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Paper 10
Date: May 11, 2022

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,
Petitioner,

v.

STRATOSAUDIO, INC.,
Patent Owner.

IPR2022-00204
Patent 8,688,028 B2

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

ARBES, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background and Summary

Mazda Motor of America, Inc., Subaru of America, Inc., and Volvo Car USA, LLC (collectively, "Petitioner") filed a Petition (Paper 1, "Pet.")

requesting *inter partes* review of claims 11, 14–16, and 18 of U.S. Patent No. 8,688,028 B2 (Ex. 1001, "the '028 patent") pursuant to 35 U.S.C. § 311(a). Concurrently, Petitioner filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), seeking to be joined as a party to *Volkswagen Group of America, Inc. v. StratosAudio, Inc.*, Case IPR2021-00716 ("the Volkswagen IPR"), which also involves claims 11, 14–16, and 18 of the '028 patent. Paper 5 ("Mot."). Patent Owner did not file an opposition to the Motion for Joinder and waived the filing of a preliminary response pursuant to 37 C.F.R. § 42.107(b). Paper 9.

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the Volkswagen IPR and grant Petitioner's Motion for Joinder.

B. Related Matters

The parties indicate that the '028 patent is the subject of the following district court cases: *StratosAudio, Inc. v. Volkswagen Group of America, Inc.*, Case No. 6:20-cv-1131 (W.D. Tex.), *StratosAudio, Inc. v. Hyundai Motor America*, Case No. 6:20-cv-1125 (W.D. Tex.), *StratosAudio, Inc. v. Mazda Motor of America, Inc.*, Case No. 6:20-cv-1126 (W.D. Tex.), *StratosAudio, Inc. v. Subaru of America, Inc.*, Case No. 6:20-cv-1128 (W.D. Tex.), and *StratosAudio, Inc. v. Volvo Cars of North America, LLC*, Case No. 6:20-cv-1129 (W.D. Tex.) (collectively, "the district court cases"). *See* Pet. 2; Paper 6, 1.

Petitioner filed a petition challenging claims of a patent related to the '028 patent and motion for joinder in Case IPR2022-00205. Other proceedings involving patents asserted in the district court cases are Cases IPR2021-00712 (instituted), the Volkswagen IPR (instituted), IPR2021-00717 (denied), IPR2021-00718 (denied), IPR2021-00719 (denied), IPR2021-00720 (instituted), IPR2021-00721 (instituted), IPR2021-01267 (instituted), IPR2021-01303 (instituted), IPR2021-01305 (instituted), IPR2021-01371 (instituted), IPR2022-00203 (pending), and IPR2022-00224 (pending).

C. Illustrative Claim

Challenged claim 11 of the '028 patent is independent. Claims 14–16 and 18 each depend directly from claim 11. Claim 11 recites:

> 11. A method for correlating media content identifying data with at least one broadcast segment received by a communication device, the method comprising:
>
> receiving a broadcast stream comprising the at least one broadcast segment and associated media content;
>
> receiving a data stream associated with the broadcast stream, the data stream comprising, at a minimum, the media content identifying data, wherein the media content identifying data comprises at least one element;
>
> extracting the media content identifying data from the data stream, associating each media content identifying data element with at least one of a plurality of media content;
>
> storing in an electronic memory of the communication device, at a minimum, media content identifying data elements into identifying data aggregates, each identifying data aggregate associated with at least one of the plurality of media content and the at least one broadcast segment, wherein the at least one broadcast segment is corollary to the at least one of the plurality of media content; and

providing for presentation of at least a portion of the data elements stored in the electronic memory of the communication device, whereby the providing provides selective outputting, using an interface, of at least one of the following: the media content identifying data, the media content, the corollary broadcast segment, a temporal position of the corollary broadcast segment of the broadcast stream.

D. Evidence

Petitioner relies on the following prior art:

U.S. Patent No. 6,317,784 B1, filed Sept. 29, 1998, issued Nov. 13, 2001 (Ex. 1005, "Mackintosh"); and

U.S. Patent No. 5,579,537, issued Nov. 26, 1996 (Ex. 1004, "Takahisa").

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 11, 14–16, and 18 of the '028 patent are unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	Reference/Basis
11, 14–16, 18	102(b)[1]	Takahisa
11, 14–16, 18	103(a)	Mackintosh

II. ANALYSIS

Joinder for purposes of an *inter partes* review is governed by 35 U.S.C. § 315(c), which states:

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102 and 103. Because the challenged claims of the '028 patent have an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103. *See* Pet. 4.

> JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

"To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). "First, the statute requires that the Director (or the Board acting through a delegation of authority) . . . determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* "Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to 'join as a party' the joinder applicant." *Id.*

A. Whether the Petition Warrants Institution

Petitioner states that its Petition and accompanying declaration of Vijay Madisetti, Ph.D. (Exhibit 1003), are "substantively identical" to those filed by Volkswagen Group of America, Inc. ("Volkswagen") in the Volkswagen IPR, with the only differences being the identification of Petitioner and mandatory notice information. *See* Pet. 1–2; Mot. 1–2. We previously instituted an *inter partes* review in the Volkswagen IPR. *See* IPR2021-00716, Paper 16 ("Dec. on Inst.").

We incorporate our previous analysis regarding the asserted grounds of unpatentability, and conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the '028 patent challenged in the Petition for the same reasons. *See* Dec. on

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