

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELECTRONIC FRONTIER FOUNDATION
Petitioner,

v.

PERSONAL AUDIO, LLC
Patent Owner.

Case IPR2014-00070
Patent 8,112,504 B2

Before SHERIDAN K. SNEDDEN, TRENTON A. WARD, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

INTRODUCTION

On October 30, 2013, Electronic Frontier Foundation (“Petitioner”) filed a revised Petition requesting an *inter partes* review of claims 31–35 of U.S. Patent No. 8,112,504 B2 (Ex. 1001, “the ’504 patent”). Paper 6 (“Pet.”). On April 18, 2014, we granted the Petition and instituted trial for claims 31–35 of the ’504 patent on less than all of the grounds of unpatentability alleged in the Petition. Paper 21 (“Decision on Institution” or “Dec.”).

After institution of trial, Personal Audio, LLC (“Patent Owner”) filed a Patent Owner Response. Paper 30 (“PO Resp.”). Petitioner filed a Reply. Paper 34 (“Pet. Reply”).

An oral hearing was held on December 17, 2014. The transcript of the hearing has been entered into the record. Paper 40 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a).

A. *Related Proceedings*

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

July 26, 2013); and (vii) *Personal Audio, LLC v. Fox Broadcasting Co.*, No. 2:13-cv-577 (E.D. Tex. Aug. 6, 2013). Pet. 1–2, Paper 28.

B. The '504 patent

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

Figure 1 of the '504 patent is reproduced below:

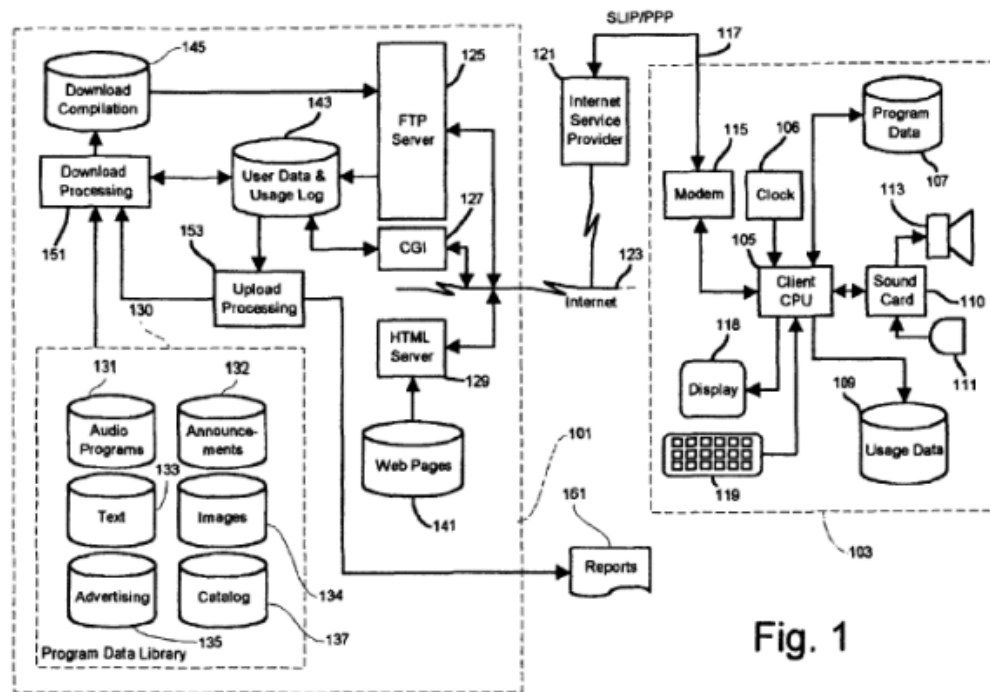


Fig. 1

Figure 1 is a block diagram of the invention that illustrates using the Internet to connect host computer 101 to audio player 103. Ex. 1001, 4:39–42. Host server 101 periodically transmits download compilation file 145 upon receiving a request from player 103. *Id.* at 6:60–62. The compilation file extracts data from library 130 based on the selections of the user as specified

in the subscriber data and usage log database 143. *Id.* at 7:3–9. The file is placed in a predetermined FTP download file directory and assigned a filename known to the player. *Id.* at 6:62–64. Using clock 106, at a time determined by the player, a dial up connection is established via service provider 121 and the Internet to FTP server 125, and the download compilation is transferred to program data store 107 in the player. *Id.* at 6:64–7:1. Once downloaded, the user plays program data 107 using the functionality of the player. *Id.* at 4:44–60.

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

C. Illustrative Claim

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

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

one or more data storage servers,

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

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

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

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

employing one of said one or more communication interfaces to:

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

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

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

D. Grounds Upon Which Trial Was Instituted

Inter partes review was instituted on two ground: (1) that claims 31–35 of the '504 patent were anticipated under 35 U.S.C.

§ 102(a) by Patrick/CBC;¹ and (2) claims 31–35 would have been obvious under 35 U.S.C. § 103(a) over Compton/CNN.² Dec. 26.

ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1279–83 (Fed. Cir. 2015). If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). The terms also are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. “episode” (Claims 31–35)

Petitioner proposes “episode” be construed as “a program segment, represented by one or more media files, that is part of a series of related segments, e.g. a radio show or a newscast.” Pet. 11–12; Pet. Reply 8. Petitioner notes that the Specification describes an episode as a program segment that is part of a series (i.e., a sequence of related segments).

¹ Andrew S. Patrick, et al, *CBC Radio on the Internet: An Experiment in Convergence*, 21 CANADIAN J. OF COMM’N 1, 125-140 (1996)(“Patrick/CBC,” Ex. 1012).

² Charles L. Compton, *Internet CNN NEWSROOM: The Design of a Digital Video News Magazine*, Massachusetts Institute of Technology (Aug. 10, 1995)(“Compton/CNN,” Ex. 1022).

Pet. 11, (citing Ex. 1001, 19:35–42). Petitioner also argues that “program segment[s]” may be combined with other “related program segments” to form a subsection of the overall compilation. Pet. Reply 6–8 (citing Ex. 1001, 29:28–34). Petitioner argues the related program segments disclosed in the ’504 patent include, among other things, world, national and local news. *Id.* (citing Ex. 1001, 30:18–25).

Patent Owner proposes that “episode” should be construed as “a program, represented by one or more media files, that is a part of a series.” PO Resp. 10 (emphasis omitted). Patent Owner notes that the ’504 patent references the episodes in a serialized sequence.” *Id.* at n. 3. Patent Owner also cites to the Specification as stating that:

. . . programming may include serialized sequences of programs. A given program segment may represent an episode in a series which is selected as a group by the subscriber.

Id. (citing Ex. 1001, 19:36–37; *see* Ex. 1001, 19:35–20:11; 20:57–21:3; 39:35–46; 43–45:67; 46:1–52:11). Notwithstanding the preceding, Patent Owner argues our final construction of “episode” is not determinative of the outcome here because “episode,” as well as “compilation file,” are “further qualified by the plain and ordinary meaning of other claim language,” which is dispositive. PO Resp. 11 (emphasis omitted).

To summarize the parties’ respective positions, Petitioner proposes that episodes are related program segments. Patent Owner argues that an episode is a program, not a segment thereof, that is part of a series. At the final hearing, Patent Owner argued the difference between episodes and segments is that episodes must be related to each other, while segments are not related. Tr. 22:14–21. However, Patent Owner acknowledges that the

Specification states that a given “program segment may represent an episode in a series.” PO Resp. 10, n.3.

The Specification lists several forms of programming that a “subscriber may select.” *See* Ex. 1001, 19:38–42.³ In that portion of the Specification cited by both parties, the only mention of “episode” states that “[a] given *program segment* may represent an episode in a series which is selected as a group by the subscriber.” *Id.* at 19:36–38 (emphasis added).

In support of its construction, Patent Owner argued at the final hearing episodes are television programs. Tr. 25:14–18; 40:1–7. The Specification is not so limited and lists, among other things, news programming as part of the “overall program compilation.” Ex. 1001, 29:8–12; 30:18–25. We are not persuaded by Patent Owner’s argument that the Specification is limited to segments and the claims refer to episodes. *See* Tr. 26:16–20.

Neither party argued that the limitation “series of episodes,” as it appears in the preamble of challenged claim 31, has any different meaning from “episode” alone. We give “series,” and therefore, “series of episodes,” its ordinary and customary meaning in the context of our construction of “episode.”

Thus, we conclude that related program segments are included in the broadest reasonable interpretation of “episode.” We construe “episode” to mean “a program segment, represented by one or more media files, which is part of a series of related segments, e.g., a radio show or a newscast.”

³ Neither declarant proposes or argues claim construction for any claim term. *See* Declaration of Chris Schmandt (“Schmandt Declaration,” Ex. 1002 ¶¶ 11); Declaration of Peter C. Nelson (“Nelson Declaration,” Ex. 2004 ¶¶ 37–39).

2. “*compilation file*” (Claims 31–35)

Petitioner proposes “compilation file” be construed as “any file that contains information about multiple episodes and satisfies the other claim requirements.” Pet. 12–13; Pet. Reply 8. Petitioner argues that the Specification describes the “compilation file” as simply an ordinary file that contains the information required by the claim. *Id.* (citing Ex. 1001, 6:60–64, 7:10–22).

Patent Owner contends that our construction of particular words or phrases is “not material” to Patent Owner’s arguments in its Response. PO Resp. 11. Rather, the words or phrases, particularly “compilation file,” are “further qualified by the plain and ordinary meaning of other claim language.” *Id.* (emphasis omitted). As a result of the preceding, Patent Owner has no proposed construction for “compilation file.”

In our Decision on Institution we preliminarily construed compilation file as “a file that contains episode information.” Dec. 8. This construction was supported by, among other things, the Specification, which describes the compilation file as “one or more subscriber and session specific files which contain the identification of separately stored sharable files.” *Id.* (citing Ex. 1001, 7:10–13). Episode information in the compilation file of claim 31, which states the “compilation file contain[s] . . . attribute data describing currently available episodes in said series of episodes.”

At the final hearing, Patent Owner objected to our preliminary construction because it included the term “episode,” but did not articulate any reason for the objection to the inclusion of episode. Tr. 32:10–14. Patent Owner argues additionally that the cited references do not include a compilation file at all. Tr. 32:15–22. However, Patent Owner does not

make any specific argument regarding how we should construe “compilation file.” Instead, Patent Owner’s argument relies on arguments relating to its proposed construction of “episode.” Tr. 33:3–34:23.

As discussed above, we also have considered the claim language, which Patent Owner argues qualifies the construction of compilation file. PO Resp. 11. Claim 31 recites, in pertinent part, “storing an *updated version of a compilation file* in one of said one or more data storage servers at a storage location identified by a predetermined URL.”⁴ Claim 31 (emphasis added). Patent Owner contends that the “updated compilation file” includes information from previous compilation files. Tr. 46:17–21. As used in claim 31, however, “updated” does modify “compilation file,” but rather it modifies “version.” The meaning of “updated” does not require express construction.

Thus, we determine the broadest reasonable interpretation of “compilation file” is “a file that contains episode information.”

3. “*media file*” (*Claims 31–35*)

Petitioner proposes that “media file” be construed as “a file with content that can be reproduced as video, audio, and/or text.” Pet. 13; Pet. Reply 9. Petitioner points to claims 32 and 33 as reciting that the media file includes “digital compressed audio” and/or “text data.” *Id.* (citing Ex. 1001, claims 32–33). Patent Owner does not propose a meaning for the term and does not object to our preliminary construction in the Decision on Institution. *See* PO Resp. 9–11.

⁴ Claim 1, which is not challenged here, also references the “current version” of a compilation file.

The Specification does not define or describe the term “media files” beyond the recitation of the term in the claims. The customary and ordinary meaning of “media” is consistent with Petitioner’s proposed construction of “media files.”

Thus, we determine the broadest reasonable interpretation of “media files” is “a file with content that can be reproduced as video, audio, and/or text.”

B. Obvious over Compton/CNN (Claims 31–35)

Petitioner contends that claims 31–35 of the ’504 patent are obvious under 35 U.S.C. § 103 over Compton/CNN (Ex. 1022). Pet. 16, 45–59. To support this position, Petitioner presents the Schmandt Declaration. Ex. 1002 ¶¶ 72–85.

1. Compton/CNN Overview

Compton/CNN describes the design of a digital video newsroom based on the video program CNN NEWSROOM.⁵ Ex. 1022, Abstract. Compton/CNN describes that the CNN NEWSROOM uses MPEG digital video and is distributed via the World Wide Web on the Internet. *Id.*

CNN NEWSROOM is disclosed as being distributed via cable television systems as well as directly to schools via satellite. Ex. 1022, 11.⁶ Compton/CNN describes that an important aspect of the Internet deployment of CNN NEWSROOM is the development of a searchable digital library of

⁵ Exhibit 1022 also uses “CNN Internet NEWSROOM,” “Internet CNN NEWSROOM,” and “Internet NEWSROOM.” We generally will refer to these disclosed video programs as “CNN NEWSROOM.”

⁶ Page references are to the actual page numbers of Exhibit 1022 and not to Petitioner’s Exhibit pages.

CNN NEWSROOM programs and segments. *Id.* at 14. CNN NEWSROOM is disclosed as being archived for six months. *Id.* at 15.

Figure 1 of Compton/CNN is reproduced below.

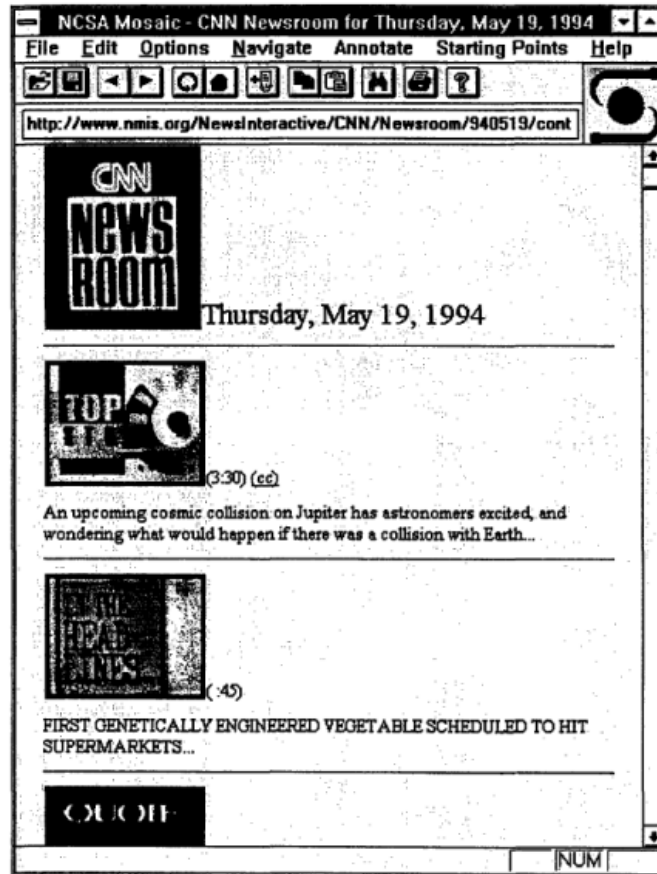


Figure 1: CNN NEWSROOM Video Magazine

Figure 1 shows the Table of Contents for a particular day's programming. Ex. 1022, 14. Figure 1 further shows the Table of Contents as an HTML document that consists of a short summary and an icon or title for each segment of the program, where a segment corresponds to a single news story. *Id.*

Figure 6 of Compton/CNN is reproduced below.

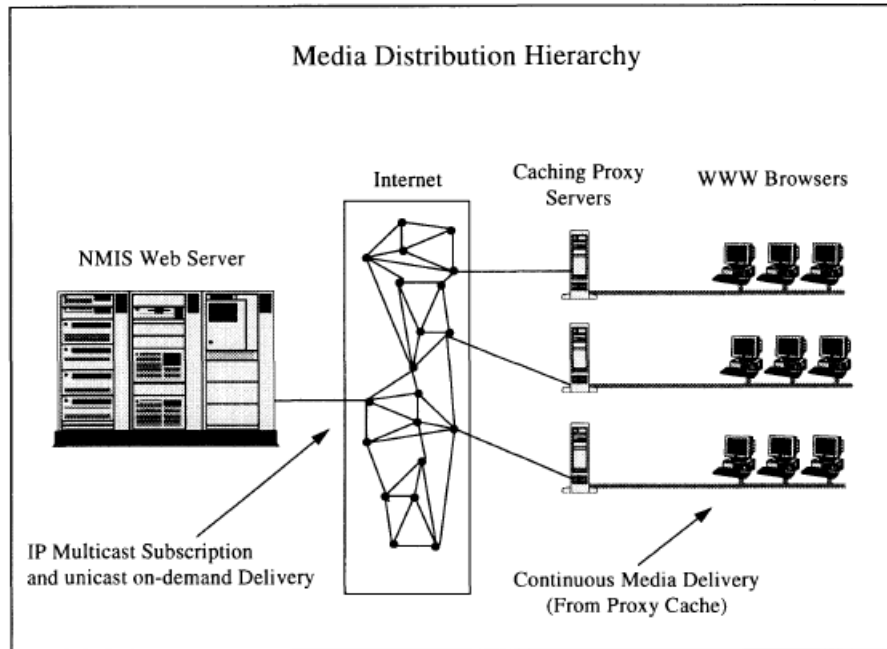


Figure 6: Media Distribution Hierarchy

Figure 6 illustrates a hardware hierarchy for network video distribution. Ex. 1022, 23–24. Caching proxy servers store video content. *Id.* Only one caching server is required for Internet connectivity. *Id.* at 23.

Ultimately, video is delivered over the Internet to the subscribing caching servers for display. Ex. 1022, 25. The programming includes past episodes of other news programs, sitcoms, and soap operas. *Id.* at 29.

2. Claims 31–35 as Obvious over Compton/CNN

We begin our obviousness analysis by determining the level of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007)(citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)). At the final hearing Patent Owner relied on the Nelson Declaration to argue the level of ordinary skill is not a “high level.” Tr. 29:1–12. The Nelson Declaration says the level of ordinary skill is an “undergraduate degree in

computer science or a few years' experience in working with web sites and programming.” Ex. 2004 ¶ 34. We find credible the Nelson Declaration's testimony that at the time the invention was conceived, 1994–1996, web developers did not necessarily have formal training. *Id.* Petitioner agrees with Patent Owner's position. Tr. 64:21–65:2. Thus, we adopt the level of ordinary skill proposed by Patent Owner.

Petitioner contends the disputed limitations of claim 31 are taught by Compton/CNN specifically including: (1) episodes; (2) an updated compilation file; and (3) a “predetermined URL” for the compilation file. *See* Pet. Reply 1. Patent Owner statement of the issues is very similar, i.e., that neither Compton/CNN or Patrick/CBC (discussed below) disclose claim limitations related to new episodes, updating the compilation file, and a predetermined URL for the compilation file. PO Resp. 46–47 (citing Ex. 2004 ¶¶ 18, 21, 56, 61, 63).

We first address the limitations both parties find to be in dispute. To the extent not addressed in our analysis, Patent Owner's arguments that other claim 31 limitations or dependent claim limitations are not shown will be addressed separately. *See* PO Resp. 35–37; Ex. 2004 ¶¶ 51–63.

a. Whether Compton/CNN teaches “episodes”

Petitioner argues CNN Newsroom describes a system for distributing a “video magazine” via the Internet. Pet. 53 (citing Ex. 1022, 13). Further, the video broadcast each day by CNN Newsroom is broken out into segments that each “corresponds to a single news story.” *Id.* (citing Ex. 1022 at 14). Compton/CNN teaches that the segments were encoded in MPEG-1 media files. *Id.* (citing Ex. 1022 at 7). Petitioner notes that Compton/CNN explains that the same system could be used for “any other

program for which users might want to be able to see past episodes (i.e., other news programs, sitcoms, soap operas . . . [.]” *Id.* (citing Ex. 1022 at 29).

Petitioner argues that the “displayable text” in the Table of Contents describes the “episode,” i.e., segment. Pet. 56, Pet. Reply 6. Petitioner contends the Table of Contents includes URLs specifying media files representing the “episode” which can be downloaded. *Id.* (citing Ex. 1002 ¶¶ 24–33; *see also* Ex. 1022 at 25 (user clicking on a link an entire MPEG file is downloaded to user’s hard disk)).

Petitioner argues that testimony by Patent Owner’s declarant, Dr. Nelson, at his deposition (Ex. 1031), supports its position that Compton/CNN teaches “episodes.” Pet. Reply 6. Specifically, Dr. Nelson, at his deposition, acknowledges that, under our construction of “episode,” Compton/CNN Figure 1 discloses “episodes.” *Id.* (citing Ex. 1031, 88:14–24).

Patent Owner’s opposition to a determination that “episodes” are not disclosed in Figure 1 of Compton/CNN relies on our accepting its construction of “episode.” As discussed above, Patent Owner argues “episode” should be construed as “a program, represented by one or more media files, that is a part of a series.” PO Resp. 10 (emphasis omitted). Thus, based on its proposed construction that an episode is part of a “series,” Patent Owner contends the news stories of Figure 1 of Compton/CNN are “not different episodes but rather part of the single May 19, 1994 episode.” *Id.* at 38. Patent Owner also argues the news segments are neither a series nor are they a program. *Id.* at 38–39.

Our construction of “episode,” however, leads us to reject Patent Owner’s argument that episodes must be either a program or in a given order. *See* Tr. 39:24–40:7. Nor are we persuaded that a theme between episodes is required. Tr. 38:6–11. As we noted in our construction analysis, the Specification specifically lists new programming as being part of a compilation file of “episodes.” Ex. 1001, 30:18–25.

Additionally, Patent Owner argues the May 19 news segments disclosed in Compton/CNN are not “updated,” as claim 31 requires. *Id.* at 39. This argument relates to the “updated version of a compilation file” limitation, which we discuss next.

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, Compton/CNN discloses “episodes” as claimed.

b. Whether Compton/CNN teaches an “updated version of a compilation file”

Claim 31 recites that a “compilation file” is updated from “time to time, as new episodes represented in said series of episodes become available.” As already discussed, the Table of Contents of Compton/CNN (*see* Figure 1 above) is relied on by Petitioner to show a “compilation file.” Pet. 55 (citing Ex. 1002 ¶ 78). Petitioner argues that the “displayable text” in the Table of Contents describes the “episode,” i.e., segment. *Id.* at 56. Petitioner contends it would have been obvious to update the compilation file as new segments are produced. *Id.* at 50 (citing Ex. 1002 ¶ 78; 1022, 13–14).

In the first instance, Patent Owner argues the Table of Contents of Compton/CNN is not a compilation file at all because it “described one

episode only.” PO Resp. 40. Based on our construction of “episode” and “compilation file,” there are two news segments, i.e., “episodes,” identified in the Table of Contents of Compton/CNN. Accordingly, we disagree with Patent Owner’s premise, that the two news segments, i.e., “episodes,” identified in the Table of Contents are only a single episode. Furthermore, we are persuaded that the Table of Contents is a “compilation file” as we have construed the term, i.e., “a file that contains episode information.”

Additionally, Patent Owner argues the Table of Contents page is devoted to a single day, May 19, 1994, and, therefore, is “not **updated as new episodes become available.**” PO Resp. 39 (emphasis in original). Patent Owner contends each day a different Table of Contents page at a different URL is created. *Id.*

Petitioner responds that “the fact that a contents.html file is stored at a different URL for each day does not imply that the contents.html file is not ‘updated.’” Pet. Reply 3. Petitioner contends the program “contents.c” runs each day and a new version of the contents.html file “describes the news segments that became available *that day.*” *Id.* (citing Ex. 1022, Fig. 3,18–19, 13–14)(emphasis in original). . Petitioner again cites to Dr.Nelson’s deposition for testimony that Compton/CNN describes updating the “contents.html” file. *Id.* (citing Ex. 1031, 91:15–18; *see* 90:10–91:14).

As Petitioner argues, the updated “compilation file” limitation is met if the “compilation file” is overwritten. Pet. Reply 4. Patent Owner argued at the final hearing that updating required some information be retained from the previous compilation file. Tr. 46:17–21. Patent Owner’s basis for this position is that the Table of Contents contains a single “episode,” and not a series of episodes or “[a]ll of the episodes required for a compilation.”

Tr.47:15–22, 48:18–23. We have determined already that the Table of Contents includes more than one segment, i.e., “episodes.” There is no claim language limiting how the updating of the compilation file occurs. Claim 31 states that as “new episodes” become available, an “updated version of the compilation file” is created including the new episodes. Ex.1001, 50:52–53.

We have reviewed the Nelson Declaration, which states that Compton/CNN discloses “HTML that was present at a single point” and does not include “disclosure that the HTML was updated.” Ex. 2004 ¶ 52. This is the same contention rejected above, that the Table of Contents, i.e., the “HTML . . . at a single point,” must be updated with new information on an ongoing basis. Other testimony from the Nelson Declaration relating to updated compilation files does not persuade us differently. *See, e.g.*, Ex. 2004 ¶ 61.

Because the claim language does not include a limitation that would prohibit creating a new file on a daily basis from being an update, we find that Compton/CNN teaches an updated compilation file. The episodes listed in one compilation file for one day which are updated for the next day are related segments concerning the news. *See* Ex. 1022, 10. The new episode is thus listed in the updated compilation file, as required by claim 31.

Even if we accept Patent Owner’s argument regarding updating, we agree with Petitioner that it would have been obvious to update the Table of contents by “amendment” as opposed to creating a new file on a daily basis. Pet. Reply 4. According to the Schmandt Declaration, the “URL is partially visible in Figure 1 – the table of contents was accessed at:

[http://www.nmis.org/NewsInteractive/CNN/Newsroom/940519/cont\[ents.ht](http://www.nmis.org/NewsInteractive/CNN/Newsroom/940519/cont[ents.ht)

ml].” Ex. 1002 ¶ 78. “[I]t would require only a trivial modification to use the described system to create an updated table of contents HTML file at a single predetermined URL, such as ‘todaysnews.html.’” *Id.* ¶ 79. We are persuaded by a preponderance of the evidence that Petitioner’s rationale for obviousness is supported by rational underpinnings. *KSR* 550 U.S. at 418. For example, Compton/CNN already archives past programming on the server, making that programming separately accessible to users. *See* Ex. 1022, 15. We agree that making all the programming available at a single URL would have been a “trivial modification” obvious to a person of ordinary skill in the art. *See, e.g.,* Ex. 1002 ¶ 79.

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, Compton/CNN discloses an updated “compilation file” as claimed.

c. Whether Compton/CNN includes a “predetermined URL”

Compton/CNN discloses the automatic generation of a WWW user interface for daily content. Ex. 1022, 7. Further, Compton/CNN captures video using the FTP protocol and delivers the files to the server. *Id.* at 22. Compton/CNN discloses links to the listed content in its teaching that “[c]ustom software agents have been developed to automatically generate the WWW user interface for the service based on daily content.” *Id.* at 7. Compton/CNN goes on to state “[t]his means that results can be delivered to any host on the Internet supporting the ftp protocol.” *Id.* at 22. Petitioner relies upon these disclosures and the testimony in the Schmandt Declaration to argue links in the Table of Contents would be understood to be unique episode URLs. Pet. 55 (citing Ex. 1002 ¶ 77).

Patent Owner again contends that the Table of Contents of Compton/CNN discloses a single episode only and not a series of episodes. PO Resp. 39. The Nelson Declaration is cited for support that Compton/CNN does not disclose “a single predetermined URL where a user can access multiple episodes of a series of episodes at a single place.” *Id.* at 47 (citing Ex. 2004 ¶¶ 58–59). This argument is not persuasive for reasons already discussed. Specifically, the Table of Contents includes information about at least two episodes.

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, Compton/CNN discloses a “predetermined URL” as claimed.

d. Additional Claim Limitations

Patent Owner argues other limitations of claim 31 and the dependent claims are not taught by Compton/CNN. PO Resp. 35–37; Ex. 2004 ¶¶ 51–63. Patent Owner provides a claim chart reproducing in bold claim limitations it contends are not disclosed or suggested by Compton/CNN. PO Resp. 35–37; Ex. 2004 ¶¶ 51–63. The claim chart is unpersuasive that any claim limitation is missing.

Patent Owner does not argue the computer components claimed, i.e., servers, communications interfaces, processors, or requesting client device, are not disclosed to a person of ordinary skill. *See* Tr. 29:13–30:2; 42:7–44:4. The Schmandt Declaration supports the conclusion that the presence of such components would be trivial to the person of ordinary skill in the art.

Ex. 1002 ¶ 47 (disclosure of a “server . . . necessarily would have included processors and a communication interface”).⁷

Patent Owner additionally cites to the Nelson Declaration for its contention that Compton/CNN lacks disclosure of certain claim limitations. PO Resp. 45–47. Patent Owner’s Response states that the Nelson Declaration “[i]n essence” supports the Response. *Id.* at 46. As specifically pertinent to Compton/CNN, Patent Owner restates the argument we rejected above that “at most, Compton/CNN discloses HTML that was present at a single point.” *Id.* at 47 (citing Ex. 2004 ¶¶ 52, 58–59).

We have reviewed paragraphs 51 through 63 of the Nelson Declaration. *See* Ex. 2004 ¶¶ 51–63. These paragraphs discuss Compton/CNN, alleging limitations discussed previously here are not present and alleging the Schmandt Declaration is conclusory regarding obviousness. *Id.* The Nelson Declaration presents no new arguments for our consideration regarding claim 31.

e. Dependent Claims 32–35

We also have reviewed the Petitioner’s argument and evidence and claim charts in connection with dependent claims 32–35. Pet. 51–53, 57–59. The argument is supported by the Schmandt Declaration. Ex. 1002 ¶¶ 82–85.

Patent Owner goes through the limitations of claims 32–35 in the Examiner’s Reasons for Allowance section discussed immediately below. PO Resp. 45. Patent Owner makes no specific argument regarding the

⁷ Although this testimony relates specifically to the Geek of the Week references (Exs. 1008–1011, 1019–1020, and 1023–1028), on which we did not institute trial, we credit it for the discussion of basic Internet hardware components.

dependent claims other than stating that the elements argued as not taught by Compton/CNN in connection with claim 31 are likewise missing from the dependent claims 32–35. *Id.* at 44. This argument is unpersuasive for reasons discussed above in connection with claim 31

f. Examiner's Reasons for Allowance

Patent Owner contends the grounds under review do not address the Examiner's Reasons for Allowance. PO Resp. 43–45. The Reasons for Allowance states, in part:

The prior art does not provide for nor suggest for updating/downloading current version of a compilation file containing attribute data describing episodes and including one or more episode URLs identifying one or more corresponding media files representing said given one of said episodes.

PO Resp. 44 (*see* Prosecution History of '504 patent, Ex. 2002, 2) (emphasis omitted).

We are not bound by an Examiner's determinations in the prosecution of a patent in an *inter partes* review proceeding. To the extent Patent Owner points out that the Examiner had reasons for allowing the claims, we acknowledge those reasons. The record here does not disclose that the Examiner was considering the Compton/CNN reference when drafting the Reasons for Allowance.

3. Conclusion Regarding Claims 31–35 as Obvious over Compton/CNN

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, that claims 31–35 would have been obvious under 35 U.S.C. § 103(a) over Compton/CNN.

C. Claims 31–35 as Anticipated by Patrick/CBC

Petitioner alleges Patrick/CBC is prior art anticipating claims 31–35 of the '504 patent under 35 U.S.C. § 102(a).⁸ Pet. 16, 35–45. Petitioner relies on the Schmandt Declaration to support its position. Ex. 1002 ¶¶ 58–71. Petitioner's supporting argument for anticipation relies heavily on the Schmandt Declaration and what a person of ordinary skill would understand from what is disclosed in the four corners of the Patrick/CBC reference. *See, e.g.*, Ex. 1002 ¶¶ 66–67; *see* Tr. 17:17–20.

Patent Owner contends that Petitioner must rely on inherency to find that Patrick/CBC discloses certain claim limitations. PO Resp. 26. Patent Owner's statement is based on Petitioner's reliance on the Schmandt Declaration for what a person of ordinary skill would understand from Patrick/CBC, as well as our analysis in the Decision on Institution. *Id.*

In order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). We must analyze prior art references as a skilled artisan would. *See Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991), *overruled on other grounds by Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282 (Fed. Cir. 2009) (to anticipate, “[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention”). As the Federal Circuit has held:

⁸ The '504 patent was filed prior to the effective date of § 102, as amended by the AIA—March 16, 2013—and is governed by the pre-AIA version of § 102(a). *See* AIA § 3(n)(1).

This modest flexibility in the rule that “anticipation” requires that every element of the claims appear in a single reference accommodates situations where the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges. It is not, however, a substitute for determination of patentability in terms of § 103.

Cont'l Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268–69 (Fed. Cir. 1991). A claim limitation is inherent if it is necessarily present in the prior art, not merely probably or possibly present. *Akami Techs., Inc. v. Cable & Wireless*, 344 F.3d 1186, 1192 (Fed. Cir. 2003).

As with Compton/CNN, with respect to Patrick/CBC, the parties focus on claim limitations related to episodes, updating the compilation file, and a predetermined URL for the compilation file. Pet. Reply 1: PO Resp. 46–47 (citing Ex. 2004 ¶¶ 18, 21, 56, 61, 63).

1. Patrick/CBC Overview

Patrick/CBC discloses an experimental trial to determine, among other things, if there was any demand for regular radio programming distributed as digital audio files over the Internet. Ex. 1012, Abstract. Patrick/CBC alleges that the trial is “the first time that audio programs produced for traditional radio broadcasts have been made available on the Internet on a regular basis.” *Id.* at 2.⁹ CBC Radio programming was stored on a server and the resulting program files were made available using standard Internet server software. *Id.* at 2–3.

⁹ Page references are to the actual page numbers of Exhibit 1012, and not Petitioner’s Exhibit pages.

a. Whether Patrick/CBC discloses “episodes”

Patrick/CBC discloses radio programming on the Internet, including *Quirks & Quarks*, a science magazine show. Ex. 1012, 5. The show was updated regularly on the server. *Id.* Petitioner cites to the preceding disclosure to meet the “episode” limitation. Pet. 40 (citing Ex. 1002 ¶ 60). Patent Owner makes no specific challenge that Patrick/CBC discloses episodes, focusing instead on the “compilation file” and “predetermined URL” limitations. PO Resp. 15–16.

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, that Patrick/CBC discloses “episodes” as claimed.

b. Whether or not Patrick/CBC discloses an “updated version of a compilation file”

Petitioner cites generally to a server which automatically is updated with new programming. Pet. 41–42 (citing Ex. 1012, 3; *see* Ex. 1012, 5). For example, “the *Quirks & Quarks* science magazine show was recorded each week, broken down into its component parts, and made available on the server.” *Id.* at 42 (citing Ex. 1012, 7). Further, “users could select those portions of the show that interested them and download the appropriate audio file.” Pet. Reply 11–12 (citing Ex. 1012, 5). Petitioner cites this disclosure as showing the compilation file. Pet. 42, Pet. Reply 11–12. The Schmandt Declaration cites to Patrick/CBC’s disclosure that radio shows are stored on a server in an HTML file at <ftp://www.radio.cbc.ca> or <http://www.radio.cbc.ca/>. Ex. 1002 ¶ 64. Based on these disclosures from Patrick/CBC, the Schmandt Declaration concludes “[a]n ordinary artisan would understand this to mean an HTML file (i.e. a compilation file).” *Id.*

Given our construction of “compilation file” as “a file that contains episode information,” we agree that a person of ordinary skill would conclude that Patrick/CBC necessarily discloses a “compilation file.” Pet. 42 (citing Ex. 1002 ¶¶ 63–66). Patent Owner’s declarant, in the Nelson Declaration, provides no analysis as to why Patrick/CBC does not disclose a “compilation file.” See Ex. 2004 ¶¶ 49–57. More importantly, none of the testimony questions whether a person of ordinary skill would understand the disclosure of Patrick/CBC to meet the recited limitation necessarily.

Claim 31 specifically recites that the updated “compilation file” includes “attribute data for each given one of said currently available episodes including *displayable text* describing said given one of said currently available episodes.” (Emphasis added). Patent Owner contends that Patrick/CBC does not show the “displayable text” limitation. PO Resp. 16. At the final hearing Petitioner argued, however, that a person of ordinary skill in the art would recognize that a compilation file is present, even though no “picture” of such a compilation file exists. Tr. 17:1–22.

We have reviewed the Schmandt Declaration and are persuaded that a person of ordinary skill would conclude that Patrick/CBC necessarily includes “displayable text” associated with the “compilation file.” We credit the testimony in the Schmandt Declaration that Patrick/CBC discloses that “[e]ach show has a menu attached to it to describe the contents of the various parts.” Ex. 1002 ¶ 64 (citing Ex. 1012, 7). Users would then “select” recordings that were of interest to them. *Id.* (citing Ex. 1012, 3). Although Patrick/CBC does not state expressly that the menu includes “displayable text,” the menu selection lists the programs the user may select and necessarily is “displayed” so the user may select the programming.

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, Patrick/CBC discloses updating the “compilation file” as claimed.

c. Whether Patrick/CBC discloses a “predetermined URL”

The Schmandt Declaration again cites to the disclosure that the server could be accessed at ftp://www.radio.cbc.ca or http://www.radio.cbc.ca/ as disclosing a “predetermined URL.” Ex. 1002 ¶ 64 (citing Ex. 1012, 7). The Schmandt Declaration concludes an “ordinary artisan would understand this to mean an HTML file (i.e. a compilation file) with links to the episodes was stored at a predetermined URL.” *Id.* As noted above, the Nelson Declaration does not contradict this testimony.

Patent Owner argues that Mr. Schmandt admitted in his deposition that he did not know the specific URL of the “compilation file,” but it must exist for users to select audio programming. PO Resp. 19–20 (citing Ex. 2002, 13:19–24). Patent Owner acknowledges one of ordinary skill could “perhaps” infer program segments include URLs. These arguments, however, tend to support the Schmandt Declaration that URLs are present in Patrick/CBC for the selected programming.

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, that Patrick/CBC discloses “predetermined URLs” for the selected programming.

d. Enablement

The Nelson Declaration asserts Patrick/CBC is not enabled because code is not disclosed to effect its functionality. Ex. 2004 ¶ 55. Dr. Nelson at his deposition acknowledged that creating and updating an HTML website was within the level of ordinary skill. *See* Pet. Reply 13 (citing Ex. 1031,

77:19–82:10). Thus, we do not agree that code disclosure is required for enablement.

f. Dependent Claims 32–35

We also have reviewed the Petitioner’s argument and evidence and claim charts in connection with dependent claims 32–35. Pet. 44–45; 57–59. The argument is supported by the Schmandt Declaration. Ex. 1002 ¶¶ 68–71. Patent Owner makes no specific argument regarding the dependent claims other than stating the elements argued as not disclosed in Patrick/CBC. PO Resp. 17–19.

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, Patrick/CBC discloses the limitations of dependent claims 32–35.

3. Conclusion Regarding Claims 31–35 as Anticipated by Patrick/CBC

Petitioner has shown sufficient evidence to establish, by a preponderance of the evidence, that claims 31–35 are anticipated under 35 U.S.C. § 102(a) by Patrick/CBC.

CONCLUSION

Petitioner has shown by a preponderance of the evidence that claims 31–35 would have been obvious over Compton/CNN and anticipated by Patrick/CBC.

ORDER

For the reasons given, it is

ORDERED that Petitioner has shown by a preponderance of the evidence that claims 31–35 of U.S. Patent No. 8,112,504 B2 are unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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