

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MAZDA MOTOR OF AMERICA, INC.,  
SUBARU OF AMERICA, INC., and VOLVO CAR USA, LLC,  
Petitioners,

v.

STRATOSAUDIO, INC.,  
Patent Owner

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IPR2022-00203  
Patent 8,166,081 B2

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Before JUSTIN T. ARBES, HYUN J. JUNG, and  
KEVIN C. TROCK, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314(a)

Granting Motion for Joinder  
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

## I. INTRODUCTION

Petitioners, Mazda Motor of America, Inc., Subaru of America, Inc., and Volvo Car USA, LLC, request institution of an *inter partes* review to challenge the patentability of claims 9–11 and 23 (the “challenged claims”) of U.S. Patent No. 8,166,081 B2 (Ex. 1001, “the ’081 Patent”). Paper 1 (“Petition” or “Pet.”). Concurrently with the Petition, Petitioners filed a Motion for Joinder with *Volkswagen Group of America, Inc. v. StratosAudio, Inc.*, Case IPR2021-00721 (“the *Volkswagen* IPR”). Paper 5 (“Motion” or “Mot.”). On March 14, 2022, pursuant to 37 C.F.R. § 42.107(b), Patent Owner filed a Waiver of Patent Owner Preliminary Response, stating that Patent Owner “does not oppose Petitioner’s Motion for Joinder.” Paper 9, 1 (“Waiver”).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioners would prevail with respect to at least one challenged claim, we institute an *inter partes* review. We also grant the Motion for Joinder for the reasons discussed below.

### A. Related Matters

The parties identify the following as related matters: *StratosAudio, Inc. v. Hyundai Motor America*, No. 20-cv-01125 (W.D. Tex.); *StratosAudio, Inc. v. Mazda Motor of America, Inc.*, No. 20-cv-01126 (W.D. Tex.); *StratosAudio, Inc. v. Volkswagen Group of America, Inc.*, No. 20-cv-01127 (W.D. Tex.); *StratosAudio, Inc. v. Subaru of America, Inc.*, No. 20-cv-01128 (W.D. Tex.); *StratosAudio, Inc. v. Volvo Cars USA, LLC*, No. 20-cv-01129 (W.D. Tex.); *StratosAudio, Inc. v. Volkswagen Group of America, Inc.*, No. 20-cv-01131 (W.D. Tex.); IPR2021-00720 (PTAB Apr. 16, 2021); IPR2021-00721 (PTAB Apr. 16, 2021); and IPR2021-01267 (PTAB Jul. 16,

2021). Pet. 2; Paper 6, 1–2.

Patent Owner also identifies these related matters: *In re Volkswagen Group of America, Inc.*, No. 21-149 (Fed. Cir.); *In re Volkswagen Group of America, Inc.*, No. 22-108 (Fed. Cir.); and *In re Hyundai Motor America*, No. 22-109 (Fed. Cir.). Paper 6, 2.

*B. The '081 Patent*

The '081 Patent relates to media advertising and associating an advertising media signal with another media signal. Ex. 1001, 1:18–20. The '081 Patent explains that it is generally desirable to associate products with specific characteristics and such associations may increase the chance that a potential customer will decide to purchase a product when the product is associated with a favorable characteristic. *Id.* at 1:22–30. In view of this, the '081 Patent states that an advertisement may be more effective if it is associated with an image of a celebrity or another media element that exhibits favorable characteristics. *Id.* at 1:31–34.

The '081 Patent describes a media enhancement system that is configured to associate a secondary media signal (e.g., an advertisement) to a primary media signal (e.g., a radio broadcast). *Id.* at 3:8–12. The '081 Patent explains that the secondary media signal may be based on the content of the primary media, user characteristics (e.g., demographic and/or geographic information), and/or third party preferences (e.g., the goals of advertisers). *Id.* at 3:16–20.

The '081 Patent provides an example in which a radio station transmits a song in a first media signal that is received by a user enabled-device (e.g., a cellular phone with a radio). *Id.* at 3:27–29. A media association system analyzes the song to determine what media elements can

be associated with the song and the media association system provides a second media signal (e.g., an advertisement) to the user enabled-device. *Id.* at 3:30–33. While the user enabled-device is playing the song, the user enabled-device displays the media content in the second media signal (e.g., a still or moving picture of the advertised product). *Id.* at 3:37–39. The '081 Patent provides another example in which a user enabled-device is playing a song from a first media signal, media content from a second media signal (e.g., a still or moving picture with selectable audio of an advertised product) is displayed by the user enabled-device, and the audio track for the first media signal is paused upon selection of the second media signal audio. *Id.* at 3:41–47.

*C. Evidence*

Petitioners rely upon the following evidence in the Petition.

- (1) U.S. Patent No. US 6,349,329 B1, issued Feb. 19, 2002 (“Mackintosh”) (Ex. 1004);
- (2) U.S. Patent Application Publication No. 2005/0262542 A1, published Nov. 24, 2005 (“DeWeese”) (Ex. 1005); and
- (3) Declaration of Tim A. Williams, Ph.D. (Ex. 1003).

*See* Pet. 16–82.

*D. Asserted Grounds of Unpatentability*

Petitioners assert the following grounds of unpatentability in the Petition.

Grounds	Prior Art	Basis	Claims Challenged
1, 2	Mackintosh	§102, §103	9–11, 23
3, 4	DeWeese	§102, §103	9–11, 23

Pet. 4.

II. ANALYSIS

Petitioners contend that the Petition “presents the same art, arguments, and grounds as the [*Volkswagen*] proceeding” and that “[t]he Petition and expert declaration are substantially identical to those submitted in the [*Volkswagen*] proceeding, except for non-substantive introductory matters and mandatory notices.” Pet. 1. Patent Owner does not contest Petitioners’ assertions. Waiver, 1.

In the *Volkswagen* IPR, we instituted an *inter partes* review of claims 9–11 and 23 of the ’081 Patent on the following bases.<sup>1</sup>

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<sup>1</sup> In the *Volkswagen* IPR, although we did not determine that the petition demonstrated a reasonable likelihood of prevailing with respect to certain challenges under 35 U.S.C. § 103(a), we nonetheless instituted *inter partes* review on all claims and all grounds raised in the petition pursuant to *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018) (holding that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition). *Volkswagen* IPR, Paper 16, 50.

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