

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ELECTRONIC FRONTIER FOUNDATION  
Petitioner

v.

PERSONAL AUDIO, LLC  
Patent Owner

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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

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*Inter Partes* Review No.  
IPR2014-00070

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PATENT OWNER'S RESPONSE UNDER 37 C.F.R. § 42.120**

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## I. INTRODUCTION

Patent Owner Personal Audio, LLC (hereafter "Patent Owner") hereby respectfully submits the following response under 37 CFR §42.120 to the Petition filed by Electronic Frontier Foundation (EFF) requesting *inter partes* review of claims 31-35 of U.S. Pat. No. 8,112,504 ("the '504 Patent"). This filing is timely pursuant to the Board's Scheduling Order.

Patent Owner respectfully submits that the following arguments and the additional evidence submitted, such as the Declaration from Patent Owner's expert Professor Peter C. Nelson, demonstrate that claims 31 to 35 of the '504 Patent are not anticipated or obvious in view of the grounds for review.

Specifically, the Patrick/CBC and Compton/CNN reference grounds for review fail to disclose or teach at least one key requirement in independent claim 31 of the '504 Patent, which include: a processor at the server, from time to time as new episodes become available, storing an updated compilation file in a storage location identified by a predetermined URL. Independent claim 31, in part, requires:

*"one or more processors coupled to said one or more data storage servers and to said one or more communications interfaces 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, 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;**” (emphasis added)

Further portions of claim 31 require the “updated version of said compilation file” “located at said predetermined URL”.

In other words, all reviewed claims require a particularly defined “compilation file” that must be generated in this particular way. EFF and its expert have glossed over this claim requirement, suggesting that a general explanation of how HTML, files, links, and URLs work suffices to account for the defined “compilation file” element. But as Patent Owner’s expert Professor Nelson explains, the references of the grounds for review do not disclose or render obvious all claim 31 limitations.

As such, the instituted grounds for review do not establish anticipation or obviousness of independent claim 31 and hence dependent claims 32 to 35 of the ‘504 Patent. Patent Owner therefore respectfully requests that the Board confirm claims 31 to 35.

## II. SUMMARY OF THE '504 PATENT AND CLAIM 31's DEFINED "updated compilation file"

The '504 Patent is titled "System for Disseminating Media Content Representing Episodes in a Serialized Sequence" and issued on February 7, 2012. The '504 Patent results of a division of application No. 09/782,546, filed on Feb. 13, 2001, now Pat. No. 7,509,178 which is a division of application No. 08/724,813, filed on October 2, 1996, now Pat. No. 6,199,076.

Important to this Response and in furtherance of the invention background, the '504 Patent describes a "compilation file" which contains the information related to the programming material. ('504 Patent, 7:10-13) ("The download compilation file 145, though represented as 10 a single file in FIG. 1, preferably takes the form of one or more subscriber and session specific files which contain the identification of separately stored sharable files."). **The compilation file is described as being both assembled and updated** by a processor in asserted claim 31 and the specification. See, e.g., '504 Patent, 16:64-66 ("FIG. 4 illustrates the principle data processing steps and information structures employed by the preferred embodiment of the invention to compile programming information . . .").

Independent claim 31 describes generally a server-side apparatus that is used to disseminate episodic media content. **Claim 31's requirement that the processor, from time to time, stores an updated version of the compilation file at a storage**



**location identified by a predetermined URL**, is essential to successful operation of the claimed invention and is dispositive of the issues before the Board. **By storing each updated version of the compilation file at a predetermined URL, a remote player device that “knows” the predetermined URL can automatically retrieve the most recently updated compilation file to automatically obtain any available episode in series of episodes.** The manner in which the host server creates and stores the compilation file at a predetermined location known to the player for automated retrieval is described as follows in the ‘504 Patent at col. 6, line 60 et seq.:

*“The host server 101 periodically transmits a download compilation file 145 upon receiving a request from the player 103. The file 145 is placed in a predetermined FTP download file directory and assigned a filename known to the player 103. At a time determined by player 103 monitoring the time of day clock 106, a dial up connection is established via the service provider 121 and the Internet to the FTP server 125 and the download compilation 145 is transferred to the program data store 107 in the player 103. The compilation 145 is previously written to the download directory by a download processing mechanism seen at 151 in the server 101.”*

The compilation file can be used to describe the available episodes in a series of episodes as they become available. As discussed in the ‘504 Patent at col. 19, line 35 et seq.:

*“As contemplated by the invention, 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, or a subscriber may select an individual program in a serial sequence and the host may then further installments or related programs within the series to the catalog or session content thereafter sent to the subscriber. The Program\_Segment record contains a GroupID field which specifies the series as a whole, and an Episode integer field specifies the position of the given program segment within the serialized sequence. When a serialized sequence is requested, the host may download the entire series in one download for playback at requested intervals, or less than all of the episodes when all are not yet available or when it is desirable to limit the total download content.”*

Independent claim 31 expressly defines the manner in which the processor at the server, from time to time as new episodes become available, stores an updated compilation file in a storage location identified by a predetermined URL. The updated compilation file includes displayable text describing each available episode in the series of episodes, and includes episode URLs which identify one or more media files representing each available episode. This allows a remote player device that “knows” the predetermined URL to retrieve the most recently updated compilation file at any time and obtain the information needed to retrieve and play any desired episode in the series, and to do so automatically without attention by the operator of the remote player.

Claim 31 is a server-side apparatus claim. The preamble and body of the claim describe a device with structure and software that operates dynamically as “episodes become available.” These dynamically added episodes of a series are updated in a listing of the episodes for downloading. That listing is embodied by the “compilation file” and the dynamic “updating” of the compilation file is concomitant with the new episodes becoming available for downloading (that is how the receiving device user knows the episodes are available). Thus, when the claim to this apparatus with dynamic episodic updating capabilities recites “one or more processors...for...storing an updated version of a compilation file,” it is the one or more processors of that apparatus that are programmed to assemble and store an *updated* compilation file “as episodes become available.”

As discussed in more detail below, neither the Patrick/CBC nor the Compton/CNN reference relied upon by EFF discloses or suggests this claimed mechanism for delivering episodic content. Instead, these references are addressed to general media postings wherein humans wrote and updated play lists or content and do not teach or enable a server-side apparatus wherein processors perform the claim 31 functions. Claim 31 defines machine performed functions, not a human being's manual work.

The key infirmity of the Patrick/CBC and Compton/CNN references is they contain no disclosure of “compiling” and “updating” by a processor, from time to time as new episodes become available, of an updated compilation file in a

storage location identified by a predetermined URL, the precise features deemed by the patent office to be inventive over the prior art<sup>1</sup>. In fact, neither the Patrick/CBC nor the Compton/CNN references even contain the words “compilation” or “updating”. There simply is no teaching, suggestion or inherency within the four corners of these two reference to even suggest a compilation file or an updating of the compilation file “...as new episodes represented in said series of episodes become available,...”

### **III. THE LEVEL ORDINARY SKILL, SCOPE AND CONTENT OF THE PRIOR ART**

The Declaration of EFF's expert Chris Schmandt asserts one of ordinary skill in the art pertaining to the '504 Patent “would have at least a Bachelor of Science degree in Computer Science or Engineering, as well as at least 3-5 years of experience in the relevant field of electronic information distribution systems, including distribution of media content over the Internet, or the equivalent thereof.” Patent Owner submits it is improper to boot-strap such a long period of special expertise and experiences therein specifically including “distribution of media content over the Internet”. One of ordinary skill in the art would not in 1996 already have had 3 to 5 years of experience in “distributing media content over the Internet”.

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<sup>1</sup> See Notice of Allowability - “Reasons for Allowance” (PA Exhibit 2001, p. 2 - “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.”)

To the contrary, Patent Owner's expert Professor Peter C. Nelson explains in his Declaration the level of ordinary skill in the art pertaining to the '504 Patent. Based on Professor Nelson's review of the '504 Patent and its prosecution history, related documents, and further based on his experience teaching and performing research relating to computer networking, multimedia, and web systems, as well as his experience collaborating and consulting with concerns in these industries, it is his opinion that a person of ordinary skill in the art at the time of the invention would have an undergraduate degree in Computer Science or a few years' experience in working with web sites and computers. He notes that at least two of the inventors of the '504 Patent (who are presumed to be of ordinary skill in the art) had no formal education or background in computer science or engineering. He states it was very common in the 1996 time frame for people working in multimedia and the Internet to have little formal scientific training or experience.

Although Patent Owner fundamentally disagrees with the definition of the level of ordinary skill proposed by EFF and Mr. Schmandt, it is believed the same is not determinative of the issues on review – rather the fact of missing claim elements / limitations in independent claim 31 is dispositive.

#### **IV. GROUNDS FOR WHICH REVIEW HAS BEEN INSTITUTED**

EFF's Petition included five proposed grounds for invalidity, and the Board's decision entered on April 18, 2014 granted review based on two of those

grounds:

- (1) Claims 31-35 are unpatentable under 35 U.S.C. § 102(a) as anticipated by Patrick/CBC (Ex. 1012); and
- (2) Claims 31-35 are unpatentable under 35 U.S.C. § 103 as obvious over Compton/CNN (Ex. 1022).

(Paper 21, Board Decision p. 26)

Pursuant to 37 CFR §42.120, Patent Owner is addressing only the grounds for which review was instituted, for the select claims 31 to 35. (*See* 37 CFR §42.120, “A patent owner may file a response to the petition addressing any ground for unpatentability not already denied.”).

## V. CLAIM CONSTRUCTION

In its decision instituting this review, the Board provided the following construction to the following terms:

- “*episode*” is construed as “as 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.”;
- “*compilation file*” is construed as “a file that contains episode information”;
- “*media file*” is construed as “a file with content that can be reproduced as video, audio, and/or text.”

The Board interprets patent claim language in an *inter partes* review by ascribing to that language its broadest reasonable meaning in light of the specification of the patent. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). The Board also interprets claim language according to its ordinary and customary meaning to one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). It is noted that “[L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir.1993) (citing *In re Zletz*, 893 F.2d 319, 321(Fed. Cir. 1989)).

Patent Owner respectfully disagrees with the Board's foregoing construction of “*episode*” as unnecessarily and improperly importing the concept of a “*segment*” therein. The concept of a program “segment” is subtly distorted in the EFF grounds for review to assert that divided portions of a singular posted program constitutes part of a serialized sequences of programs<sup>2</sup>. More properly, an “episode” should be construed as “*a program, represented by one or more media files, that is a part of a series*”<sup>3</sup>.

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<sup>2</sup> EFF Declarant Chris Schmandt testified during his deposition “A newscast is episodic and the contents of the newscast is -- are episodes as well” and radio programs broken into segments are “both” episodes and segment parts of an episode. (PA Exhibit 2002, Schmandt Dep. Tr. at 14 and 21-22 respectively)

<sup>3</sup> The title of the ‘504 Patent references “...episodes in a serialized sequence”. The ‘504 specification at 19:36-37 states: “...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

For purposes of this IPR only, Patent Owner suggests that its disagreement with the Board's claim construction of "episode" is not determinative of the *inter partes* review issues – rather the fact of missing claim elements / limitations in independent claim 31 is the crux of this proceeding.

Indeed, it is observed that the Board's initial claim constructions is restricted to the particular word or phrase construed and are not material to the arguments in this Response because the construed word or phrase, particularly "compilation file" **are further qualified by the plain and ordinary meaning of other claim language**, language which is dispositive of the issues before the Board.

## **VI. THE BOARD SHOULD CONFIRM VALIDITY OF CLAIMS 31 TO 35 OVER THE INSTITUTED GROUNDS**

Independent claim 31 and its dependent claims 32 to 35 require a specific type of "updated compilation file" located at a "predetermined URL". Neither the Patrick/CBC nor the Compton/CNN references at issue in the instituted grounds for review disclose or suggest the same.

### **A. Patrick/CBC Does Not Anticipate The Challenged Claims Because It Fails To Disclose All Elements and Limitations Of Independent Claim 31.**

Independent claim 31 sets forth claim language that qualifies and defines the "compilation file" in a manner not accounted for in the Patrick/CBC article.

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subscriber...". See also, the '504 specification at 19:35-20:11; 20:57-21:3; 39:35-46; 43-45:67; 46:1-52:11.



To prevail in its challenges to the patentability of claims, EFF as the petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). The Court of Appeals for the Federal Circuit has summarized the analytical framework for determining whether prior art anticipates a claim as follows:

If the claimed invention was “described in a printed publication” either before the date of invention, 35 U.S.C. § 102(a), or more than one year before the U.S. patent application was filed, 35 U.S.C. § 102(b), then that prior art anticipates the patent. Although § 102 refers to “the invention” generally, the anticipation inquiry proceeds on a claim-by-claim basis. *See Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313,1319 (Fed. Cir. 2007). **To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation.** *Celeritas Techs., Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). **But disclosure of each element is not quite enough—this court has long held that “[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.”** *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542,548 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 175 Ct.Cl. 644, 360 F.2d 954, 960 (1966) (emphasis added)). *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1334–35 (Fed. Cir. 2008). (emphasis added)

The Board 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) (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”).

### **1. The Asserted Anticipation By Patrick/CBC**

The Board's decision instituting *inter partes* review noted that 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.) 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.) The server was used as a source for Canadian government documents. (Ex. 1012, 3.) The server could be accessed at <ftp://www.radio.cbc.ca> or <http://www.radio.cbc.ca/>. (*Id.* at 7.) The program files for CBC Radio programs were made available via FTP, Gopher, and World Wide Web (WWW) using standard Internet server software. (Ex. 1012, 2-3.) A FM radio receiver was installed in the laboratory to constantly monitor the CBC broadcasts. (Ex. 1012, 3.) Using a “cron” program, a Sun computer automatically recorded programs and transferred them to the server. (Ex. 1012, 3.) This included the Quirks & Quarks science magazine show which was recorded each week, broken down into its component parts, and made available on the server. (*Id.*) The radio programs were made available “on demand” in that users could request them from the server at any time. (*Id.* at 3.)

The Board decision instituting *inter partes* review stated EFF relies on the foregoing to argue: (1) the media files are located at a specific URL (Pet. 41, citing Ex. 1002 ¶¶ 63-64, 67), (2) the radio programs meet the claim 31 requirement that, “from time to time, as new episodes represented in said series of episodes become available” (Pet. 41-42, citing Ex. 1002 ¶¶ 63-66), and (3) Patrick/CBC discloses accompanying text describing the episodes (*Id.*, citing Ex. 1012, 3) fulfilling the “displayable text requirement of claim 31.

## **2. Patrick/CBC Does Not Account for All Elements And Limitations Of Independent Claim 31**

Initially, the Patrick/CBC reference at EFF Ex. 1012-4 states its experimental and evaluation trials including the collection of traffic data went from December 15, 1993 through October 31, 1994. (Ex. 1012 at 3).

Standardized URLs were first defined by URL standard RGC 1738, published in December of 1994 after the Patrick/CBC's Radio Internet trial had already ended. Patrick says in the reference that the experimental CBC Radio trial had media files accessible by the public via the Internet, yet nowhere in the reference does the word “URL” appear to describe how the alleged media files were made available by the “links.” At the top of page 4 of Ex. 1012, it really appears that FTP and Gopher sites were generally used to access the media files and anyone who has used an FTP or Gopher site to download media files knows about the serious usability problems

during downloads. This is in large part based on the fact that the system did not provide a unique storage location for each episode. All episodes were indiscriminately stored on “the server” and therefore subject to traffic demands. The Personal Audio system claims a severe advantage over Patrick in that each episode is stored at a unique resource location and provides the server side apparatus to balance high traffic demands.

Also, there is a disconnect between what the Patrick/CBC reference actually teaches or suggests and the stated claim elements found in Claim 31. For the claimed invention as a whole to have been anticipated before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains, there must be a correlation of apparatus elements found in the reference to each and every claim element and claim limitation found in Claim 31.

Clearly, the Patrick/CBC reference does not teach a person with ordinary skill in the art on how to compile and update episodic compilation file for downloading from predetermined and unique URL addresses over the Internet since at the time of the CBC Radio experimental trial through October of 1994, there were no standardized defined URL addresses yet.

While the Patrick/CBC system states it disseminated for a time a series of weekly Quirks & Quarks episodes represented by media files via the Internet as the episodes become available, the article has no disclosure of how this was performed

and there is no disclosure that a compilation file of the kind claimed (or any compilation file for that matter) was produced and updated from time to time as set forth in independent claim 31.

The Patrick/CBC does not expressly or inherently teach anything that can be said to be a “compilation file” as claimed. Also claim 31 requires that the “displayable text” be present in the claimed compilation file. The Patrick/CBC paper at page 3 says only that “The larger programs were broken into segments that were described in accompanying text so users could select only the parts of the program that were of interest to them” – but does not explain where the “accompanying text” was stored. There is no description anywhere of anything that can be said to be a compilation file of the kind set forth in detail in claim 31, namely:

...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;... (emphasis added)

The claim 31 further requires receiving a “request for **an updated version of the compilation file,**” downloading **the updated compilation file,** and then receiving and responding to a request for “one or more corresponding episode URLs.” (emphasis added).

**(i) Claim Chart of Missing Elements And Limitations Not Disclosed By Patrick/CBC**

Set forth below is a claim chart of the reviewed ‘504 patent claims 31 to 35 wherein bold printed claim language indicates required claim elements and limitations not disclosed by the Patrick/CBC reference:

**U.S. Patent 8,112,504**

**Claim Chart of Missing Elements And Limitations Not Disclosed By Patrick/CBC**

**IPR Claims 31 to 35**

(wherein bold print indicates missing claim elements and 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 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.**

**32. The apparatus as set forth in claim 31** wherein at least some of said media files contain digital compressed audio recordings that may be reproduced in audible form by a requesting client device.

**33. The apparatus as set forth in claim 31** wherein at least some of said media files contain text data which may be displayed or reproduced in spoken audible form by a requesting client device.

**34. The apparatus set forth in claim 33** wherein said attribute data for each given one of said episodes further includes displayable text data describing said given one of said episodes.

**35. The audio program player set forth in claim 34 wherein said updated version of said compilation file further includes displayable text describing said series of episodes.**

**(ii) Patrick/CBC does not disclose the “*updated compilation file*” “*at a predetermined URL*” claim limitations**

How does EFF attempt to account for the claim charted missing claim 31 to 35 elements and limitations above, particularly the independent claim 31 elements and limitations which give further definition to the phrase “compilation file”?

EFF cites to Patrick/CBC's disclosure of the HTML construct of the URL for downloading the radio programming as meeting the “compilation file” limitation, when the limitation is merely construed as “a file that contains episode information”. (Pet. 43, citing Ex. 1012, 3, 7; Ex. 1002 ¶¶ 64, 65, 67). EFF's Declarant Chris Schmandt candidly admitted when discussing the Board's construction of “compilation file” as “a file that contains episode information”:

“I don't know the URL of that [compilation] file. They don't tell us that in the [Patrick/CNN] paper, but that file must exist because there are links that the users can click to get to the audio and to get to information



about those programs, and that is the compilation file, whatever its name is.” (PA Exhibit 2002, Schmandt Dep. Tr. at 13, lines 19-24)

But claim 31 further qualifies and defines “compilation file”.

The Patrick/CBC paper states only that “These radio programs were made available ‘on demand’ in that users could request them from the server at any time. The larger programs were broken into segments that were described in accompanying text so users could select only the parts of the program that were of interest to them.” – but the paper does not explain at all how this was done<sup>4</sup>. Speculatively, perhaps one skilled in the art could infer that the programs were described on an HTML page that, for larger programs, described the segments of each program and included links that contained the URLs of the audio file for each such segment – but there is no disclosure of even that. Nothing in the disclosure suggests **storing an updated version of a compilation file at a storage location identified by a predetermined URL from time to time as new episodes become available**, and nothing suggests that **the updated version of the compilation file describes the currently available episodes in the series of episodes**. The Petitioner (and the Board’s institution decision) failed to identify anything disclosed in the Patrick/CBC paper that can be said to be a compilation file of the kind claimed.

The Board’s institution decision stated:

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<sup>4</sup> Indeed, a large program broken into segments is still ONE episode.

“Patrick/CBC discloses storing media files, in the form of radio programming, on a server for later use. Ex. 1012, Abstract. A series of programs are stored and made available, i.e., the *Quirks & Quarks* science magazine show was recorded each week, broken down into its component parts, and made available on the server. *Id.* at 3. New episodes are added as they become available. Two newscasts were recorded each day and made available on the server immediately after the broadcast. *Id.* Thus we are persuaded that the key element of claim 31 as asserted by Patent Owner (Prelim. Resp. 3)<sup>5</sup> is shown in Patrick/CBC and explained in the petition.” ...

‘...*For purposes of this decision*, we are persuaded by Petitioner’s argument that Patrick/CBC discloses to the person of ordinary skill in the art *the use of URLs to identify specific file locations.*” (emphasis added)

Yet the contention that Patrick/CBC discloses the use of URLs to identify specific file locations does not account for the “key” claim 31 limitations of:

“...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;”

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<sup>5</sup> The key element being: “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).

First, it is respectfully submitted there is no evidence Patrick/CBC discloses a “compilation file” as expressly defined in substantial detail in claim 31. EFF has not identified a disclosure in Patrick/CBC of anything that can be said to be a compilation file as claimed, because there is no such disclosure.

The “initial program offerings” described in the Patrick/CBC article above did not deliver episodes in the series as they become available. Instead, only a single episode of the “Quirks and Quarks” series and of the “Basic Black” series were made available. Even then, there is no specific information given describing how that was done and there is no description of the manner in which the user listened to individual programs. Presumably, in the World Wide Web version, there was an HTML page or pages that identify the programs, but no specific information is given describing how that was done. There is no disclosure of the mechanism for identifying and associating episodes, so the underlying mechanism for creating a compilation is missing from the Patrick/CBC reference.

In the Patrick/CBC paper, it is explained that, subsequent to the “initial program offerings,” newscasts and the Quirks and Quarks science magazine show were recorded daily or weekly and made available on the server. (See, Ex. 1012, 3) However, although the distribution of episodic content is described, there is no disclosure or suggestion of the use of the compilation file as claimed. *All that is disclosed is that the episodes were recorded and made available on the server.* There

is no description of anything that would correspond to a compilation file. There is no description of distinguishing files of different programs.

Further, the Patrick/CBC paper states that the audio files for older episodes did not continue to be available, so that a compilation file which described past episodes in a series as well as new episodes as they become available would not have been feasible. The Patrick/CBC article at p. 7 stated:

“The distribution of programming in a digital format can be different than traditional broadcasting. Material that is broadcast is very short-lived: if it is not consumed at the time of broadcast it will likely never be consumed. The material can be recorded for later use, but this is rare, especially for radio programs, and the copies may not be as good as the original.

On the other hand, material that is offered digitally on a server can have a much longer life. Listeners can transfer the files at any time, and material may be preserved for long periods in the original condition. Initially, this led to a fear that the material may not be timely. **News and current affairs shows pride themselves on being current and up to date, and there was some concern about users transferring older material without realizing its age. In practice, it was necessary to remove files from the server regularly due to their large size so this was not a problem.** There was also the opposite concern--some material should be archived and made available permanently, but this requires a large investment in storage hardware and useful search and retrieval technology.” (emphasis added)

It is clear that the “media files representing each episode as said one or more media files become available” were not “stored at a storage location specified by a unique episode URL.” At best the CBC “program files” were made available via FTP without a unique episode URL.

EFF cites to portions of the Schmandt Declaration describing how HTML files, links and URLs work. Yet, the EFF reliance upon what an ordinary artisan would understand from the Patrick/CBC use of HTML files, links, and URL's does not account for independent claim 31's missing elements and limitations – particularly the further defined “updated compilation file” at a “predetermined URL”.

The '504 Patent, at col. 1, line 63 to col. 2, line 11 acknowledges the existence of, and points out the shortcomings of, HTML “Internet Radio” delivery mechanisms of the kind likely contemplated by the Patrick/CBC reference:

“More recently, "Internet radio" sources has been introduced which make files of audio program material available for downloading on the World Wide Web using conventional web browsers to locate and request specific files which are then played in real time by special programs, including the popular "Real Audio" program offered by Progressive Networks. Although Internet radio systems make it possible to deliver a richly diverse selection of audio programs to interested listeners on request, including specialized information not offered by conventional broadcast media, the use of a visual web browser to search for and then play individual program selections one at a time makes conventional Internet radio players impractical for

routine desktop use, and wholly unsuitable for use by an automobile drive (sic).”

But the claimed invention of claim 31 represents an advance over conventional web pages that include links to media files. Its use of a compilation file which described the available episodes in a series, which was updated from time to time as new episodes became available, and which was stored at a predetermined URL so that a remote client player device could automatically fetch the compilation file and obtain new episodes, made it possible to automate that transfer of desired program files representing a series of episodes without requiring the attention of the remote subscriber. Nothing like that is described or suggested in the Patrick/CBC paper. Indeed, Patrick/CBC teaches away from the concept of a compilation file, which conveniently displays episodes episodically and available for immediate playback. “The news audio files were made available only via the FTP protocol and the FTP server parameters were set to limit the traffic... WWW and Gopher users could still access the news programs, but the menus and links pointed to the FTP service.” EFF Ex. 1012 - 4. Although the exact operation of CBC system is not fully disclosed, it seemingly required the user to navigate through a maze of links and menus before the user could begin download of the program.

Patrick/CBC fails to disclose the “updated compilation file” requirement of the subject ‘504 Patent claims 31 to 35. This deficiency negates anticipation. Under

MPEP §2131, to anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, to anticipate, the reference must teach “all of the limitations arranged or combined in the same way as recited in the claim.” *Net Moneyin, Inc., v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed Cir. 2008).

**(iii) Patrick/CBC Does Not Disclose The “updated compilation file”  
“at a predetermined URL” Under The Doctrine of Inherency**

EFF and its expert Chris Schmandt relies upon what an ordinary person of skill in the art would understand from the Patrick/CBC use of HTML files, links, and URL's to account for the “updated compilation file” requirement of the subject ‘504 Patent claims 31 to 35. When discussing a “compilation file” in the sense of “a file that contains episode information” during his deposition, Mr. Schmandt did not know its URL and acknowledged the Patrick/CNN reference does not disclose it, but “that file must exist because there are links that the users can click to get to the audio and to get to information about those programs, and that is the compilation file, whatever its name is.” (PA Exhibit 2002, Schmandt Dep. Tr. at 13, lines 19-24)

Thus EFF's case of anticipation based on Patrick/CBC, and the Board's comments in response, implicitly rest on the *doctrine of inherency*.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). **Inherency, however, requires that a claimed limitation be “necessarily” and “inevitably” present.** See *Transclean Corp. v. Bridgwood Servs., Inc.*, 290 F.3d, 1364, 1373 (Fed. Cir. 2002) (“Inherent” anticipation is appropriate only when the prior art necessarily includes a claim limitation that is not expressly disclosed.). **It is not enough that a claim limitation was possibly or probably present in a prior art reference.** See *Scaltech, Inc. v. Retec/Tetra, LLC.*, 178 F.3d 1378, 1384 (Fed. Cir. 1999) (**invalidity based on inherency is not established by mere “probabilities or possibilities”**). See also, e.g., *Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2012-00026, docket 65, p.34 (PTAB, Feb. 19, 2014 Final Decision (“A finding of anticipation by inherency requires more than probabilities or possibilities.” – citing *Motorola Mobility LLC v. Int’l Trade Comm’n*, 737 F.3d 1345, 1350 (Fed. Cir. 2013)) (emphasis added)

In other words, because Patrick/CBC does not expressly disclose the specific “compilation file” required by independent claim 31 in order to find anticipation, EFF is required to show that Patrick/CBC “necessarily” and “inevitably” included the specifically defined “updated compilation file” “at a predetermined URL” inclusive of all of its elements and limitations (i.e., not that it was merely possible or probable that Patrick/CBC used the claimed type of “compilation file”). EFF, however, did not and cannot establish this requirement, for two



reasons. First, Patrick/CBC itself at Ex. 1012 page 3, states that the “program files were made available via FTP, Gopher, and World Wide Web (WWW) using standard Internet server software” and such a statement does not “necessarily” and “inevitably” disclose the claimed “updated compilation file” “at a predetermined URL” because it establishes multiple alternatives to making programs available such as FTP and Gopher.

Second, EFF has glossed over the key elements and limitations of challenged independent Claim 31 which require:

“...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 Patrick/CBS trial is a periodic posting of CBC Radio "program files" "made available via FTP, Gopher, and World Wide Web (WWW) using standard Internet server software" that does not teach Patent Owner's foregoing definition of its "updated compilation file" "at a predetermined URL". Patrick/CBC sets forth no disclosure of how the trial posting software operated or was coded. Patrick/CBC could have and appears to involve mere Internet posting software, which fails to satisfy claim 31's defined requirements.

If the Board agrees that Patrick/CBC does not "necessarily" and "inevitably" disclose the claimed "compilation file" "at a predetermined URL", then the instituted ground for review of claims 31 to 35 based on anticipation by Patrick/CBC fails.

**B. Compton/CNN Does Not Render The Challenged Claims Obvious Because It Fails To Disclose All Elements And Limitations Of Independent Claim 31**

35 U.S.C. § 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art to which said subject matter pertains.’’ *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). To establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *See CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (CCPA 1974).

The Board granted review of claims 31 to 35 for obviousness over Compton/CNN. The Board decision instituting *inter partes* review disagreed that Compton/CNN discloses updating a compilation file. Yet, the decision stated that given the Compton/CNN disclosure of storing multiple episodes of news programming in a compilation file, updating the compilation file would have been a predictable step and, therefore, obvious to the person of ordinary skill in the art. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

Since the instituted grounds do not combine another reference with Compton/CNN, the reviewed claims can only be held invalid under 35 U.S.C. § 103 if the Compton/CNN reference combined with the knowledge of one of ordinary skill in the art discloses every claim limitation so as to render the claim, as a whole, obvious. However, not every claim 31 limitation is disclosed or accounted for as one skilled in the art would view Compton/CNN.

### **1. The Compton/CNN Reference**

Compton/CNN describes the design of a digital video newsroom based on the video program CNN NEWSROOM. (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 in addition to being distributed via cable television systems as well as directly to schools via satellite. (Ex. 1022, 11.10)

Compton/CNN discloses that each day of the CNN NEWSROOM program is distributed over the Internet. (Ex. 1022, 10.) Compton/CNN shows servers in the form of the NMIS Web Server. (Ex. 1022, fig. 6.) The Compton/CNN thesis states in part:

“The World-Wide-Web is used to present and deliver the digital video news magazine to end-users. Custom software agents have been developed to automatically generate the WWW user interface for the service based on daily content. (Ex. 1022, p. 8)...

“The multimedia program is assembled automatically on a daily basis as a digital video news magazine distributed via the Internet. High quality 1.5 Mbit/second MPEG-I video is used in the program, giving the video clips VHS level quality. (Ex. 1022, p. 11)...

“One of the major NMIS deliverables is Internet CNN NEWSROOM, a networked multimedia program based on the CNN NEWSROOM program. With Turner Broadcasting, a complete multimedia news program is automatically generated from CNN NEWSROOM content on a daily basis and made available on the Internet via the World Wide Web [citing Berners-Lee, Tim. "World Wide Web Initiative." (Ex. 1022, p. 11)...

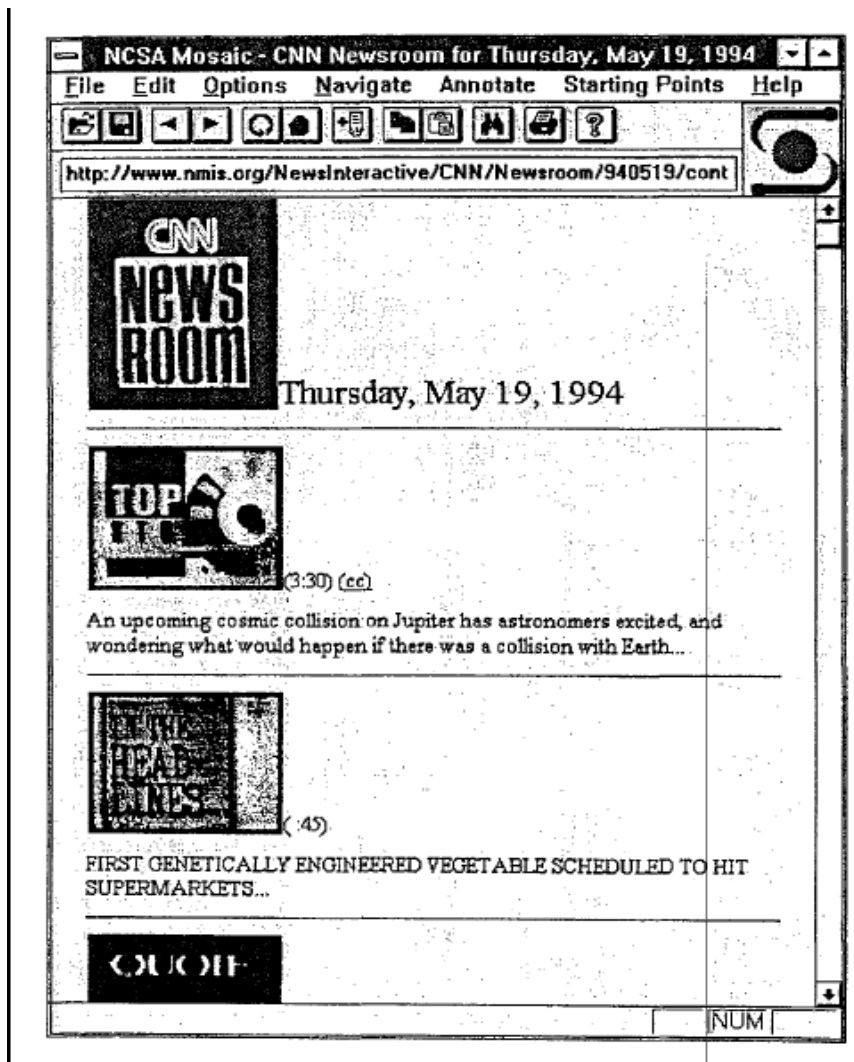
“Internet NEWSROOM consists of several major components. The "table of contents" for a particular day's program is a html document

that consists of a short summary and an icon or title for each segment of the program. (A segment corresponds to a single news story.) An example of the Table of Contents is shown in Figure 1.” (Ex. 1022, p. 15)

The Table of Contents page shown in Figure 1 on Page 14 of Compton/CNN and reproduced below is a screen image of the display produced by the NCSA Mosaic Browser. The box below the “buttons” contains the URL of the page being displayed, the readable portion of which reads:

<http://www.nmis.org/NewsInteractive/CNN/Newsroom/940519/cont>

Figure 1 depicts:



Compton/CNN discloses the automatic generation of a WWW user interface for daily content. (Ex. 1022, p. 7.) Further, Compton/CNN captures video using the FTP protocol and delivers the files to the server. (*Id.* at p. 22.) The results can be delivered to “any host on the Internet supporting the FTP protocol.” (*Id.*)

EFF argues the Compton/CNN servers meet the “data storage servers” recited in claim 31. (Pet. 47-48, 54.) Petitioner alleges that a person of ordinary skill would have understood, at the time the invention was made, that “processors” and the claimed “communications interface” are “necessarily contained” in the server once media files are requested over the Internet. (Pet. 47-48, citing Ex. 1002 ¶ 76). EFF relies upon these disclosures and the testimony of Mr. Schmandt to argue the claim 31 limitation of storing “one or more media files representing each episode as said one or more media files become available” at a “unique episode URL” is met because links would be understood to be unique episode URLs. (Pet. 55, citing Ex. 1002 ¶ 77).

Importantly, EFF relies upon the Compton/CNN Table of Contents, see Figure 1 above, as a “compilation file.” (Pet. 55, citing Ex. 1002 ¶ 78). The EFF position is that at the displayable text in the Table of Contents describes the

episode, i.e., “segment.” (Pet. 56.) The Table of Contents is an HTML file that “was automatically updated each day and presented attribute data describing each episode (in this case, the episodes were news segments).” (Ex. 1022, 13-14, 17-19.) Further, the link in the Table of Contents is a URL in that it “specifies the location of one of the media files representing the episode.” Pet. 56 (citing Ex. 1002 ¶¶ 24-33).

## **2. Compton/CNN Does Not Account for All Elements And Limitations Of Independent Claim 31**

Although the Compton/CNN system is asserted to account for the claim 31 preamble environment to “*disseminate a series of episodes represented by media files via the Internet as said episodes become available*”, it does not do so in the manner set forth in the remainder of claim 31. Likewise, the Compton/CNN system description of data storage servers, communications interfaces connected to the Internet for responding to requests for data files identified by URLs, and one or more processors coupled to the data storage serves and the communications interfaces does not perform all of the functions set forth in the remainder of claim 31.

Indeed, it cannot be shown that the Compton/CNN article meets all the limitations of claim 31’s “apparatus for disseminating a series of episodes represented by media files via the Internet as said episodes become available,” particularly an apparatus that “from time to time, as new episodes represented in said series of episodes become available” was “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” wherein the updated compilation file was “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.”

**(i) Claim Chart of Missing Elements And Limitations  
Not Disclosed Or Suggested By Compton/CNN**

Set forth below is a claim chart of the reviewed ‘504 patent claims 31 to 35 wherein bold printed claim language indicates required claim elements and limitations

|  |
|--|
| <b>U.S. Patent 8,112,504</b>   |
| <b>Claim Chart of Missing Elements And Limitations Not Disclosed By<br/>Compton/CBC</b>  |
| <b>IPR Claims 31 to 35</b>   |
| (wherein bold print indicates missing claim elements and limitations)  |
| <b>31. Apparatus for disseminating a series of episodes represented by media files via the Internet as said episodes become available</b> , said apparatus comprising:<br><br>one or more data storage servers,<br><br>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.**

**32. The apparatus as set forth in claim 31** wherein at least some of said media files contain digital compressed audio recordings that may be reproduced in audible form by a requesting client device.

**33. The apparatus as set forth in claim 31** wherein at least some of said media files contain text data which may be displayed or reproduced in spoken audible form by a requesting client device.

**34. The apparatus set forth in claim 33 wherein said attribute data for each given one of said episodes further includes displayable text data describing said given one of said episodes.**

**35. The audio program player set forth in claim 34 wherein said updated version of said compilation file further includes displayable text describing said series of episodes.**

**(ii) Figure 1 is not the claimed “updated compilation file”**

The Compton/CNN article Figure 1 (Ex. 1022, 14) is not a “compilation file” as claimed in independent claim 31 for several reasons.

First, Compton/CNN describes a single episode, the May 19, 1994 edition of the CNN Newsroom. It does not contain attribute data describing currently available episodes in said series of episodes as required by the claims. The Table of Contents page seen in Fig.1 is devoted to the single May 19, 1994 episode and is not updated as new episodes become available. Instead, each new episode is represented by different Table of Contents page at a different URL.

The Figure 1 “Table of Contents” displays “a short summary and an icon or title for each segment the program. (A segment corresponds to a single news story)” (Ex. 1022, 15). Thus, in the portion of the segment listing visible in Figure 1, an icon and a short description (“An upcoming cosmic collision on Jupiter ...”) describes a 3:30 duration segment. The icon provides the anchor for a clickable link to a video file for the news story. The “(cc)” to the right of the icon is

underlined, indicating it is a link to the closed caption text of the news story. Similarly, an icon and a short summary of a second :45 second segment of the May 19, 1994 episode appears below the first segment description and, again, the icon anchors a link to the video file representing the second news story.

While the Table of Contents HTML page contains links “one or more media files representing each episode” since the May 19, 1994 episode is represented by several media files each containing a segment (news story) forming part of that episode, it is important to recognize that the segments (news stories) are not different episodes but rather part of the single May 19, 1994 episode.

It is the position of EFF's declarant Chris Schmidt during his deposition testimony that a newscast is episodic and “the contents of the newscast is -- are episodes as well”. (PA Exhibit 2002, Schmandt Dep. Tr. p. 14, line 25-26) This position is indiscriminate. It fails to account for the nature of serialized sequence of episodes and claim 31's “compilation file” relative “a series of episodes represented by media files via the Internet as said episodes become available,” that is updated “from time to time, as new episodes represented in said series of episodes become available”. The particular cosmic collision on Jupiter or the genetically engineered vegetable “news story” content segment of the Figure 1 single May 19, 1994 CNN Newsroom is not episodic in a series or a serialized sequences

of programs which is selected as a group by a subscriber. Such “segments” are only temporally related, because they were broadcast as part of the same newscast unit.

Second, the Table of Contents page is located at a URL that is unique to that episode, as made plain by fact that the date of the episode is part of the URL. All claims herein require the independent claim 31 feature:

**“...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 Table of Contents page seen in Fig.1 is devoted to the single May 19, 1994 episode and is not **updated as new episodes become available**. Instead, each new episode is represented by different Table of Contents page at a different URL.

Third, the Table of Contents page seen in Fig. 1 does not contain **“attribute data describing currently available episodes in said series of episodes”** as required by the claims. The page contains attribute data describing a single episode only. There is no disclosure about how to identify and aggregate episodes, or even to do so when new episodes become available.

Fourth, claim 31 requires a “compilation file” updated from “time to time, as new episodes represented in said series of episodes become available”. The “updated compilation file” also must contain the foregoing “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.”

A fundamental infirmity underlies the EFF reliance upon the Compton/CNN Figure 1 accounting for claim 31's “*compilation file*” (even if the phrase is merely construed as “a file that contains episode information”): the “Table of Contents” seen in Figure 1 is not a compilation file as claimed. It is not and cannot be. While a new Table of Contents file was automatically created each day to describe that day's episode, and each new episode's Table of Contents HTML file described the segments making up that episode, those new Table of Contents files were stored a different URLs, each unique to that episode, rather than at a predetermined URL. Moreover, the Table of Contents files of the type seen in Fig. 1 did not “contain attribute data describing currently available episodes in said series of episodes” but rather each Table of Contents described one episode only.

As to the recitations of claim 31 regarding a “compilation file,” Petitioner relies upon the disclosure in Compton/CNN regarding updates to the Table of Contents. Pet. 50 (citing Ex. 1022, 13-14). The Table of Contents is an HTML file that includes information about each program or segment, which is updated as new segments are produced. *Id.* (citing Ex. 1022, 14). Compton/CNN discloses that

clicking a link downloads a MPEG file to playback. *Id.* at 25. Petitioner points to these features of Compton/CNN as meeting the recited limitations. Pet. 56-57 (citing Ex. 1002 ¶¶ 80, 24-33).

However, there is no disclosure or suggestion at Pages 13-14 of the Compton/CNN reference that the Table of Contents page seen in Fig. 1 is ever “updated” in any way, nor need it be, since there is no reason to believe that the content of the May 19, 1994 episode described by that page ever changes. New Table of Contents HTML pages may be created and stored at different URLs, but there is no teaching that the Table of Contents page for the May 19, 1994 at its unique URL is ever updated, or that it ever needs to be updated. The Compton/CNN reference does not tell how to select and aggregate disparate media into one or more playlists. Compton only publishes all captured content, without differentiation. The Table of Contents file of Fig. 1 is not a “compilation file” as claimed. In fact, in order for a client device to download the next “episode”, in this case the Friday, May 20<sup>th</sup>, 1994 episode of CNN NEWSROOM, the user would have had to navigate to another URL in order to view that episode. This is antithetical to the claimed invention. The ‘504 patent allows a client device to navigate to a single predetermined URL in order to receive the latest episode in a series of episodes. This inventive feature saves the user considerable time and ensures that a user does not miss an episode in the series.

While the Table of Contents file is a “file that contains episode information,” that is plainly not all that claim 31 requires. Certainly claim 31 should be given its

broadest reasonable interpretation, but its express limitations cannot be totally ignored. For the reasons discussed above, the segments of an episode described by a the Compton/CNN Figure 1 Table of Contents file are not different “episodes” in a series, and the Table of Contents file is not updated as new episodes become available as claim 31 requires. To the contrary, the content of the single episode (e.g. the May 19, 1994 episode) never changes<sup>6</sup>. The EFF positions have ignored the detailed, express description of the compilation file given by claim 31 and replaced the express language of the claim with the incorrect construction: “a file that contains episode information.”

Because Compton/CNN not disclose the claim 31 defined “compilation file” feature, the reference cannot render claims 31 to 35 obvious. See *Microsoft Corp. v. Proxycorr, Inc.*, Case IPR2012-00026, docket 65 (PTAB, Feb. 19, 2014 Final Decision), stating at p. 52-53 that “We cannot conclude that a claim would have been obvious when the prior art does not describe every element recited in the claim.”).

Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “there must be some articulated reasoning with some rational

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<sup>6</sup> EFF declarant Chris Schmidt testified “each newscast is in a separate URL” and the “information they post never changes...”. (PA Exhibit 2002, Schmandt Dep. p. 42, lines 13-15 and p.44, lines 14-16 respectively)

underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

The failure of Compton/CNN to teach or suggest each and every feature of Patent Owner’s independent claim 31 is dispositive of Compton/CNN *inter partes* issue despite the post-*KSR* revisions to the Manual of Patent Examining Procedure (MPEP). In particular, Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely “consider” each and every feature for the claim. Instead, any 35 U.S.C. § 103 application of Compton/CNN to claim 31 must also teach or suggest **each and every claim feature**. Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between the **claimed** invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

### **C. The Asserted Grounds For Review Do Not Address the Reasons For USPTO Allowance Of The ‘504 Patent**

The prosecution history of the “504 Patent includes the Examiner’s November 10, 2011 “Reasons for Allowance”:

“3. The following is an examiner's statement of reasons for allowance:



**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.**

The closest prior art of record is Reisman et al. (US PGPUB No. 2002/0069282) [hereinafter "Reisman"] which discloses a method for distributing updates for software products. While Reisman discloses updating using an object manifest, *see* (Reisman; [0094], lines 4-7), Reisman does {sic} not disclose the objects being a compilation file representing episodes with corresponding URLs of media files of said episodes.

For these reasons and in conjunction with the other limitations of the independent claims, this case is put in condition for allowance. Claims 1-35 are not taught or rendered obvious by the prior art of record.” (Prosecution History Excerpts, Exhibit \*\*) (emphasis added)

In essence, EFF and its expert have glossed over the “compilation file” reasons for allowance of the ‘504 Patent and their foregoing reliance upon a general explanation of how HTML, files, links, and URLs work does not account for the defined “compilation file” elements and limitations of independent claim 31, and hence, the elements and limitations of claims 32 to 35 dependent thereon.

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.

## **VII. The Declaration Of Professor Peter C. Nelson**

In PA Exhibit 2004, Professor Peter Nelson opines that the overall concepts found in the '504 Patent and as defined in claims 31 to 35 thereof are simply not

disclosed in or made obvious from the Patrick/CBC and Compton/CNN references and claims 31-35 are not anticipated by or rendered obvious by the references (PA Ex. 2004, at ¶¶ 18, 21, 56, 61, 63)

In essence, Professor Nelson confirms the Patent Owner's contentions of missing claim elements and missing claim limitations discussed in this Response. He finds that references of Patrick/CBC and Compton/CNN each do not disclose all the limitations of an "apparatus for disseminating a series of episodes represented by media files via the Internet as said episodes become available" and particularly do not disclose an apparatus that "from time to time, as new episodes represented in said series of episodes become available" was "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" wherein the updated compilation file was "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." (*Id.*, at ¶ 56)

Professor Nelson states the Patrick/CBC reference would not be "enabling", as there is very little explanation given for any of the coding involved. In any event,

Patrick/CBC reference is an experimental coding and does not disclose how to practice the invention as called for in claims 31-35 of the '504 Patent. (*Id.*, at ¶ 55).

Professor Nelson states the Compton/CNN reference does not disclose a “predetermined URL” for the supposed compilation HTML file. (*Id.*, at ¶ 58) Rather, at most, Compton/CNN discloses HTML that was present at a single point. There is no disclosure that such HTML was updated, nor any disclosure as to how. (*Id.*, at ¶ 52) Compton/CNN taught, at most, a searchable database with only one episode available at a given URL, thus the reference actually is clearly different from the challenged claims 31 to 35 because it 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 ¶ 58-59)

## **VIII. CONCLUSION**

For at least the foregoing reasons, Patent Owner respectfully requests that the Board confirm the validity of claims 32 to 35 of the '504 Patent over the grounds raised in EFF's Petition, including those for which review was instituted.

Dated: July 3, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify service of the foregoing Patent Owner's Response to the following lead and backup counsel for Electronic Frontier Foundation Petitioner on July 3, 2014 via overnight delivery by Federal Express:

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