

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELECTRONIC FRONTIER FOUNDATION
Petitioner

v.

PERSONAL AUDIO, LLC Patent
Owner

Patent No. 8,112,504 (Claims 31-35)

Issued: February 7, 2012

Inventors: James D. Logan, Daniel F. Goessling, Charles G. Call

Title: SYSTEM FOR DISSEMINATING MEDIA CONTENT REPRESENTING
EPISODES IN A SERIALIZED SEQUENCE

Inter Partes Review No.
IPR2014-00070

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PRELIMINARY RESPONSE BY PATENT OWNER
UNDER 37 C.F.R. § 42.107

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PRELIMINARY RESPONSE BY PATENT OWNER
UNDER 37 C.F.R. § 42.107

Patent Owner Personal Audio, LLC (hereafter “Patent Owner”) hereby respectfully submits this Preliminary Response to the present Petition seeking inter Partes review. This filing is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, as it is being filed within the extension granted by the Board to February 7, 2014.

No inter partes review should be instituted under 35 U.S.C. 314 because none of the references relied upon by Petitioner in its Petition gives rise to a reasonable likelihood of Petitioner prevailing with respect to a challenged claim of the U.S. Patent No. 8,112,504 (the ‘504 Patent), either alone or in any combination with each other.

I. There Is No Reasonable Likelihood of Petitioner Prevailing As To A Challenged Claim of the ‘504 Patent.

“The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.” 35 U.S.C. §314(a).

Petitioner Electronic Frontier Foundation (hereafter “EFF”) must demonstrate that there is a reasonable likelihood that it would prevail as to at least one of the claims challenged to trigger an inter partes review. 35 U.S.C. 314 (a). The Petition fails to do so in several respects:

(1) the Petition primarily and inextricably relies upon non-statutory grounds of public use or knowledge evidence rather than challenging the Claims 31-35 based on only “patents or printed publications”,

(2) the Petition’s supporting evidence, including declarations, is fatally insufficient to account for all of the claim limitations in Claims 31-35 and thus does not establish a reasonable likelihood that at least one of the claims challenged is unpatentable, and

(3) the Petition is deficient for failing to adequately explain the relevance of the references to the claims as required by 37 C.F.R. §42.104(B)(5).

Notably, among other failures, the Petition fails to anticipate, teach or suggest the elements of independent Claim 31 as follows:

“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 processors coupled to said one or more data storage servers for:

* * * from time to time, as new episodes represented in said series of episodes become available, storing an updated version of a compilation file in said one or more data servers at a storage location identified by a predetermined URL.”
(independent claim 31).

As discussed below, all anticipation grounds proposed in the Petition are deficient for failing to set forth each and every feature arranged as recited by the respective Claims 31-35 of the ‘504 Patent, and thus do not establish a *prima facie* case of anticipation.

Further, all of the obviousness grounds proposed in the Petition lack articulated reasoning with a rational underpinning to support a legal conclusion of obviousness. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir.2006)). Indeed, the Petition barely provides “mere conclusory statement[s]” (id.) that the claims are obvious, let alone provide cogent reasoning as to why a person of ordinary skill in the art would modify or combine the alleged cited printed publications in the manner recited by the respective Claims 31-35 of the ‘504 Patent. *See, e.g.*, Petition at 16-17.

Tellingly, EFF’s proposed Grounds 1-5 for *inter partes* review at pages 16-17

of its Petition do not cite a single patent or any combination of patents that disclose the claimed combination of elements as found in independent Claim 31 of the '504 Patent.

For at least these reasons, the Petition does not show a reasonable likelihood of prevailing with respect to even a single one of the challenged claims, and *inter partes* review should not be instituted.

A. Technology Background

The '504 Patent shows an apparatus for disseminating a series of episodes represented by media files via the Internet as the episodes become available. There are one or more data storage servers that store one or media files representing each available episode whereby media files stored at the storage location and specified by a unique episode URL can be requested by remotely located client devices. And from time to time, as new episodes represented in a series of episodes become available, there is storing of 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. This automatic updating of episodes in a compilation file, stored in a server and accessible to a requesting client device through a unique episode URL had never been in existence or available to the public before the '504 Patent invention.

B. Claims 31 to 35

The '504 Patent describes in Claims 31-35 an apparatus for disseminating a series of episodes represented by media files via the Internet as the episodes become

available. The media files are stored on one or more data storage servers at storage locations specified by a unique episode URL. This permits the requests to come over the Internet through communication interfaces with these servers to upload the requested episode that is from time to time updated as new episodes become available through a compilation file updated by the processor located on one or more of the data storage servers with the location identified by a predetermined URL. This unique combination of elements in Claim 31 provides the end user with the ability of going to one place on the Internet and having all of the episodes currently available in a series at his disposal for downloading to the user's client device for enjoyment. Nothing in the prior art comes close to matching the functionality or uniqueness of the claimed combination and arrangement of elements to provide the claimed apparatus of the '504 Patent. Claim 32 further defines that some of the stored media files contain digital compressed audio recordings. Claim 33 further defines that some of the media files contain text data which may be displayed or reproduced in spoken audible form. Claim 34 further defines attribute data for each of the episode to identify the episode. And Claim 35 further defines the update version of the compilation file includes text describing the series of episodes. The Petition challenges the validity of Claims 31-35.

Claims 31 is directed to an apparatus disseminating a series of episodes represented by media files via the Internet as new episodes become available

including, *inter alia*, from time to time as new episodes represented in a series becomes available, the new episode is stored in an updated compilation file in one or more data storage servers at a storage location identified by a predetermined URL.

C. References Asserted by the Petition

Petitioner relies essentially upon four asserted “printed publication” references, namely:

- A web page called ww.ncsaiuc.edu/radio/radio.html that allegedly appeared on April 22, 1993 (“NCSA GotW page”, Ex. 1019 (rendered version), 1021(HTML version)).
- An edition of SurfPunk Technical Journal (“SurfPunk”, Ex. 1020) that allegedly appeared on April 22, 1993.
- Patrick, A. et al, *CBC Radio on the Internet: An Experiment in Convergence*, 21 Canadian J. of Comm’n 1, 125-140 (Jan. 1, 1996) (the “CBC Radio Article”, Ex. 1012)
- Compton, C., *Internet CNN NEWSROOM: The Design of a Digital Video News Magazine*, Massachusetts Institute of Technology (Aug. 10, 1995)(“Internet CNN NEWSROOM”, Ex. 1022) and the knowledge of one of ordinary skill.

The Petition further includes two Declarations asserted as evidence supporting the foregoing references. The Declarations purport to explain why these references can be used for proving anticipation or obviousness despite the fact the references do not account for several claim elements and limitations required by the challenged

Claims 31-35. In this regard, the Declarations are asserted to state the references somehow inherently include the arranged elements of the challenged Claims 31-35 even though several elements and limitations are missing from the four corners of each cited reference.

The first two references of the NCSA GotW / SurfPunk web page are not valid printed publications under 35 U.S.C. 311(b) and thus cannot support *inter partes* review. Indeed, as demonstrated by the Petition's asserted Declarations, the first two references inextricably rely upon non-statutory grounds of public use or knowledge evidence. Moreover all references fail to account for all of the claim elements and limitations of independent Claim 31 and thus do not establish a reasonable likelihood that at least one of the five claims challenged is unpatentable.

II. Petitioner's Evidence of Record Urges *Inter Partes* Review Based On Public Use or Knowledge Rather Than Upon Patents or Printed Publications.

The scope of an *inter partes* review is restricted to prior art consisting of "patents or printed publications." 35 U.S.C. 311 (b) states:

"SCOPE.—A petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 **and only on**

the basis of prior art consisting of patents or printed publications.” (emphasis added)

37 CFR § 42.104 (b)(2) and (b)(4) requires an inter partes review petition to, respectively, specify:

“(2) The specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and **the patents or printed publications relied upon** for each ground. ...

(4) How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. **The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”** (emphasis added)

The Petition contends challenged Claims 31-35 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the web page www.ncsa.uiuc.edu/radio/radio.html as it allegedly appeared on April 22, 1993 (“NCSA GotW page”, Ex. 1019 {rendered version}, Ex. 1021 {HTML version}) or as “reproduced” at the alleged April 22, 1993 edition of the SurfPunk Technical Journal (“SurfPunk”, Ex. 1020).

Alternatively, Claims 31-35 are said to be unpatentable under 35 U.S.C. § 103 as being obvious over “all of the Geek of the Week publications cited herein,

considered collectively with their supporting evidence”. (“Geek of the Week publications”, Exs. 1003, 1007-1011, 1018-1028).

A. The Asserted NCSA GotW / SurfPunk Web Page Is Not A Printed Publication.

A threshold infirmity of the Petition’s asserted NCSA GotW single web page or its SurfPunk reproduction is they are not printed publications. Neither are the Declarations of Chris Schmandt (Ex. 1002) and Carl Malamud (Ex. 1003) that are asserted to explain the same.

Whether a document constitutes a printed publication under 35 U.S.C. § 102 is a question of law based upon the underlying facts of each particular case. *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1332-33 (Fed. Cir. 2009).

The statutory phrase “printed publication” has been interpreted to mean that “before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination of whether the prior art reference was “published.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989); see also *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986) (explaining that public accessibility is the “touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b)”).

“Whether a reference is publicly accessible is determined on a case-by-case basis based on the ‘facts and circumstances surrounding the reference’s disclosure to

members of the public.’ ” *In re Lister*, 583 F.3d 1307, 1311 (Fed.Cir. 2009) (quoting *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed.Cir. 2004)). Public accessibility is a legal conclusion based on underlying factual determinations. *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1321 (Fed.Cir. 2002).

“A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006). Herein lies the Petition’s infirmity – there is no showing the NCSA GotW web page was accessible or available **to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, could locate it.**

The Petition’s Exhibits belie such a degree of accessibility. One would need to know the precise URL of <http://www.ncsa.uiuc.edu/radio/radio.html> to locate the single web page and even then such information is not particularly informative of the contents one might expect to find there.

In order to locate the NCSA GotW web page, an interested person of ordinary skill in the subject art - even if knowledgeable of what might be found at the web page - would still have to have precise directions to find it. The preliminary need for precise direction to locate the web page defeats the “public accessibility”

requirement for a statutory “printed publication”. See, *SRI international, Inc. v. Internet Security Systems, Inc.*, 511 F3d 186, 1196-97 (Fed. Cir. 2008) (wherein a November 1997 paper sent via email and posted on a file transfer protocol server to facilitate peer review by a review committee was not sufficiently publicly accessible to constitute a printed publication because in order to locate the paper, a person of ordinary skill in the art who knew of the paper would not have found the reference without precise direction.)

The Petition argues that the web page www.ncsa.uiuc.edu/radio/radio.html as it supposedly appeared on April 22, 1993 “was publicly accessible and known to those of skill in the relevant field”, because the maker of Mosaic, Marc Andreessen, “announced the public availability of Geek of the Week through” the web page (Ex. 1018) and the SurfPunk Technical Journal article (Ex. 1020) shows that on April 22, 1993 the webpage was actually copied and republished.

Exhibit 1018 however, highlights and confirms the need for “precise direction” to the asserted web page <http://www.ncsa.uiuc.edu/radio/radio.html> by stating:

“Internet Talk Radio is up for grabs via World Wide Web at URL:
<http://www.ncsa.uiuc.edu/radio/radio.html>

The easiest way to access this is to pull down a copy of NCSA Mosaic for X at [ftp.ncsa.uiuc.edu](ftp://ftp.ncsa.uiuc.edu) in /Mosaic (source, and binaries for Sun, SGI, DEC, and IBM are available), and paste the above URL into the File->Open window. What you'll get is a "hypermedia"

interface to ITR...”.

The Exhibit 1020 SurfPunk web page reproduction likewise confirms the need for “precise direction” for accessibility to the asserted NCSA GotW web page. It also facially establishes the Exhibit is in the nature of a private e-mail exchange:

“Date: Fri, 16 Apr 1993 13:13:19 -0700 (PDT)

From: Kwan-Seng Low <kwan@osc.versant.com>

Here's something I got from the net, did anyone play with this before?
care to comment/discussion?

Kwan

...

Internet Talk Radio is a bunch of audio files that Carl Malamud has put together. He's been interviewing folks and junk like that. Its interesting. I only know of it through the world wide web (www) - **you can find** a handy web page for it at

http://www.ncsa.uiuc.edu/radio/radio.html, if you have access to the web. ...(emphasis added)

From: surfpunk <strick>

Subject: Internet Talk Radio

Kwan, I meant to assemble more info on this, but didn't get around to it. Perhaps someone can assemble us a precis on Internet Talk Radio. Here's the page from the web. If you don't have access to the web, **notice how I telnet to port 80 and then type capital GET followed by the tail end of the path in order to get the page**. You should be able to read through this markup language. (emphasis added)

Archie can find "vat", and the IP multicasting package.

On a sparcstation you should be able to play the .au files by
cutting into /dev/audio, right?

This is something I haven't built/heard yet, either. strick

Script started on Thu Apr 22 16:48:48 1993

\$ telnet www.ncsa.uiuc.edu 80

Trying 141.142.4.5 ...

Connected to rs5.ncsa.uiuc.edu.

Escape character is '^['.

GET /radio/radio.html ...”

Private communications or e-mail exchanges, although printed, are not statutory “printed publications.” A publication must be (1) a work of public character, intended for general use; (2) within reach of the public. See, 1 W. Robinson, *The Law of Patents for Useful Inventions*, §§ 325-27 (1890).

Still further, the Declaration of Chris Schmandt (Ex. 1002, ¶ 34) advanced by the Petitioner fully admits and confirms the need for one to have prior “precise direction” for accessibility to the asserted NCSA GotW web page:

“34. For a complete example, **at the time the URL was active, if a user typed `http://ncsa.uiuc.edu/radio.html1` into the browser’s destination window, the browser would use the HTTP protocol to GET the following HTML content from the web server at `ncsa.uiuc.edu`;**” (emphasis added)

The NCSA GotW web page was not reasonably accessible even to a person informed of its existence – one would need the precise direction of <http://www.ncsa.uiuc.edu/radio/radio.html> to locate it. The Federal Circuit in *SRI international, Inc. v. Internet Security Systems, Inc.*, supra at 1196-97, has addressed “pubic accessibility” in circumstances analogous to the present Petition:

“The record on summary judgment does not show that an anonymous user skilled in the art in 1997 would have gained access to the FTP server and would have freely navigated through the directory structure to find the Live Traffic paper. To the contrary, the paper’s author, Mr. Porras, thought it necessary to provide Dr. Bishop with the full FTP address for the file. Surely Dr. Bishop, the Program Chair for SNDSS, would have qualified as one of ordinary skill in the art in 1997. Yet, despite his knowledge of the field, FTP servers, and the paper, Dr. Bishop apparently would not have found the reference without Mr. Porras’s precise directions. It is doubtful that anyone outside the review committee looking for papers submitted to the Internet Society’s Symposium would search a subfolder of an SRI FTP server. These are separate entities. It is also doubtful that anyone outside the review committee would have been aware of the paper or looked for it at all in early August 1997. These facts seem to militate against a finding of public accessibility. At least they warrant examination upon remand.”
(emphasis added)

To exacerbate the lack of public accessibility, it is evident that the GotW web page indexing by 1993 URL web address alone fails to reveal pre-knowledge of the URL web page's available content. The asserted content of the NCSA GotW web page is not catalogued or indexed in a meaningful way linking information available there to the interested public seeking it exercising due diligence. In this sense, the present Petition is similar to the Federal Circuit decision of *In re Cronyn* wherein the asserted thesis document was in a library with an alphabetical index by the author's name. The Federal Circuit found no public accessibility because "the only research aid in finding the theses was the student's name, which of course, bears no relationship to the subject of the student's thesis." *In re Cronyn*, 890 F.2d 1158, 1161 (Fed.Cir. 1989). An index by name alone or by URL address alone bears no relationship to the subject of available content.

EFF has made no showing that the single NCSA GotW web page was available to the extent necessary to constitute a printed publication. A printed publication must be sufficiently assessable to the public interested in the art - actually published in such a manner that the members of the public who are likely to be concerned with and interested in the field of art to which the printed publication relates can locate it and avail oneself of the information it contains. On this point, it is clear that the EFF in its Petition and exhibits has made no showing whatsoever

about the extent to which the NCSA GotW web page could be located by those skilled in the art.

Therefore, the NCSA GotW web page or its private e-mail SurfPunk reproduction is not a “printed publication” upon which a request for *inter partes* review can be based. 35 U.S.C. 311 (b). Even if this web page can be shown to be publicly available, it still doesn’t anticipate all of the claim 31 elements.

B. The “prior art” Date of The Asserted GotW / SurfPunk Web Page Is Not Established.

The critical date for a printed publication “prior art” is defined as the date one year prior to the filing date of the patent application. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988).

The EFF Petition asserts that the NCSA GotW web page was existent in 1993. Yet in 1993, there were no “search engines” on servers with a web crawler to locate specific content on the web. Indeed the Petition concedes that “precise direction” fore-knowledge of the NCSA GotW web page URL was needed by those skilled in the art to locate it. Ex.1018, Ex.1020, Ex 1002, ¶ 34.

In fact, the Petition concludes that there is no way of knowing when the printed publication references were available to the public or those skilled in the art. The Ex. 1003 Declaration of the Carl Malamud at ¶ 19 states that the NCSA GotW / SurfPunk web page was not captured until April 18, 1999 on the Internet Archive

“Wayback Machine” for the “Geek of the Week” episode index. Moreover, the same Declaration at ¶ 17 states that the Internet Archive’s “Wayback Machine” found the first posting of the NCSA GotW web page on December 20, 1996. This Archive goes back further than December 20, 1996 so why is there not an earlier posting of either the NCSA GotW / SurfPunk or the NCSA GotW html web page before December 20, 1996? The reason is obvious. The alleged printed publication references cited in the Petition were not publicly accessible and known to those of skill in the relevant field because a person had to enter the precise URL address to find the “Geek of the Week” html web page. The cited NCSA GotW web page exhibits cited in the Petition were just not available to the public without precise directions to find the URL address. Thus, the Internet URL addresses for these alleged printed publications in this Petition were hidden to one ordinarily skilled in the field looking for this single html web page and its alleged pertinent information. Therefore, for at least these above reasons, the cited web page fails to qualify as a reference that should be considered in this proceeding.

C. Petitioner’s Evidence of Record on the NCSA GotW Web Page Inextricably Relies Upon Public Use or Knowledge Rather Than on 35 U.S.C. 311 (b) “patents or printed publications”.

Separate from the threshold issue of whether the NCSA GotW web page is a “printed publication”, that which is asserted to be actually published is so limited that the Petition is replete with impermissible reliance upon testimony or evidence of public use or knowledge to challenge Claims 31 to 35.

In essence, all that is allegedly presented to one who has successfully accessed the NCSA GotW web page by having the “precise direction” fore-knowledge of the page’s URL is a single web page screen display, namely the screen shot reproduction taken by Chris Schmandt on August 29, 2013 (at Dec ¶ 17) that was captured by the Archive “WayBack Machine” on December 20, 1996:

Internet Talk Radio

General Information

- [Introduction to Internet Talk Radio.](#)
- [Overview of Geek of the Week.](#)

April 21, 1993

Here's the [overview](#) of the April 21 edition of Internet Talk Radio.

- [Steve Deering, Part 1](#) (5.6 megs)
- [The Incidental Tourist](#) (1.6 megs)
- [Steve Deering, Part 2](#) (6.0 megs)
- [Book Byte](#) (0.7 megs)
- [Steve Deering, Part 3](#) (5.4 megs)

April 14, 1993

Here's the [overview](#) of the April 14 edition of Internet Talk Radio.

- [Daniel Lynch, Part 1](#) (5.7 megs)
- [The Incidental Tourist](#) (0.9 megs)
- [Daniel Lynch, Part 2](#) (5.5 megs)
- [Legal Stuff](#) (0.2 megs)
- [Daniel Lynch, Part 3](#) (3.4 megs)

April 7, 1993

Here's the [overview](#) of the April 7 edition of Internet Talk Radio.

- [Dr. Erik Huizer, Part 1](#) (5.4 megs)
- [The Incidental Tourist](#) (1.5 megs)
- [Dr. Erik Huizer, Part 2](#) (4.8 megs)
- [Book Byte](#) (0.7 megs)
- [Dr. Erik Huizer, Part 3](#) (5.9 megs)
- [Name That Acronym](#) (0.5 megs)
- [Dr. Erik Huizer, Part 4](#) (5.2 megs)

March 31, 1993

Here's the [overview](#) of the March 31 edition of Internet Talk Radio.

- [Dr. Marshall Rose, Part 1](#) (5.6 megs)
- [The Incidental Tourist](#) (1.5 megs)
- [Dr. Marshall Rose, Part 2](#) (5.1 megs)
- [Book Byte](#) (0.6 megs)
- [Dr. Marshall Rose, Part 3](#) (5.6 megs)
- [Name That Acronym](#) (0.5 megs)
- [Dr. Marshall Rose, Part 4](#) (4.2 megs)

marca@ncsa.uiuc.edu

The Petition devotes enormous energy to “explain” the significance of the foregoing screen display (Ex. 1019) in relation to the challenged Claims 31 to 35. The infirmity here is two-fold. As discussed, the screen display is not a statutory “printed publication” upon which an inter partes review can be instituted. Also, the explanation of what is displayed as perceived by one of ordinary skill in the art devolves into inextricable reliance upon testimony or evidence of public use or knowledge.

Initially, although the NCSA GotW web page describes four editions of “Internet Talk Radio,” there is no suggestion anywhere on the page that this collection of editions was previously available before the April 21 edition, or that an updated version of the NCSA GotW web page would be made available in the future as more editions became available. The web page is merely a single web page as shown above and, in and of itself, represents a one-time posting. Such a fact is particularly important when considered in relation to the challenged independent Claim 31 requirements for:

“...disseminating a series of episodes represented by media files via the Internet as said episodes become available...

...storing one or more media files representing each episode as said one or more media files become available...

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...

...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.”

In and of itself, the NCSA GotW web page screen display is a one-time posting and that depicted in the screen is not “a series of episodes represented by media files via the Internet as said episodes become available” or “storing one or more media files representing each episode as said one or more media files become available” or “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...”, etc., as required in independent Claim 31. Rather the singular screen display, in and of itself, is a one-time, one-shot post having no periodic update as episodes become available. Indeed, there is no indication within the “four-corners” of the screen display that any future posting of “editions” will ever occur.

To overcome such a deficiency, the Petition submits the Declarations of Chris Schmandt (Ex. 1002) and Carl Malamud (Ex. 1003) and advances multiple Exhibits to explain the “use” or “activities” allegedly done in support of the Geek of the Week show. Yet such Declarations are not a statutory “printed publication” upon which an *inter partes* review can be instituted. Moreover, they are inextricably replete with descriptions of alleged prior public uses of what was allegedly done by whom and when and how as the Geek of the Week show was produced or developed and how listeners used or benefited from the same. This is NOT what one of ordinary skill in the art would understand from reading the above screen display. For example, the Schmandt Declaration describe how early users used the Internet and how the World Wide Web “gained popularity” (§ 20), how a user employs a browser to use HTTP protocol (§ 21, 27), how a browser communicates with a remote server (§ 22, 27), how GET commands or URLs work (§ 23-24, 27) among other activities of public use and knowledge. The Malamud Declaration describes how he allegedly recorded and produced Geek of the Week shows (§ 5-9) among what activities he did or what he or others did, used or knew (§ 10-12). Such proffered endeavors, activities, uses, or knowledge are extrinsic evidence not “patents or printed publications” upon which an *inter partes* review can be instituted. What it appears Malamud was doing back in 1993 is simply putting an Internet Talk radio segment on a FTP server and then an “administrator” would manually access the FTP site to retrieve the index

and a new segment of the InternetTalk radio show. This is not the apparatus as found in Claim 31 were a processor of the apparatus performs the task.

Fundamentally, both Declarations are devoid of any meaningful statements for comparing the elements of Claims 31-35 as found in the '504 Patent with the screen display text found in the NCSA GotW web page because no elements of the claims are present therein. These Declarations to the Petition are apparently attached as exhibits in an attempt to breathe life into the dead reference, the NCSA GotW web page, that has no recitation of claim elements.

D. The GotW / SurfPunk Web Page Does Not Disclose All Limitations Of The Challenged Claims.

The Petition attempts the bridge the broad gulf between what one having “precise direction” access to the NCSA GotW web page would supposedly actually see at its screen display and what the challenged Claims 31 to 35 define in their claim elements and limitations by resort to extrinsic evidence of what one of ordinary skill in the art would understand from reading the screen display. Even then, the EFF arguments fail to account for all limitations of independent Claim 31.

For purposes of this Preliminary Response, we invite the Board to focus upon one aspect of independent Claim 31, namely the claim limitations:

“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 processors coupled to said one or more data storage

servers for:

* * * from time to time, as new episodes represented in said series of episodes become available, storing an updated version of a compilation file in said one or more data servers at a storage location identified by a predetermined URL . . .” (independent claim 31)

The position of the Revised Petition with respect to the GotW page relative the foregoing underlined independent Claim 31 claim language is:

Independent Claim 31	The NCSA GotW page (Ex. 1019 (rendered) & Ex. 1021 (HTML); SurfPunk (Ex. 1020); Geek of the Week publications (Exs. 1003, 1007-1011, 1018-1028).
Apparatus for disseminating a series of episodes represented by media files via the Internet <u>as said episodes become available</u> , said apparatus comprising 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,	“...as said episodes become available”: The disclosed GotW webpage was updated with new weekly episodes and media files representing those episodes as they became available. (Ex. 1019 & 1021; Ex. 1020 at 2-3; Schmandt Decl. ¶¶ 48-49; Ex. 1003 ¶ 11; see also Ex. 1028 (GotW was a “weekly” program)). (Emphasis added) The disclosed web server stored a file (radio.html) at the location www.ncsa.uiuc.edu/radio/radio.html. that compiled the available Geek of the Week episodes and was updated as new episodes in the weekly series became available. (Ex. 1019 & 1021; Ex. 1020 at 2-3; Schmandt Decl. ¶¶ 46, 49-50; Ex. 1003 ¶ 11; <i>see also</i> Ex. 1018; Ex. 1029 at 5, 7; Ex. 1003 ¶ 11). (Emphasis added)

As discussed before, if anything was “published” by the singular NCSA GotW web page, it was its screen display alone, namely the Petition Exhibit 1019 – as it supposedly appeared on April 22, 1993. The above bold-print position of the Revised Petition departs from the “four-corners” of the Exhibit 1019 screen display and presents a misplaced conclusion that independent Claim 31’s required “as available”, updated compilation file is somehow inherently present in the April 22, 1993 screen display as compared to what content might have preceded April 22, 1993 or what content might have followed that date. The conclusion is misplaced because it is dependent upon a backward and forward timeline being interposed upon the Exhibit 1019 screen display. It further assumes a comparison of posted content along such a timeline to filter differences among what might have been posted at different times. This exceeds the “four corners” of Exhibit 1019 and casts an unproved speculative interpretive overlay upon the April 22, 1993 screen display. Although the GotW web page apparently lists four editions of “Internet Talk Radio”, there is no suggestion anywhere on the April 22, 1993 page that the collection of editions thereof was previously available before the April 21 edition, or that an updated version of the NCSA GotW web page would be made available in the future as more editions became available.

Further, the above bold-print positions of the Revised Petition are rooted in the public use or knowledge statements of the Declaration of Carl Malamud explaining

the “use” or “activities” allegedly done in support of the Geek of the Week show. The same is not “patents or printed publications” upon which an *inter partes* review can be instituted.

Note also that the EFF original Petition took a less definitive position on exactly what the “four-corners” of the Exhibit 1019 screen display actually shows in deference to an increased reliance upon what a person of ordinary skill in the art might glean from it.

The original Petition at page 30-31 states:

“It would have been understood that the NCSA GotW page was updated regularly, as shown by the fact that it contained four weekly episodes (March 31, April 7, April 14, and April 21) when it was published at www.ncsa.uiuc.edu/radio/radio.html as of April 22, 1993. (Schmandt Decl. ¶ 49; Ex.1019; Ex.1003 ¶ 11). In addition, it would have been known that the site previously did not contain the April 21, 1993 episode, as the site was known to exist before then. (Schmandt Decl. ¶¶ 49-50; *see* also Ex. 1018). Thus the NCSA GotW page disclosed that the web server stored “an updated version of a compilation file...at a storage location identified by a predetermined URL,” as claimed, and it did so “as new episodes...became available.” (Emphasis added)

The original Petition at page 27-28 states:

“... It would have been understood from the NCSA GotW page that new files were added as they became available. (Schmandt Decl. ¶¶ 48-49). In addition, the NCSA GotW page, prior to April 22, 1993,

was known to have Geek of the Week content, also showing that it would be understood to be updated as files became available. (See Ex. 1018)” (Emphasis added)

The Declaration of Chris Schmandt at ¶ 49 likewise testifies with regard to the Exhibit 1019 GotW screen display:

“An ordinary artisan would have understood by the dating of the sections of the web page and that the page existed prior to April 22 (and before the episode of April 21), that the web page was updated each time a new episode was available, and had been updated several times by April 22, 1993.”

What an ordinary artisan would gleam from reading the Exhibit 1019 screen display is highly speculative and conflicts with the NCSA GotW page as it appeared on April 22, 1993 because the screen display itself does not disclose that its contents had been or will be devoted to updating a listing of “Geek of the Week” episodes as they become available. The posted page itself does not establish what content existed at the cited URL before April 22, 1993, does not establish whether such unknown content met Claim 31 limitation for a “compilation file”, and does not establish that the unknown content even described in earlier Geek of the Week editions.

Finally, the EFF Petition takes the erroneous position that web server servicing the NCSA GotW URL www.ncsa.uiuc.edu/radio/radio.html stored a file (radio.html)

that is synonymous with Claim 31's required "updated version of a compilation file" that is updated by a processor "from time to time, as new episodes represented in said series of episodes become available" at a storage location identified by a predetermined URL. At best, Malamud's declaration suggest a laborious manual process of uploading files from a FTP server to the web by a series of individuals and web administrators. (Exhibit 1003). This process does not anticipate the apparatus disclosed in independent Claim 31.

III. The Petition Is Deficient For Failing To Adequately Explain The Relevance Of The References To The Claims As Required By 37 C.F.R. § 42.104(B)(5).

37 C.F.R. § 42.104(b)(5) states:

"the petition must set forth: ... (5) The exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge."
(emphasis added)

To comply with 37 C.F.R. § 42.104(b)(5), the Petition "must set forth . . . the relevance of the evidence to the challenge raised." The wording of the rule indicates that the identification of specific portions of the evidence is part of this requirement, but does not alone satisfy the requirement.

The Petition provides a deficient discussion and explanation of the relevance of the relied upon html page NCSA GotW, Ex. 1019, in conjunction with Ex. 1021. For example, how does the listing of the four program dates with the respective overview of the Internet Talk Radio for the NCSA GotW web page, Ex. 1019 have anything to do with the identified claim elements in Claims 31-35. For example, the Petition provides no explanation of how this reference shows each and every element “arranged as required by the claim” as required for a proper anticipation rejection. See MPEP 2131; *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (“Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102 must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements arranged as in the claim.” (citation omitted)). In fact, the Petition actually omits any reference to the elements “arranged as required by the claim” requirement for anticipation. See Petition at 17-24 (representing that § 102 unpatentability only requires that the reference explicitly or inherently disclose each and every element). See Petition at 27.

In addition, the Petition finally concludes with the bizarre admission:

“As explained above, many of the elements of the claims are disclosed by the NCSA GotW page **not in the words of the web**, but by virtue of its existence as a published web page:...” (emphasis added), See Petition at 27.

The elements of claims 31-35 are then stated to be arranged as set forth in the claims by magic since the NCSA GotW web page must inherently include all of the cited elements in the claim even though none of the elements or arrangements thereof are within the four corners of the NCSA GotW web page reference itself. The asserted evidence in the Petition does not comply with 37 C.F.R. § 42.104(b)(5) or 35 U.S.C §§ 102 and 103 or the MPEP.

Further, the Petition includes claim charts that merely recite disjointed quotations from each of the four main references. There is no explanation anywhere in the Petition of specifically how the items discussed in the quotations throughout the claim charts are being applied by the Petitioner or why the highlighted language corresponds to (or is otherwise relevant to) the claim elements.

A few example deficiencies are highlighted below for CBC Radio Article Exhibit 1012 Claim chart for comparison to Claim 31 of the '504 Patent:

- Claim 31 preamble refers to an “Apparatus for disseminating a series of episodes represented by media files via the Internet as said episodes become available, said apparatus.” The Petition cites from the CBC Radio Article Ex. 1012 for the claim chart based upon this reference and refers to a quotation therein that mentions “experimental trial” but the Petition provides no explanation of what portions of the quoted materials

correspond to these precise elements and admits at the end that the “trial was not updated during this time.”

- Claim 31, element 2, after comprising refers to “one or more communication interfaces connected to the Internet for receiving requests received from remotely located client devices...” For this claim element the claim chart merely refers back to the CBC Radio programs being “...prepared on a computer in a laboratory made available on the Internet.” for the claim element, and the Petition again provides no explanation of what portions of the quoted materials correspond to these precise elements.
- Claim 31, element 2, the second portion of thereof, states “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.” The CBC Radio Article claim chart refers to a quotation that states “program files were made available via FTP, Gopher, and World Wide Web using standard Internet server software.” but the Petition provides no explanation of how or whether users requesting a data file happen to connect with the same elements arranged in this same order by the experimental trial CBC Radio Internet when client users at this time in 1993 had very primitive equipment and software to use with limited bandwidth dial up modems on telephone

lines so what were those exact elements of the CBS Radio compared to the identified elements of claim 31. It is anybody's guess at this point in time.

- Claim 31 calls for a 5th element that states “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;...” The CBC Radio reference includes the statement that “By referring to “links”, the Article disclosed that the files were at unique episode URLs.” Somehow by referring to the word “links” in the text of this Article that obviously infers that episode series were being stored and updated for downloading to end users. How can the word “links” within this article possibly be relied upon to show the claimed elements of the “episodes represented in a series of episodes become available, storing an updated version of a compilation file in on of

said one or more data storage servers at a storage location identified by a predetermined URL. The Petition provides no explanation for the reasoning behind this overreaching conclusion that is not supported by text within the four corners of this Article.

The NCSA GotW page claim chart does the same thing as there are no recitals of any arrangement of elements as found in claims 31-35 in the first referenced D. Claim Chart on page 28 based on Ex. 1019, 1020, 1021, 1002, 1007-1011, 1018-1028 or the *Internet CNN Newsroom* claim chart based on Ex. 1022 found on page 53 of the Petition.

Another example of deficiencies are highlighted below for *Internet CNN Newsroom* claim chart based on Ex. 1022 when compared to Claim 31 of the '504 Patent:

Claim 31 calls for "Apparatus for disseminating a series of episodes represented by media files via the Internet as said episodes become available,..." in the preamble. The Petition Claim chart for this element cleverly ignores the teachings of what happens on a typical CNN Newsroom broadcast where you have multiple segments during a single day of broadcasting that covers many different topics as shown in the Table of Contents for a particular day at Fig. 1. The Petition tries to associate segments on a particular day with "...episodes represented by media files as said episodes become available,..." Each segment

corresponds to a single news story that is not an episode that is later updated when a new version of the segment becomes available. (Id. at 14) There is not even a hint of episodes or updating of compilation file with new episodes as they become available throughout the 57 pages of EFF Ex. 1022.

Claim 31 calls 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..." The Petition states "The paper describes how web pages were automatically generated and used to store files at unique episodes URLs." However, the words "unique" and "episode" are not found anywhere within the paper. This is apparently a fatal flaw in the Petition claim chart logic. In short, this arrangement of claimed elements is absent from the paper reference.

- Claim 31 calls for "...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,..." The Petition diverts ones attention from the arrangement of elements by saying the Table of Contents html file in Fig. 1 is the "compilation file." However,

we now know there are no episodes collected or update from time to time in a compilation file

What this example shows is that once more the Petition makes attempts to infer that the arrangement of elements found in Claim 31 are somehow captured by totally different meaning words found in this reference. In short, the arrangement of elements found in Claim 31 do not exist in Ex. 1022, not even inherently.

In fact, all three claim charts are shockingly devoid of any real comparison of any arrangement of elements as found in the Claims 31-35 because none of the references cited are drawn to explaining the design of an apparatus but are centered on the past history and future potential of the Internet. So naturally none of the cited references in the Petition's claim charts are focused on the arrangement of the elements in Claims 31-35. Therefore, this provide yet another reason for denying the Petition.

IV. **Conclusion**

For the foregoing reasons, there is no reasonable likelihood of Petitioner prevailing with respect to even one of challenged claims 31-35. Accordingly, the Petition should be denied under 35 U.S.C. § 314(a).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify service of the foregoing Preliminary Response by Patent Owner to the following lead and backup counsel for Electronic Frontier Foundation Petitioner on February 7, 2014 via overnight delivery by Federal Express:

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