

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

CEDAR LANE TECHNOLOGIES INC.,
Patent Owner.

IPR2020-00006
Patent 7,173,177 B1

Before CHRISTOPHER M. KAISER, NORMAN H. BEAMER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 318(a)

INTRODUCTION

A. Background

Unified Patents, LLC¹ (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–26 of U.S. Patent No. 7,173,177 B1 (Ex. 1001, “the ’177 patent”). Cedar Lane Technologies Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We instituted review of all challenged claims on each of the grounds asserted in the Petition. Paper 8 (“Dec. Inst.”). Following institution, Patent Owner filed a Response (Paper 10, “PO Resp.”), and Petitioner filed a Reply (Paper 12, “Reply”). We held a hearing on December 16, 2020, the transcript of which has been entered into the record. Paper 19 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6, and we issue this Final Written Decision pursuant to 35 U.S.C. § 318(a). We conclude that Petitioner has established by a preponderance of the evidence that claims 1–15 and 23 of the ’709 patent are unpatentable but has not established by a preponderance of the evidence that claims 16–22 and 24–26 are unpatentable.

B. Related Matters

Petitioner identifies *AVInnov LLC v. Charter Communications, Inc.*, Case No. 1:19-cv-00373 (D. Del.), as a related case.² Pet. 2. Patent Owner

¹ After filing the Petition, Petitioner changed its name from Unified Patents Inc. to Unified Patents, LLC. Paper 7, 1.

² We take official notice that this proceeding has been dismissed without prejudice.

identifies *Cedar Lane Technologies Inc. v. Charter Communications, Inc.*, Case No. 2:19-cv-00368 (E.D. Tex.), as a related case. Paper 5, 2.

C. The Asserted Grounds of Unpatentability

Petitioner contends that claims 1–26 of the ’177 patent are unpatentable based on the following grounds (Pet. 13–75):³

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 10, 12, 13, 15, 16	103(a) ⁴	Looney, ⁵ DeMartin, ⁶ Cluts ⁷
2–7, 9, 11, 17–19, 21, 22, 24, 25	103(a)	Looney, DeMartin, Cluts, Wiser ⁸
8, 14, 20, 26	103(a)	Looney, DeMartin, Cluts, Wiser, Burke ⁹
23	103(a)	Looney, DeMartin, Cluts, Morioka ¹⁰

D. The ’177 Patent

The ’177 patent, titled “User Interface for Simultaneous Management of Owned and Unowned Inventory,” issued on Feb. 6, 2007. Ex. 1001,

³ Petitioner also relies on a Declaration from Harley R. Myler, Ph.D., P.E. Ex. 1003.

⁴ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the ’177 patent issued was filed before this date, the pre-AIA version of § 103 applies.

⁵ Looney et al., US 5,969,283, issued Oct. 19, 1999 (Ex. 1004, “Looney”).

⁶ DeMartin et al., US 6,226,672 B1, issued May 1, 2001 (Ex. 1005, “DeMartin”).

⁷ Cluts, US 5,616,876, issued Apr. 1, 1997 (Ex. 1006, “Cluts”).

⁸ Wiser et al., US 6,385,596 B1, issued May 7, 2002 (Ex. 1007, “Wiser”).

⁹ Burke, US 6,032,162, issued Feb. 29, 2000 (Ex. 1008, “Burke”).

¹⁰ Morioka et al., EP 0 427 264 A2, published May 15, 1991 (Ex. 1009, “Morioka”).

codes (45), (54). The '177 patent “relates to maintaining an inventory of items through use of a user interface incorporating a user customized organization wherein both owned and un-owned items can be processed simultaneously and wherein un-owned items can be purchased directly from the user interface.” *Id.* at 1:12–18. In particular, the '177 patent describes an interface that “includes one or more customized lists, capable of displaying a selection of items of mixed ownership” along with “an indication of whether or not the item is already owned by the user.” *Id.* at 4:22–25. The interface also “provides a mechanism for purchasing those items that are not” already owned. *Id.* at 4:26–27.

An embodiment of the '177 patent is depicted in Figure 4, which is reproduced below:

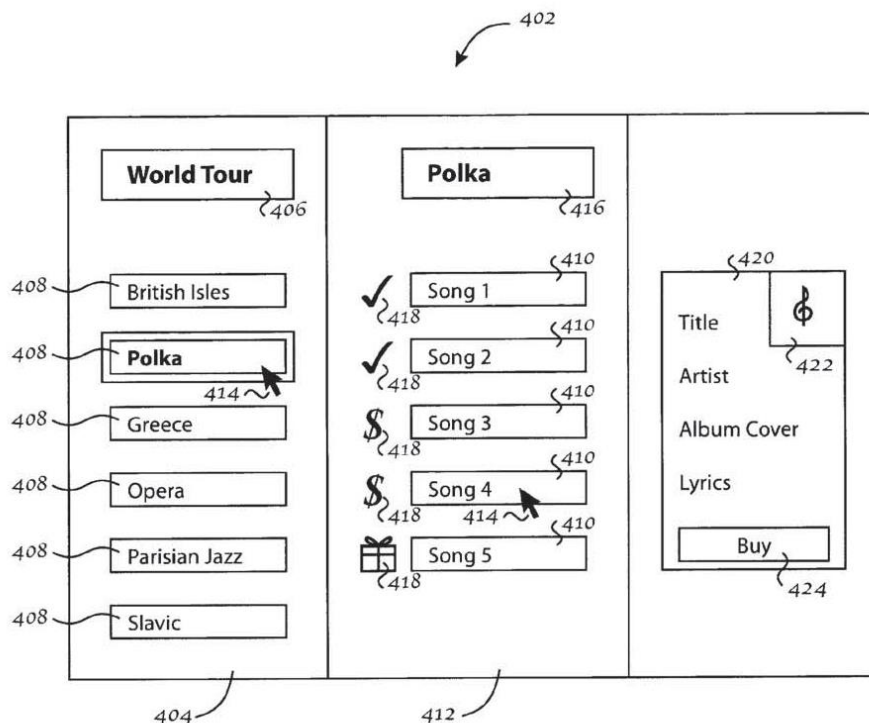


Figure 4

Figure 4 depicts user interface 402 that includes window regions 404 and 412, plus a third window region. *Id.* at 5:8–11. Window region 404 displays heading 406 and a set of list icons 408 associated with that heading. *Id.* at 5:11–17. When the user selects one of the list icons, icons 410 corresponding to the items contained in that list are displayed in second window region 412. *Id.* at 5:35–39. The second window region also displays “title status icon 418 . . . next to each listed title [icon] 410,” with each of the title status icons “indicat[ing] the status of the [associated] item in the list.” *Id.* at 5:48–51. “For example a check mark, might appear next to an item to indicate that the item is already in the possession of the user,” and “a dollar sign, might appear next to items which have not yet been purchased.” *Id.* at 5:51–54. When the user selects an icon 410, the third window region can display various information depending on the status of the item to which the selected icon corresponds. *Id.* at 5:58–6:7.

In Figure 4, the selected icon represents a song which the user does not yet own, and the third window region displays “information regarding that title, such as artist, record label, and album cover graphics . . . in a title description window 420.” *Id.* at 5:60–64. The third window region also displays sample icon 422 whose selection by the user “will initiate a sample play of the music,” as well as buy icon 424, whose selection “will initiate a purchase of the title.” *Id.* at 5:64–67. Different information may be displayed if the icon selected in the second window region corresponds to a song the user owns or a song the user has purchased but not yet received. *Id.* at 6:1–7. The system of the ’177 patent is designed to work both with music “downloaded directly from a network such as the Internet using MP3 or

similar technology” and with “music recorded on compact discs or the like which must be purchased and delivered.” *Id.* at 6:8–20.

E. Illustrative Claim

Claims 1–26 of the ’177 patent are challenged. Claim 1 is independent and illustrative; it recites:

1. A computer readable medium storing instructions that when executed by a computer are capable of causing the computer to:
 - store a play list transferred via a network, wherein the play list includes one or more items;
 - generate a user interface;
 - display the one or more items on the user interface;
 - determine whether each item in the play list is owned or un-owned; and
 - indicate on the user interface whether each item is owned or un-owned.

Ex. 1001, 9:51–61.

ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent,” as the claims would be construed “in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Neither party proposes construing any terms. Pet. 13; PO Resp. 1–20. We agree that no terms require construction in order to resolve the patentability of the challenged claims. Accordingly, we do not construe any claim terms expressly.

B. Obviousness over Looney, DeMartin, and Cluts

Petitioner argues that claims 1, 10, 12, 13, 15, and 16 of the '177 patent would have been obvious given the combined teachings of Looney, DeMartin, and Cluts. Pet. 13–47. Patent Owner disputes this, arguing that none of the asserted references teaches the creation or use of playlists that combine both owned and un-owned items. PO Resp. 6–19.

1. Looney

Looney “relates to music recording and playback systems, and more particularly to a system that enables storage and playback of a wide range of individual music selections/songs according to a pre-programmed list of categories.” Ex. 1004, 1:20–24. Users of Looney’s system can purchase music from a service provider or can play back previously purchased music. *Id.* at 6:33–35, 10:37–42. When the user purchases music, it is delivered on compact disc or other physical media, or it is delivered electronically over the internet or a similar network. *Id.* at 2:43–46, 7:27–42. Looney discloses a master list of songs that includes both songs in the user’s library and those available for purchase from the service provider. *Id.* at 11:23–27, Fig. 8. The display of this list includes information about each song, including an indication of “whether the music data accompanying the title is present in the [user’s] own database,” referred to by Looney as an “ownership” indicator. *Id.* at 14:16–32, Fig. 24.

2. *DeMartin*

DeMartin relates to “a method and system for allowing users to access and/or share personal media libraries, including multimedia collections of audio and video information, via a wide area network or a group of networks.” Ex. 1005, 1:9–14. A student using DeMartin’s system may request a “music tutorial,” causing an expert to “obtain[] [the] Student’s media library contents.” *Id.* at 4:21–35. After reviewing the contents of the library, the expert “creates a playlist based on the Student’s media library contents,” placing the songs “in a particular order to expertly introduce” the student to a given type of music. *Id.* at 5:17–27. DeMartin also teaches exchanging playlists between peers. *Id.* at 6:1–34. Regardless of whether a playlist is transferred to the user from an expert or from a peer, it is transmitted over the internet. *Id.* at 4:25–35, 6:1–9.

3. *Cluts*

Cluts relates to “[a]n interactive network [for] provid[ing] music to subscribers.” Ex. 1006, code (57). The network of Cluts includes a headend system with a continuous media server to manage access to stored audio and video data by customer systems, where the customer systems “include[] the equipment required for a consumer to receive programming information directly at his or her office or residence and to transmit requests and instructions to the headend system.” *Id.* at 6:21–37, 6:57–7:2, 7:56–8:2, Fig. 1. At each customer system, a subscriber may interact with a user interface to request the playback of individual songs or playlists from the continuous media server. *Id.* at 11:38–43, 12:41–42, Fig. 4. The subscriber may request a display of all songs or all albums associated with a given artist. *Id.* at 12:42–53. In addition, the subscriber may request the display of a playlist

provided by the service provider that maintains the network or by other publishers. *Id.* at 12:54–65.

4. *Analysis*

Petitioner argues that claims 1, 10, 12, 13, 15, and 16 of the '177 patent would have been obvious given the combined teachings of Looney, DeMartin, and Cluts. Pet. 13–47.

a. Claim 1

(1) Preamble

The preamble of claim 1 recites “[a] computer readable medium storing instructions that when executed by a computer are capable of causing the computer to.” Ex. 1001, 9:51–53. Petitioner argues that Looney teaches the preamble.¹¹ Pet. 19–20. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19. We agree that Looney teaches a hard drive that stores software modules and a CPU for executing those software modules. Ex. 1004, 6:1–8, Fig. 3. Accordingly, Petitioner has shown by a preponderance of the evidence that the combination of Looney, DeMartin, and Cluts teaches or suggests the preamble of claim 1.

(2) “Store a play list transferred via a network”

Claim 1 also recites “store a play list transferred via a network.” Ex. 1001, 9:54. Petitioner argues that the combination of Looney, DeMartin, and Cluts teaches this limitation. Pet. 21–28. Patent Owner does not dispute Petitioner’s argument that the references teach this limitation, PO

¹¹ Neither Petitioner nor Patent Owner addresses whether the preamble is limiting. Because Petitioner has shown that the recitation in the preamble is satisfied by the prior art, there is no need to determine whether the preamble is limiting. *See Vivid*, 200 F.3d at 803.

Resp. 6–19, but Patent Owner does argue that a person of ordinary skill in the art would not have combined the teachings of Looney with those of Cluts. *Id.* at 15–19.

Looney teaches creating playlists using various categories and storing those playlists on a hard drive. Ex. 1004, 9:36–64, Figs. 13, 14. Looney also teaches transferring groups of songs from the service provider to the customer over the internet. *Id.* at 2:43–44, 7:35–44, 8:1–6. Dr. Myler testifies that, given Looney’s teachings that a group of songs may be transferred over a network and that a group of songs may be chosen and made into a playlist, it would have been obvious to create a playlist based on the transferred songs and then to transfer the playlist across the network with the songs. Ex. 1003 ¶ 55. According to Petitioner, creating, transferring, and storing such a playlist would have provided more convenient and efficient access to the transferred songs. Pet. 23. Patent Owner does not direct us to any argument or evidence contradicting Dr. Myler’s testimony or Petitioner’s argument. PO Resp. 6–19.

In addition, Cluts teaches sending a playlist over a network. Ex. 1006, 12:57–59 (“various types of playlists may be provided by the service provider or other publishers”). The playlists in Cluts are made of songs not owned by the subscribers to whom they are transferred, because the service disclosed by Cluts is for delivering on-demand music. *Id.* at 1:34–49, 6:56–65. Petitioner argues that modifying Looney to transmit a playlist along with a transferred group of songs as taught by Cluts “would simply have been the use of a known technique (transferring a playlist over a network) to improve Looney’s music system in the same way to yield predictable results.” Pet. 23–24 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417

(2007)). Petitioner also argues that a person of ordinary skill in the art would have been motivated to modify Looney to transmit a playlist containing unowned songs as taught by Cluts because doing so would improve the ability of the user of Looney's system to identify additional music they might enjoy. Pet. 28. Dr. Myler's testimony supports this motivation. Ex. 1003 ¶ 62. In addition, Petitioner argues that a person of ordinary skill in the art would have combined the teachings of Cluts with those of Looney "because doing so would permit the user to view ownership information for a particular playlist of interest, rather than view the ownership information for every music file in the master list." Pet. 39; see Ex. 1003 ¶ 85. Dr. Myler testifies that, even when dealing with less than all the songs available in Looney's master list, a user might "wish to know whether a song in a playlist would have to be purchased and downloaded before playback of the song," both to "help the user complete a collection" and to "prevent [the] user from needlessly purchasing multiple copies of the same song." Ex. 1003 ¶ 82.

Patent Owner argues that a person of ordinary skill in the art would not have combined the teachings of Cluts and Looney for several reasons. PO Resp. 15–19. First, Patent Owner argues that a person of ordinary skill in the art "would never combine" Looney and Cluts "to achieve a play list interface that combines owned and unowned songs" because Cluts fails to teach "using ownership information as a category for making play lists." *Id.* at 15–17. This argument is unpersuasive. Claim 1 cannot be interpreted to require a playlist containing both owned and unowned items. Such a playlist would need to include at least two items, one owned and one unowned, but a

playlist under claim 1 may include a single item. Ex. 1001, 9:51–61 (“wherein the play list includes **one** or more items”) (emphasis added).

Next, Patent Owner argues that, if a system combined the teachings of Cluts and Looney, “a user would need to purchase any unowned song in a playlist before playback,” so the user “could not enjoy playing through the full playlist without disruption.” PO Resp. 17. This argument is unpersuasive for two reasons. First, it is pure attorney argument, unaccompanied by any citation to evidence of record. An “[a]ttorney’s argument in a brief cannot take the place of evidence.” *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). Second, the ability to play back unowned songs in a playlist or to “enjoy playing through the full playlist without disruption” appears nowhere in claim 1 of the ’177 patent.¹² Accordingly, the failure of the Looney-Cluts combination to carry out this function is immaterial to the patentability of claim 1. *See In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (unclaimed features cannot impart patentability to claims).

Finally, Patent Owner argues that “Looney by itself already solves the problem of informing the user ‘whether the song in a playlist would have to be purchased before playback of a song’—the ownership column in the master play list provides this information *and* it does not require the *additional* step of adding unowned songs to a playlist to later be reminded that they are unowned.” PO Resp. 17 (quoting Ex. 1003 ¶ 82). Similarly,

¹² We note that the ’177 patent describes only playing owned songs, not unowned songs. *Compare* Ex. 1001, 6:1–7 (describing selecting an owned song causes the song to be played), *with id.* at 5:58–67 (describing how selecting an unowned song causes information about that song to be displayed).

Patent Owner also argues that “Looney’s master list already addresses the issue of completing a music collection” and “effectively prevents a user from purchasing multiple copies of the same song.” *Id.* at 17–18 (citing Ex. 1004, 6:9–28, 14:16–32, Fig. 24). As discussed above, however, Petitioner proposes using Looney’s display of master list information, including ownership status, but with Cluts’s display of less than all available songs, with the person of ordinary skill in the art motivated to do so because they would be able to focus on “a preferred genre of music or a favorite artist . . . as an alternative to reviewing the entire master list.” Pet. 38. The fact that Looney itself permits review of ownership status when viewing an enormous list of all available songs does not overcome Dr. Myler’s testimony that a person of ordinary skill in the art would have wanted to be able to review the same information for a smaller list of songs. *See* Ex. 1003 ¶ 85.

Moreover, DeMartin also teaches transferring a playlist over a network. Ex. 1005, 6:21–34, Fig. 4. Petitioner argues that a person of ordinary skill in the art would have been motivated to combine this teaching of DeMartin with Looney “because Looney’s system would be enhanced” by permitting the user “to not only receive a group of files over a network but also a playlist so that the user can efficiently play that group of files.” Pet. 24. Dr. Myler’s testimony supports this argument. Ex. 1003 ¶ 59. Patent Owner does not direct us to any argument or evidence contradicting this argument. PO Resp. 6–19.

Accordingly, Petitioner has shown by a preponderance of the evidence that the combination of Looney, DeMartin, and Cluts teaches or suggests

this limitation of claim 1 and that a person of ordinary skill in the art would have had a reason to combine the teachings of Looney, DeMartin, and Cluts.

(3) “Wherein the play list includes one or more items”

Claim 1 also recites “wherein the play list includes one or more items.” Ex. 1001, 9:54–55. Petitioner argues that each of Looney, DeMartin, and Cluts teaches this limitation. Pet. 28–29. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Petitioner is correct that each of Looney, DeMartin, and Cluts teaches a playlist that contains several songs. Ex. 1004, 9:36–45, Fig. 13; Ex. 1005, 5:23–35, 6:1–4, 6:22–29, Figs. 2, 4; Ex. 1006, 12:56. Accordingly, Petitioner has shown by a preponderance of the evidence that the combination of Looney, DeMartin, and Cluts teaches or suggests this limitation of claim 1.

(4) “Generate a user interface”

Claim 1 also recites “generate a user interface.” Ex. 1001, 9:56. Petitioner argues that Looney teaches this limitation. Pet. 29–31. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

We agree that Looney teaches a software module that instructs the CPU to generate a user interface using the video card and a computer monitor. Ex. 1004, 5:26–37, 5:48–6:8, 9:19–51, 14:16–32, Fig. 13, Fig. 24. Accordingly, Petitioner has shown by a preponderance of the evidence that the combination of Looney, DeMartin, and Cluts teaches or suggests this limitation of claim 1.

(5) “Display the one or more items on the user interface”

Claim 1 also recites “display the one or more items on the user interface.” Ex. 1001, 9:57. Petitioner argues that Looney teaches this limitation. Pet. 31–32. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

We agree that Looney teaches displaying the songs in a playlist in its user interface. Ex. 1004, 9:36–45, Fig. 13. In addition, Looney also teaches displaying all the songs in its master list—a list of all available songs, both owned and unowned—in its user interface. *Id.* at 2:46–50, 14:17–21, Fig. 24. Accordingly, Petitioner has shown by a preponderance of the evidence that the combination of Looney, DeMartin, and Cluts teaches or suggests this limitation of claim 1.

(6) “Determine whether each item in the play list is owned or un-owned”

Claim 1 also recites “determine whether each item in the play list is owned or un-owned.” Ex. 1001, 9:58–59. Petitioner argues that Looney teaches this limitation. Pet. 34–41.

Looney’s master list displays the ownership status for every available song, indicating whether the song is owned or unowned. Ex. 1004, 6:33–35, 11:25–27, 11:35–37, 14:26–31, Fig. 24. To display this information, Looney must determine whether or not the subscriber owns each of the songs in the master list. Ex. 1003 ¶ 79. Looney’s playlist contains a subset of all songs that are in the master list. Ex. 1004, 6:64–7:1, 8:59–9:3, 9:24–38. Accordingly, when Looney determines the ownership status of all songs in the master list, it necessarily determines the ownership status of all songs in any of its playlists.

Patent Owner argues that Looney cannot teach this limitation because Looney's playlists contain only purchased songs rather than combining both owned and unowned items. PO Resp. 10–13. Patent Owner also argues that, because Looney's playlist contains only owned items, a person of ordinary skill in the art would have had no reason to modify Looney's playlists to display ownership status. *Id.* at 13–14. We disagree. As we discussed above, this limitation does not require the presence of both owned and unowned items on a playlist. Moreover, this limitation does not require the display of ownership information on the playlist, only a determination of whether each of the songs that make up a playlist is owned or unowned. As discussed above, Looney's determination of ownership status for the songs on the master list necessarily includes a determination of ownership status for the subset of those songs that is on the playlist.

Accordingly, Petitioner has shown by a preponderance of the evidence that the combination of Looney, DeMartin, and Cluts teaches or suggests this limitation of claim 1.

(7) *“Indicate on the user interface whether each item is owned or un-owned”*

Finally, claim 1 recites “indicate on the user interface whether each item is owned or un-owned.” Ex. 1001, 9:60–61. Petitioner argues that a person of ordinary skill in the art would have been motivated to modify Looney's display of its master list to display only a playlist in view of the teachings of Cluts. Pet. 42 (citing Pet. 38–41). This proposed combination would use Looney's display of master list information, including ownership status, but with Cluts's display of less than all available songs, with the displayed songs chosen based on categories such as artist or genre. *Id.* at 38.

Petitioner is correct that Cluts teaches displaying less than all available songs, with the displayed songs chosen based on a category such as artist or genre. Ex. 1006, 7:65–8:20, 12:9–11, 12:41–65, 13:47–52, Figs. 4–6. One collection of less than all available songs taught by Cluts is a playlist. *Id.* at 13:47–52, Fig. 6. For this limitation, Patent Owner only argues that a person of ordinary skill in the art would not have combined the teachings of Cluts and Looney for several reasons. PO Resp. 15–19. As discussed above with respect to the limitation “store a play list transferred via a network,” we find Petitioner’s arguments for combining the teachings of Cluts and Looney persuasive.

Accordingly, Petitioner has shown by a preponderance of the evidence that the combination of Looney, DeMartin, and Cluts teaches or suggests this limitation of claim 1.

(8) Conclusion as to Claim 1

Petitioner has shown that a person of ordinary skill in the art would have had a reason to combine the teachings of Looney, DeMartin, and Cluts and that the combination of those references teaches or suggests the subject matter of claim 1. Accordingly, Petitioner has shown by a preponderance of the evidence that claim 1 would have been obvious over the combination of Looney, DeMartin, and Cluts.

b. Claim 10

Claim 10 depends from claim 1 and recites a limitation requiring that “the instructions [be] further capable of causing the computer to play each owned item selected by a user.” Ex. 1001, 10:22–24. Petitioner argues that Looney teaches this limitation. Pet. 42–43. Other than the arguments discussed above regarding the reason to combine the teachings of Looney,

DeMartin, and Cluts, Patent Owner does not dispute Petitioner's argument. PO Resp. 6–19.

We agree that Looney teaches the entertainment center uses the CPU to control a sound card, amplifier, and speakers to play back owned songs selected by the user. Ex. 1004, 7:9–26, 8:18–20, 9:18–41, 10:35–43. Accordingly, Petitioner has shown by a preponderance of the evidence that claim 10 would have been obvious over the combination of Looney, DeMartin, and Cluts.

c. Claim 12

Claim 12 depends from claim 1 and adds a limitation requiring that “the play list [be] created and organized by another party who transfers the play list to a user.” Ex. 1001, 10:28–30. Petitioner argues that DeMartin teaches this limitation. Pet. 43. Other than the arguments discussed above regarding the reason to combine the teachings of Looney, DeMartin, and Cluts, Patent Owner does not dispute Petitioner's argument. PO Resp. 6–19.

Petitioner is correct that DeMartin teaches a playlist created by a music expert and transferred to a student over the internet. Ex. 1005, 2:59–3:5, 3:64–65, 4:25–35, 5:12–57, 7:14–20. Accordingly, Petitioner has shown by a preponderance of the evidence that claim 12 would have been obvious over the combination of Looney, DeMartin, and Cluts.

d. Claim 13

Claim 13 depends from claim 12 and adds a limitation requiring that “the play list [be] transferred via the network by using an electronic communication.” Ex. 1001, 10:31–33. Petitioner argues that DeMartin teaches this limitation. Pet. 43–44. Other than the arguments discussed above regarding the reason to combine the teachings of Looney, DeMartin,

and Cluts, Patent Owner does not dispute Petitioner's argument. PO Resp. 6–19.

Petitioner is correct that DeMartin teaches transferring its playlist from the expert to the student using FTP. Ex. 1005, 5:52–57. Accordingly, Petitioner has shown by a preponderance of the evidence that claim 13 would have been obvious over the combination of Looney, DeMartin, and Cluts.

e. Claim 15

Claim 15 depends from claim 12 and requires that “the party [be] a music dealer.” Ex. 1001, 10:36–37. Petitioner argues that Looney teaches this limitation. Pet. 44. Specifically, Petitioner argues that, because the service provider in Looney sells music to subscribers, the service provider is the recited “music dealer.” *Id.* (citing Ex. 1004, 6:33–35). Other than the arguments discussed above with respect to claim 1, from which claim 15 ultimately depends, Patent Owner does not dispute Petitioner's argument for the obviousness of claim 15. PO Resp. 6–19.

In our Decision on Institution, we noted that we were unsure whether a computer readable medium within the scope of claim 12 could be outside the scope of claim 15 because “it [was] not clear how a set of instructions capable of causing a computer to store a playlist would differ based on the playlist's provenance.” Dec. Inst. 18. During trial, Petitioner agreed that claims 12 and 15 do not have differing scope. Reply 11. Patent Owner did not disagree.¹³ PO Resp. 6–19. Based on the full trial record, we find that

¹³ Although Petitioner did not argue that claims 12 and 15 do not have differing scope until the Reply, Patent Owner had an opportunity to file a Sur-Reply disputing that contention. Paper 9, 8.

claim 15 does not materially differ in scope from claim 12. Accordingly, because Petitioner has shown that claim 12 would have been obvious over the combination of Looney, DeMartin, and Cluts, Petitioner also has shown by a preponderance of the evidence that claim 15 would have been obvious over this combination of references.

f. Claim 16

Claim 16 depends from claim 1 and adds a limitation requiring that the user interface include[] a first window region and a second window region, the first window region including a list icon corresponding to the play list that was transferred and the second window region including titles of the one or more items in the play list and an indication whether each item is owned or un-owned.

Ex. 1001, 10:38–44.

Petitioner argues that Looney teaches the additional limitation of claim 16. Pet. 45–47. Specifically, Petitioner argues that the “first window region” of claim 16 is taught by Looney’s “Screen2” and that the “second window region” of claim 16 is taught by Looney’s “Screen4.” *Id.*

Patent Owner argues that “Looney’s ‘Screen2’ and ‘Screen4’ are ‘**separate** screens displayed at **different** times and in response to **different** events’ rather than window regions within the same screen displayed separately.” PO Resp. 19 (quoting Dec. Inst. 19) (emphasis added by Patent Owner). According to Patent Owner, the window regions of claim 16 must be displayed on “a single screen.” *Id.* (citing Ex. 1001, Fig. 4).

Petitioner argues, for the first time on Reply, that limiting the window regions of claim 16 to areas that are displayed simultaneously on the same screen, as Patent Owner suggests, would improperly limit the claim to a

single illustrative embodiment. Reply 12–13. Instead, Petitioner argues that “‘first window region’ and ‘second window region’ should have their plain meaning, which would be regions or areas of the same *window* (and not ‘screen,’ as [Patent Owner] attempts to insert).” *Id.* at 13–14 (emphasis in original). In addition, Petitioner argues that, even under Patent Owner’s proposed construction, a person of ordinary skill in the art would have known that separate areas of a display could be used to display different types of information simultaneously. *Id.* at 15–19. There are thus two proposed constructions in the record, with Petitioner arguing that claim 16 would have been obvious using either construction.

We are not persuaded that either proposed construction is correct. As Petitioner notes, Patent Owner’s construction attempts to limit “window region” to a single embodiment in the specification of the ’177 patent without showing that embodiment was intended as limiting rather than illustrative. PO Resp. 19 (citing Figure 4 of the ’177 patent as the source of the single-screen requirement). Claims generally are not limited to illustrative embodiments. *In re Susi*, 440 F.2d 442 (CCPA 1971). But Petitioner offers no support at all for its proposed construction. Reply 13–14 (citing no evidence in support of Petitioner’s contention that “‘first window region’ and ‘second window region’ should have their plain meaning, which would be regions or areas of the same *window*”). Accordingly, we have not been directed to sufficient evidence of record to establish how a person of ordinary skill in the art would have interpreted the phrase “window region.” Because Petitioner “must identify . . . [h]ow the challenged claim is to be construed,” 37 C.F.R. § 42.104(b)(3), Petitioner’s failure to do so here is improper.

Even if we were to ignore Petitioner's failure to cite any evidence in support of its construction, we are not persuaded that the evidence of record supports a finding that Looney teaches the window regions of claim 16. Petitioner argues that "Looney describes that its interface has different regions of a window arranged as different tabs." Reply 14–15 (quoting Ex. 1004, 8:21–37, Fig. 15). But Looney says no such thing. Instead of "regions of a window arranged as different tabs," Looney discloses "various screens" that "are denoted respectively by buttons" that "appear on the bottom of all display screens." Ex. 1004, 8:32–37. Similarly, Dr. Myler testifies that a person of ordinary skill in the art would "have understood different tabs to be regions of the same window." Ex. 1012 ¶ 9. This begs the question. The issue is not, as Dr. Myler would have it, whether a person of ordinary skill in the art would have considered separate graphical displays brought to the fore by tab controls to be regions of the same window. Instead, the issue is whether a person of ordinary skill in the art would have considered Looney's "various screens . . . denoted respectively by buttons," Ex. 1004, 8:32–37, to be a type of tab-controlled display. Other than Petitioner's statement that Looney teaches a tab-controlled display, Reply 13–14, the record is devoid of any support for such a finding.

In addition to its new claim construction argument, Petitioner also raises two arguments in its Reply that were not present in the Petition. First, Petitioner argues that Looney teaches simultaneously displaying different regions on a single screen. *Id.* at 15–17. Second, Petitioner argues that a person of ordinary skill in the art "would have been familiar with user interface designs displaying different regions simultaneously." *Id.* at 18. The implication of these arguments is that, based either on Looney's

disclosure of simultaneous display of multiple regions or on their own knowledge, a person of ordinary skill in the art would have been motivated to create a display not taught expressly in Looney that showed the information from Looney's Screen2 and Screen4 simultaneously on the same screen. *Id.* at 18–19. To the extent these arguments prove anything, it is merely that a person of ordinary skill in the art knew how to display multiple pieces of information in different portions of a simultaneous display, not that they had reason specifically to combine Looney's Screen2 and Screen4. Indeed, Petitioner never argues that a person of ordinary skill in the art would have had reason to combine Screen2 and Screen4 into a single screen, arguing instead only that Looney's screens “were not limited to any particular layout” and that Looney teaches a simultaneous display of some types of information. *Id.* at 18. Without a reason to combine the disparate teachings of Looney, Petitioner cannot prove obviousness. *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (a reason to combine the teachings is required even for a single-reference obviousness ground).

In addition, at least Petitioner's second new argument runs afoul of our rules on the proper scope of a Reply, under which “[a] reply may only respond to arguments raised in the corresponding . . . patent owner response.” 37 C.F.R. § 42.23(b). Petitioner's original argument was that Looney itself taught the limitation of claim 16. Pet. 45–47. Patent Owner responded that “Looney's separate screens . . . cannot teach separate windows or similar regions displayed on the same screen.” PO Resp. 19. In reply, Petitioner was free to present evidence and argument clarifying its argument that Looney did in fact teach the limitation of claim 16. But Petitioner was not permitted to change its theory to one under which the

knowledge of one of ordinary skill in the art, rather than the disclosure of Looney, was the source of this teaching. Accordingly, when Petitioner argues that a person of ordinary skill in the art “certainly would have been familiar with user interface designs displaying different regions simultaneously” and would have been motivated to combine this knowledge with the teachings of Looney, Reply 18, Petitioner violates Rule 42.23(b).

For all these reasons, we are not persuaded that Petitioner has shown by a preponderance of the evidence that claim 16 would have been obvious over the combination of Looney, DeMartin, and Cluts.

C. Obviousness over Looney, DeMartin, Cluts, and Wiser

Petitioner argues that claims 2–7, 9, 11, 17–19, 21, 22, 24, and 25 of the ’177 patent would have been obvious given the combined teachings of Looney, DeMartin, Cluts, and Wiser. Pet. 47–68. Patent Owner does not argue any of these claims separately. PO Resp. 6–19.

1. Wiser

Wiser relates to a “system and methods for the online distribution of digital media data over public communication networks.” Ex. 1007, 1:6–9. In Wiser’s system, a client system interacts with a music distribution center to download music over the internet. *Id.* at 5:43–49. The client system includes both a media player and a web browser. *Id.* at 6:15–27, 10:1–12, Figs. 1A, 1B. The media player organizes and plays music downloaded from the music distribution center and facilitates the creation and management of playlists. *Id.* The web browser communicates with the music distribution center over the internet. *Id.* In particular, Wiser teaches a purchase module of the media player interfacing with the web browser to permit the user to purchase media files by navigating to a website associated

with the music distribution center, selecting songs for download, and, following verification of payment by the music distribution center, downloading encrypted files that can be unlocked by the media player. *Id.* at 16:31–40, 18:9–34, 18:66–19:49, 26:40–53.

2. *Analysis*

Petitioner argues that claims 2–7, 9, 11, 17–19, 21, 22, 24, and 25 of the '177 patent would have been obvious given the combined teachings of Looney, DeMartin, Cluts, and Wiser. Pet. 47–68.

a. Claim 2

Claim 2 depends from claim 1 and adds a limitation requiring that “the instructions [be] further capable of causing the computer to initiate a purchase of at least one un-owned item in the play list.” Ex. 1001, 9:62–65. Petitioner argues that Wiser teaches this limitation. Pet. 51–55. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Looney teaches that users can purchase unowned music displayed on the master list by sending an order over the internet to be filled by the service provider. Ex. 1004, 2:43–46, 7:31–42, 11:23–38, 14:16–22, Fig. 24. Petitioner argues that, although Looney teaches a service provider taking and filling orders over the internet, it does not necessarily provide all the details a person of ordinary skill in the art would have wanted regarding how to construct such a provider, and those details would have been provided by Wiser. Pet. 52–55. We agree. Wiser teaches the particulars of how to accomplish the purchase of a media file via the internet that Looney suggests. Ex. 1007, 9:54–67, 25:63–26:2, 26:40–53, Fig. 8. This more detailed explanation of a feature of Looney would have provided a person of ordinary skill in the art with sufficient motivation to combine the teachings

of Wiser with those of Looney because it is the combination of prior-art elements according to known methods to yield predictable results. *KSR*, 550 U.S. at 416. Moreover, Patent Owner does not dispute this argument. PO Resp. 6–19.

Accordingly, Petitioner has shown by a preponderance of the evidence that a person of ordinary skill in the art would have had a reason to combine the teachings of Wiser with those of Looney, DeMartin, and Cluts and that claim 2 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

b. Claim 3

Claim 3 depends from claim 2 and adds a limitation requiring that “the instructions [be] further capable of causing the computer to generate a button on the user interface that can be selected by a user to initiate the purchase.” Ex. 1001, 9:66–10:2. Petitioner argues that Wiser teaches this limitation. Pet. 56–57. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Wiser teaches that its media player generates a “Buy Download” button that the user can click to initiate the purchase of a specified music file. Ex. 1007, 9:54–67, 16:31–40, 25:63–26:2, 26:40–53, Fig. 14. As discussed above with respect to claim 2, Petitioner has shown by a preponderance of the evidence that a person of ordinary skill in the art would have had a reason to combine the teachings of Wiser with those of Looney, DeMartin, and Cluts.

Accordingly, Petitioner has shown by a preponderance of the evidence that claim 3 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

c. Claim 4

Claim 4 depends from claim 1 and adds a limitation requiring that “the instructions [be] further capable of causing the computer to provide a link to an on-line vendor from which a user can purchase at least one un-owned item in the play list.” Ex. 1001, 10:3–6. Petitioner argues that Wiser teaches this limitation. Pet. 57–58. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

In Wiser, the music distribution center is an online music vendor, because it sells and distributes music over the internet. Ex. 1007, 2:48–62, 3:5–10. Further, Wiser teaches that the “Buy It” or “Buy Download” button displayed in its user interface provides a URL, which Wiser teaches is a link to the music distribution center. *Id.* at 9:54–67, 14:46–47, 16:31–40, Figs. 1B, 14.

Accordingly, Petitioner has shown by a preponderance of the evidence that claim 4 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

d. Claim 5

Claim 5 depends from claim 4 and adds a limitation requiring that the “purchased item [be] in the form of music downloaded over the network.” Ex. 1001, 10:7–9. Petitioner argues that Looney and Wiser each teach this limitation. Pet. 58–59. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Petitioner is correct that Looney and Wiser both teach transferring purchased music over the internet. Ex. 1004, 2:40–50, 7:27–44; Ex. 1007, 19:33–43. Accordingly, Petitioner has shown by a preponderance of the

evidence that claim 5 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

e. Claim 6

Claim 6 depends from claim 4 and adds a limitation requiring that the “purchased item [be] in the form of a compact disc.” Ex. 1001, 10:10–11. Petitioner argues that Looney teaches this limitation. Pet. 59. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Petitioner is correct that Looney teaches that the purchased music may be delivered to the subscriber on a physical compact disc. Ex. 1004, 6:35–37, 7:28–29. Accordingly, Petitioner has shown by a preponderance of the evidence that claim 6 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

f. Claim 7

Claim 7 depends from claim 4 and adds a limitation requiring that “the play list [be] created and organized by another party who transfers the play list via an electronic communication over the network.” Ex. 1001, 10:12–15. Petitioner argues that DeMartin teaches this limitation. Pet. 60. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Petitioner is correct that DeMartin teaches an expert transferring a playlist to a student via the internet using FTP. Ex. 1005, 2:59–3:5, 3:64–65, 4:25–35, 5:12–57, 7:14–20. Accordingly, Petitioner has shown by a preponderance of the evidence that claim 7 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

g. Claim 9

Claim 9 depends from claim 4 and adds a limitation requiring that “the instructions [be] further capable of causing the computer to indicate that

a purchased item has not yet been received.” Ex. 1001, 10:18–20. Petitioner argues that Wiser teaches this limitation. Pet. 60–61. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Wiser teaches maintaining data regarding purchased but undelivered media files in the content manager of the music distribution center. Ex. 1007, 17:22–48. In Wiser, purchased but undelivered items are issued a receipt token that has not yet been redeemed by the media player. *Id.* Accordingly, Petitioner has shown by a preponderance of the evidence that claim 9 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

h. Claim 11

Claim 11 depends from claim 1 and adds a limitation requiring that “the instructions [be] further capable of causing the computer to play a portion of each un-owned item selected by a user.” Ex. 1001, 10:25–27. Petitioner argues that Wiser teaches this limitation. Pet. 61–62. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Wiser teaches previewing music before purchase. Ex. 1007, 23:59–24:35. This previewing can include playing a clip of a selected song. *Id.* at code (57), 23:59–24:35, Fig. 14. Accordingly, Petitioner has shown by a preponderance of the evidence that claim 11 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

i. Claims 17–19, 21, and 22

Claims 17–19, 21, and 22 all depend directly or indirectly from claim 16. Ex. 1001, 10:45–57, 10:60–65. As discussed above, Petitioner relies on Looney to teach or suggest the additional limitation of claim 16, but Petitioner has not shown this teaching by a preponderance of the

evidence. In arguing that claims 17–19, 21, and 22 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser, Petitioner does not argue that Wiser teaches or suggests the limitation of claim 16 in question. Pet. 63–67. Accordingly, Petitioner has not shown by a preponderance of the evidence that claims 17–19, 21, and 22 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

j. Claims 24 and 25

Claims 24 and 25 both depend from claim 23, which recites a limitation requiring “instructions [that] are further capable of causing the computer to generate status icons that indicate whether each item is owned or un-owned.” Ex. 1001, 10:66–12:2. This further limits the limitation of claim 1 requiring that the instructions be “capable of causing the computer to . . . indicate on the user interface whether each item is owned or un-owned.” *Id.* at 9:51–61. The limitation in claims 23,¹⁴ 24, and 25 to “status icons” suggests a narrower scope than the “indicat[ion]” of claim 1,¹⁵ but Petitioner argues that “[t]he words ‘Yes’ and ‘No’” displayed in the ownership column of Looney’s master list, which Petitioner relied upon to teach the indication of claim 1, “are status icons.” Pet. 74 (citing Ex. 1004, 14:26–31; Ex. 1003 ¶ 160).

¹⁴ As discussed below, Petitioner argues that Morioka teaches the “status icons” of claim 23. Pet. 74. But Morioka forms no part of Petitioner’s argument for the obviousness of claims 24 and 25, *id.* at 67–68, so we do not consider it here.

¹⁵ Petitioner admitted at oral argument that there were indications within the scope of claim 1 that would not be status icons within the scope of claim 23, so “status icons” must have a scope at least somewhat narrower than “indicat[ions].” Tr. 70:3–13.

Petitioner’s argument raises two questions. First, how does the scope of claim 23’s “status icons” differ from that of claim 1’s “indicat[ions]”? Second, does Looney teach or suggest that differing scope? With respect to the first question, neither party requests that we construe the term “status icons.” Pet. 1–76; PO Resp. 6–19.

With respect to the second question, Petitioner cites two pieces of evidence to support its contention that “[t]he words ‘Yes’ and ‘No’ are status icons,” but neither piece of evidence supports the argument. Pet. 74 (citing Ex. 1003 ¶ 160; Ex. 1004, 14:26–31). First, Petitioner cites Looney’s disclosure, but the cited portion teaches merely “an ownership column” that “indicates” ownership status using the words “yes” and “no.” Ex. 1004, 14:26–31. This says nothing about the use of a “status icon” or whether the word “yes” or “no” constitutes such an icon. Second, Petitioner cites Dr. Myler’s testimony, but the cited portion of the testimony states only that “[t]he words ‘Yes’ and ‘No’ are status icons that indicate whether the song is owned or unowned” without further explanation. Ex. 1003 ¶ 160. “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a). Accordingly, Dr. Myler’s conclusory testimony cannot support a finding that the words “Yes” and “No” fall within the scope of claim 23’s “status icons.”

For these reasons, we are not persuaded that Petitioner has shown by a preponderance of the evidence that claims 24 and 25 would have been obvious over the combination of Looney, DeMartin, Cluts, and Wiser.

D. Obviousness over Looney, DeMartin, Cluts, Wiser, and Burke

Petitioner argues that claims 8, 14, 20, and 26 of the ’177 patent would have been obvious given the combined teachings of Looney,

DeMartin, Cluts, Wiser, and Burke. Pet. 68–71. Patent Owner does not argue any of these claims separately. PO Resp. 6–19.

1. *Burke*

Burke relates to “the processing, storage and activation of Internet address links.” Ex. 1008, 1:6–8. Burke teaches that computer files can be transferred from one computer to another using electronic communication protocols, including FTP and email. *Id.* at 4:3–17.

2. *Analysis*

Petitioner argues that claims 8, 14, 20, and 26 of the ’177 patent would have been obvious given the combined teachings of Looney, DeMartin, Cluts, Wiser, and Burke. Pet. 68–71.

a. Claims 8 and 14

Claim 8 depends from claim 7, and claim 14 depends from claim 13. Both of these claims add a limitation requiring that “the electronic communication [be] electronic mail.” Ex. 1001, 10:16–17, 10:34–35. Petitioner argues that Burke teaches this limitation. Pet. 69–71. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

DeMartin teaches transferring a playlist from an expert to a student using FTP. Ex. 1005, 5:52–57. Burke teaches transferring files between computers using either FTP or electronic mail. Ex. 1008, 4:3–17. Petitioner argues that a person of ordinary skill in the art would have modified the combination of Looney, DeMartin, Cluts, and Wiser by replacing DeMartin’s FTP file transfer with Burke’s email file transfer. Pet. 70. Specifically, Petitioner argues that this modification “is a simple substitute of one known equivalent element . . . for another . . . to yield predictable results.” *Id.* We agree. Burke does not describe the FTP and email file

transfer processes as “equivalent,” as Petitioner argues, but Burke does describe them as alternative processes that achieve the same result. Ex. 1008, 4:3–17. Moreover, Patent Owner does not dispute this argument. PO Resp. 6–19.

Accordingly, Petitioner has shown by a preponderance of the evidence that a person of ordinary skill in the art would have had a reason to combine the teachings of Burke with those of Looney, DeMartin, Cluts, and Wiser and that claims 8 and 14 would have been obvious over the combination of Looney, DeMartin, Cluts, Wiser, and Burke.

b. Claim 20

Claim 20 depends indirectly from claim 16. Ex. 1001, 10:58–59. As discussed above, Petitioner relies on Looney to teach or suggest the additional limitation of claim 16, but Petitioner has not shown this teaching by a preponderance of the evidence. As discussed above, Petitioner has not established that the combination of Looney, DeMartin, Cluts, and Wiser teaches or suggests all the limitations of claim 16. In arguing that claim 20 would have been obvious over the combination of Looney, DeMartin, Cluts, Wiser, and Burke, Petitioner does not argue that Burke teaches or suggests the limitations of claim 16 that we found not taught or suggested by the other references. Pet. 71. Accordingly, Petitioner has not shown by a preponderance of the evidence that claim 20 would have been obvious over the combination of Looney, DeMartin, Cluts, Wiser, and Burke.

c. Claim 26

Claim 26 depends from claim 23, which recites a limitation requiring “instructions [that] are further capable of causing the computer to generate status icons that indicate whether each item is owned or un-owned.”

Ex. 1001, 10:66–11:2, 12:3–5. Among the references relied on to show the obviousness of claim 26, Petitioner argues only that Looney teaches or suggests this limitation.¹⁶ As discussed above with respect to claims 24 and 25, however, Petitioner has not shown by a preponderance of the evidence that Looney actually does teach or suggest this limitation. Accordingly, Petitioner has not shown by a preponderance of the evidence that claim 26 would have been obvious over the combination of Looney, DeMartin, Cluts, Wiser, and Burke.

E. Obviousness over Looney, DeMartin, Cluts, and Morioka

Petitioner argues that claim 23 of the '177 patent would have been obvious given the combined teachings of Looney, DeMartin, Cluts, and Morioka. Pet. 71–75. Patent Owner does not argue this claim separately. PO Resp. 6–19.

1. Morioka

Morioka relates to “an automatic system of generating an icon displayed on the computer’s display screen and selected by a user.” Ex. 1009, 1:3–6. In Morioka, a command phrase such as “text deletion” is broken down into a noun and a verb, each of which is associated with an icon pattern, and the appropriate icon patterns are combined into an icon that replaces the command phrase. *Id.* at 5:1–27, Fig. 3. Morioka teaches that these icon patterns improve user-friendliness. *Id.* at code (57).

¹⁶ As discussed below, Petitioner argues that Morioka teaches the “status icons” of claim 23. Pet. 74. But Morioka forms no part of Petitioner’s argument for the obviousness of claim 26, *id.* at 71, so we do not consider it here.

2. *Analysis*

Claim 23 depends from claim 1 and adds a limitation requiring that “the instructions [be] further capable of causing the computer to generate status icons that indicate whether each item is owned or un-owned.”

Ex. 1001, 10:66–11:2. Petitioner argues that this claim would have been obvious given the combined teachings of Looney, DeMartin, Cluts, and Morioka. Pet. 71–75. Patent Owner does not dispute Petitioner’s argument. PO Resp. 6–19.

Looney teaches displaying the words “yes” and “no” in an ownership column as an indicator of whether a song is owned. Ex. 1004, 14:26–31. Morioka teaches replacing commands with graphical icons to improve user-friendliness. Ex. 1009, code (57), 5:1–27, Fig. 3. Petitioner argues that a person of ordinary skill in the art would have modified Looney’s text-based indicators with the teaching of Morioka in order to arrive at icon-based ownership indicators because doing so is merely a substitution of one known technique for another to yield predictable results. Pet. 74 (citing *KSR*, 550 U.S. at 417). We agree. Morioka teaches that graphical icons are “used in lieu of a more traditional command input,” Ex. 1009, 1:18–20, suggesting substitution of its graphical icons for other display options, such as text-based commands.

Accordingly, Petitioner has shown by a preponderance of the evidence that a person of ordinary skill in the art would have had a reason to combine the teachings of Morioka with those of Looney, DeMartin, and Cluts and that claim 23 would have been obvious over the combination of Looney, DeMartin, Cluts, and Morioka.

CONCLUSION¹⁷

Upon consideration of the papers and evidence before us, we determine that Petitioner has proven by a preponderance of the evidence that claims 1, 10, 12, 13, and 15, but not claim 16, are unpatentable as obvious over the combination of Looney, DeMartin, and Cluts. Petitioner also has proven by a preponderance of the evidence that claims 2–7, 9, and 11, but not claims 17–19, 21, 22, 24, and 25, are unpatentable as obvious over the combination of Looney, DeMartin, Cluts, and Wiser. Petitioner has proven by a preponderance of the evidence that claims 8 and 14, but not claims 20 and 26, are unpatentable as obvious over the combination of Looney, DeMartin, Cluts, Wiser, and Burke. Finally, Petitioner has proven by a preponderance of the evidence that claim 23 is unpatentable as obvious over the combination of Looney, DeMartin, Cluts, and Morioka.

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 10, 12, 13, 15, 16	103(a)	Looney, DeMartin, Cluts	1, 10, 12, 13, 15	16

¹⁷ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Decision, we draw Patent Owner’s attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. §§ 42.8(a)(3), (b)(2).

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
2–7, 9, 11, 17– 19, 21, 22, 24, 25	103(a)	Looney, DeMartin, Cluts, Wiser	2–7, 9, 11	17–19, 21, 22, 24, 25
8, 14, 20, 26	103(a)	Looney, DeMartin, Cluts, Wiser, Burke	8, 14	20, 26
23	103(a)	Looney, DeMartin, Cluts, Morioka	23	
Overall Outcome			1–15, 23	16–22, 24–26

ORDER

It is hereby

ORDERED that Petitioner has proven by a preponderance of the evidence that claims 1–15 and 23 of U.S. Patent No. 7,173,177 B1 are unpatentable;

FURTHER ORDERED that Petitioner has not proven by a preponderance of the evidence that claims 16–22 and 24–26 of U.S. Patent No. 7,173,177 B1 are unpatentable;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 318(b), upon expiration of the time for appeal of this decision, or the termination of any such appeal, a certificate shall issue canceling claims 1–15 and 23 and confirming the patentability of claims 16–22 and 24–26 of U.S. Patent No. 7,173,177 B1;

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2020-00006
Patent 7,173,177 B1

PETITIONER:

Edward D. Manzo
Nathan P. Sportel
HUSCH BLACKWELL, LLP
edward.manzo@huschblackwell.com
nathan.sportel@huschblackwell.com

Michelle Callaghan
Roshan S. Mansinghani
Jonathan R. Bowser
UNIFIED PATENTS INC.
roshan@unifiedpatents.com
jbowser@unifiedpatents.com
michelle@unifiedpatents.com

PATENT OWNER:

Isaac Rabicoff
RABICOFF LAW LLC
isaac@rabilaw.com