Trials@uspto.gov
571-272-7822

Paper 46
Entered: March 18, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAMAHA CORPORATION OF AMERICA,
Petitioner,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2013-00597
Patent 8,230,099 B2

Before BRIAN McNAMARA, STACEY G. WHITE, and PETER P. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Yamaha Corporation of America ("Petitioner") filed a Petition requesting *inter partes* review of claims 1, 2, 6, and 9–12 of U.S. Patent No. 8,230,099 B2 (Ex. 1001, "the '099 patent"). Paper 1 ("Pet."). Black Hills Media, LLC ("Patent Owner") filed a Preliminary Response on December 26, 2013. Paper 10 ("Prelim. Resp."). On March 20, 2014, we instituted an *inter partes* review for all challenged claims on certain grounds of unpatentability alleged in the Petition. Paper 15 ("Dec. to Inst.").

After institution of trial, Patent Owner filed a Motion to Amend, moving to cancel claims 1 and 9 (Paper 25, "Mot. to Amend"), and a Patent Owner Response (Paper 26, "PO Resp."), to which Petitioner filed a Reply (Paper 30, "Pet. Reply"). In the Reply, Petitioner stated it does not oppose the Motion to Amend canceling claims 1 and 9. Pet. Reply 1. A consolidated oral hearing for IPR2013-00593, IPR2013-00594, IPR2013-00597, and IPR2013-00598, each involving the same Petitioner and the same Patent Owner, was held on October 20, 2014. The transcript of the consolidated hearing has been entered into the record. Paper 44 ("Tr.").

The Board has jurisdiction under 35 U.S.C. § 6(c). In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine Petitioner has shown by a preponderance of the evidence that challenged claims 2, 6, and 10–12 are unpatentable. Patent Owner's Motion to Amend is granted, and its Motion to Exclude is dismissed as moot.

A. Related Proceedings

Petitioner indicates that the '099 Patent is at issue in *Black Hills Media, LLC v. Yamaha Corp. of America,* No. 2:13-cv-006054 (C.D. Cal.). Pet. 2–3. In addition, Patent Owner has pending cases concerning the '099 Patent in the United States District Court for the District of Delaware and the Eastern District of Texas, and an investigation before the U.S. International Trade Commission, *Certain Digital Media Devices, Including Televisions, Blu-Ray Disc Players, Home Theater Systems, Tablets and Mobile Phones, Components Thereof and Associated Software,* Inv. No. 337-TA-882 (USITC). Supplemental Mandatory Notice (Paper 45), 1–3. The '099 Patent is subject of two other petitions for *inter partes* review.[1] *Id.*

B. The '099 Patent

The subject matter of the challenged claims of the '099 patent relates generally to methods and devices for sharing playlists. Ex. 1001, Title. As stated in the specification:

> Playlists for music and movies are well known . . .sharing of playlists is also known . . . such playlists and playlist sharing systems . . . possess inherent deficiencies . . . Therefore, it is desirable to provide a system and method for sharing playlists, wherein the playlists are communicated to, stored in, and displayed upon player devices other than general purpose computers.

[1] Cases IPR2014-00711 and IPR2015-00338.

Ex. 1001, 1:33, 1:64, 2:3–5, 2:21–24. The '099 patent in particular describes a method for presenting a playlist on a wireless handheld remote control for selection for playback on a media player device associated with, but separate from, the remote control. Ex. 1001, 1:25–29, 9:1–8.

Figure 2 of the '099 patent is reproduced below.

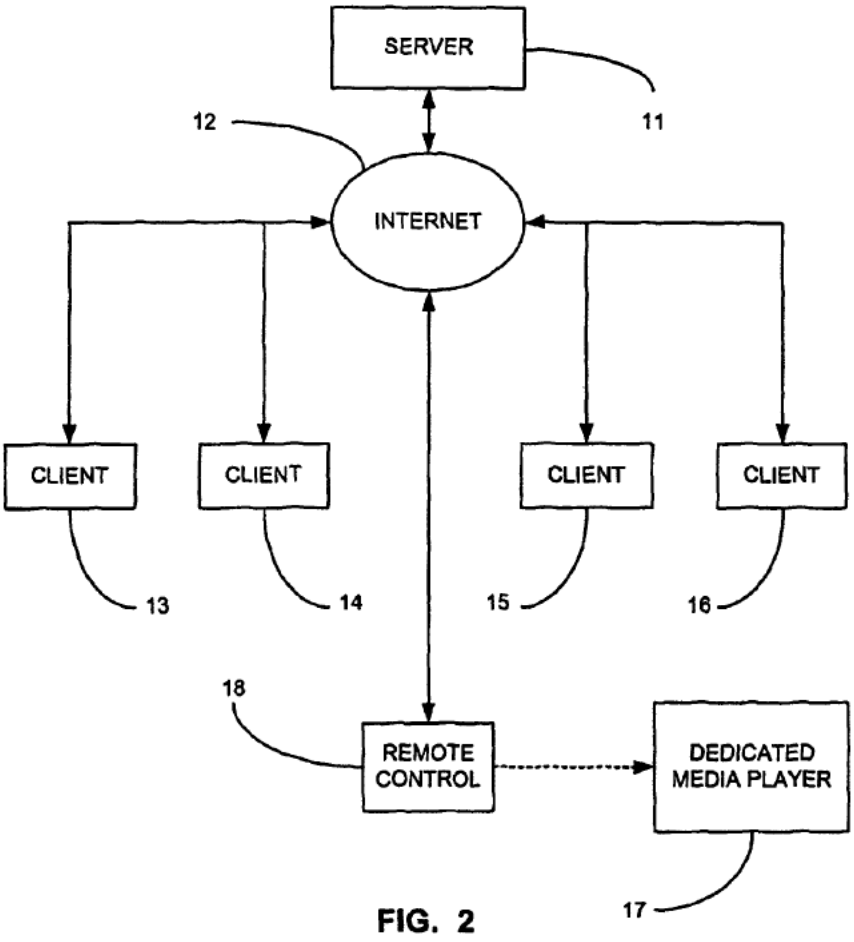


FIG. 2

Figure 2 depicts an embodiment of the invention with a playlist communicated from server 11 to remote control 18 via Internet 12. Ex. 1001, 9:1–23. After the

playlist has been communicated to the remote control, the playlist may be displayed on the remote control and used to choose which selection is to be played by dedicated media player 17. *Id*. at 9:5–8. Playlists may be communicated from remote server 11 to the media player 17 and to remote control 18, either directly from the server (*id*. at 9:1–4) or indirectly, through media player 17 to remote control 18, or through remote control 18 to media player 17. *Id*. at 9:9–20. Thus, playlists may be stored in, displayed upon, and used to make selections from either dedicated media player 17, remote control 18, or both. *Id*. at 9:21–23; *see also id.* at 10:20–43 (communication of playlists in embodiment using peer-to-peer network). As summarized by Petitioner, the display of the playlist on the remote control allows the user to select a song to be played on the media player without physically making a selection at the media player. Pet. 5 (citing Ex. 1001, 9:9–23).

C. Illustrative Claims

Claims 1, 2, 6, and 9–12 were the subject of the Petition. Independent claim 1 and dependent claim 9 are the subject of Patent Owner's Motion to Amend canceling those claims. Of the remaining claims, claims 2 and 6 directly depend from claim 1, and claims 10-12 are independent claims. Independent claims 1 and 11 are reproduced as follows:

1. A method comprising:
receiving, at a wireless handheld remote control, a playlist from a remote source; and
presenting, at the wireless handheld remote control, the playlist to a first user associated with the wireless handheld remote control such that the first user is enabled to select

at least one item from the playlist for playback by a media player device which is associated with and separate from the wireless handheld remote control.

11. A method comprising:
receiving, at a media player device, a play list from a remote source; and
communicating the play list from the media player device to a wireless handheld remote control associated with and separate from the media player device, wherein, at the wireless handheld remote control, the playlist is presented to a first user associated with the wireless handheld remote control and used by the first user to select at least one item from the play list for playback by the media player device.

D. Prior Art Supporting the Instituted Challenges

The following three prior art references were asserted in the instituted grounds:

Reference	**Title**	**Ex. No.**
Bi	US 2002/0087996 A1 (pub. July 4, 2002)	Ex. 1008
Gladwin	WO 01/17142 A2 (Pub. Mar. 8, 2001)	Ex. 1009
Berman	US 6,502,194 B1 (issued Dec. 31, 2002)	Ex. 1010

E. The Instituted Challenges of Unpatentability

The following table summarizes the challenges to patentability on which we instituted *inter partes* review.

Reference(s)	Basis	Claims Challenged
Bi	§ 102(b)	1, 2, 6, and 9–12
Gladwin	§ 102(b)	1, 2, 6, 9, 11, and 12
Berman	§ 103(a)	1, 2, 6, 9, 11, and 12

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Claim terms are given their ordinary and customary meaning, as would be understood by 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).

In the Decision on Institution, we interpreted "playlist" as "a list of media selections." Petitioner asserts that our "construction of this term is correct and should be maintained," Pet. Reply 3. Patent Owner contends that "playlist" should be interpreted as "a list referencing media items arranged to be played in a sequence," PO Resp. 8-14; *see* Prelim. Resp. 6–7. The '099 specification states,

"[a] playlist is a list of a user's favorite selections." Ex. 1001, 1:33–34. Patent Owner quotes from the specification of the '099 Patent:

> Playlists also facilitate the playing of a plurality of selections in a particular order. That is, the playlist *may* be compiled in an order in which the playing of selections therefrom is desired. The selections *may* then be automatically played sequentially from the playlist. *Typically, selections may also be played randomly from a playlist*.

PO Resp. 10; Ex. 1001, 1:45–52 (emphasis added).[2] As noted by Petitioner, this passage reflects that a playlist *may* have a particular order of selections (*see* Pet. Reply 6), but also expressly discloses that selections may be played randomly from a playlist.

Patent Owner also relies on extrinsic evidence in the form of witness testimony, which we find unpersuasive. Patent Owner cites to the Declaration of its expert witness, Dr. Gareth Loy, who opines that one of ordinary skill in the art would have understood that playing a playlist "means to play a playlist in sequence." PO Resp. 9–12; Ex. 2001 ¶ 54. This testimony is contrary to the above-cited portions of the specification, which expressly define playlist and also provide that selections may be played randomly. Ex. 1001, 1:33–34, 1:52. Indeed, the term "sequence" urged by Patent Owner, appears only once in the entire

[2] Patent Owner misquotes the cited excerpt from the '099 patent, asserting, "The '099 patent also states: Playlists also facilitate the playing of a plurality of selections in a particular sequence. . . ." PO Resp. 10. The word "sequence," however, nowhere appears in that cited excerpt of the '099 patent. Ex. 1001, 1:48–49. We attribute Patent Owner's insertion of "sequence" into the excerpt to be an inadvertent error.

specification, in an unrelated description of the sequence of steps for constructing and operating the invention. *Id.* at 8:4–5. Patent Owner also cites to excerpts of the deposition testimony of Petitioner's expert witness, Dr. V. Michael Bove, Jr., whose testimony that a playlist may be played in a "sequence" refers to how a playlist is played by a media player, rather than to what constitutes a playlist. PO Resp. 12; *see* Pet. Reply 5; Ex. 2012, 217:1–218:7. Dr. Bove further opines that the construction in the Decision to Institute is the broadest reasonable construction consistent with the specification. PO Resp. 13; Ex. 2012, 280:19–281:7.

As we stated in the Decision to Institute, we are persuaded that the construction proposed by Patent Owner is too narrow and would exclude the embodiment described in the specification. Accordingly, we decline to adopt Patent Owner's proposed construction, and maintain the construction of playlist from the Decision to Institute, i.e., "a list of media selections."

Patent Owner's Response for the first time proposes a construction for "a wireless handheld remote control which is associated with and separate from the media player device," arguing that the term requires "a handheld remote control that can operate as an *independent* device relative to the media player that it control." PO Resp. 14–16 (emphasis and grammatical error in original); *see also* Tr. 70:1–14 ("independent and separate would be synonyms."). Petitioner argues that Patent Owner's proposal is narrow and excludes "a standard remote control for a device," Pet. Reply 8–9. We agree, as in addition to the Petitioner's contentions, we note the terms "operate" and "independent" do not appear in the '099 patent.

We decline to adopt Patent Owner's proposed construction over the ordinary and customary meaning of the term.

For the term "remote source," in the Decision to Institute, we adopted the Petitioner's proposed construction ("a source of a playlist that is separate from a remote control"). Dec. to Inst. 9. Patent Owner has not proposed a construction for "remote source," which is a term found only in the claims of the '099 patent, where it is not defined. We see no reason to alter the construction from the Decision to Institute, and maintain the construction for this Final Written Decision.

In the Decision to Institute, we also construed "media player device" as "a device capable of playing audio or video or a combination of both." Dec. to Inst. 9–10. Neither party has thereafter discussed this term. We see no reason to alter this construction, and maintain the construction for this Final Written Decision.

All other claim terms are given their ordinary and customary meaning and need not be further construed.

B. Motion to Amend

In its Motion to Amend, Patent Owner moves to cancel independent claim 1 and dependent claim 9. Paper 25. Petitioner's Reply does not oppose the motion. Pet. Reply 1. We grant the motion to amend, and proceed to analyze the remaining five claims.

C. Level of Ordinary Skill in the Art

Petitioner proposes that the level of ordinary skill in the art is "at least a bachelor's degree in computer science or electrical engineering, and at least one

year of practical experience with networked multimedia." Ex. 1002 ¶ 8. Patent Owner's proposal is similar, requiring "a person with a bachelor's degree in computer science or electrical engineering and one year of practical experience with networked media." PO Resp. 7. The parties dispute Petitioner's use of the qualifying phrase "at least" in describing the level of education and work experience. While we disagree with Patent Owner's argument that "at least" is "improper because it is open-ended" (PO Resp. 7–8),[3] we determine that an express definition of the level of ordinary skill is not required.

The level of ordinary skill in the art can be reflected in the cited prior art references. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("the absence of specific findings on the level of skill in the art does not give rise to reversible error where the prior art itself reflects an appropriate level and a need for testimony is not shown.") (internal quotations omitted); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Here, neither party has provided a sufficient explanation as to how their specific proposal regarding the level of ordinary skill (and in particular the importance of the inclusion or exclusion of "at least") affects the analysis in this case. Therefore, we find the level of ordinary skill in the art to

[3] There is ample authority upholding the usage of "at least" in describing the level of ordinary skill in the art. *See, e.g., Unigene Labs., Inc. v. Apotex, Inc*., 655 F.3d. 1352, 1358 (Fed. Cir. 2011); *Perfect Web Techs., Inc. v. InfoUSA, Inc*., 587 F.3d 1324, 1332 (Fed. Cir. 2009). The Board similarly has made determinations regarding the level of skill in the art without delineating an upper limit on experience. *See, e.g., Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co*., CBM2012-00010, 2014 WL 869413 (PTAB Feb. 24, 2014); *Apple Inc. v. Achates Reference Publ'g, Inc*., 2014 WL 2530789 (PTAB June 2, 2014).

be reflected in the cited references and we determine that no express statement of the level of ordinary skill in the art is required.

D. Claims 2, 6, 10–12 – Anticipated by Bi

Petitioner contends claims 2, 6, and 10–12 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Bi. Pet. 10–20. We have reviewed the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in each of those papers, and are persuaded, by a preponderance of the evidence, that claims 2, 6, and 10–12 are anticipated by Bi.

Bi (Exhibit 1008)

Bi is titled, "Interactive Remote Control of Audio or Video Playback and Selections." Petitioner contends Bi discloses a system for an interactive remote control, which may be wireless, of an audio or playback application running on a personal computer or other computing platform. Pet. 11. Ex. 1008, Abstract. The interactive remote control provides various functions, such as playback of current digital audio or video content, selection of new audio or video content, and providing lists of content for playback. Ex. 1008 ¶ 7. Figure 2 of Bi is reproduced below.

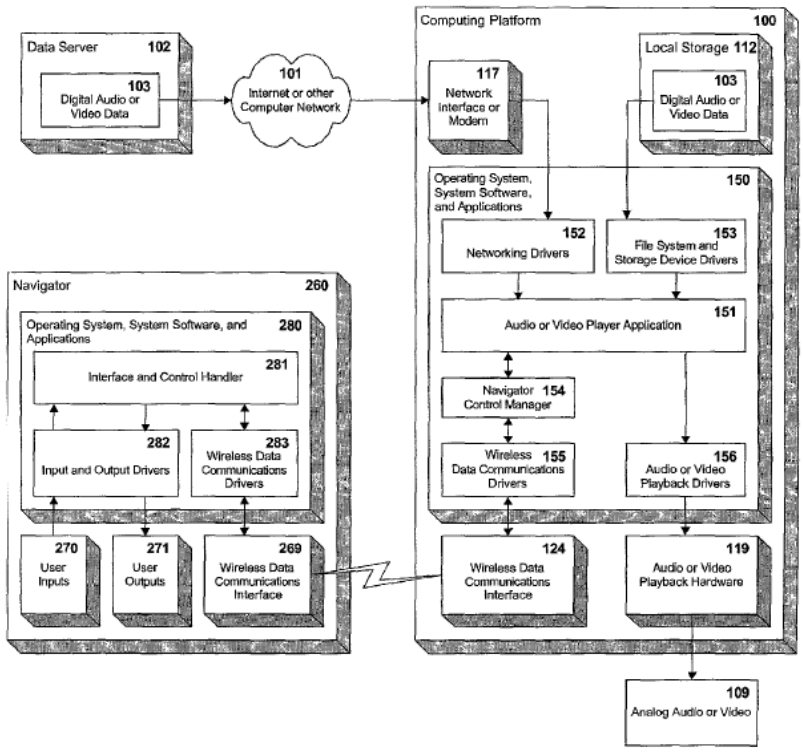


Figure 2

Figure 2 depicts data server 102 that provides digital audio or video data via the Internet or other network 101 to computing platform 110. Navigator 260 is a wireless remote control that communicates with computing platform 100 to control selection of audio or video data. Ex. 1008 ¶ 20. Navigator control manager 154 runs on computing platform 100, and takes user input on navigator 260 and translates the input 270 into commands and actions for audio or video application 151, and then takes results from actions of audio or video application 151 to provide user outputs 271, such as updated graphics on navigator 260. *Id.* ¶ 31.

Figure 7 of Bi is reproduced below.

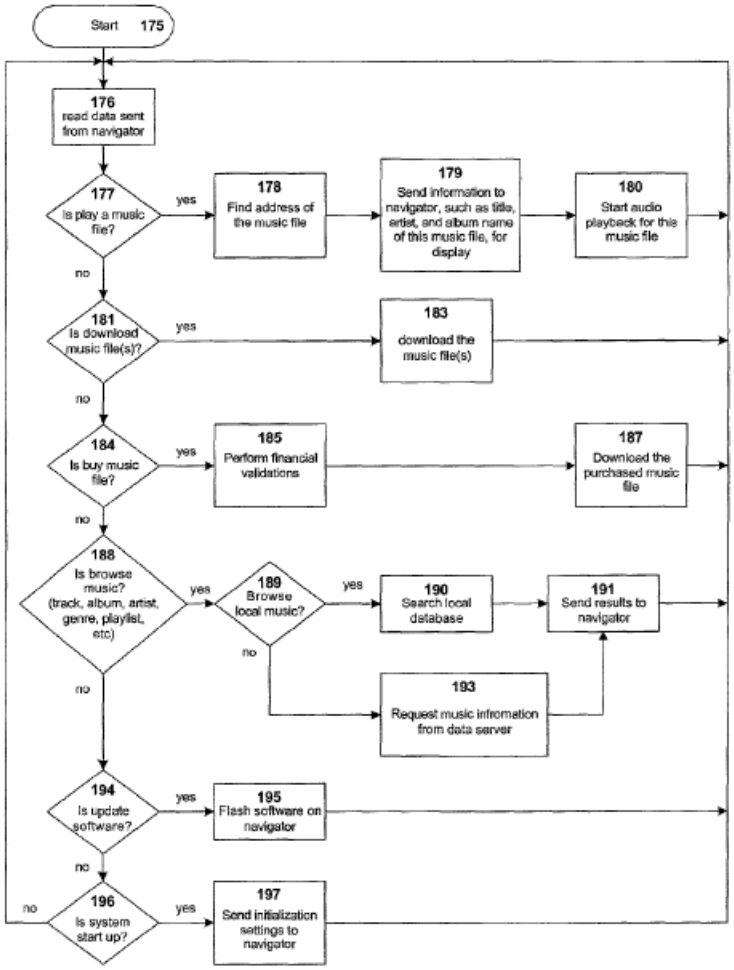


Figure 7

Figure 7 is a diagram of the software flow of navigator control manager 154. Ex. 1008 ¶ 31. Steps 188–193 depict the browsing and selection of music utilizing navigator 260. Pet. 12; Ex. 1008 ¶ 31. In step 188, if there is a browse music command from navigator 260, then in step 189, navigator control manager 154 checks if the music to browse is local to computing platform 100. Ex. 1008 ¶ 31.

"Typically, a browse of music is based on such criteria as music track, album, artist, music genre, and playlists." *Id.* If the music to browse is local, in step 191 navigator control manager 154 sends results of local music browse to navigator 260. *Id.* If the music to browse is not local, navigator control manager 154 requests music information from data server 193 and then sends the results to navigator 260. *Id.*

Analysis

In support of this asserted ground of unpatentability, Petitioner provides explanations of how the subject matter of each claim is disclosed by Bi. Pet. 14–20.

Claim 2 directly depends from claim 1 and recites that the "playlist is further communicated from the remote source to the media player device." Ex. 1001, 11:28–30. Patent Owner contends "the use of the term 'further' in claim 2 . . . supports the interpretation of claim 2 as requiring that the handheld remote control receive the playlist from a source other than the media player device." PO Resp. 25. Patent Owner then asserts that Bi's navigator 260 does not receive a playlist from data server 102, which is "a source other than the media player device." PO Resp. 24–26.

We disagree with Patent Owner's unduly restrictive construction of claims 1 and 2 as requiring the remote control to receive a playlist directly from a remote server. In contrast, the '099 specification discloses that the communication of playlists, from the remote server to the media player device and to the remote

control unit, may occur in several different ways, either directly from the server (Ex. 1001, 9:1–4) or indirectly, through the media player device to the remote control unit, or through the remote control unit to the media player device (*id*. at 9:9–20). Thus, Patent Owner's argument would exclude disclosed embodiments of the '099 patent, and we do not construe claim 2 to require a remote control to receive a playlist directly from a remote server. For claim 2, Petitioner contends Bi's data server 102, which is a remote source, communicates a playlist to computing platform 100, which is a media player device. Pet. 15; Ex. 1008 ¶ 32. We conclude that Petitioner has shown by a preponderance of the evidence that Bi anticipates dependent claim 2.

Claim 6 also directly depends from claim 1, reciting that "the remote source is a central server," Ex. 1001, 11:50–51. As with claim 2, Patent Owner contends that claim 6 "should be understood as the handheld remote control receiving a playlist from a central server without the playlist first being communicated to the media player device, and then from the media player device to the handheld remote control." PO Resp. 32. Again, we reject this argument as unsupported by the '099 specification, which expressly describes communication of a playlist to a remote from a central server via a media player device. Ex. 1001, 9:1–23. Petitioner contends Bi's data server 102 is the recited central server of claim 6. Pet. 15; Ex. 1008 ¶ 18, Fig. 1. We conclude that Petitioner has shown by a preponderance of the evidence that Bi anticipates dependent claim 6.

Independent claim 10 recites a wireless handheld remote control that receives a playlist from a remote source. Ex. 1001, 12:11–17. Independent claim

11 is a method claim reciting the communication of a playlist from a remote source to a media player device, and from the media player device to a wireless handheld remote control. *Id.* at 12:24–29. Independent claim 12 recites a media player device that receives a playlist from a remote source and communicates the playlist to a wireless handheld remote control. *Id.* at 12:35–44.

On independent claims 10, 11, and 12, Patent Owner asserts Bi's navigator does not receive a playlist. PO Resp. 36–37, 39–40, 45. We have construed "playlist" to be "a list of media selections." *See* Section II. A. Petitioner cites to Figure 7 and paragraph 32 of Bi, which disclose that a browse of music may be based on criteria including playlists, and that results of a browse of music are sent to navigator 260. Pet. 17–19; Pet. Reply 9, 15. At the oral hearing, Patent Owner's counsel stated that the results of a browse of music sent to navigator 260 are "most likely a list of titles that are being sent to the navigator." Tr. Oral Hr'g 72:3–20.

Petitioner also notes that Bi discloses its "interactive remote control provides various functions, such as playback of current digital audio or video content; selection of new audio or video content; and *providing lists of content for playback*." Pet. 12; Ex. 1008 ¶ 7 (emphasis added). As Petitioner argues, "Bi discloses that browsing of music can be based upon criteria including playlists. . . . To browse based upon a playlist, a playlist is necessarily provided to the navigator 260 from the computing platform 100 and displayed on the navigator." Pet. Reply 15. We agree, and determine that Petitioner has proven that Bi discloses the recited receipt of a playlist by navigator 260.

Patent Owner also contends that, with respect to claim 10, "there is no reason to conclude that such a playlist would be necessarily sent by the data server 102 to the computing platform 100." PO Resp. 37. Claim 10, however, recites only the communication of a playlist from a remote source to the remote control, without any receipt by a media player device. Ex. 1001, 12:11–17. Petitioner provides evidence that this limitation recited in claim 10 (and claim 1) is disclosed by Bi. Pet. 14, 17; Ex. 1008, Fig. 7, ¶ 32.

Patent Owner further asserts claim 10's limitation of the "media player device is associated with and separate from the wireless handheld remote control" requires navigator 260 to be "capable of functioning independently of" the media player device. PO Resp. 38. As set forth above in Section II. A, we do not adopt Patent Owner's proposed construction of this limitation. Petitioner's evidence is sufficient to show Bi's navigator as associated with and separate from its computing platform. Ex. 1008 ¶¶ 31–32, Figs. 5, 7.

Finally, on claims 11 and 12, which include the limitation of the playlist being communicated from a media player device to a remote control, Patent Owner argues, "Bi does not disclose that the computing platform 100 communicates the browse results in the form of a playlist to the navigator 260." PO Resp. 40, 45–46. Petitioner contends Bi's computing platform does communicate the playlist to the navigator. Pet. 18; Ex. 1008 ¶ 32, Fig. 7. We are persuaded of Bi's disclosure of this limitation in claims 11 and 12.

Accordingly, we are persuaded by a preponderance of the evidence of the unpatentability of claims 2, 6, and 10–12 as anticipated by Bi.

E. Claims 2, 6, 11, and 12: Anticipated by Gladwin

Petitioner contends claims 2, 6, 11, and 12 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Gladwin. Pet. 21–26. We have reviewed the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in each of those papers, and are persuaded Petitioner has proven by a preponderance of the evidence that claims 2, 6, 11, and 12 are anticipated by Gladwin.

Gladwin (Exhibit 1009)

Gladwin is titled, "Structure and Method for Selecting, Controlling and Sending Internet-Based or Local Digital Audio to an AM/FM Radio or Analog Amplifier." Petitioner contends Gladwin discloses a remote device interfacing with a personal computer that obtains audio "from the Internet or other digital audio from any web server." Pet. 21–22 (citing Ex. 1009, 3:1–9). Figure 1 of Gladwin is reproduced below.

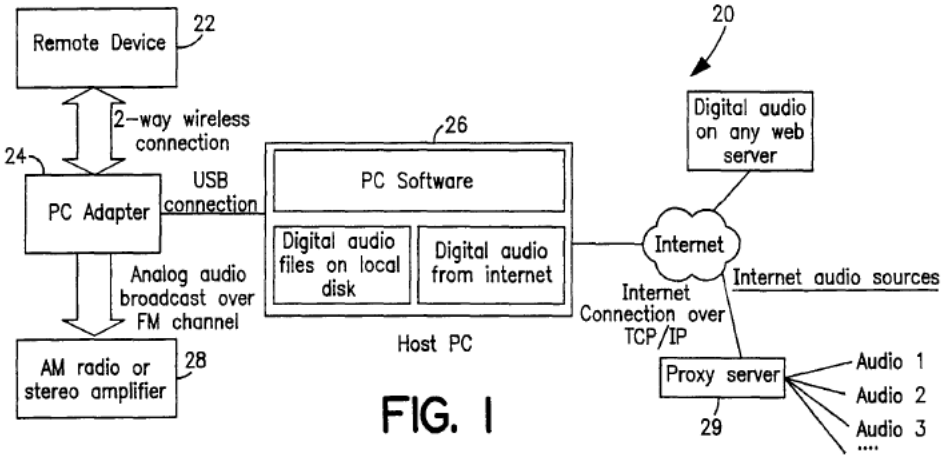


FIG. 1

In Figure 1, digital audio obtained by host PC 26 via the Internet is selected by remote device 22 to be played through a radio or stereo amplifier 28 using PC adapter 24. Ex. 1009, 3–4. The digital audio data is organized as a play list. *Id*. at 4:13–14. Petitioner contends Gladwin "discloses precisely what was asserted to be missing from the prior art during the prosecution of the '099 patent" – a wireless handheld remote for selecting an item from a playlist for playback on a separate media player device. Pet. 23–26 (citing Ex. 1009, 3–6, Figs. 1–6).

Analysis

In support of this asserted ground of unpatentability, Petitioner provides explanations of how the subject matter of each claim is disclosed by Gladwin. Pet. 21–26.

Claim 2 directly depends from cancelled claim 1 and recites that "the playlist is further communicated from the remote source to the media player device" (Ex. 1001, 11:28–30). Patent Owner argues Gladwin does not disclose the receipt of a playlist by a media player device because the PC host of Gladwin is not a media player device, and the PC adapter of Gladwin, which "broadcasts analog radio data" (Ex. 1009, 3:28) is a "separate device" from the PC host. PO Resp. 27–28. Although Petitioner's Reply is silent on this issue as to claim 2, the Petition contends the playlist is communicated from a remote server to the Host PC, which along with "PC adapter 24 constitute a media player device." Pet. 24; Ex. 1009, 4:12–14, Figs. 1, 5. Petitioner's Reply argues as to a similar limitation in claim 11:

> Patent Owner is thus arguing that a media player device must be a unitary device. But there is no such limitation in the claims. Indeed, as noted by the Board, the '099 specification states that the player device may be a general purpose computer (8:61-62), which would, of course, encompass a standard desktop computer having a separate computer, keyboard, and monitor.

Pet. Reply 10. We agree with Petitioner that Patent Owner's argument is not supported by the claim language or the '099 specification. We determine that Gladwin's PC host and PC adapter disclose the media player device recited in claim 2, and that Gladwin anticipates dependent claim 2.

Claim 6 also directly depends from cancelled claim 1 and recites that the remote source is a central server. Ex. 1001, 11:50–51. Patent Owner contends claim 6 requires Gladwin's remote device to receive data directly from a web server. PO Resp. 33. The Reply is silent on this issue as to claim 6, and the Petition states only that "[p]roxy server 29 and other web servers are central servers." Pet. 24; Ex. 1009 4:6–9, Fig. 1. We find, however, that Gladwin discloses that the proxy server links to digital audio sources on the Internet, and that digital audio data "is organized as a play list" by the PC, and the play list is transferred to the remote device. Ex. 1009, 4:6–14. The '099 patent expressly describes various direct and indirect communications of playlists from remote sources to media players and remote controls, Ex. 1001, 9:1–23. Patent Owner's argument would exclude disclosed embodiments of the '099 patent, and we do not construe claim 6 to require a remote control to receive a playlist directly from a remote server. Thus, we determine that Gladwin discloses the remote source of

claim 6 from which the remote control indirectly receives a playlist, and therefore, anticipates dependent claim 6.

On independent claim 11, Patent Owner first argues that Gladwin does not disclose the receipt of a playlist by a media player device because the PC host and PC adapter of Gladwin are "separate devices." PO Resp. 40–41. Petitioner's Reply contends:

> Patent Owner is thus arguing that a media player device must be a unitary device. But there is no such limitation in the claims. Indeed, as noted by the Board, the '099 specification states that the player device may be a general purpose computer (8:61-62), which would, of course, encompass a standard desktop computer having a separate computer, keyboard, and monitor.

Pet. Reply 10. As with claim 2, we agree with Petitioner that Patent Owner's argument is not supported by the claim language. Patent Owner also argues that the PC host and adapter "are not capable of playing music," (PO Resp. 41), but Gladwin discloses an audio player in the host PC, and PC software that plays music. Ex. 1009, 4:15–16, 4:22–24, 5:1–5, Fig. 6. In addition, Patent Owner asserts Gladwin fails to disclose the communication of a playlist from the media player device to the remote control (PO Resp. 41), but this argument fails in light of our finding that the media player device in Gladwin includes the host PC, which transfers the playlist to the remote control. Pet. 25; Ex. 1009, 4:12–14, 5:13–16, Figs. 1–4, 8. We conclude that Gladwin anticipates claim 11.

On independent claim 12, Patent Owner asserts that Gladwin fails to disclose a media player receiving a playlist from a remote source. PO Resp. 46.

As stated above, we find that Gladwin's media player includes the host PC, and as the Petition contends, the host PC can receive from the internet, audio "data [that] is organized as a play list." Pet. 26; Ex. 1009, 4:12–14, Fig. 5. In addition, as with claim 11, Patent Owner asserts Gladwin fails to disclose the communication of a playlist from the media player device to the remote control (PO Resp. 46), but again, this argument fails in light of our finding that the media player device in Gladwin includes the host PC, which transfers the playlist to the remote control. Pet. 26; Ex. 1009, 4:12–14, 5:13–16, Figs. 1–4, 8. We conclude that Gladwin anticipates claim 12.

F. Claims 2, 6, 11, and 12: Obvious Over Berman

Petitioner contends claims 2, 6, 11, and 12 are unpatentable under 35 U.S.C. § 103 as obvious over Berman. Pet. 27–35. We have reviewed the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in each of those papers, and are persuaded Petitioner has proven by a preponderance of the evidence that claims 2, 6, 11 and 12 are obvious over Berman.

Berman (Exhibit 1010)

Berman is titled, "System for Playback of Network Audio Material on Demand." Petitioner contends Berman discloses the use of a remote control that displays a playlist to select music for playback from a separate media playback device. Pet. 27–30 (citing Ex. 1010, 3:33–39, 4:47–53, 5:42–67, 6:64, Figs. 1, 3,

13). An embodiment of Berman's system is depicted in Figure 1, which is reproduced below.

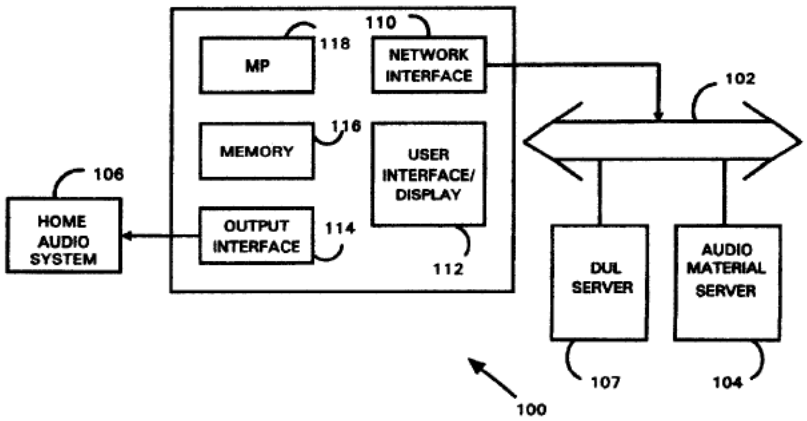


FIG. 1

Figure 1 is a block diagram of Berman's playback unit 100. Ex. 1010, 4:17–19. Playback unit 100 receives audio material from audio material server 104, and access rights to this material are controlled by directory and user list ("DUL") server 107. *Id.* at 4:51–53, 4:63–65. Playback unit 100 includes network interface 110 that facilitates communication with the servers over the internet. *Id.* at 5:11–13. Memory 116 temporarily stores audio for playback and processing. *Id.* at 6:6–8. In certain embodiments, the user may be permitted to record a song to memory. *Id.* at 8:4–6. Berman's playback unit may receive input from a wireless remote control unit. *Id.* at 5:46–49. The remote control unit may be used to move through the song list and search for songs. *Id.* at 5:54–61, 13:51–64, Figs. 2, 13.

The operation of the playback unit is illustrated in Figure 3, which is reproduced below.

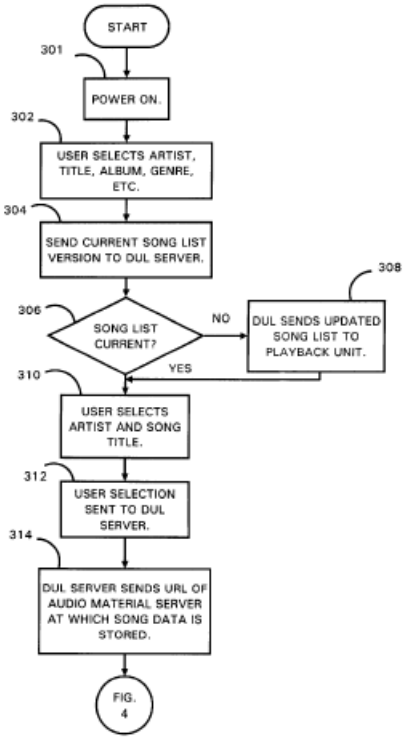


FIG. 3

Figure 3 is a processing flow diagram depicting the steps executed to request and receive audio material. Ex. 1010, 4:22–25. At step 302, the user selects a music category or type of song. *Id.* at 6:65–7:4. The playback unit then contacts the DUL server to confirm that the playback unit's song list is up to date. *Id.* at 7:4–6, Fig. 3 step 304. If the song list is not up to date, the DUL server will send an updated song list to the playback unit. *Id.* at 7:14–19, Fig. 3 steps 306, 308. In certain embodiments, the song list may be updated to reflect the user's preferred songs. *Id.* at 13:9–15. The user selects a song from the song list. *Id.* at 7:22–24.

The DUL server then sends playback unit 100 the network address or URL for the requested song. *Id*. at 7:30–41. Playback unit 100 then uses that URL to obtain the requested sound file or streaming audio from the appropriate audio material server. *Id*. at 7:41–45, 8:32–34.

Analysis

Petitioner contends that Berman explicitly discloses all of the elements of the challenged claims in the '099 patent, with the exception of the remote control being wireless, which Petitioner asserts would have been obvious to one of skill in the art, citing the Declaration of Dr. Bove. Pet. 30 (citing Ex. 1002 ¶ 14). As noted in the Decision to Institute and in the Patent Owner Response, Berman also explicitly discloses the playback unit "may also include a sensor, such as an infrared sensor 206, for receiving command signals from a remote control unit." Ex. 1010, 5:46–48. PO Resp. 21, 28. Berman's disclosure of a sensor in its playback unit suggests that its remote control unit could be implemented as a wireless unit.

Claim 2 directly depends from cancelled claim 1, which recites that a playlist is received at a remote control from a remote source. Ex. 1001, 11:20–21. For this limitation of cancelled claim 1, Petitioner contends Berman discloses a graphical user interface ("GUI") of playback unit 100 displaying a playlist received from DUL server 107, and a remote control device with a GUI that replicates the controls of playback unit 100. Pet. 29–31; Ex. 1010, 6:64–7:38, 13:51–64, Figs.

1–3, 13. Claim 2 recites that "the playlist is further communicated from the remote source to the media player device." Ex. 1001, 11:28–30.

Patent Owner contends that claim 2 requires Berman's remote control to receive a playlist from DUL server 107, which according to Patent Owner, "only communicates with the player 100 and not with Berman's remote control." PO Resp. 30; *see* PO Resp. 25, 29. We disagree with Patent Owner's construction of claim 2. The '099 specification discloses that the communication of playlists, from the remote server to the media player device and to the remote control unit, may occur in several different ways, either directly from the server (Ex. 1001, 9:1–4) or indirectly, through the media player device to the remote control unit, or through the remote control unit to the media player device (*id*. at 9:9–20). Thus, Patent Owner's argument would exclude disclosed embodiments of the'099 patent, and we do not construe claim 2 to require a remote control to receive a playlist directly from a remote server. For claim 2, Petitioner contends Berman discloses the playlist being communicated from DUL server 107 to playback unit 100. Pet. 32. We agree that Berman expressly discloses such a communication of a playlist. Ex. 1010, 6:64–7:38, Fig. 3. We conclude Petitioner has shown by a preponderance of the evidence that Berman teaches the limitation of dependent claim 2 for communicating the playlist from the remote source (DUL server) to the media player device (playback unit), and that dependent claim 2 therefore is obvious over Berman.

Like claim 2, claim 6 directly depends from cancelled claim 1 and recites that the remote source is a central server. Ex. 1001, 11:50–51. Patent Owner

makes arguments similar to those for claim 2, namely, that Berman's remote control does not communicate directly with the DUL server. PO Resp. 33–35. As with claim 2, Patent Owner's narrow construction of claims 1 and 6 ignores the embodiments disclosed in the '099 patent. Ex. 1001, 9:1–20. Petitioner contends Berman's DUL server is a central server. Pet. 32; Ex. 1010, 4:63–5:4, 7:4–13, 7:45–8:43, Fig. 4. We agree, and conclude Petitioner has shown by a preponderance of the evidence that dependent claim 6 is obvious over Berman.

For independent claims 11 and 12, Patent Owner argues that Berman's playback unit does not receive a playlist from the DUL server, as the "updated song list sent by the DUL server to the playback unit is not a playlist. [citation omitted]. Rather, it is simply a collection of references to songs to update the internal catalog of the playback unit." PO Resp. 41–42 (claim 11); *see also id.* at 46–47 (claim 12). Petitioner's Reply contends that the playlist in Berman is a list of songs for a selected music category, and discloses a list of media selections, in accordance with how we have construed "playlist" above, in Section II. A. Pet. Reply 12; Ex. 1010, 6:64–66, 7:14–24, 17:65–66. We agree with Petitioner that Berman discloses the recited playlist as construed herein.

Patent Owner next argues that pursuant to its proposed construction of the term "a wireless handheld remote control associated with and separate from the media player device," Berman's remote control cannot "operate independently" from the playback unit. PO Resp. 42–44, 47. This argument fails because it is based on Patent Owner's erroneous proposed construction for wireless handheld remote control associated with and separate from the media player device, which

we rejected. *See* Section II. A. There is no requirement of claims 11 and 12 that a remote control "operate independently" from an associated media player device. Berman's remote control is, as recited in claims 11 and 12, separate from and associated with the playback unit. Ex. 1010, 5:46–49, 13:62–64, Fig. 5. We conclude that Petitioner has proven by a preponderance of the evidence that claims 11 and 12 are obvious over Berman.

G. Patent Owner's Motion to Exclude

Patent Owner filed a Motion to Exclude Evidence (Paper 34, "Mot. to Excl."), to which Petitioner responded (Paper 39) and on which Patent Owner filed a Reply (Paper 40, "Reply on Mot. to Excl."). Patent Owner's motion seeks to exclude exhibits 1014 and 1015 as hearsay, irrelevant, lacking foundation, and prejudicial pursuant to Federal Rules of Evidence ("FRE") 802, 401, 402, and 403. Mot. to Excl. 1. Patent Owner also seeks to exclude exhibit 1016 as untimely, irrelevant and prejudicial pursuant to FRE 613(b), 401, 403. *Id.* Patent Owner's reply on its motion also requests expungement of exhibit 1017, which is a declaration of counsel submitted by Petitioner. Reply on Mot. to Excl. 4–5.

The moving party has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c), 42.62(a). Exhibits 1014 and 1015 were submitted by Petitioner as extrinsic evidence in support of its proposed construction of "playlist." Pet. Reply 7–8. As stated in Section II. A, our construction of "playlist" is based on intrinsic evidence, and we do not rely upon either Exhibit 1014 or 1015. The motion therefore is dismissed as moot as to these exhibits.

Exhibit 1016 was submitted by Petitioner to support its proposal for level of ordinary skill in the art. As stated in Section II. D, our determination of the level of ordinary skill in the art is informed by relevant case law authority and we do not rely on exhibit 1016. The motion to exclude is dismissed as moot for this Exhibit and the related Exhibit 1017.

III. CONCLUSION

Petitioner has demonstrated by a preponderance of the evidence the unpatentability of claims 2, 6, and 10–12 of the '099 patent as anticipated by Bi, and of claims 2, 6, 11, and 12 as anticipated by Gladwin and as obvious over Berman. Patent Owner's Motion to Amend is granted for the cancellation of claims 1 and 9. Patent Owner's Motion to Exclude is dismissed as being moot.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, based on a preponderance of the evidence, claims 2, 6, and 10–12 of the '099 patent are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Amend is granted for the cancellation of claims 1 and 9 of the '099 patent; and

FURTHER ORDERED that Patent Owner's Motion to Exclude is dismissed as moot.

This is a Final Written Decision. Parties to the proceeding seeking judicial review of this decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

PETITIONER:

David L. Fehrman
Mehran Arjomand
MORRISON & FOERSTER LLP
dfehrman@mofo.com
marjomand@mofo.com

PATENT OWNER:

Theodosios Thomas
BLACK HILLS MEDIA, LLC
ted.thomas@sceneralabs.com

Thomas Engellenner
Reza Mollaaghababa
Lana Gladstein
PEPPER HAMILTON LLP
engellennert@pepperlaw.com
mollaaghababar@pepperlaw.com
gladsteinl@pepperlaw.com