

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

STRATOSAUDIO, INC.,
Patent Owner

IPR2022-00203
Patent 8,166,081 B2

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.¹

¹ 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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