

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

QURIO HOLDINGS, INC.,
Patent Owner.

Case IPR2015-01991
Patent 7,787,904 B2

Before BARBARA A. BENOIT, KERRY BEGLEY, and
JASON J. CHUNG, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Unified Patents Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–5, 7–10, 12, and 14–18 of U.S. Patent No. 7,787,904 B2 (Ex. 1001, “the ’904 patent”). Paper 2 (“Pet.”). Patent Owner, Qurio Holdings, Inc., filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition and the Preliminary Response, we conclude the information presented does not show there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–5, 7–10, 12, and 14–18 of the ’904 patent. Accordingly, we deny institution of an *inter partes* review.

A. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 2; Paper 5 (Patent Owner’s Mandatory Notices). We also note that two additional requests for *inter partes* reviews of the ’904 patent have been filed—*DIRECTV, LLC v. Qurio Holdings, Inc.*, Case IPR2015-02005 (PTAB October 1, 2015) (Paper 2) and *DISH Network L.L.C. v. Qurio Holdings, Inc.*, Case IPR2016-00007 (PTAB October 2, 2015) (Paper 1).

B. The '904 Patent

The '904 patent relates to techniques for using a mobile device to control content played by multiple media players. Ex. 1001, Abs., 1:6–7, 1:26–27. According to the '904 patent, these techniques address the problem of ascertaining and selecting media content available on numerous media devices (such as computers, televisions with digital video recorders, MP3 players) at various locations (such as one's home, office, or automobile). *Id.* at 1:12–22. Figure 1, reproduced below, shows an exemplary system 10. *Id.* at 2:58–59.

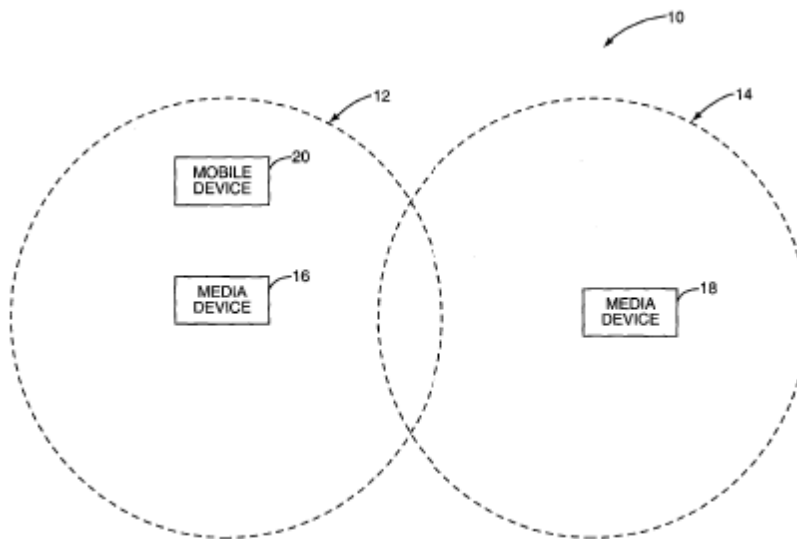


FIG. 1

System 10 includes two wireless personal networks (“WPANs”) 12 and 14, each having a media device 16 or 18, respectively. *Id.* at 2:64–3:3. The range of each WPAN depends on the range of the wireless communication interface associated with its media device. *Id.* According to the '904 patent, the wireless communication interface “may operate according to a wireless communication standard such as . . . the Bluetooth wireless communication

standard, the Zigbee wireless communication standard, the Wireless Fidelity (WiFi) wireless communication standard, or IEEE 802.11 wireless communication standards.” *Id.* at 3:40–47. Each media device includes a media player and content that can be played by the media player. *Id.* at 3:4–6.

System 10 also includes mobile device 20 that includes a wireless communication interface and “operates to control the content played by the media players of the media devices 16 and 18.” *Id.* at 3:6–8. The ’904 patent provides examples of mobile device 20—a mobile phone, a Personal Digital Assistant (“PDA”), or “a stand-alone device similar to a remote control.” *Id.* at 4:3–7.

As shown in Figure 1, mobile device 20 is within the range of WPAN 12 having media device 16. *Id.* at Fig. 1. According to the ’904 patent, the first time mobile device 20 enters WPAN 12, the mobile device communicates with media device 16 to obtain metadata defining the content and stores the metadata. *Id.* at 3:8–12. The ’904 patent describes the metadata as “any information describing the content stored at media device 16.” *Id.* at 3:13–14. In some embodiments, metadata may include “a file name, file type, and an identifier of the WPAN” and be stored in a media database on a control system of mobile device 20. *Id.* at 4:7–9, 4:21–22, 4:30–33.

After the mobile device stores the metadata about content on the media device and when the mobile device is within the WPAN associated with the media device, “a user associated with the mobile device 20 may

select desired content to be played using the stored metadata” or “the mobile device 20 may automatically select desired content to be played using the stored metadata.” *Id.* at 3:15–18. Then the mobile device communicates with media device 16 to play the selected content. *Id.* at 3:8–20.

C. Illustrative Claim

Claims 1 and 16 of the challenged claims in the ’904 patent are independent. Claim 1 is illustrative of the claimed subject matter:

1. A mobile device for controlling digital content played by a plurality of media devices comprising:

a) a wireless communication interface for communicating with the plurality of media devices;

b) a media database; and

c) a control system adapted to, for each of the plurality of media devices:

i) communicate with the media device when the mobile device is within a wireless personal area network (WPAN) associated with the media device to obtain information describing content residing at the media device; and

ii) store the information describing the content residing at the media device in the media database;

wherein desired content is selected from the content at the media device based on the information in the media database and played at the media device when the mobile device is within the WPAN associated with the media device.

Ex. 1001, 8:37–55.

D. Asserted Grounds of Unpatentability

Petitioner contends that claims 1–5, 7–10, 12, and 14–18 of the '904 patent are unpatentable under 35 U.S.C. § 103¹ based on the following specific grounds (Pet. 8–60):

References	Basis	Challenged Claim[s]
Lambourne ² and Elabbady ³	§ 103	1–3, 12, 16, and 17
Lambourne, Elabbady, and Meade ⁴	§ 103	4 and 7
Lambourne, Elabbady, Meade, and Plastina 2003 ⁵	§ 103	5 and 8
Lambourne, Elabbady, and Dwek ⁶	§ 103	9
Lambourne, Elabbady, and Melpignano ⁷	§ 103	10 and 18
Lambourne, Elabbady, and Weinans ⁸	§ 103	14
Lambourne, Elabbady, and Willson ⁹	§ 103	15

¹ Section 3(c) of the Leahy-Smith America Invents Act (“AIA”) amended 35 U.S.C. § 103. Pub. L. No. 112-29, 125 Stat. 284, 287–288 (2011). Because the '904 patent has a filing date before March 16, 2013 (effective date of section 3), the pre-AIA version of § 103 applies in this proceeding. *See id.* § 3(n)(1), 125 Stat. at 293.

² U.S. Patent No. 7,571,014 B1, issued Aug. 4, 2009 (Ex. 1005, “Lambourne”).

³ U.S. Patent No. 7,483,958 B1, issued Jan. 27, 2009 (Ex. 1006, “Elabbady”). Elabbady is listed in the Examiner’s Notice of References provided with the Notice of Allowability for the '904 patent. Ex. 1004, 13.

⁴ US 2003/0073412 A1, pub. Apr. 17, 2003 (Ex. 1009, “Meade”).

⁵ US 2003/0182315 A1, pub. Sept. 25, 2003 (Ex. 1010, “Plastina 2003”).

⁶ US 2001/0018858 A1, pub. Sept. 6, 2001 (Ex. 1011, “Dwek”).

⁷ WO 2004/008693 A1, pub. Jan. 22, 2004 (Ex. 1012, “Melpignano”).

⁸ WO 2002/056536 A1, pub. July 18, 2002 (Ex. 1013, “Weinans”).

⁹ US 2003/0033413 A1, pub. Feb. 13, 2003 (Ex. 1014, “Willson”).

References	Basis	Challenged Claim[s]
Chen ¹⁰ and Plastina ¹¹	§ 103	1–3, 12, 16, and 17
Chen, Plastina, and Meade	§ 103	4 and 7
Chen, Plastina, Meade, and Plastina 2003	§ 103	5 and 8
Chen, Plastina, and Dwek	§ 103	9
Chen, Plastina, and Melpignano	§ 103	10 and 18
Chen, Plastina, and Weinans	§ 103	14
Chen, Plastina, and Willson	§ 103	15

II. DISCUSSION

A. Claim Construction

Petitioner and Patent Owner each propose constructions for several claim limitations. Pet. 6–7; Prelim. Resp. 9–15. On this record and for purposes of this decision, we determine that no claim terms require express construction.

B. Asserted Grounds of Obviousness over Lambourne and Elabbady, Alone or in Combination with Other References

Petitioner contends that claims 1–3, 12, 16, and 17 of the '904 patent are unpatentable under 35 U.S.C. § 103 as obvious over Lambourne and Elabbady. Pet. 8–23. Petitioner further contends that claims 4, 5, 7–10, 14, 15, and 18 are unpatentable under 35 U.S.C. § 103 as obvious over

¹⁰ U.S. Patent No. 8,479,238 B2, issued July 2, 2013 (Ex. 1007, “Chen”).

¹¹ US 2007/0048712 A1, pub. Mar. 1, 2007 (Ex. 1008, “Plastina”). Plastina is listed in the Examiner’s Notice of References provided with the Notice of Allowability for the '904 patent. Ex. 1004, 13.

Lambourne, Elabbady, and various other references. *Id.* at 41–60.

Petitioner supports its contentions with citations to the references and with declaration testimony of Jon Weissman, Ph.D. (Ex. 1002). *Id.* at 8–23, 41–60. Patent Owner opposes. Prelim. Resp. 16–26.

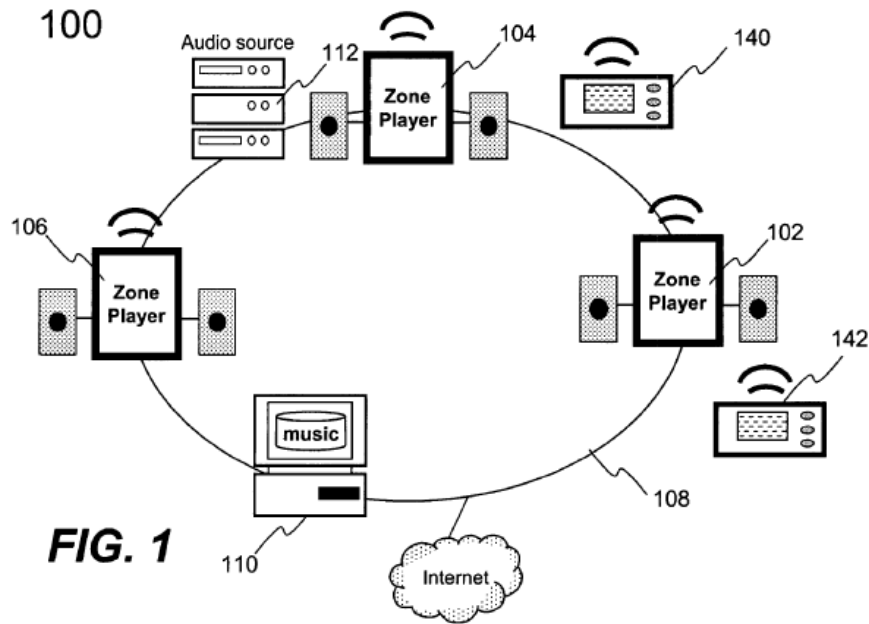
A claim is unpatentable as obvious “if the differences between the claimed subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.”

35 U.S.C. § 103. “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, No. 2015-1072, 2016 WL 798192, at *4 (Fed. Cir. March 1, 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Thus, Petitioner must explain how the combination of Lambourne and Elabbady would have rendered the challenged claims unpatentable. For the reasons that follow, we determine that Petitioner has not done so.

1. Summary of Lambourne

Lambourne is a United States Patent that describes techniques for controlling multimedia players in “a multi-zone system.” Ex. 1005, Abs., 1:18–22. According to Lambourne, audio sources for an audio player in such systems may be provided locally at the audio player itself or from a centrally located audio source. *Id.* at 1:38–45. Lambourne addresses the problem of controlling a household audio system including multiple audio

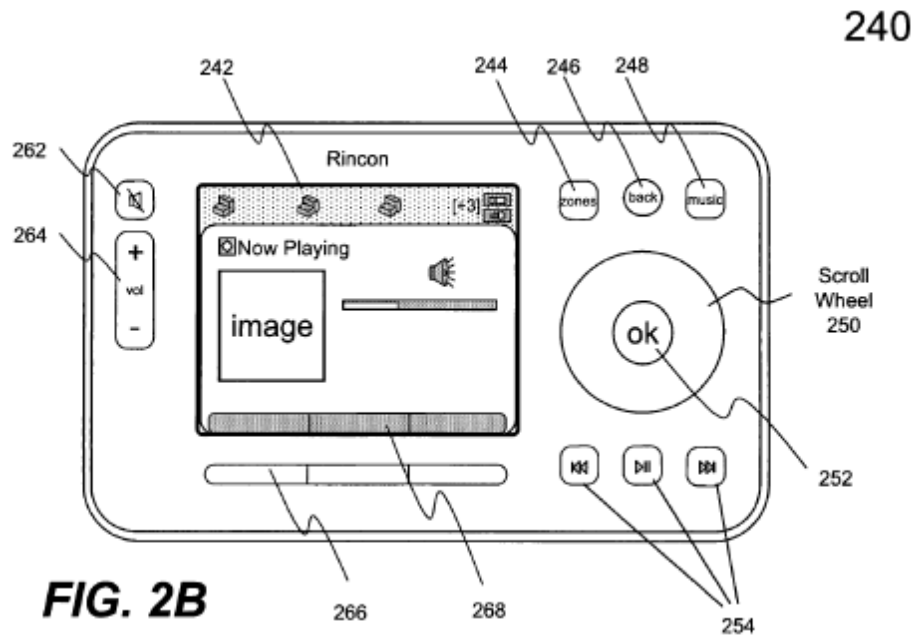
players. *Id.* at 1:24–38. Lambourne describes using a controller to control the audio source for one or more audio players. *Id.* at 2:24–31. Figure 1 of Lambourne, reproduced below, depicts an audio system in a residential home. *Id.* at 4:58–63, 5:4–7.



As shown in Figure 1, system 100 includes audio devices 102, 104, and 106, each of which is located in a particular area, called a “zone” and is referred to as a “zone player.” *Id.* at 4:63–67. In the example of Figure 1, audio devices are located in various rooms of the home. *Id.* at 5:5–8. Each audio player is coupled to network 108, which may be a wireless network based on the industry standard 802.11. *Id.* at 5:8–18. In addition to the audio players, computing device 110 is coupled to network 108. *Id.* at 5:9–11. Other devices, such as a MP3 player, a storage device, and a home gateway device, may be coupled to network 108. *Id.* at 5:11–13.

According to Lambourne, “[m]any devices on the network 108 are configured to download and store audio sources.” *Id.* at 5:22–23. As an example, Lambourne describes storing audio files downloaded from the Internet on computer device 110 “for sharing with other devices” on network 108. *Id.* at 5:23–26.

Lambourne indicates “[m]any devices on the network 108 may be configured to control operations of the zone players 102, 104 and 106.” *Id.* at 6:6–7. Figure 1 shows two examples—controlling devices 140 and 142. *Id.* at 6:7–10. The controlling devices are “portable and remotely control the zone players via wireless means (e.g., infrared, radio, wireless standard IEEE 802.11b or 802.11g).” *Id.* at 6:10–13. Figure 2B of Lambourne, reproduced below, depicts example 240 of controlling device 140 or 142. *Id.* at 7:23–25.



Controller 240 facilitates selection of audio sources available on the network and controls operations of zone players through a wireless interface.¹² *Id.* at 7:25–32.

2. Summary of Elabbady

Elabbady is a United States Patent that describes techniques for sharing media content, such as digital music files and digital video files downloaded using an Internet connection to personal computers (“PCs”). Ex. 1006, Abs., 1:14–23. Figure 2A of Elabbady, reproduced below, depicts a media content sharing environment 200.

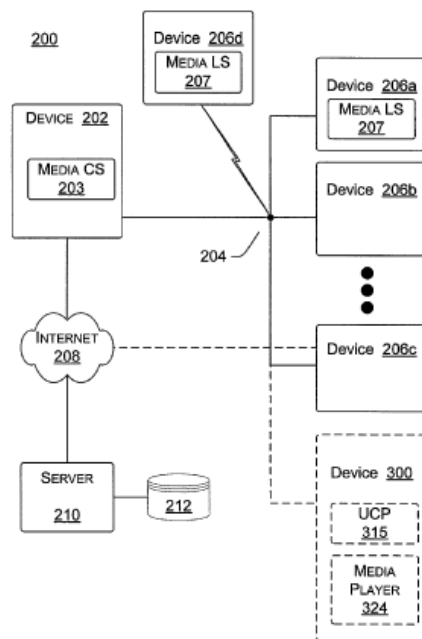


Fig. 2A

¹² Lambourne indicates a wireless interface may be referred to as an RF interface. Ex. 1005, 6:38–39.

As depicted in Figure 2A, media content sharing environment 200 includes devices 202, 206a–d, and 300 connected by network 204. *Id.* at 5:24–31. Device 202 “is configured to provide media cataloging service (CS) over a network 204” for devices 206a–d that are configured to act as media players. *Id.* As shown in Figure 2A, devices 206a and 206d also provide “media library services (LSs).” *Id.* Device 202 connects through Internet 208 to server 210, which has a media content sharing mechanism—database 212. *Id.* at 5:34–39.

Media catalog service (CS) 203 on device 202, which is “a personal computer (PC) or like device,” gathers and distributes information about media content available for sharing between the connected devices. *Id.* at 6:8–11, 6:53–56. For example, the media catalog service 203 may query the other devices “to gather information about shared media content.” *Id.* at 6:11–15. The gathered data may include “metadata” associated with the media content, such as media content descriptive information and location information. *Id.* at 6:28–36. For example, media library service 207 on device 206d provides, to media catalog service 203, metadata about media content available on device 206d. *Id.* at 7:16–21. Then the media catalog service 203 converts the received metadata “to produce the media catalog in the form of a markup language file.” *Id.* at 6:37–39. Media catalog service 203 “can publish” the aggregated information in the media catalog, which may be formatted for displaying in a user interface. *Id.* at 6:19–23.

Device 300 is configured to play shared media content and is “operatively interconnected” to devices 202 and 206 through network 204.

Id. at 9:56–60. Device 300 queries media catalog 203 on device 202, which returns query results to device 300. *Id.* at 10: 17–18. For example, “a query of the media catalog for music could result in one or more matches that are identified” by a location identifier to device 300 and then a selected media content file could be provided to device 300 from device 206. *Id.* at 10:18–39. Thereafter, device 300 plays the received media content file. *Id.* at 10:39–42.

3. Petitioner’s Contentions

Independent claim 1 recites “[a] mobile device for controlling digital content played by a plurality of media devices” that includes “(a) a wireless communication interface for communicating with the plurality of media devices; (b) a media database; and (c) a control system.” The recited “control system” on the mobile device is “adapted to, for each of the . . . media devices: . . . [to] store the information describing the content residing at the media device in the media database.” Claim 1 also requires that the controller use the media database in a particular manner: to select desired content from the content at the media device based on the information in the media database and to play the desired content at the media device under certain conditions.

Petitioner contends that the combination of Lambourne and Elabbady would have conveyed these limitations to one of ordinary skill in the art at the time of the invention. Pet. 12–17. In general, Petitioner relies on Lambourne’s controller 140 for the recited mobile device. *Id.* Petitioner contends “Lambourne describes a ‘music menu’ providing a list of available

content residing at a zone player” on Lambourne’s controller. *Id.* at 12 (citing Ex. 1005, 7:59–61). Petitioner acknowledges, as does Petitioner’s declarant, that Lambourne “does not explicitly disclose how the data used to create the music menu is stored.” *Id.* (citing Ex. 1002 ¶ 37).

With no express teaching of a media database on Lambourne’s controller, Petitioner relies on Elabbady’s media catalog. Petitioner contends that, because Lambourne discloses a music menu, one of ordinary skill in the art “would have been motivated to use the media cataloging service 203 and media catalog 205 of Elabbady to easily implement this feature” of the recited mobile device having a media database storing information describing content residing at the media devices. *Id.* at 13 (citing Ex. 1005 7:59–61, Ex. 1002 ¶¶ 42–45).

More specifically, Petitioner contends that “Lambourne is silent as to how this menu is generated, but Elabbady discloses a system for generating a media catalog and providing it to a user.” *Id.* at 10–11 (citing Ex. 1002 ¶ 43). With support from its declarant, Petitioner contends it would have been within the ability of one of ordinary skill in the art “to implement Elabbady’s disclosure of a media catalog service within the controller of Lambourne,” which includes a network interface, memory, and a processor. *Id.* at 11 (citing Ex. 1005, 3:6–12, 8:19–8, Ex. 1002 ¶¶ 42–45). Petitioner and its declarant continue that one of ordinary skill in the art “would have been motivated” to generate a music menu in this way “to reduce network congestion and improve performance and enhance the ability to remotely control multimedia, as advocated by Elabbady and Lambourne.” *Id.* (citing

Ex. 1002 ¶¶ 42, 43, 45). Petitioner concludes, with support from its declarant, that Lambourne’s “[c]ontroller 140 would then store the information describing the zone player content in” a media database. *Id.* (citing Ex. 1002 ¶ 43).

4. Analysis

In response, Patent Owner contends that Petitioner’s combination is insufficient because Elabbady “does not disclose or suggest storing a media database at the remote control.” Prelim. Resp. 22. Rather, according to Patent Owner, Elabbady’s media catalog service is on a separate device 202 that does not control the media player. *Id.*

We agree with Patent Owner that Elabbady, like Lambourne, does not teach expressly a media database stored on a mobile device in the manner required by claim 1. In addition, as discussed *supra* in Part II.B.3., Petitioner acknowledges that Lambourne “does not explicitly disclose how the data used to create the music menu is stored.” Pet. 12. Elabbady describes a media catalog for use by a control device, and Lambourne describes a controller for selecting music to be played on audio devices. Thus, both parties appear to recognize, as we do, that neither reference expressly describes a media database storing content available at a media device on a mobile device, from which content at the media device is selected based on information in the media database. Pet. 12; Prelim. Resp. 21–22.

That neither reference describes such a mobile device is not dispositive. Rather, the test for obviousness “is what the combined

teachings of the references would have suggested to those having ordinary skill in the art.” *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). Moreover, it is axiomatic, that an asserted ground of obviousness must demonstrate articulated reasoning with rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Mere conclusory statements are not sufficient. *Id.* Furthermore, “[c]are must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’” *Grain Processing Corp. v. Am.-Maize Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988) (quoting *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012 (Fed. Cir. 1983)).

Accordingly, the central issue before us is why one of ordinary skill in the art at the time the invention was made would have combined Elabbady’s media catalog with Lambourne’s system in the manner proposed by Petitioner and required by the claims: by storing Elabbady’s media catalog (the recited “media database”) on Lambourne’s controller (the recited “mobile device”). Petitioner provides insufficient analysis or evidence that one of ordinary skill in the art would have combined Elabbady’s media catalog with the controller of Lambourne.

Instead, Petitioner provides analysis and support for its contention that one of ordinary skill in the art would have looked to Elabbady for how to generate Lambourne’s music menu. Pet. 10–11 (“Lambourne is silent as to

how this menu is generated, but Elabbady discloses a system for generating a media catalog and providing it to a user.”); *id.* at 11 (contending one of ordinary skill in the art “would have been motivated to” implement Elabbady’s disclosure of a media catalog service within the controller of Lambourne because “Elabbady discloses a simple, optimized method of generating the music menu advertised by Lambourne”).

Petitioner’s analysis regarding combining Elabbady’s menu generation techniques with Lambourne’s system does not provide sufficient reasoning for why the combination of Lambourne and Elabbady would have suggested to one of ordinary skill in the art placing Elabbady’s media catalog on the *controller* of Lambourne. For a purported reason to combine the references, Petitioner states “caching metadata for the music menu would reduce network congestion and improve performance and enhance the ability to remotely control multimedia, as advocated by Elabbady and Lambourne.” Pet. 11 (citing Ex. 1006, 1:44–53; Ex. 1005, 2:5–13; Ex. 1002 ¶ 45).

Petitioner’s statement, which merely restates Dr. Weissman’s testimony, is conclusory. Ex. 1002 ¶ 45 (“Given the disclosure of *Lambourne*, one of ordinary skill would be motivated to include this feature, because caching metadata for the music menu would reduce network communication and therefore improve performance and enhance the ability to remotely control multimedia, as both *Elabbady* and *Lambourne* advocate. EX1006 at 1:44-52; EX1005 at 2:5–13.”). Neither Petitioner, nor its declarant, explains sufficiently how the benefits of caching the music menu would have conveyed to one of ordinary skill in the art the idea of storing the media

catalog/database on Lambourne's controller. Thus, we accord Dr. Weissman's testimony in this regard little weight. 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

Furthermore, Petitioner does not explain sufficiently why one of ordinary skill in the art would have combined Elabbady's media catalog service with Lambourne's controller 140, rather than combining Elabbady's media catalog service with other of Lambourne's devices. *See* Pet. 10–13. For example, Petitioner does not provide a reason why one of ordinary skill in the art would store Elabbady's media catalog on Lambourne's controller, rather than on Lambourne's computing device 110 that stores audio files downloaded from the Internet. *See* Ex. 1005, 5:23–26. Similarly, Petitioner does not explain why one of ordinary skill in the art would have stored Elabbady's media catalog on Lambourne's controller, rather than storing it on Lambourne's storage device or MP3 player. *See id.* at 5:9–13.

For these reasons, we determine that the Petition falls short of providing an articulated reasoning with rational underpinning for combining the teachings of Lambourne and Elabbady in the manner required by claim 1—storing Elabbady's media catalog on Lambourne's controller. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art").

Independent claim 16 similarly recites “storing the information describing the content residing at the media device in a media database of the mobile device” and “selecting desired content to play from the content residing at the media device based on the media database when” certain conditions are met; and “playing the desired content at the media device.” Regarding independent claim 16, Petitioner makes substantially similar arguments regarding Lambourne and Elabbady to those Petitioner makes for claim 1. Pet. 21–23.

For similar reasons, we determine that the Petition also falls short of providing an articulated reasoning with rational underpinning for combining the teachings of Lambourne and Elabbady in the manner required by independent claim 16.

Accordingly, we determine the Petition does not show a reasonable likelihood that Petitioner would prevail in establishing independent claim 1, independent claim 16, or dependent claims 2–5, 7–10, 12, 14, 15, 17, and 18 would have been obvious over the combination of Lambourne and Elabbady or over the combination Lambourne and Elabbady with other references (i.e., Meade, Dwek, Melpignano, Weinans, or Willson).

*C. Asserted Grounds of Obviousness over Chen and Plastina,
Alone or in Combination with Other References*

Petitioner contends that claims 1–3, 12, 16, and 17 of the ’904 patent are unpatentable under 35 U.S.C. § 103 as obvious over Chen and Plastina. Pet. 23–41. Petitioner further contends that claims 4, 5, 7–10, 14, 15, and 18 are unpatentable under 35 U.S.C. § 103 as obvious over Chen, Plastina, and various other references. *Id.* at 41–60. Petitioner supports its contentions

with citations to the references and with declaration testimony of Dr. Weissman (Ex. 1002). *Id.* at 23–60. Patent Owner opposes. Prelim. Resp. 26–36. For the reasons that follow, we determine that Petitioner does not explain sufficiently how the combination of Chen and Plastina would have rendered the challenged claims unpatentable.

1. Summary of Chen

Chen is a United States Patent that describes techniques for controlling video playback on a video device using a separate controller. Ex. 1007, Abs., 4:47–50. Figure 2 of Chen, reproduced below, depicts a network topology for implementing Chen’s techniques. *Id.* at 4:44–45.

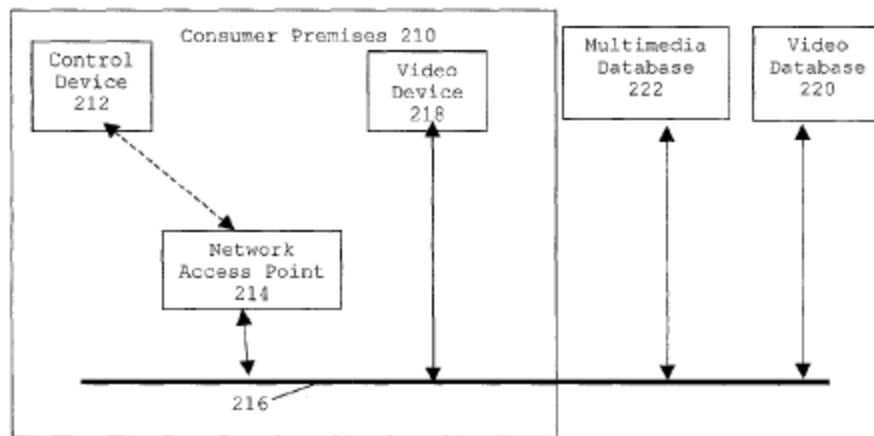


Figure 2

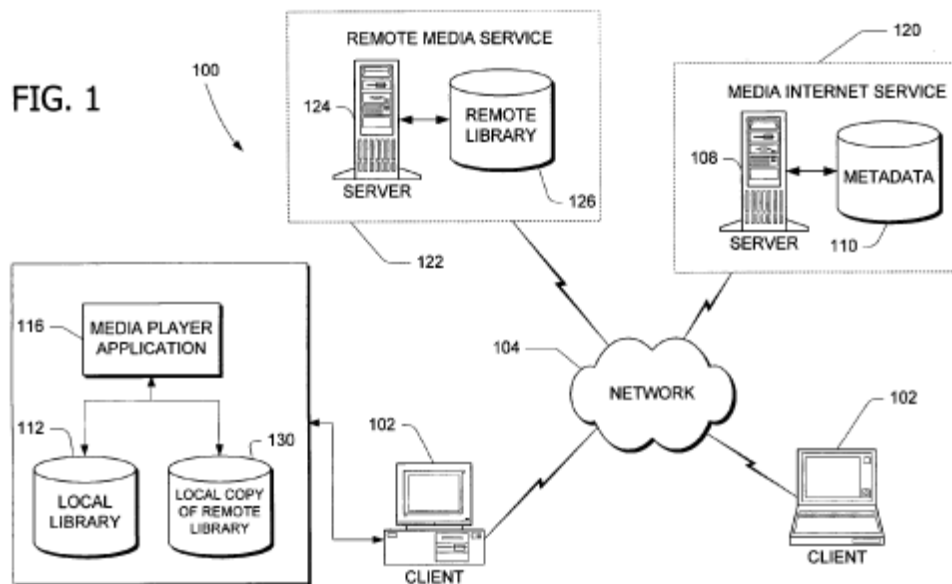
As depicted in Figure 2, consumer premises 210 includes control device 212 that communicates through network access point 214 over network 216. *Id.* at 6:45–47. Control device 212 controls playback of video on video device 218, such as a television or computer monitor, which is located at

consumer premises 210. *Id.* at 5:4–7. Chen indicates control device 212 may be a “Personal Digital Assistant (PDA).” *Id.* at 4:47–50.

“Video server 220 stores the video database” of content that is streamed to video device 218, and “[m]ultimedia server 222 stores the multimedia database,” which includes content specific data corresponding to video data stored on video server. *Id.* at 5:14–18, 5:40–43. Video server, multimedia server, and video device are each connected to network 216. *Id.* at 5:7–9, 5:14–18. A consumer “interacts with the control device and multimedia data displayed” on the control device to select a video program, which is transmitted from video server 220 over network 216 and displayed on video device 218. *Id.* at 5:25–28, 5:58–62.

2. Summary of Plastina

Plastina is a United States Patent Application Publication that describes techniques for managing media playback across multiple devices. Ex. 1008 ¶¶ 1–3, 16–17. Figure 1 of Plastina, reproduced below, depicts a media playing system. *Id.* ¶ 14.



As shown in Figure 1, media player system 100 includes user computer 102 that executes media player application 116 to play local media files stored in local media library 112. *Id.* ¶ 16. Media player application 116 also communicates over network 104 to media internet service site 120, having server 108 and metadata 110, that enables media player application 116 to access, retrieve, and display metadata related to the digital media being played by media player application. *Id.* ¶¶ 17, 18. Such metadata includes title, composer, performer, genre, and description of the content. *Id.* ¶ 17.

Media player application 116 also may communicate with remote media server 122 having server 124 and remote library 126, which is a catalog of available media files. *Id.* ¶ 20. Local copy 130 of remote library 126 is maintained on user computer 12. *Id.* ¶ 28.

3. *Petitioner's Contentions*

Petitioner contends that the combination of Chen and Plastina would have conveyed the limitations recited in claim 1 to one of ordinary skill in the art at the time of the invention. Pet. 27–35. In general, Petitioner relies on Chen's control device for the recited mobile device. *Id.* Petitioner acknowledges, as does Petitioner's declarant, that Chen “does not explicitly disclose that information describing the available content is stored on the control device.” *Id.* at 25 (citing Ex. 1002 ¶ 53).

With support from its declarant, Petitioner contends “[i]t would have been obvious to [one of ordinary skill in the art] to combine the teachings of [Plastina's] disclosure of a locally maintained metadata catalog with Chen's control device.” *Id.* at 26 (citing Ex. 1002 ¶¶ 53–57). One of ordinary skill in the art would have done so because “[s]toring metadata on the control device ensures the control device displays the content lists faster.” *Id.* (citing Ex. 1002 ¶ 55, Ex. 1008 ¶ 31). Petitioner further contends that it would have been “a simple design choice” to implement the database of Plastina with the control device of Chen. *Id.* at 26–27 (citing Ex. 1002 ¶ 57).

In addition, because Chen describes combining the multimedia server and video server in the same server, Petitioner contends that one of ordinary skill in the art would have combined Chen's combined multimedia/video server with Chen's video device 218. *Id.* at 30. Petitioner concludes that this combination “would result in direct communication between control device 212 and video device 218,” which, according to Petitioner,

correspond to the recited mobile device and media device, respectively. *Id.* at 31.

4. Analysis

In response, Patent Owner contends Petitioner's combination is insufficient because Plastina describes storing the copy of the remote library at computer 102, which is also the media player and is not a separate mobile device, as required by claim 1. Prelim. Resp. 34–35. Further, Patent Owner notes that the copy of the remote library stores information about media stored remotely from the media player (i.e., corresponding to the recited “media device”) and, as such, is not “describing content at the media device” (i.e., the media player), as required by claim 1. *Id.* at 35.

Similarly to Petitioner's combination of Lambourne and Elabbady, neither Chen, nor Plastina, individually describes a media database storing content available at a media device on a mobile device in the manner required by claim 1. In addition, as discussed *supra* in Part II.C.3., Petitioner acknowledges, as does Petitioner's declarant, that Chen “does not explicitly disclose that information describing the available content is stored on the control device.” Rather, Chen describes a control device for selecting video content provided by video and multimedia databases for playing on a video device, and Plastina describes storing a local copy of a remote library on a user computer playing the video using a media player application on the computer.

Petitioner's analysis does not provide sufficient reasoning as to why the combination of Chen and Plastina would have suggested to one of

ordinary skill placing Plastina's local copy of a remote library on control device 212 of Chen. Petitioner asserts that one of ordinary skill in the art would have done so because "[s]toring metadata on the control device ensures the control device displays the content lists faster." *Id.* (citing Ex. 1002 ¶ 55, Ex. 1008 ¶ 31). In support, Dr. Weissman testifies storing data on the control device ensures the control device operates quickly and "routine optimization of making resources local to a device, in order to improve the speed at which information can be accessed and loaded, was a well-known technique for improving performance." Ex. 1002 ¶ 55.

On its face, Petitioner's rationale of the benefits of local placement also would seem to apply to Petitioner's proposed combined video device/multimedia database/video database, which also would have been located at the consumer premises. *See* Ex. 1007, Fig. 2. Neither Petitioner nor Dr. Weissman addresses why one of ordinary skill in the art would have placed the local copy on control device 212, rather than placing the local copy on Petitioner's proposed combined video device/multimedia database/video database.

Petitioner further contends that it would have been "a simple design choice" to implement the database of Plastina with the control device of Chen. *Id.* at 26–27 (citing Ex. 1002 ¶ 57). Merely stating that a particular placement of an element is a design choice does not make such placement obvious. Rather, Petitioner must offer a reason for why a person of ordinary skill in the art would have made the specific design choice to locate

Plastina's local copy on the control device of Chen, rather than on another device. Petitioner does not do so.

Nor does Petitioner's assertion that one of ordinary skill in the art "would have readily known how to apply the teachings of [Plastina] to the control device of Chen" provide sufficient reason why one of ordinary skill in the art would have done so in the manner required by claim 1. Pet. 28.

For these reasons, we determine that the Petition falls short of providing an articulated reasoning with rational underpinning for combining the teachings of Chen and Plastina in the manner required by claim 1. See *KSR*, 550 U.S. at 418 ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art").

As noted earlier, independent claim 16 similarly recites "storing the information describing the content residing at the media device in a media database of the mobile device" and "selecting desired content to play from the content residing at the media device based on the media database when" certain conditions are met; and "playing the desired content at the media device." Regarding independent claim 16, Petitioner makes substantially similar arguments regarding Chen and Plastina to those Petitioner makes for claim 1. Pet. 39–41. For similar reasons, we determine that the Petition also falls short of providing an articulated reasoning with rational underpinning for combining the teachings of Chen and Plastina in the manner required by independent claim 16.

Accordingly, we determine the Petition does not show a reasonable likelihood that Petitioner would prevail in establishing independent claim 1, independent claim 16, or dependent claims 2–5, 7–10, 12, 14, 15, 17, and 18 would have been obvious over the combination of Chen and Plastina or the combination Chen and Plastina with other references (i.e., Meade, Dwek, Melpignano, Weinans, or Willson).

III. CONCLUSION

For the foregoing reasons, we determine that the information presented does not establish a reasonable likelihood that Petitioner would prevail in showing that at least one of claims 1–5, 7–10, 12, and 14–18 of the '904 patent are unpatentable.

IV. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that the Petition is denied and no trial is instituted.

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