

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC.,
Petitioner,

v.

PERSONAL AUDIO LLC,
Patent Owner.

Case IPR2015-00846
Patent 7,509,178 B2

Before MITCHELL G. WEATHERLY, DAVID C. McKONE, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

A. BACKGROUND

Google, Inc. (“Petitioner”)¹ filed a petition (Paper 6, “Pet.”) to institute an *inter partes* review of claims 1–9, 13–17, 28, and 29 (the “challenged claims”) of U.S. Patent No. 7,509,178 B2 (Ex. 1001, “the ’178 patent”). Petitioner supported the Petition with the Declaration of Martin G. Walker, PhD (Ex. 1002). Personal Audio LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 13 (“Prelim. Resp.”). On September 17, 2015, based on the record before us at the time, we instituted an *inter partes* review of claims 1–9, 13–17, 28, and 29. Paper 18 (“Institution Decision” or “Dec.”). We instituted the review on the following challenges to the claims:

References	Basis	Claims
U.S. Patent Publication No. 2002/0177914 A1 (Ex. 1007, “Chase”) and Shoshana Loeb, <i>Architecting Personalized Delivery of Multimedia Information</i> , VOL. 35, NO. 12 COMMUNICATIONS OF THE ACM 39–48 (Dec. 1992) (Ex. 1011, “Loeb”)	§ 103	1–4, 9, and 13
Chase, Loeb, and U.S. Patent No. 4,811,315 (Ex. 1009, “Inazawa”)	§ 103	5, 6, 14–17, 28, and 29
Chase, Loeb, Inazawa, and U.S. Patent No. 4,609,954 (Ex. 1010, “Bolton”)	§ 103	7 and 8

¹ With our prior authorization, the parties filed joint motions to terminate the proceeding with respect to original petitioner Barnes & Noble, Inc., Paper 20, and original petitioners Lenovo (United States) Inc., Lenovo Holding Company, Inc., and Lenovo Group Ltd., Paper 22. We granted the motions and dismissed Barnes & Noble, Inc., Lenovo (United States) Inc., Lenovo Holding Company, Inc., and Lenovo Group Ltd. from the proceeding, which left Google, Inc. as the sole remaining petitioner. Paper 24.

After we instituted this proceeding, Patent Owner filed a Patent Owner Response in opposition to the Petition (Paper 29, “PO Resp.”) that was supported by the Declaration of Kevin C. Almeroth, PhD (Ex. 2016). Petitioner filed a corrected Reply in support of the Petition (Paper 31, “Reply”). Patent Owner did not move to amend any claim of the ’178 patent.

We heard oral argument on June 16, 2016. A transcript of the argument has been entered in the record (Paper 38, “Tr.”).

We entered our Final Written Decision on September 9, 2016, Paper 39 (“Final Written Decision” or “Final Dec.”), in which we concluded that claims 1–4, 9, and 13 were unpatentable but claims 5–8, 14–17, 28, and 29 were not unpatentable. Final Dec. 44. Petitioner filed a timely Request for Rehearing in which it asks that we reconsider the Final Written Decision and find that claims 5–8, 14–17, 28, and 29 are unpatentable as challenged in the Petition. Paper 40 (“Reh’g Req.” or “Request for Rehearing”). For the reasons that follow, we deny the Request for Rehearing.

B. STANDARD FOR RECONSIDERATION

The party filing a request for rehearing of a final written decision has the burden of showing that the decision should be modified, and the request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked and the place at which each matter was previously addressed in its papers during the trial. 37 C.F.R. § 42.71(d). Therefore, Petitioner bears the burden of establishing that we misapprehended or overlooked the matters that it requests that we review.

II. ANALYSIS

In our Final Written Decision we concluded that Petitioner failed to establish by a preponderance of evidence that the combination of Chase, Loeb, and Inazawa rendered claims 5, 6, 14–17, 28, and 29 obvious, Final Dec. 35–42, and that the combination of Chase, Loeb, Inazawa, and Bolton rendered claims 7 and 8 obvious, *id.* at 43. Both conclusions were based on Petitioner’s failure to establish by a preponderance of evidence that Inazawa taught aspects of claims 5, 6, and 14 to which we referred as the “skip back algorithm.” Final Dec. 35–42.

The parties agree that the skip back algorithm is a portion of the algorithm that is recited in means-plus-function form as a “processor for continuously delivering a succession of said audio program files.” Pet. 6 (adopting District Court interpretation of “processor for” in related Apple Litigation²); PO Resp. 22, 30, 33 (implicitly adopting means-plus-function nature of “processor for”). The algorithm is generally depicted in Figure 3 of the ’178 patent.

Petitioner argues that we should overturn our prior decision regarding claims 5, 6, 14–17, 28, and 29 because we “overlooked or misapprehended the claim construction with respect to claims 5, 6, and 14 and the claims that depend from those claims” in two ways. Reh’g Req. 1–13. First, Petitioner contends that we wrongly interpreted the skip back algorithm as one that “precludes multiple button presses.” *Id.* at 1. Second, Petitioner contends that we wrongly interpreted the skip back algorithm as referring to a “predetermined time” that is measured “from the beginning of the currently

² *Personal Audio LLC v. Apple, Inc., et al.*, Case No. 9:09-cv-00111 (E.D. Tex.) (the “Apple Litigation”)

playing audio program file.” *Id.* at 5–6. Based on these allegedly erroneous claim interpretations, Petitioner contends that we wrongly concluded that the prior art, particularly Inazawa, fails to describe the claimed skip back algorithm. *Id.* at 1–11. Petitioner also contends that, even if we were to maintain our interpretation of the skip back algorithm, we wrongly concluded that Inazawa fails to describe that algorithm. *Id.* at 11–13. We disagree with Petitioner on both contentions and maintain our determination that Petitioner failed to establish that Inazawa describes the claimed skip back algorithms of recited in claims 5, 6, and 14 and their respective dependent claims 7, 8, 15–17, 28, and 29.

A. MULTIPLE BUTTON PRESSES

Petitioner contends that we wrongly interpreted claims 5, 6, and 14 as reciting a “skip back algorithm” that “precludes multiple button presses.” Reh’g Req. 1. In doing so, Petitioner identifies two statements in the Final Written Decision that it contends reflect the manner in which we “misapprehended” the meaning of these claims. For the reasons expressed below, we disagree.

Petitioner quotes our statement that the “plain terms recited in claims 5, 6, and 14 require that the skip back algorithm is invoked by the same command, a ‘skip backward program selection’ in claims 5 and 6, and a ‘third one of said control commands’ in claim 14.” *Id.* at 2 (quoting Final Dec. 39–40 with Petitioner’s emphasis). Petitioner argues that the use of the indefinite article “a” preceding “skip backward program selection command” in claims 5 and 6 dictates that claims 5 and 6 refer to different “skip backward” commands. *Id.* at 2–3.

Petitioner's argument is unpersuasive for two reasons. First, Petitioner's argument was not advanced in any paper during the trial and is thus an improper basis for modifying the Final Written Decision on rehearing. *See* 37 C.F.R. § 42.71(d) (requests for rehearing must identify "the place where each [contested] matter was previously addressed" during trial).

Second, even if Petitioner's argument were properly before us, it is unpersuasive. In its Reply, Petitioner correctly noted that claims 5, 6, and 14 were "nearly identical" as they relate to the skip backward algorithm. Reply 14. Claim 14 twice refers to the command that executes the skip backward algorithm, first as "a third one of said control commands," Ex. 1001, 48:50, and then as "said third one of said control commands," *id.* at 48:58. Petitioner identifies no evidence supporting its argument that the use in claim 6 of "a" to introduce the "skip backward program selection" represents anything other than a typographical error.

Additionally, the Specification describes, as the structure corresponding to means-plus-function limitations of claims 5, 6, and 14, an algorithm in which one "BACK command" results in two different outcomes depending upon whether it is issued before or "after any given segment has played for a predetermined amount of time." Ex. 1001, 15:47–59. When the BACK command issues after the predetermined amount of time elapses, the currently playing segment is restarted from its beginning. *Id.* at 15:53–56. Claim 5 recites this outcome of the BACK command. When the BACK command issues before the predetermined amount of time elapses, the prior segment in the playlist is played back. *Id.* at 15:57–59. Claim 6 recites this outcome of the BACK command. Both outcomes are recited in claim 14.

For all these reasons, we do not disturb our prior interpretation of claims 5, 6, and 14, and we disagree that we interpreted these claims to “preclude multiple button presses.”

B. PREDETERMINED TIME

Petitioner contends that we wrongly interpreted claims 5, 6, and 14 as requiring that the “skip back algorithm” refers to a “predetermined time” that is measured “from the beginning of the currently playing audio program file.”³ *Id.* at 5–6 (quoting Final Dec. 41 with Petitioner’s emphasis).

Petitioner describes the Final Written Decision as “correctly” reciting the agreed upon interpretation of the skip back algorithm that was first promulgated by the District Court in the Apple Litigation. *Id.* at 6 (citing Final Dec. 11–15). Petitioner contends, however, that we “improperly added a limitation that the skip back algorithm requires a predetermined time from the beginning of the currently playing audio program file.” *Id.*

Petitioner’s argument is unpersuasive. The agreed upon interpretation of the skip back algorithm to which Petitioner refers states:

Specifically, this algorithm includes the following steps:

(1) if the currently playing audio program file has played for a predetermined amount of time, resetting the playback position to the beginning of the audio program file; and

(2) playing the audio program file from its beginning.

³ Petitioner also identifies the following statement as reflecting our misapprehension of the predetermined time of the skip back algorithm: “the ’178 patent describes the skip back algorithm as determining whether to skip to the beginning of the current program segment or the beginning of the previous program segment based on the amount of time that has lapsed since the beginning of the current program segment.” Reh’g Req. 5. We consider Petitioner to present the same argument with respect to both bases of alleged misapprehension.

Final Dec. 11–12 (citing Ex. 1014, 18–19).

This passage, by stating “if the currently playing audio program file has played for a predetermined amount of time” plainly and necessarily implies that the “predetermined amount of time” refers to an amount of time to be compared to the amount of time that “the currently playing audio program file has played.” To determine the amount of time that “the currently playing audio program file has played” from any reference point other than the beginning of the playback would render the amount of playback time arbitrary and therefore impossible to compare to the predetermined amount of time.

Petitioner attempts to explain its position by contending that the amount of playback time is measured from the recording of the start time in item 267 shown in Figure 3, which occurs “before the beginning of the currently playing audio program file” which is shown in item 235 in Figure 3. Reh’g Req. 7–8. Petitioner fails, however, to quantify the difference in time between the execution of items 267 and 235 in Figure 3 or even whether any difference in time exists. More importantly, however, none of the plain language of claims 5, 6, and 14 or the agreed upon interpretations of that language refers to any time “before the beginning of the currently playing audio program file” as the reference time for measuring whether the predetermined amount of time has elapsed.

Additionally, Petitioner’s analysis of Figure 3 and its contention that the predetermined amount of time is measured from a time “before the beginning of the currently playing audio file” were not advanced in any paper during the trial and, thus, are not properly before us under 37 C.F.R. § 42.71(d). In fact, Petitioner’s current position is inconsistent with its prior

argument that because “Inazawa starts a timer to measure t_3 *and* starts playing the current song (program segment) after an initial press of the program selecting key 11,” Inazawa “effectively measures whether ‘the currently playing audio program’ has or has not yet played ‘for a predetermined amount of time.’” Reply 13. Petitioner’s argument recognizes that the start of playback is also the reference point for measuring whether the predetermined amount of time has passed.

For all these reasons, we do not disturb our prior description of claims 5, 6, and 14 as “determining whether to skip to the beginning of the current program segment or the beginning of the previous program segment based on the amount of time that has lapsed since the beginning of the current program segment.” That description remains consistent with our interpretation of claims 5, 6, and 14 as stated at pages 11–15 of the Final Written Decision.

C. INAZAWA COMPARED TO CLAIMS 5, 6, AND 14

Many of Petitioner’s arguments that Inazawa describes the claimed skip back algorithm depend upon one or the other argued changes to our interpretation of the meaning of the claimed algorithm. See Reh’g Req. 5 (“Because claims 5, 6, and 14 do not preclude multiple button presses in the ‘skip back algorithm,’ . . . the Board should not have dismissed Inazawa’s teachings due to an initial press of the program selecting key 11.”), 9–11 (depending upon argued change in meaning of “predetermined amount of time”). Because we do not alter our interpretation of the claimed skip back algorithm, we are not persuaded by these arguments.

Nevertheless, Petitioner also argues that:

even if the Board maintains its view that the claimed predetermined time cannot include Inazawa’s duration t_2 in

which the optical head is moved to the beginning of the program segment, but instead is only an amount of time from the beginning of the currently playing audio program file, Inazawa still discloses the required functionality.

Id. at 11. Petitioner contends that it explained the factual basis for its argument at the oral hearing. *Id.* at 11–12. More specifically, Petitioner argues that an ordinarily skilled artisan would have understood that after Inazawa’s time period t_2 (representing the time needed to move Inazawa’s optical head) expires, audio would begin playing. *Id.* (citing Ex. 1002 ¶ 112).⁴ Petitioner contends that the time period represented in Inazawa as t_2 - t_3 (i.e, the duration of time elapsing between times t_2 and t_3) would constitute a predetermined amount of time measured from the beginning of playback. *Id.* at 12–13. Petitioner argues that because pressing a back button after expiration of the t_2 - t_3 time period causes a skip backward to the currently playing program, Inazawa describes the skip back algorithm of claims 5, 6, and 14. *Id.* at 13.

⁴ Petitioner also alleges that it cited supporting evidence for this proposition in its Reply and in the Petition. Reh’g Req. 12. Petitioner contends that it cites pages 107–10 and 116–17 of Dr. Walker’s Declaration on page 13 of its Reply, but it does not. Rather, Petitioner cites pages 110 and 117–18, which address the prosecution history of claims 5, 6, and 14, but do not address how an ordinarily skilled artisan would have understood the operation of Inazawa. Petitioner also alleges that it cites evidence supporting its contention about Inazawa’s operation on page 46 of the Petition, where it cites, among other evidence, ¶ 112 of Dr. Walker’s Declaration, which does address how Inazawa operates. Reh’g Req. 12 (citing Ex. 1002 ¶ 112); Pet. 46 (citing Ex. 1002 ¶ 112). Petitioner’s argument that Inazawa’s time period t_2 - t_3 represents a measure of time from the beginning of playback was not, however, presented in the Petition or in the Reply.

Petitioner's argument is unpersuasive for at least two reasons. First, Petitioner's argument is not properly before us because it was proffered for the first time at the oral hearing, Tr. 29:25–30:9, 82:21–83:6, and then reiterated in the Request for Rehearing, Reh'g Req. 11–13. *See* 37 C.F.R. § 42.70(a) (“A party may request oral argument on an issue raised in a paper”); § 42.71(d) (“The request [for rehearing] must specifically identify . . . the place where each matter was previously addressed in a motion, an opposition, or a reply.”). Petitioner argues that we should consider its argument even though it was newly raised at oral hearing because Patent Owner also argued for the first time at oral hearing that the “predetermined amount of time” of claims 5, 6, and 14 was an amount of time measured from the beginning of playback. Reh'g Req. 11 (arguing that Patent Owner Response at 41–51 did not contain this argument). Petitioner contends, without citing authority, that we “must allow [Petitioner] to respond as a matter of fairness and due process.” *Id.* Petitioner's argument is unpersuasive because Patent Owner sufficiently argued in the Patent Owner Response that the “predetermined amount of time” is measured from the beginning of playback. Patent Owner repeatedly refers to comparing the amount of time the audio file has played to the predetermined amount of time for determining whether to skip to the beginning of the current or previous audio segment. *E.g.*, PO Resp. 44 (“None of the prior art of record teach the function provided by the controls of skipping back based on a predetermined time an audio segment has played.”), 46 (“Inazawa's ‘duration t3’ does not refer to the time audio file has played” and Inazawa does not describe “how long a current program segment has played, as claimed”). The amount of time an audio segment has played plainly refers

to time measured from the beginning of the playback. Petitioner had ample opportunity to address Patent Owner's argument in its Reply.

Second, even if we were to decide that Petitioner's argument is properly before us now, Petitioner's argument is unpersuasive on its merits. Petitioner's argument presupposes that it is irrelevant that Inazawa only sets a reference point in time for tracking durations t_2 and t_3 when the user first presses the back button after playback has started. Inazawa's system does not react to a first back button press as required by claim 5 because before Inazawa's first button press, Inazawa does not measure any duration at all. Stated another way, Inazawa's system always reacts to the initial press of its back button by restarting playback at the beginning of the currently playing track regardless of when that initial button press occurs. Ex. 1009, 6:17–60. Petitioner's expert, Dr. Walker agrees as he explains in the following testimony:

When the program selecting key 11 is *initially manipulated* (producing the signal T_s illustrated in Fig. 2A), a reverse program selection mode is entered where: 1) a timer is started (duration of t_1 in Fig. 2B); and 2) a skip to the beginning of the current audio program (identified at address N) is performed that includes moving the optical head to the area according to address N (the beginning of the current audio program) and playing the audio program therefrom.

* * *

Using the program selecting key 11 *once again* while the program is playing and within the duration t_3 , would cause a skip backward to the beginning of the preceding program identified at address N-1, the previous track. But manipulating the program selecting key 11 when the duration t_3 has expired would cause a skip to the beginning of the current audio program identified at address N, the current track.

Ex. 1002 ¶¶ 112–13 (citing Ex. 1009, 6:17–7:56) (internal citations omitted) (emphasis added). Essentially, Dr. Walker explains that Inazawa does not measure any durations of time until after a skip back button is pressed and that the first press of a back button always restarts playback from the beginning of the currently selected audio program.

1. Claim 5

Claim 5 requires monitoring the duration of playback from the beginning of playback and comparing that duration to a predetermined amount of time to evaluate how to respond to every issuance of a “skip backward program selection command.” Inazawa fails to meet this requirement for its first press of a back button, and meeting the requirement in connection with the second of two consecutive presses of a back button is insufficient to meet the claimed skip back algorithm.

2. Claim 6

Inazawa fails to describe the algorithm of claim 6, which depends from claim 5, for essentially the same reasons that it fails to describe the algorithm of claim 5. Additionally, claim 6 requires that one of two and only two responses occur to a skip backward command with the response being chosen based on when it occurs in relation to the predetermined amount of time. If the command is issued before the predetermined amount of time, playback skips to the beginning of the prior audio segment. If the command is issued after the predetermined amount of time, playback skips to the beginning of the current audio segment. The response to Inazawa’s first button press is insensitive to when that press occurs; Inazawa always responds to that press by restarting playback of the currently playing segment from the beginning. Before a first button press, Inazawa fails to

measure any time or compare any time to a predetermined time.

Accordingly, in response to a first button press, Inazawa never skips to the previous audio segment as required of the algorithm of claim 6.

3. *Claim 14*

Claim 14, like claim 6, recites a skip back algorithm that restarts playback to either the beginning of the currently playing segment in response to a command issued after the predetermined amount of time or to the beginning of the prior segment in response to the same command issued before the predetermined amount of time. Inazawa fails to describe the skip back algorithm of claim 14 for the same reasons that it fails to describe the algorithm of claim 6.

D. DEPENDENT CLAIMS 7, 8, 15–17, 28, AND 29

Claims 7 and 8 depend ultimately from claim 6. Ex. 1001, 46:60–47:33. Claims 15–17, 28, and 29 depend ultimately from claim 14. *Id.* at 49:1–21, 50:41–61. Other than the arguments discussed above regarding claims 5, 6, and 14, Petitioner proffers no argument for reversing our prior determination that it has failed to establish that claims 7, 8, 15–17, 28, and 29 are unpatentable. We find those arguments to be unpersuasive for the reasons discussed above. Accordingly, we see no reason to disturb our prior determination that these claims are not unpatentable.

III. ORDER

For the reasons given, it is

ORDERED that Petitioner's Request for Rehearing is *denied*.

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