using such details, those skilled in the art would be able to develop a device driver object and user interface object that do not add undue complexity to the Rio 500 or destroy the basic operation thereof.

Furthermore, Naughton provides the requisite motivation and reasoning for initiating the proposed combination. Namely, Naughton's disclosure outlines the desirability of connecting

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various remote devices to a single hand-held display that controls the various devices. Such a system of connecting various remote devices to a graphic-based touch-screen device creates an "intuitive methodology for an operator to control remote devices with a computer controlled object-oriented user interface utilizing animated graphic images" that overcomes the drawbacks of the traditional hierarchical computer interface (primarily, the drawback of user confusion)—see Naughton, Background of the Invention. Also, Naughton's system provides the inherent benefit of allowing numerous devices to be controlled by a single hand-held device, thereby facilitating ease of use and control among a large number of electronic devices.

Accordingly, the adaptation of the Rio 500 player to Naughton's display device allows the Rio 500 player to communicate interface information to Naughton's touch-screen display device such that a user interface for controlling the Rio 500 is displayed on Naughton's display device. A user is able to control the operation of the Rio 500 player—such as by selecting an audio file for playback—by selecting corresponding icons that are displayed on Naughton's display device.

Therefore, for the reasons given above, the combination of SoundJam and Rio 500 with Naughton does achieve the claimed invention, which is rendered obvious by express and implicit motivation found in Naughton, and would not require undue experimentation or add undue complexity to the Rio 500 player such that its intended mode of operation is negated.

Accordingly, the previous rejection of claim 1 is maintained.

Regarding **claim 2**, Requester's response to Patent Owner's arguments is persuasive (see Requester's remarks, pp. 14-15), and the previous rejection is maintained. Furthermore, it is not

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clear that the recitation of a "physical interface" necessarily precludes a wireless connection, as a "physical interface" of the portable audio player could constitute the physical interface (e.g., hardware) through which the wireless connection is maintained.

Regarding **claim 6**, Requester's response to Patent Owner's arguments is persuasive (*id.* at 15), and the previous rejection is maintained.

Regarding **claim 9**, Requester's response to Patent Owner's arguments is persuasive (*id.* at 16), and the previous rejection is maintained. Attaching an audio file to an email such that the receiver of the email can access the file via a selectable link would have been an obvious expedient in view of the teachings of SoundJam, as explained by the Requester.

Rejections based on Lau, Naim, and Lee (Grounds EE—MM)

(see Patent Owner remarks, 9/9/2010, pp. 20-26; Requester remarks, 10/12/2010, pp. 16-25)

Regarding claim 1, Patent Owner presents the following arguments:

—" [N]othing in [Lau] anywhere teaches or suggests that the Lau system be configured to operate in connection with a portable audio file player Instead, Lau simply teaches that songs can be loaded on the disk cartridge." (Patent Owner remarks, p. 21)

The specification of the '926 patent, however, does not define the term "portable" or otherwise delimit the metes and bounds of the term. Therefore, the plain and ordinary meaning of the word is adopted for the purposes of construing the claim. An item that is "portable" is generally recognized as something that is capable of being carried or moved about.

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Lau's music server 102, by all accounts, constitutes a "portable audio file player" since it is small enough to be mounted in the trunk of an automobile (column 5/1-13). While the exact size, dimensions, and weight of Lau's music server are not provided, those skilled in the art would have recognized its portable nature by the fact it is designed for installation in an automobile.

—"Lau nowhere teaches or suggests that a software application configured for storage on a personal computer be configured to initiate downloading of an audio file included in a created playlist from a PC to a portable audio file player. The secondary references further fail to address this missing subject matter." (Patent Owner remarks, p. 21)

Requester, however, explains how such a limitation is met by Lau (see Requester remarks, p. 17):

Furthermore, Lau discloses "initiat[ing] a downloading of an audio file included in the playlist from the personal computer to a portable audio file player ..." as recited in Claim 1. Lau discloses software running on a computer that includes a playlist creation function that allows the user to assign a user-defined name to the playlist. Lau at 13:49-60 ("In step 1304, the user provides a name for the new play list"). Lau then discloses storing the playlist with the user-defined name and its contents on a disk cartridge 120. *Id.* at 17:7-17 and 26-33. The disk cartridge 120 may then be inserted into a music server 102 in a vehicle such that the playlist may be played in the vehicle. *Id.* at 8:42-52, 18:29-31. Alternatively, Lau discloses that for devices that do not use a disk cartridge, the download can proceed directly to the device. *Id.* at 17:12-16 ("In embodiments that don't use a disk cartridge 120, the steps of Fig. 19 are used to synchronize between a computer 124 and the storage medium for the particular device."). Thus, Lau discloses initiating a downloading of an audio file included in the playlist from the personal computer to the portable audio file player. Maggs Decl. at ¶ 19.

—"Lau teaches away from use of its system in connection with a portable audio file player ... Lau's invention is directed to a system that *avoids* use of a portable player. This teaching away destroys the proposed combination, and as a result there can be no motivation to combine it with the secondary references." (Patent Owner remarks, p. 21)

However, Lau's avoidance was of prior art portable players at the time of Lau's invention. Lau noted the following disadvantages of the then-existing players: sending the sound signal through the cassette deck causes a degradation in sound quality; usage in the car is dangerous because all the controls are on the player, rather than on the dashboard or other convenient location; music can be sent to the car stereo from the player, but the car stereo cannot communicate back to the player so the user is unable to use the controls of the car stereo to control the music player; portable players have a limited amount of storage; and there is no convenient place to store the portable player. See Lau, column 2/9-36.

Lau's disclosure directly addresses these drawbacks of the then-existing portable players by adapting a portable player for utilization in an automobile such that most or all of those drawbacks are overcome. As explained above, Lau's music server 102 is considered a portable audio player.

—"Lau nowhere teaches or suggests a player [having a processor, display and memory configured to store multiple audio files] ... Instead, the identified portions of Lau are simply directed to a personal computer or a music server, neither of which is a portable audio file player." (Patent Owner remarks, p. 21)

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Lau's music server shown in figure 6 includes a processor (302) and memory (IDE connector 310 connects to disk cartridge 120) but does not appear to include a display, as claimed.

Naim, however, is relied upon for demonstrating that including a display in a portable audio file player was conventional at the time of the invention. Naim characterizes its device as a "portable audio player" (Naim, figure 1) while Lau's device is characterized as a "music server" (Lau, figure 6). Notwithstanding the different labels, the two device are substantially equivalent in that they are both compact audio players that include a processor, memory, and associated circuitry for receiving audio files from an external source, storing the files, and playing the files; in addition, they can both be selectively connected to a hard disk capable of storing large amounts of audio data thereon (compare figures 1 and 6 of Lau with figure 1 of Naim).

The primary difference between Lau's music server 102 and Naim's portable audio device 1 is that Naim's device includes an on-board display 16, whereas Lau's music server does not. Nevertheless, those skilled in the art would have recognized that including a display in Lau's music server would have been an obvious expedient in view of Naim's teaching that such portable audio devices are conventionally equipped with a display for operating purposes.

—"Lau ... nowhere addresses subject matter of a portable audio file player configured with local saved instructions." (Patent Owner remarks, p. 21)

Requester, however, explains how such a limitation is met by Lau (see Requester remarks, p. 18):

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Affinity next argues that Lau fails to teach "a portable audio file player configured with locally saved instructions." Reply at 21. Requester disagrees. Lau first details that software that operates on a PC creates a GUI that can then be used to create playlists. Lau at 12:64-13:17. Next, Lau discloses that the technology, *i.e.*, GUI, software, etc., "can also be implemented on music server 102." *Id.* at 18:11-18. Therefore, while some citations in the Request and relied on in the Office Action are to functions on a PC, Lau expressly teaches that the same functionality is implemented on the music server, thereby creating a portable audio file player that meets the limitations of the claims. Clearly, Affinity has failed to comprehend the full teachings of Lau as it continuously tries to distinguish between what takes place at the music server and what takes place at the PC, going so far as to state that Requester has "collapse[d] different components of Lau into a single component...." Reply at 22. This argument is untenable given the explicit disclosure of Lau: "[t]he technology for creating and updating play lists is described above in conjunction with a personal computer. ***However, the technology can also be implemented on music server 102***, on another music player, ... on another audio/visual device, on another computing device, etc." Lau at 18:11-18 (emphasis added); *see also* Maggs Decl. at ¶ 19.

—"[W]hile Lau teaches that a head unit of an automobile including the music server can be used to access tracks on the disk cartridge, nothing in the reference anywhere teaches or suggests presentation of a selectable representation of a particular selectable icon on a head unit display, nor to begin playing a file in connection with user selection of this selectable representation. Instead, all that Lau teaches is that head unit can send commands to a music server to request certain music to be played... nothing in the reference anywhere teaches or suggests communication from the music server to the head unit first to allow display of a selectable representation of a selectable icon" (Patent Owner remarks, p. 22)

At column 5/14-16, Lau expressly teaches that "a user can use head unit 104 to access tracks on disk cartridge 120 [which has been inserted into music server 102] and play those tracks through speakers 106, 108, 110 and 112." Inherent to such an action is that the user

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selects, on the display, an "icon" or equivalent visual representation of an audio track so that the head unit can signal to the music server to begin playing the selected track.

Patent Owner admits that "Lau teaches [the] head unit can send commands to a music server to request certain music to be played." As Lau is best understood, such an operation is accomplished by the user actively selecting, on the head unit, which track to be played.

However, to the extent that such a mode of operation is not implicit or inherent in Lau, Lee has been relied upon for showing that interfacing a head unit with a portable device within an automobile in the claimed manner was conventional at the time of the invention.

—"Lee also fails to teach or suggest this collection of instructions, or any communication of data to another electronic device to allow such device to present a selectable representation of a selectable icon and to begin playing the file in connection with user selection." (Patent Owner remarks, pp. 22-23)

As indicated above, Lau appears to teach, or at least suggest, that selectable icons of music tracks are communicated from the music server to the head unit and displayed for user selection thereof. However, to the extent that such a teaching is not implicit or inherent in Lau, Lee has been relied upon for such a teaching (see Requester remarks, p. 19):

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Lau discloses that the music server and the head unit of a car audio system are in communication. Lau at 4:27-39; *see also* 5:9-15, 8:35-55. This communication between the head unit and the music server allows for a user to request that certain music files be played. *Id.* at 5:9-15, 8:35-55. Lau also describes the ability to communicate with a different electronic device via USB connectivity. *See, e.g., id.* at 4:42-44. To more explicitly disclose the types of communication that were known in the prior art to take place between a portable audio file player and a head unit of a car audio system, Lau is combined with Lee. Lee explicitly discloses that a multimedia device in a vehicle can interact with portable audio file players, among other electronic devices. Lee at 5:47-55 and 63-65, 7:56-61, 8:54-64, FIG. 4 (USB connectivity for peripheral devices). Therefore, when Lee and Lau are combined, the music server of Lau can communicate and be controlled by the automobile head unit that is disclosed in Lee to teach the "collection of instructions" stored at the portable audio file player. Maggs Decl. at ¶¶ 20, 21.

Lee also discloses that it displays information from a peripheral electronic device, such as a connected portable audio player; Lee discloses that the names of channels and recorded audio files (such as recorded MP3 files available on a peripheral device) are displayed on the multimedia device's user interface as a "hierarchical tree" or "user defined labels 170." Lee at 9:10-10:22. Thus, the combination of Lau, Naim, and Lee provides for communicating data from Lau's portable audio player (as modified by the disclosure of Naim) to Lee's multimedia device to allow Lee's multimedia device to present a selectable representation of the particular selectable icon on its display.

Accordingly, Patent Owner's arguments regarding Grounds EE-MM are not persuasive, and the previous rejections have been maintained.

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Rejections based in-part on Van Zoest (Grounds NN—TT)

(see Patent Owner remarks, 9/9/2010, pp. 26-27; Requester remarks, 10/12/2010, pp. 25-33)

Patent Owner argues that the rejections based on Van Zoest should be withdrawn because Van Zoest allegedly does not qualify as prior art. In particular, Patent Owner asserts that Van Zoest's provisional application (60/175,159, filed 1/7/2000) does not teach the subject matter relied upon in rejecting the claims, and therefore, for the purposes of rejecting the claims, Van Zoest does not antedate the 3/28/2000 effective date of the '926 patent.

In response to this assertion, Requester has demonstrated that, while Van Zoest's provisional application does not precisely match the disclosure of the nonprovisional application (i.e., according to Patent Owner it is "markedly different than the subject matter in the issued patent"), there is nonetheless requisite support in the provisional application for the passages relied upon in rejecting claims of the '926 patent (see Requester remarks, pp. 25-33). In view of Requester's identification of support in the provisional application for relied-upon portions of the Van Zoest patent, those portions of Van Zoest that have been relied upon for rejecting the claims are considered to be supported by Van Zoest's provisional application.

In any event, the claims of the '926 patent have been assigned an earliest effective date of March 2, 2007 (see paragraph 2, above). Against this effective date, Van Zoest qualifies as prior art under 35 U.S.C. § 102(b).

For these reasons, the previous Grounds NN—TT of rejection have been maintained.

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5. Secondary considerations of non-obviousness

(see Patent Owner remarks, 18-19)

Patent Owner's arguments pertaining to secondary considerations of non-obviousness (primarily, commercial success arguments) have been considered, but they are not sufficient to overcome the previous rejections. Patent Owner admits that the iPod + iTunes ecosystem was developed in 2001 (see White Declaration, 9/9/2010, ¶ 13). As indicated above, the claims of the '926 patent are considered to be entitled to an earliest effective date of 3/2/2007, which date does not antedate the introduction of the iTunes ecosystem. Therefore, Patent Owner's remarks with respect to secondary considerations of nonobviousness are moot at this time.

In any event, it is unclear whether and to what extent the success of the iTunes ecosystem is based on other factors unrelated to the advantages offered by the claimed invention such as marketing, product design, brand recognition, customer loyalty, pricing, customer support, other patented or unpatented technical features, commercial availability, and so forth. Without a more complete market analysis of a product that embodies the claimed invention versus comparable products that do not, it is difficult, if not impossible, to attribute the commercial success of the iTunes system to any particular factor or set of factors.

Disposition of Proposed Grounds of Rejection

6. **Grounds A—K** (adopted-in part; not adopted-in-part)

A. Claims 1-3, 5, and 7 are rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar.

B. Claims 4 and 10 are rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, and further in view of RealJukebox.

C. Claim 8 is rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, and further in view of Kaplan.

D. Claims 6 and 8 are rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of RealJukebox, and further in view of the knowledge of a person of ordinary skill in the art.

E. Claim 9 is rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of SoundJam, and further in view of the knowledge of a person of ordinary skill in the art.

F. Claim 9 is rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of Chen, and further in view of the knowledge of a person of ordinary skill in the art.

These rejections are **adopted** as explained in the Request (pp. 103-132 and Exhibits CC-A—CC-F).

Regarding claim 1, Rio 500 appears to disclose every limitation of the claim except the collection of instructions saved locally at the portable audio player being operable to direct the

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processor "to communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display."

Kumar, however, cures such a deficiency in Rio 500, as explained in the claim chart Exhibit CC-A. Kumar teaches a docking station (30) that receives a detachable handset unit (20), such as a portable audio player, cell phone, PDA, or the like. The handset unit communicates interface data to the docking station via communication interface (17). The docking station is equipped with an associated display (31) that is operative to display the interface data received from the handset unit—i.e., when a larger display is desired, the handset can utilize the docking station's display (see column 2/44-51). In the docked mode, "the detachable handset unit provides the processing and the communication power to the docking display unit" (column 2/44-51), so that when the docked handset unit functions as a portable audio player and a user selects a particular audio file on the associated display (31), the portable handset unit begins playing the file according to the normal operation of a portable audio device.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rio 500 by Kumar to achieve the claimed invention by including a docking station having an associated display since Kumar teaches that interfacing a portable audio player with a docking station was a convenient accessory for portable audio devices. The docking station facilitates operation of the portable device in a vehicle (column 3/5-15), functions to recharge the portable device, and provides utilization of a larger display and keyboard for easier operation.

B. Claims 11, 12, 14, 16, and 19 are not rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, and further in view of RealJukebox.

G. Claim 13 is not rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of RealJukebox, and further in view of Rhoads.

H. Claim 15 is not rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of RealJukebox, further in view of SoundJam, and further in view of the knowledge of a person of ordinary skill in the art.

I. Claim 15 is not rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of RealJukebox, further in view of Chen, and further in view of the knowledge of a person of ordinary skill in the art.

J. Claim 17 is not rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of RealJukebox, and further in view of the knowledge of Kaplan.

K. Claims 18 and 20 are not rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, further in view of RealJukebox, and further in view of RealPlayer.

The above rejections are **not adopted** because the combination of Rio 500, Kumar, and RealJukeBox does not appear to teach presenting a "soft button" comprising the user-defined name on an associated display of the different audio system, as claimed in claim 11. That is,

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Kumar's associated display does not appear to incorporate soft button controls, as claimed.

Kumar does mention a "pen-input" interface, but it is unclear whether such an interface necessarily includes presenting a soft button to the user, as claimed.

7. **Grounds L—R** (adopted-in-part; not adopted-in-part)

L. Claims 1-5 and 7 are rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Kumar.

M. Claim 6 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, further in view of RealJukebox, and further in view of the knowledge of a person of ordinary skill in the art.

N. Claim 8 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of Kaplan.

O. Claim 9 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of the knowledge of a person of ordinary skill in the art.

P. Claim 10 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of RealJukebox.

These rejections are **adopted** as explained in the Request (pp. 147-187 and Exhibits CC-L—CC-P).

Regarding claim 1, SoundJam, which incorporates the use of a portable audio player such as Rio 500, appears to disclose every limitation of the claim except the collection of instructions saved locally at the portable audio player being operable to direct the processor "to communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display."

Kumar, however, cures such a deficiency in Rio 500, as explained in the claim chart Exhibit CC-L. Kumar teaches a docking station (30) that receives a detachable handset unit (20), such as a portable audio player, cell phone, PDA, or the like. The handset unit communicates interface data to the docking station via communication interface (17). The docking station is equipped with an associated display (31) that is operative to display the interface data received from the handset unit—i.e., when a larger display is desired, the handset can utilize the docking station's display (see column 2/44-51). In the docked mode, "the detachable handset unit provides the processing and the communication power to the docking display unit" (column 2/44-51), so that when the docked handset unit functions as a portable audio player and a user selects a particular audio file on the associated display (31), the portable handset unit begins playing the file according to the normal operation of a portable audio device.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify SoundJam and Rio 500 by Kumar to achieve the claimed invention by including a docking station having an associated display since Kumar teaches that interfacing a portable audio player with a docking station was a convenient accessory for owners of portable devices.

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The docking station facilitates operation of the portable device in a vehicle (column 3/5-15), functions to recharge the portable device, and provides utilization of a larger display and keyboard for easier operation.

L. Claims 11, 12, 18, and 19 are not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Kumar.

N. Claims 14 and 17 are not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of Kaplan.

O. Claim 15 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of the knowledge of a person of ordinary skill in the art.

P. Claim 16 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of RealJukebox.

Q. Claim 13 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of Rhoads.

R. Claim 20 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Kumar, and further in view of RealPlayer.

The above rejections are **not adopted** because the combination of SoundJam, Rio 500, and Kumar does not appear to teach presenting a "soft button" comprising the user-defined name on an associated display of the different audio system, as claimed in claim 11. That is, Kumar's

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associated display does not appear to incorporate soft button controls, as claimed. Kumar does mention a "pen-input" interface, but it is unclear whether such an interface necessarily includes presenting a soft button to the user, as claimed.

8. **Grounds S—DD** (adopted-in-part; not adopted-in-part)

S. Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Naughton.

T. Claim 6 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, further in view of RealJukebox, and further in view of the knowledge of a person of ordinary skill in the art.

U. Claim 8 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of Kaplan.

V. Claim 9 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of the knowledge of a person of ordinary skill in the art.

W. Claim 10 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of RealJukebox.

X. Claim 3 is rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Naughton, and further in view of Abecassis.

These rejections are **adopted** as explained in the Request (pp. 194-218 and Exhibits CC-S—CC-X).

Regarding claim 1, SoundJam, which incorporates the use of a portable audio player such as Rio 500, appears to disclose every limitation of the claim except the collection of instructions saved locally at the portable audio player being operable to direct the processor "to communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display."

Naughton, however, cures such a deficiency in Rio 500, as explained in the claim chart Exhibit CC-S. Naughton discloses a graphical user interface intended to display selectable objects on a touch screen for controlling an attached portable device.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify SoundJam and Rio 500 by Naughton to achieve the claimed invention by attaching the Rio 500 portable audio device to Naughton's display since Naughton teaches that interfacing portable devices with the disclosed display provides an intuitive interface for controlling portable devices via touch-sensitive icons without the need for separate input devices (see column 3/15-27).

Y. Claims 11, 12, 18, and 19 are not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Abecassis.

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Z. Claim 13 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Abecassis, and further in view of Rhoads.

AA. Claims 14 and 17 are not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Abecassis, and further in view of Kaplan.

BB. Claim 15 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Abecassis, and further in view of the knowledge of a person of ordinary skill in the art.

CC. Claim 16 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Abecassis, and further in view of RealJukebox.

DD. Claim 20 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, further in view of Abecassis, and further in view of RealPlayer.

The above rejections are **not adopted** because the combination of SoundJam, Rio 500, and Abecassis does not appear to teach presenting a "soft button" comprising the user-defined name on an associated display of the different audio system, as claimed in claim 11. That is, Abecassis's associated display does not appear to incorporate a soft button control comprising a user-defined name associated with an audio file, as claimed.

9. **Grounds EE—MM** (adopted)

EE. Claims 1-5, 7, 10-12, 16, and 18 are rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, and further in view of Lee.

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FF. Claim 6 is rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, and further in view of the knowledge of a person of ordinary skill in the art.

GG. Claim 6 is rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of Dwyer, and further in view of the knowledge of a person of ordinary skill in the art.

HH. Claims 8, 14, and 17 rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, and further in view of Kaplan.

II. Claims 9 and 15 are rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of SoundJam, and further in view of the knowledge of a person of ordinary skill in the art.

JJ. Claims 9 and 15 are rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of Chen, and further in view of the knowledge of a person of ordinary skill in the art.

KK. Claim 13 is rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, and further in view of Van Zoest.

LL. Claim 19 is rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, and further in view of Dimenstein.

MM. Claim 20 is rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, further in view of Lee, further in view of Leeke, and further in view of Kumar.

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These rejections are **adopted** as explained in the Request (**pp. 244-298 and Exhibits CC-EE—CC-MM**).

10. **Grounds NN—TT** (adopted)

NN. Claims 1, 2, 4-8, 10-14, 17, and 20 are rejected under 35 U.S.C § 103(a) as being unpatentable over Van Zoest in view of Gioscia, and further in view of the knowledge of a person of ordinary skill in the art.

OO. Claim 3 is rejected under 35 U.S.C § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Kumar.

PP. Claims 9 and 15 are rejected under 35 U.S.C § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of SoundJam.

QQ. Claims 9 and 15 are rejected under 35 U.S.C § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Chen.

RR. Claim 16 is rejected under 35 U.S.C § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Rio 500.

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SS. Claim 18 is rejected under 35 U.S.C § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Leeke.

TT. Claim 3 is rejected under 35 U.S.C § 103(a) as being unpatentable over Van Zoest in view of Gioscia, further in view of the knowledge of a person of ordinary skill in the art, and further in view of Dimenstein.

These rejections are **adopted** as explained in the Request (**pp. 299-329 and Exhibits CC-NN—CC-TT**).

11. **Grounds UU—CCC (adopted)**

UU. Claims 1-5, 10-12, and 16 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, and further in view of Kumar.

VV. Claims 6 and 7 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of the knowledge of a person of ordinary skill in the art.

WW. Claims 8, 14, and 17 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Kaplan.

XX. Claims 9 and 15 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, further in view of SoundJam, and further in view of the knowledge of a person of ordinary skill in the art.

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YY. Claims 9 and 15 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, further in view of Chen, and further in view of the knowledge of a person of ordinary skill in the art.

ZZ. Claim 13 is rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Van Zoest.

AAA. Claim 16 is rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Rio 500.

BBB. Claims 18 and 20 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Leeke.

CCC. Claim 19 is rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, further in view of Kumar, and further in view of Dimenstein.

These rejections are **adopted** as explained in the Request (**pp. 330-380 and Exhibits CC-UU—CC-CCC**).

Rejections of New Claims 21-37

12. Claims 21-27 are rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar. This combination teaches all of the limitations of base claims 1-3 (see Ground A). As explained on pp. 39-40 of Requester's remarks dated 10/12/2010, Kumar is considered to teach the additional limitations recited in claims 21-27.

Claim 34 is not rejected under 35 U.S.C § 103(a) as being unpatentable over Rio 500 in view of Kumar, and further in view of RealJukebox, since this combination does not render base claim 11 obvious (see Ground B).

13. Claims 21-27 are rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500 in view of Kumar. This combination teaches all of the limitations of base claims 1-3 (see Ground L). As explained on pp. 39-40 of Requester's remarks dated 10/12/2010, Kumar is considered to teach the additional limitations recited in claims 21-27.

Claim 34 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500 in view of Kumar, and further in view of RealJukebox, since this combination does not render base claim 11 obvious (see Ground L).

14. Claims 22, 23, and 25 are rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Naughton. This combination teaches all of the limitations of base claims 1 and 2 (see Ground S). As explained on pp. 40-41 of Requester's remarks dated 10/12/2010, Rio 500 is considered to teach the additional limitations recited in claims 22, 23, and 25.

Claim 24 is not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Naughton, since Rio 500 operates on AA batteries, and there is no teaching of recharging these batteries in the claimed manner.

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15. Claims 21 and 26-29 are rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Naughton, and further in view of Abecassis. This combination teaches all of the limitations of base claim 3 (see Ground X). As explained on pp. 41-42 of Requester's remarks dated 10/12/2010, Abecassis is considered to teach the additional limitations recited in claims 21 and 26-29.

16. Claims 22-25 and 30-31 are rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Naughton, and further in view of Abecassis. The combination of SoundJam, Rio 500, and Naughton teaches all of the limitations of base claims 1 and 2 (see Ground S). As explained on pp. 41-43 of Requester's remarks dated 10/12/2010, Abecassis is considered to teach and render obvious the additional limitations recited in claims 22-25 and 30-31.

Claims 32-37 are not rejected under 35 U.S.C § 103(a) as being unpatentable over SoundJam in view of Rio 500, and further in view of Abecassis, since this combination does not render base claim 11 obvious (see Ground Y).

17. Claims 21-37 are rejected under 35 U.S.C § 103(a) as being unpatentable over Lau in view of Naim, and further in view of Lee. This combination teaches all of the limitations of base claims 1-3 and 11 (see Ground EE). As explained on pp. 44-46 of Requester's remarks dated 10/12/2010, this combination is considered to teach and render obvious the additional limitations recited in claims 21-37.

18. Claims 21-27 and 32-34 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, and further in view of Kumar. This combination teaches all of the limitations of base claims 1-3 and 11 (see Ground UU). As explained on pp. 46-48 of Requester's remarks dated 10/12/2010, this combination is considered to teach and render obvious the additional limitations recited in claims 21-27 and 32-34.

Claims 28, 29, and 35 are rejected under 35 U.S.C § 103(a) as being unpatentable over Looney in view of Dwyer, and further in view of Kumar, and further in view of Leeke or Kaplan. The combination of Looney, Dwyer, and Kumar teaches all of the limitations of base claims 1, 3, and 11 (see Ground UU). As explained on pp. 48-49 of Requester's remarks dated 10/12/2010, Leeke and Kaplan are each considered to teach and render obvious the additional limitations recited in claims 28, 29, and 35.

Conclusion

This is a RIGHT OF APPEAL NOTICE (RAN); see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

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By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
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of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to the Office of Patent Legal Administration at (571) 272-7701.

Conferees:

/Colin LaRose/
Primary Examiner
Art Unit 3992

Handwritten signatures of two conferees. The first signature is 'ZD' and the second is 'ASK'.

Receipt date: 10/12/2011

95001263 - CALL: 3992

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White, et al.		
	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

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Receipt date: 10/12/2011 INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	95001263 - GAU: 3992
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	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

1	MULTI TECHNOLOGY EQUIPMENT, "Neo Car Jukebox, Installation and Instruction Manual," Prior to March 28, 2000, 29 pages.	<input type="checkbox"/>
2	SONY CORPORATION, "FM/AM Compact Disc Player Operating Instructions," 1998, 132 pages.	<input type="checkbox"/>

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95001263 - CALL: 3992

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	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

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Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	6349223		2002-02-19	Chen	
	2	7945284		2011-05-11	Cao et al.	
	3	5978689		1999-11-02	Tuoriniemi et al.	
	4	6697470		2004-02-24	McDonough	
	5	6493429		2002-12-10	Cannon et al.	

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	1	20040203608		2004-10-14	Osann, Jr.	

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	First Named Inventor	Russell W. White, et al.		
	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

2	20050143047	2005-06-30	Kwon et al.
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	1	WO 99 38266	WO		1999-07-29	Qureshey et al.		<input type="checkbox"/>

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	1	Exhibit 4 in Request for Inter Partes Reexamination of U.S. Patent No. 7,634,228 filed October 26, 2011 (Declaration of Dr. Dewayne Perry (12 pages) with exhibits A - P, dated February 11, 2011).	<input type="checkbox"/>
	2	Exhibit 5 in Request for Inter Partes Reexamination of U.S. Patent No. 7,634,228 filed October 26, 2011 (Declaration of Scott Andrews (8 pages) with exhibits A - C dated February 11, 2011).	<input type="checkbox"/>
	3	"Alpine Debuts Worlds First Audio Head Units That Allow True Integration with iPod," Press Release, Alpine Electronics of America, Inc., January 8, 2004, 1 page.	<input type="checkbox"/>
	4	"iPhone User's Guide," Apple Computers, Inc., date unknown, 124 pages.	<input type="checkbox"/>
	5	"Owner's Manual for iPod Interface," BMW of North America, LLC., 2004, 22 pages.	<input type="checkbox"/>

Receipt date: 11/17/2011 INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95001263	95001263 - GAU: 3992
	Filing Date		2009-11-13	
	First Named Inventor	Russell W. White, et al.		
	Art Unit	3992		
	Examiner Name	Colin M. Larose		
	Attorney Docket Number	AFF.004B6US		

6	"Infotainment/MMI Operating Instructions," Audi AG, 2006, 195 pages.	<input type="checkbox"/>
7	"VRX755VD, Owner's Manual & Installation Manual," Clarion Corp., date unknown, 74 pages.	<input type="checkbox"/>
8	"iPod User's Guide," Apple Computer, Inc., date unknown, 64 pages.	<input type="checkbox"/>
9	Declaration of Hugo Fiennes in Support of Apple's Opposition to Affinity Labs of Texas, LLC's Motion for Summary Judgment and Apple's Cross Motion for Summary Judgment, in AFFINITY LABS OF TEXAS, LLC. v. APPLE INC., case no. CV 09-4436-CW, on June 23, 2011, 62 Pages.	<input type="checkbox"/>
10	"The Free iPod Book 2.2 from iLounge.com," The Media LLC. 2005-2006, 202 pages.	<input type="checkbox"/>


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Reexamination 	Application/Control No. 95001263	Applicant(s)/Patent Under Reexamination 7486926
	Certificate Date	Certificate Number

Requester Correspondence Address: **Patent Owner** **Third Party**

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 1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
 HOUSTON, TX 77002

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<small>Case Name</small>		<small>Director Initials</small>
Affinity Labs v. Apple 4:09cv4436 (N CA) - OPEN		NDQ R 34
Affinity Labs v. Apple 9:09cv47 (E TX) - OPEN		↓

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TYPE OF PROCEEDING	NUMBER
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