

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

WILDSEED MOBILE LLC,
Patent Owner

Case IPR2023-00246
U.S. Patent No. 9,141,960

PATENT OWNER'S RESPONSE

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	File History of U.S. Patent No. 9,141,960
2002	Case No. 3:22-cv-04928, Plaintiff Wildseed Mobile, LLC'S Patent L.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions
2003	U.S. Patent No. 9,141,960 Invalidity Contentions
2004	<i>Intentionally Left Blank</i>
2005	Declaration of Andrew G. Hamill In Support Of <i>Pro Hac Vice</i> Admission Under 37 C.F.R. § 42.10(c)
2006	Supplemental Declaration of Andrew G. Hamill In Support Of <i>Pro Hac Vice</i> Admission Under 37 C.F.R. § 42.10(c)
2007	Declaration of Robert Stillerman ("Stillerman Decl.")
2008	<i>Curriculum Vitae</i> of Robert Stillerman
2009	Transcript of the Deposition of Henry H. Houh, Ph.D.
2010	Richter, F., "The History of Portable Music," Statista, May 11, 2022, accessible at https://www.statista.com/chart/18555/portable-music-milestones/ , last accessed August 23, 2023
2011	Lynch, M., "The Difference Between Streaming and Downloading Media," The Tech Advocate, June 10, 2023, accessible at https://www.thetechadvocate.org/the-difference-between-streaming-and-downloading-media/ , last accessed August 24, 2023
2012	Definition of "streaming," Cambridge Dictionary, accessible at https://dictionary.cambridge.org/us/dictionary/english/streaming , last accessed August 23, 2023
2013	"Streaming," Verizon, February 21, 2023, accessible at https://www.verizon.com/articles/internet-essentials/streaming-definition/ , last accessed August 24, 2023

Exhibit No.	Description
2014	U.S. Patent Application Publication No. 2005/0262251 A1 to Klemets et al., published November 24, 2005
2015	Rouse, M., “Internet Radio,” Techopedia, December 9, 2016, accessible at https://www.techopedia.com/definition/3108/internet-radio , last accessed August 24, 2023
2016	U.S. Patent Application Publication No. 2013/0218970 A1 to Svendsen et al., published August 22, 2013
2017	Definition of “podcast,” Cambridge Dictionary, accessible at https://dictionary.cambridge.org/us/dictionary/english/podcast , last accessed August 23, 2023
2018	Definition of “podcast,” Merriam-Webster Dictionary, accessible at https://www.merriam-webster.com/dictionary/podcast , last accessed August 23, 2023
2019	Definition of “infer,” Merriam-Webster Dictionary, accessible at https://www.merriam-webster.com/dictionary/infer , last accessed August 23, 2023

I. INTRODUCTION

The Board should refuse to find claims 1-25 of U.S. Patent No. 9,141,960 (“the ’960 patent”) unpatentable.

First, Petitioner’s asserted combination of references does not disclose or render obvious at least two claim limitations of every independent claim of the ’960 patent. One of these limitations—“inferring, by the server, based at least in part on the retrieved *plurality* of media or the retrieved information about said *plurality* of media, one or more entertainment preferences of a user”—is not taught by the Petition’s cited art because only inferring preferences based on audio media is disclosed. Petitioner’s cited art also fails to disclose, teach, or suggest another limitation: a portable media player device that transmits its location to a server, which is recited by dependent claim 6, as well. Further, Petitioner impermissibly combines embodiments from a cited reference without explanation. These flaws are each fatal to the Petition.

Additionally, the Petition advances three- and four-reference combinations that rely on declaration testimony from Petitioner’s proffered expert, Dr. Houh. But Dr. Houh’s opinions should not be given any weight because his opinions on key issues repeat—often *verbatim*—the conclusory arguments presented in the Petition. Because Petitioner relies on Dr. Houh’s conclusory testimony throughout the Petition, every ground of unpatentability lacks sufficient evidentiary support

from the perspective of a skilled artisan on key issues—such as the teachings of the references and motivations to support the proposed combinations—and thus the Petition fails to show that the claims would have been obvious.

II. THE '960 PATENT

A. Summary

The '960 patent, titled “Venue and Event Recommendations for A User of A Portable Media Player Device,” issued on September 22, 2015, was filed on June 23, 2008, and claims priority to U.S. Provisional Application No. 60/945,677, filed on June 22, 2007. EX1001, [22], [45], [54], [60].

The '960 patent notes that “[w]ith the advance of storage technology, the amount of media that can be stored in a portable media player device has grown exponentially.” *Id.*, 1:48-50. Additionally, “with the advance of telecommunications and networking technology, the number of sites offering media and other media-rich environments to provide new and/or replacement media content for portable media player devices have also grown exponentially.” *Id.*, 1:51-55.

The '960 patent “relates to venue or event recommendations for a user of a portable media player device.” *Id.*, 1:18-20. The '960 patent describes a server that transmits the venue or event recommendations to the portable media player device. *Id.*, 3:51-4:11.

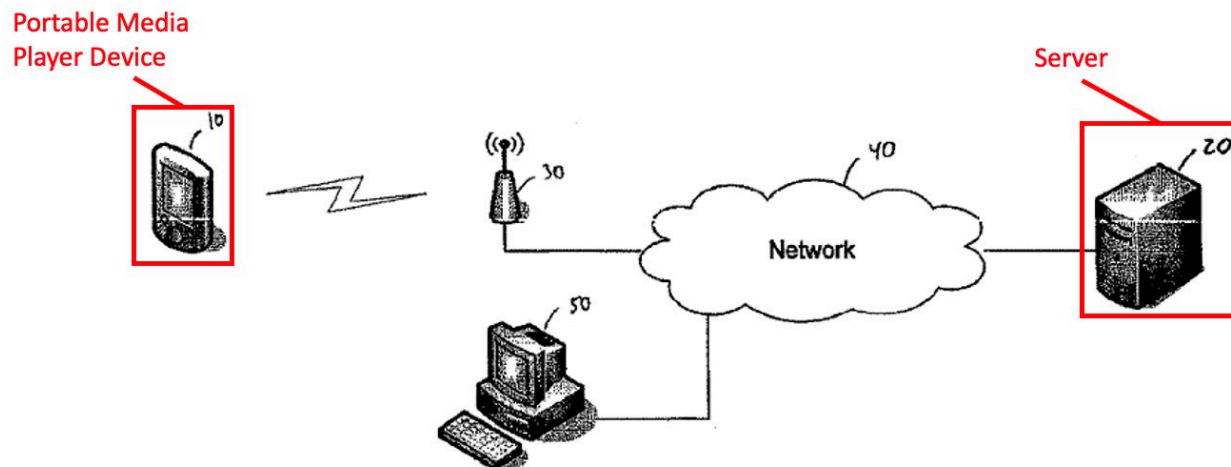


Figure 1

EX1001, FIG. 1 (annotated).

The server infers the preferences of the user of a portable media player device based on an analysis of a wide variety of media types, such as “music, podcasts, books or audiobooks, video, photos or other images.” EX1001, 5:26-32. The server also infers the current location of the user of the portable media player device. *Id.*, 4:32-34. The server transmits venue or event recommendations based on the user’s inferred preferences and current location. *Id.*, 4:16-20, 4:27-31. Figure 2 illustrates the role of the server in determining the location and entertainment preferences of the user, and generating a recommendation for a venue or event.

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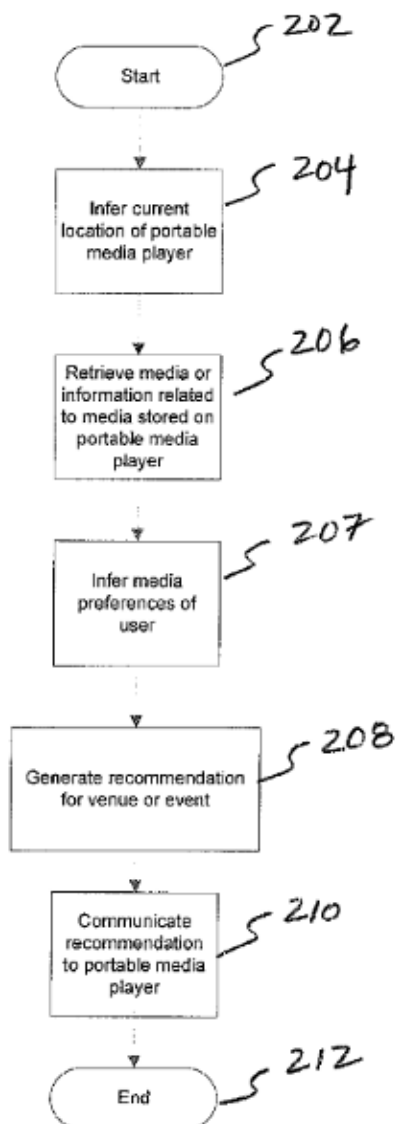


FIGURE 2

EX1001, FIG. 2.

B. '960 Patent Prosecution History

Claim 1 of the originally filed application that led to the '960 patent included a limitation requiring a server to infer a media preference of a user:

wherein the recommendation is based at least in part on the . . . inferred media preference of a user of the portable media player device, *wherein the inferred media preference is determined based at least in part on media stored on or accessed* using the portable media player device.

EX2001, 18¹. The initial version of claim 1 did not require basing the inference of the user's preferences on more than one type of media. *Id.*; EX2007, ¶71.

After a rejection by the Examiner, the Applicant amended claim 1:

inferring, by the server, based at least in part on the retrieved one or more of media or media-associated meta data, one or more entertainment preferences of a user of the portable media player device;

EX2001, 77. The amended claim 1 did not yet require basing the inference of a user's entertainment preferences on more than one of media or media-associated metadata. EX2007, ¶72.

After another rejection, however, the Applicant further amended claim 1 to require basing the inferred entertainment preferences of the user on a *plurality* of media or retrieved information about said *plurality* of media.

¹ Emphasis is added throughout unless otherwise noted.

inferring, by the server, based at least in part on the retrieved ~~one or more of~~ plurality of media or the retrieved information about said plurality of media ~~media-associated meta data~~, one or more entertainment preferences of a user of the portable media player device;

EX2001, 119; EX2007, ¶73.

Further, in distinguishing the Ng reference cited by the Examiner, Applicant argued that entering user preference information does not satisfy the *inferring* portion of this claim limitation: “Thus, Ng teaches that a user ‘preference’ is either *entered by the user* of the device . . . or is *inferred based on the user’s location*” *Id.*, 131 (emphasis in original).

After further rejections (but no further amendment to this limitation), the Applicant appealed to the P.T.A.B. *Id.*, 217-245. In the Board’s decision, the panel addressed the inferring step, finding:

The recited step of “inferring, by the server, based at least in part on the retrieved plurality of media or the retrieved information about said plurality of media, one or more entertainment preferences of a user of the portable media player device” infers the user preferences based on the retrieved media or the retrieved information about the retrieved media. In other words, “entertainment preferences of a user” are not the recited basis for the “inferring”; instead, those preferences are themselves inferred. Considering the proper interpretation of the disputed claim limitation, the Examiner has not identified any teachings in Ng that would meet the claimed step of inferring.

EX2001, 299. Claim 1 of the ’960 patent then issued with this language.

C. Person of Ordinary Skill in the Art (POSITA)

“[T]he level of skill in the art is a prism or lens through which ... the Board views the prior art and the claimed invention.” *Okajima v. Bourdeau*, 261 F.3d 1350, 1354-55 (Fed. Cir. 2001). “This reference point prevents these factfinders from using their own insight or, worse yet, hindsight, to gauge obviousness.” *Id.*

Petitioner and Dr. Houh contend that a POSITA “would have a bachelor’s degree in electrical engineering, or equivalent training, and approximately two years of experience working in the field of portable devices. Lack of work experience can be remedied by additional education, and vice versa.” EX1003, ¶20; Pet. 12-13.

Patent Owner’s expert proposes a similar level of ordinary skill. EX2007. ¶¶35-38. In particular, a POSITA “would have had a degree in computer science, computer engineering or related field and one year of experience in working with portable devices.” *Id.*, ¶37. “Additional education could compensate for less practical experience and vice versa.” *Id.* Petitioner’s asserted grounds fail under either party’s definition of a POSITA. *Id.*

D. Claim Construction

Patent Owner agrees with Petitioner that the terms of the challenged claims should be given their plain and ordinary meaning. Pet., 13. Further discussion

regarding the plain meaning of certain claim limitations is pertinent to resolving the parties' dispute.

1. “the retrieved plurality of media or the retrieved information about said plurality of media”

Claim 1 recites a method in which a claimed server performs the step of “inferring, by the server, based at least in part on the retrieved *plurality of media* or the retrieved information about said *plurality of media*, one or more entertainment preferences of a user of the portable media player device.” EX1001, Claim 1. By its plain language, this limitation requires that the inference of the user's entertainment preferences be based on *more than one* media or information about *more than one* media. EX2007, ¶¶81-83.

2. “inferring, by the server ... one or more entertainment preferences of a user...”

Claim 1 recites “inferring, by the server, based at least in part on the retrieved plurality of media or the retrieved information about said plurality of media, one or more entertainment preferences of a user[.]” The plain language of the claim requires that the entertainment preferences be inferred. EX2007, ¶¶84-91. The plain and ordinary meaning of “infer” is “to derive as a conclusion from facts or premises.” EX2019; EX2007, ¶84. If a user preference is explicitly provided, as in Sasaki for example, then this preference is not derived from anything—let alone “based at least in part on the retrieved plurality of media or the retrieved

information about said plurality of media,” as claimed—and accordingly is not inferred. EX2007, ¶84. The Institution Decision suggests that the claims can encompass forming inferences based on user preference keywords entered by a user. DI, 17. Claim 1, however, requires that the user preferences themselves are inferred, not that they form the basis of the inference. EX2007, ¶87. This is an important distinction.

Furthermore, this construction is consistent with Applicant’s statements made during prosecution to distinguish the Ng reference. EX2007, ¶85. As discussed above, Applicant distinguished the Ng reference by stating, “Ng teaches that a user ‘preference’ is either entered by the user of the device . . . or is inferred based on the user’s location.” EX1002, 210; *supra* Section II.B. The Applicant, thus, argued against a claim scope that covers the user simply providing user preference information or inferring the preferences based on something other than “the retrieved plurality of media or the retrieved information about said plurality of media,” as claimed. EX2007, ¶85. Patent Owner’s construction also is consistent with the Board’s finding regarding the ’960 patent claims, that “‘entertainment preferences of a user’ are not the recited basis for the ‘inferring’; instead, *those preferences are themselves inferred*.” EX1002, 39. The Board should treat this limitation consistently here.

Accordingly, in order to meet the plain language of the claims, the recited “entertainment preferences of a user” cannot simply be provided by the user or inferred from other known or stored preferences, but rather, must be “*infer[red]* ... based at least in part on the retrieved plurality of media or the retrieved information about said plurality of media.” EX2007, ¶89.

* * *

Petitioner acknowledges that independent claims 11, 16, and 21 have substantially similar limitations as those of claim 1 discussed above. Pet., 46, 55-56, 59. Patent Owner submits that the above claim construction discussion applies to those claims as well.

III. PETITIONER FAILS TO DEMONSTRATE THE OBVIOUSNESS OF ANY CHALLENGED CLAIM.

Petitioner contends the independent claims would have been obvious under 35 U.S.C. § 103 based on the combination of Sasaki, Ellis, and Jacobi. Pet. 20. The combination of Sasaki and Ellis,² however, fails to disclose, teach, or suggest one

² Petitioner relies on Jacobi only for its disclosure of “techniques for generating and displaying recommendations to the user.” Pet. 27; *see, e.g., id.*, 37-39 (claim element 1.5-1.6). These claim elements are not the focus of Patent Owner’s arguments herein and so Jacobi is not further discussed herein.

or more limitations in each of the '960 patent's independent claims. First, as discussed below, neither Sasaki nor Ellis teaches or suggests relying on the claimed plurality of media to infer a user's entertainment preferences. EX2007, ¶¶132-145. Instead, Ellis discloses a device that pertains only to audio content and, in fact, teaches away from applying its teachings to other media, such as video. EX2007, ¶¶133-136, 122-124. Second, Sasaki and Ellis also fail to disclose, teach, or suggest a server that determines the location of a portable media player device or a portable media player device that sends location information to a server. *Id.*, ¶¶146-158. Sasaki discloses only portable terminal devices that send location information as part of a recommendation sent to other portable terminal devices, not to a server from which it receives a recommendation. *Id.*, ¶¶147-153. And Ellis teaches only a portable device that determines its own location for use locally and does not send it to a server. *Id.*, ¶¶156-159. Third, Petitioner impermissibly combines embodiments from Sasaki without explanation. *Id.*, ¶¶129-131. Each of these flaws is fatal to Petitioner's obviousness challenge.

Furthermore, Petitioner also fails to meet its burden of establishing obviousness of at least one dependent claim. Petitioner does not establish that Sasaki and Ellis render obvious a portable device that transmits its location to a server (claim 6).

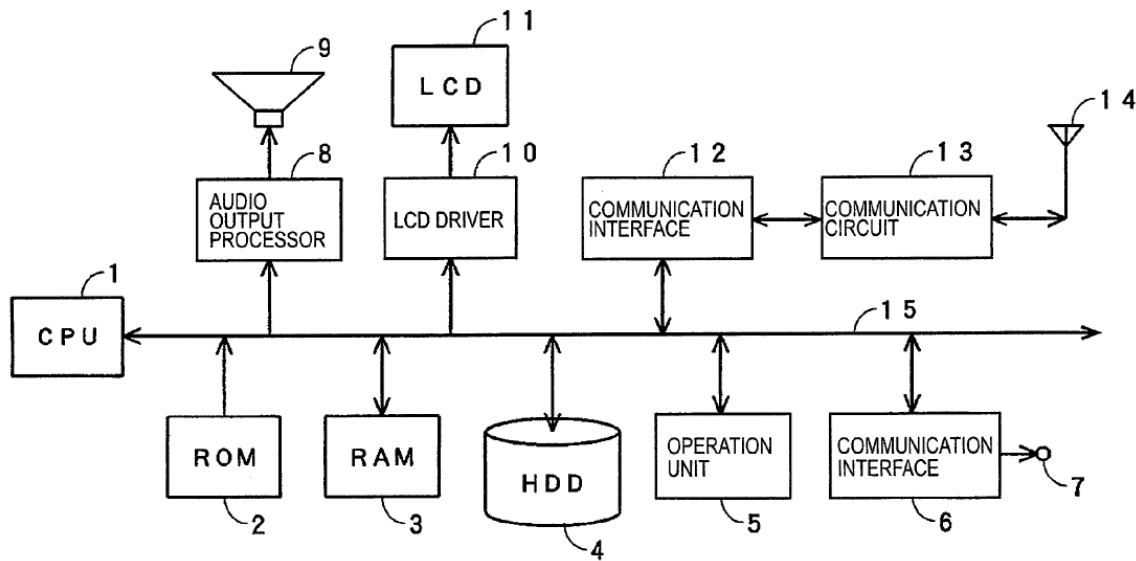
A. Summaries of the Asserted References

1. Sasaki

Sasaki relates to the transmission of electronic media content recommendations to users of portable media terminals. Sasaki discloses two distinct embodiments. EX2007, ¶¶92-105. Sasaki discloses a first embodiment involving the transmission of media content recommendation information from one portable terminal device to another portable terminal device. Sasaki discloses a second embodiment involving the transmission of media content recommendation information from a server to a portable terminal device. EX1004, ¶¶29-111 (terminal-to-terminal embodiment), ¶¶112-130 (server-to-terminal embodiment).

The portable terminal device, illustrated by Figure 1, includes “a central processing unit (CPU) 1, a read-only memory (ROM) 2, a random access memory (RAM) 3, a hard disk drive (HDD) 4, an operation unit 5, a communication interface 6, a communication terminal 7, an audio output processor 8, a speaker 9, an LCD (liquid crystal display) driver 10, an LCD 11, a communication interface 12, a communication circuit 13, and a transmitting/receiving antenna 14.” *Id.*, ¶29.

FIG. 1



EX1004, FIG. 1.

The portable terminal device can receive “audio data such as music, and image data such as still images and video ... and can record and store the audio data and the image data in the HDD 4.” EX1004, ¶¶45-47. The server of the server-to-terminal embodiment includes similar components but does not need audio and video playback systems and therefore does not include an audio output processor, speaker, LCD driver, and LCD. *Id.*, ¶113.

The particular media content recommendation information may be based on preferences of the user receiving the recommendation. *Id.*, ¶¶83, 99-100, 119. Although preferences are taken into account, in each embodiment, the user preference information is explicitly provided, e.g., registered in the hard disk drive

(HDD) of the terminal device or stored beforehand at the server. *Id.*, ¶¶73, 126, 128, 130.

Sasaki's Figure 3A illustrates the content recommendation data stored "in the transmitting area of the HDD 4," including "information of recommenders' recommendation comments, and locations at which sample data items of recommended content are stored." *Id.*, ¶66.

FIG. 3A

RECOMMENDATION COMMENT INFORMATION, ETC.	SAMPLE
MANHATTAN! AT DUSK!	NYview.jpg
THIS PIECE OF MUSIC IS THE BEST OF Mike XXXXX, THE SECOND NUMBER OF ALBUM "XXX".	Rocking.mp3

EX1004, FIG. 3A.

As discussed with respect to Sasaki's Figure 3C, user preference information is explicitly entered into the terminal device: "As shown in FIG. 3C, *by entering*, in the preference information area of the HDD 4, *preference information including content types and preference keywords* of the user of the terminal device, and using the preference information to selectively use pieces of content recommendation information, only a piece of content recommendation information that matches user's preferences can be obtained." EX1004, ¶73; *see also id.*, ¶85 ("[P]reference information . . . is registered in the preference information area of the HDD 4 in [the] terminal device . . ."). In Sasaki's server-to-terminal embodiment, users

update the preference information stored by the server by using a “personal computer at a home to access a service site through a network such as the Internet” or by using “a terminal device such as a cellular phone.” *Id.*, ¶128; *see also id.*, ¶126 (“[P]reference information . . . [is] stored beforehand . . .”). There is no disclosure in Sasaki of a server inferring or determining a user’s preferences.

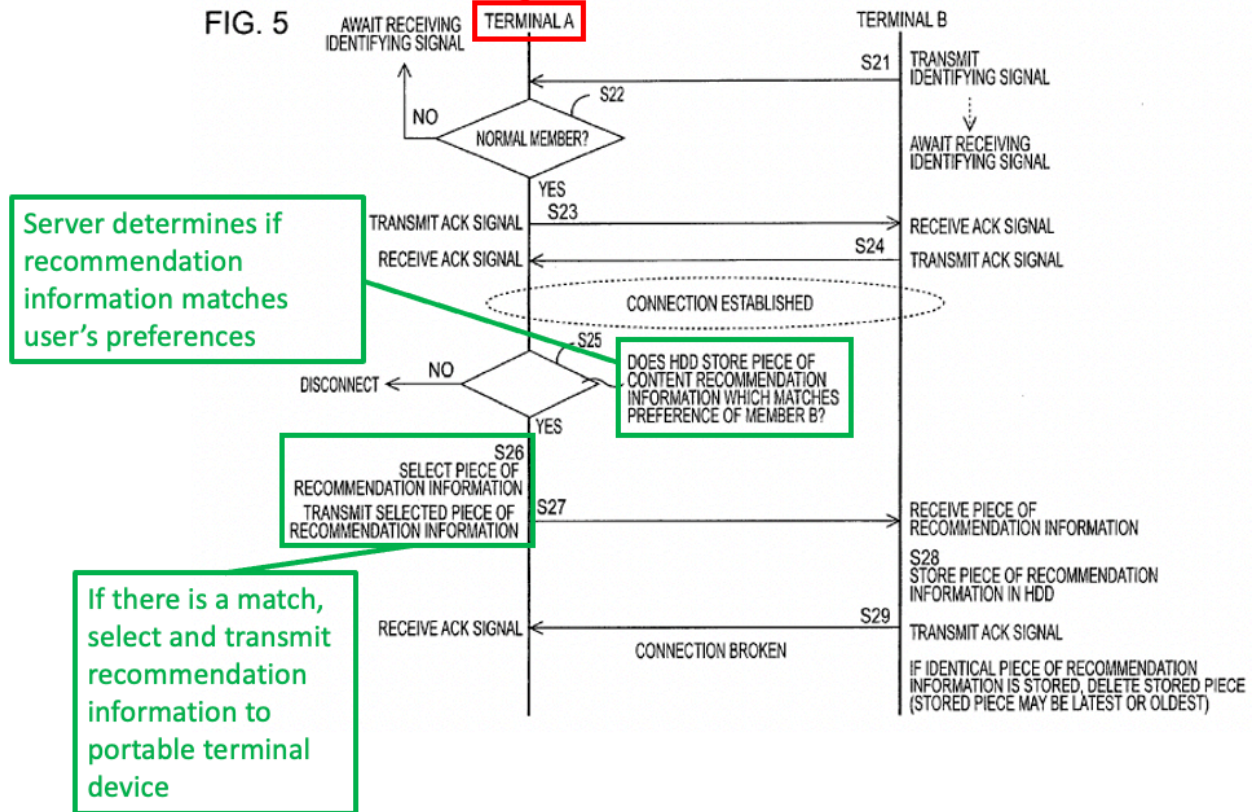
FIG. 3C

CONTENT TYPE	PREFERENCE KEY WORDS
MUSIC	MIKE XXXXX; ROCK; BEATLES; LOVE
PHOTOGRAPH	MOUNT FUJI; NIGHT VIEW; LANDSCAPE; PROSPECT; MOUNTAINS, SEA, SKY; DUSK; SUNSET

EX1004, FIG. 3C.

Sasaki’s Figure 5 depicts the sequence of communications for Sasaki’s second (server-to-terminal) embodiment. In this embodiment, “communication is performed between the server [located at a service spot] and terminal device B.” EX1004, ¶113. Sasaki describes a “service spot” as “a predetermined area in which various types of information are provided to users or members”—“such as CD/DVD shops and bookstores, sightseeing areas, attraction places, art museums, museums, movie theaters, coffee shops, hotel lobbies, and other public facilities”—“and in which a server for providing content recommendation information to terminal devices is installed.” *Id.*, ¶114.

Fig. 5's Terminal A refers to the server. Sasaki ¶¶0113, 0116.



EX1004, FIG. 5 (annotated).

“At the service spot, the installed server provides content recommendation information to a user's terminal device and the terminal device receives and stores the content recommendation information in the HDD 4 of the terminal device.”

EX1004, ¶115. In this regard, “the CPU 1 of the server determines whether or not the HDD 4 of the server stores a piece of content recommendation information which matches a preference of the member of terminal device B.” *Id.*, ¶119. If there is a match, “the server selects the piece of content recommendation information that matches the preference of the member of the terminal device B,

and, in step S27 transmits the selected piece of content recommendation.” *Id.*, ¶120.

Sasaki’s discussion of the first (terminal-to-terminal) embodiment describes the transmission of recommendation and location information. But in this embodiment, portable terminal A “determines whether or not any one piece of the content recommendation information [stored in the transmitting area of HDD 4 in terminal device A] matches the one or more preference keywords of preference information from terminal device B,” *id.*, ¶99, and, if there is a match, “transmits the selected piece of content recommendation information to terminal device B,” *id.*, ¶100. Regarding the first embodiment, Sasaki further describes the portable terminal device communicating its location as part of the content recommendation information:

[T]he content recommendation information to be transmitted does not contain only the information shown in FIG. 3A. Necessary information, such as an owner of a transmitting terminal device, a date and time of transmission, *and a place of transmission*, is added to the content recommendation information

Id., ¶68. In other words, the terminal device that is *providing* the recommendation information—namely, terminal device A, which corresponds to the *server* in the second (server-to-terminal) embodiment—transmits location information. In contrast, in Sasaki’s second embodiment (server-to-terminal) the portable terminal

device only *receives* recommendation information, so it does not transmit its location.

2. Ellis

Ellis relates to radio systems, including “enhanced radio reception and processing features, utilizing multiple radio receivers, digital storage of radio content, independent control of radio reception and playback, listener profiles, and two-way communication features.” EX1005, ¶2; EX2007, ¶¶106-115.

According to Ellis, “[r]adio is a very popular entertainment source today.” EX1005, ¶3. “It is used in many locations-in the home, in the automobile, at the office, and on the go.” *Id.* Ellis recognizes, however, that “radio functions have been fairly constant for years.” *Id.* Ellis states that “[a] system is needed that allows a radio listener to better control the audio content she hears.” *Id.*, ¶7.

Ellis discloses an “Enhanced Radio System (ERS),” which is a portable device that “may be used at home, at the office, in the shower, on the go, in the car, on the boat, or in any other environment.” *Id.*, ¶¶21, 24. The ERS “may tune in one or more radio sources, such as broadcast radio, satellite radio, Internet radio, shortwave radio, and radio scanner.” *Id.*, ¶25. The ERS simultaneously stores “content from multiple radio receivers” and allows the user to “quickly select output from the stored content.” *Id.*, ¶21. The ERS “may ... keep track of user radio preferences, and may have the ability to recognize specific content items,

such as songs, that the user may like.” *Id.*, ¶185. Although Ellis describes the ability of the ERS to connect to a “central facility,” *id.* ¶265, the only examples of the system determining user listening preferences describe the ERS portable device itself performing the determination. *Id.*, ¶¶212, 221.

B. Independent Claims 1, 11, 16, and 21 are not rendered obvious by Petitioner’s asserted combination.

Petitioner fails to show that the asserted combinations render obvious two limitations of each independent claim. Petitioner also fails to establish that a POSITA would have been motivated to combine the asserted references. ***First***, each independent claim requires that the user preferences are inferred based at least in part on a plurality of media or retrieved information about a plurality of media. EX1001, Claims 1, 11, 16, 21. The asserted combination of Sasaki and Ellis teaches only inferring user preferences based on audio media. ***Second***, each of the claims require a server to use the location of a portable media player device or a portable media player device to transmit its location to a server. Claims 1 and 21 recite that a server accesses (or has instructions that, when executed, cause the server to access) information about venues or events proximal to the current location of the user. Claims 11 and 16 recite a portable media player device that transmits (or has instructions that, when executed, cause the portable media player device to transmit) its location information to a server. Neither Sasaki nor Ellis teach a portable media player device transmitting location information to a server

or a server otherwise determining the location of a portable media player device.

Third, the Petition fails to meet its burden of establishing why a POSITA would have been motivated to combine Sasaki and Ellis. Further, the Petition relies on two embodiments in Sasaki without even addressing motivation to combine. Thus, Petitioner fails to carry its burden of showing that the asserted combinations render obvious any independent claim.

1. **Petitioner’s combination of Sasaki and Ellis fails to teach “inferring, by the server, based at least in part on the retrieved plurality of media or the retrieved information about said plurality of media, one or more entertainment preferences of a user of the portable media player device” as recited in claim 1 and similarly recited in claims 11, 16, and 21.**

Claim 1 recites “*inferring, by the server, based at least in part on the retrieved plurality of media or the retrieved information about said plurality of media, one or more entertainment preferences of a user of the portable media player device[.]*” EX1001, Claim 1. As Petitioner acknowledges, claims 11, 16, and 21 have substantially similar limitations. Pet., 45-46, 55-56, 59. As discussed above, the plain language of the claim, as confirmed by the file history discussion of this limitation, requires that the server infer the one or more entertainment preferences based at least in part on a plurality of media or information about a plurality of media. *Supra* Sections II.B., II.D.1; EX2007, ¶¶81-83.

Petitioner relies on the combination of Sasaki and Ellis to argue that this limitation would have been obvious. Pet., 31-33. However, neither Sasaki nor Ellis discloses, teaches, or suggests relying on a plurality of media or information about a plurality of media to infer a user's preferences. EX2007, ¶¶132-145. And Petitioner does not meet its burden of establishing why it would have been obvious to do so. *Id.*

a) Sasaki does not disclose or suggest inferring a user's entertainment preferences at all.

First, Sasaki does not disclose or suggest *inferring* a user's entertainment preferences at all. EX2007, ¶¶139-139. Instead, as discussed above, Sasaki discloses a system where user preferences are explicitly provided. EX1004, ¶¶73, 128, 130. Sasaki explains that “*by entering, in the preference information area of the HDD 4, preference information including content types and preference keywords of the user of the terminal device, and using the preference information to selectively use pieces of content recommendation information, only a piece of content recommendation information that matches user's preferences can be obtained.*” EX1004, ¶73; *see id.*, ¶85. In Sasaki's second (server-to-terminal) embodiment, users update the preference information stored by the server by using a “personal computer at a home to access a service site through a network such as the Internet” or by using “a terminal device such as a cellular phone.” *Id.*, ¶¶128, 130; *see id.*, ¶126. However, as discussed above, explicitly providing user

preference information, as disclosed in Sasaki, is not encompassed by the claim language, which requires *inferring* the user's entertainment preferences. *Supra* Section II.D.2; EX2001, 131. Therefore, Sasaki does not disclose or suggest the inferring limitation. EX2007, ¶¶137-139.

In the Institution Decision, the Board preliminarily found that “Sasaki’s system relies on inferences.” DI, 17. Pointing to Sasaki’s Figure 3C and the use of “generic preference key words” entered by a user, the Board stated:

Different users for example, may have different (subjective) opinions of what ‘entertainment preference’ arises from generic key words such as ROCK and LOVE, so that a match by the server of such a generic word provided by different users is an inference of an entertainment preference.

DI, 17.

At the outset, Patent Owner notes that Petitioner does not allege that Sasaki discloses inferring a user’s entertainment preferences, instead relying on Ellis to teach this element. Pet., 31-33; *see also* EX2009, 35:14-36:8, 37:19-22, 38:2-3, 39:5-11 (Dr. Houh confirming that he relies on Ellis, not Sasaki, for the disclosure of determining a user’s preferences). Further, the Board’s preliminary finding here is inconsistent with the plain language of the claims. EX2007, ¶¶84-91. Claim 1, for example, recites “inferring ... one or more entertainment preferences of a user” (e.g., that the user likes a certain type of music). Claim 1 does not recite inferring

whether a specific media item falls within the user's preferences (e.g., whether a particular song matches a generic key word entered by a user). Although the Board indicated that the server in Sasaki determines whether a specific media item falls within the user's preferences, the server in Sasaki does not infer those preferences, as required by the claims. Rather, the user provides them. EX1004, ¶¶73, 128, 130.

This important distinction also is consistent with statements made during prosecution, where Applicant distinguished the Ng reference because “Ng teaches that a user ‘preference’ is ... *entered by the user of the device*[.]” EX1002, 210 (emphasis in original).

The Institution Decision preliminarily found that the claims could encompass a “match by the server of a generic [key] word provided by different users” as an “inference of an entertainment preference.” DI, 17. But, as discussed, the claim recites “infer[ring] one or more entertainment preferences *of a user*.” EX1001, Claim 1. Categorizing media into generic categories based on different users' subjective description of the media in order to match it to a user's preselected genre preferences is not the same as inferring what the particular user's entertainment preferences are based on the media stored on their device. EX2007, ¶¶85, 87. As described in the '960 patent, for example:

In various embodiments, the server can analyze the media and the information about the media stored on or accessed using the portable media player device to identify user preferences for particular genres of

media. Thus, in various embodiments, the server may analyze e.g. the meta data associated with a wide variety of media stored on or accessed using the portable media player device such as music, podcasts, books or audiobooks, video, photos or other images for various trends that can be translated into user preferences for a particular genre of music, film, video or art. The meta data may include data about the media title, media type, artist, subject matter, and so forth. For example, the server may determine that the user has a preference for a jazz music genre if the portable media player device stores or has been used to access a substantial amount of music by famous jazz artists such as Ella Fitzgerald or Louis Armstrong.

EX1001, 5:22-38.

In distinguishing Ng, Applicant clarified that “entertainment preferences of a user” must be “infer[red]” by the server, and that they cannot be entered by the user (as in Sasaki). EX1002, 210. For this distinction to be as narrow as the Board implies (DI, 17), a user “preference” would need to be an exhaustive list of every specific writing, picture, song, movie, show, or other piece of media that falls within the user’s taste. EX2007, ¶88. Anything short of an exhaustive list would require the server to perform some “inference” to determine whether a specific media item falls within the user’s preferences. *Id.* This interpretation is contrary how a POSITA would understand the Applicant’s statement distinguishing Ng and thus should be rejected. EX2007, ¶¶84-86.

Regarding Sasaki's disclosure at ¶74, which the Board highlights in the Institution Decision, DI, 17, this discussion is related to the *recommendation of* various media, e.g., "CD music, still pictures ..., DVD video, and text data," once preference information is *already known* (i.e., by having been provided by the user). EX1004, ¶¶73-74. Sasaki teaches that once a user's preference information *is entered into* the HDD 4, only pieces of content recommendation information that match that user's preferences can be obtained. *Id.*, ¶¶73-74. The *recommended content* itself may be music, image, video, or text media. *Id.*, ¶74. But Sasaki does not disclose or suggest inferring a user's preferences based on the media or information about the media stored on or accessed by their device.

Thus, neither the Petition nor the evidence of record support a finding that Sasaki discloses or suggests inferring a user's entertainment preferences at all, let alone based on the recited plurality of media. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) ("[W]hile the PTO has broad authority to establish procedures for revisiting earlier-granted patents in IPRs, that authority is not so broad that it allows the PTO to raise, address, and decide unpatentability theories never presented by the petitioner and not supported by record evidence.").

b) Ellis does not disclose or suggest inferring a user's preferences based on the claimed plurality of media content types.

Second, Ellis discloses a system that only determines a user's preferences for radio (i.e., audio) content. EX2007, ¶¶133-136. The examples cited in the Petition each refer to determining preferences based on what a user has *listened* to:

The system may also monitor the content *listened to* by the user, and automatically determine the groups liked and disliked

EX1005, ¶212.

The system may also determine user preferences automatically by monitoring what content the user *listens to*.

Id., ¶185.

In step 2220, the system may determine user information automatically by monitoring the content the user *listens to*. For example, the system may add points to a specific song, artist, genre, or other type of item or grouping, based on the user *listening to* an entire item.

Id., ¶221; Pet., 34-35. Thus, Ellis teaches determining user preferences based only on a single media, namely audio media. Ellis does not disclose or suggest inferring user preferences based on a plurality of media content types.

- c) **Petitioner's combination does not disclose or suggest inferring a user's entertainment preferences based on a plurality of media, and Petitioner does not meet its burden of establishing why it would have been obvious to do so.**

The combination of Sasaki and Ellis fails to disclose or suggest inferring a user's preferences based on any media other than audio media. As discussed above, the claim recites inferring a user's preferences based on *a plurality* of media. *Supra* Section II.D.1. Because neither Sasaki nor Ellis discloses inferring a user's entertainment preferences based on a plurality of media and because Petitioner does not meet its burden of establishing why it would have been obvious to combine the references teachings to do so, Petitioner's combination must fail. EX2007, ¶¶132-145.

In the Institution Decision, the Board stated that Patent Owner's argument that Ellis teaches only determining preferences based on audio media does not undermine Petitioner's showing because Petitioner relies on Sasaki for its disclosure of several media and relies on the combined teachings of Sasaki and Ellis to infer preferences. Institution Dec., 18. However, the claims are not met by a mere disclosure of a plurality of media; the claims require inferring preferences based on a plurality of media. *Supra* Section II.D.1. Neither Sasaki nor Ellis teaches this key claim element. EX2007, ¶¶132-145.

Even if Sasaki and Ellis were combined, there is no disclosure in either reference of a server that infers user preferences based on a plurality of media. *Id.*, ¶¶144-145. This is not an attack on Sasaki and Ellis individually, but rather on the combination of the two references. Petitioner provides no explanation of how a POSITA would implement Ellis’s method of determining preferences based only on what a user has listened to in Sasaki’s system to arrive at the claimed invention, which requires inferring preferences based on a plurality of media. *Id.*, ¶¶83-83. So Petitioner’s arguments fail.

Petitioner further contends that “Sasaki discloses that its recommendation system collects information about different media content types, such as ‘music,’ ‘still pictures,’ ‘video,’ and ‘text.’” Pet., 33 (citing EX1004, ¶74). But, as explained above, Sasaki’s ¶74 teaches only that the *recommended content* itself may be music, image, video, or text media. EX1004, ¶74. In other words, Sasaki teaches a plurality of media on a terminal device that is *making* a recommendation. Sasaki does not disclose or suggest collecting information about media stored on or accessed by the device of a user that is *receiving* the recommendation in order to make an inference about that user’s preferences.

Petitioner also does not explain how or why a POSITA would have further modified its proposed combination of Sasaki and Ellis to additionally include determining user’s preference information based on a plurality of media. Pet., 31-

33; EX2007, ¶¶144-145. In fact, Dr. Houh’s declaration on this critical element merely repeats almost the identical language from the Petition with the exception that Dr. Houh’s declaration merely adds block quotes from the references.

Compare Pet., 31-33, with EX1003, ¶¶84-90. Dr. Houh’s testimony is thus entitled to little weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-16 (P.T.A.B. August 24, 2022) (precedential) (holding that the Board may not credit declaration testimony that “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support.” (emphasis in original)); 37 C.F.R. § 42.65(a).

Petitioner therefore fails to carry its burden of establishing obviousness.

In sum, neither Sasaki nor Ellis—individually or in combination—disclose or suggest inferring user preferences based on a plurality of media. EX2007, ¶¶144-145. And Petitioner provides no explanation as to why it would be have been obvious to do so based on the teachings of Sasaki and Ellis. EX2007, ¶145. It is Petitioner’s burden to explain with particularity how and why a POSITA would have combined the asserted art to arrive at the claimed invention. Petitioner has not done so here, and therefore, Petitioner has not shown by a preponderance of the evidence that the combination of Sasaki and Ellis renders the claims obvious. *Id.*, ¶¶145, 165, 170.

2. Petitioner’s proposed combination impermissibly relies on two distinct embodiments from Sasaki without explanation.

Petitioner’s asserted ground challenging each of the independent claims combines features of two distinct embodiments from Sasaki without explaining why or how a person of ordinary skill in the art would have been motivated to make the combination. EX2007, ¶¶128-131. This flaw is fatal to Petitioner’s challenge.

Indeed, it is *Petitioner’s burden* to establish that a POSITA would have been motivated to combine different references or different embodiments within a reference. *See Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 9 (IPR2017-01204), Paper 8 (IPR2017-01205) at 9-11 (P.T.A.B. Oct. 23, 2017) (finding that “Petitioner has failed to establish sufficiently that the features of [] different embodiments [of the asserted reference] are interchangeable or provide sufficient rationale to combine the teachings of those different embodiments”); *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references, *combining multiple embodiments from a single reference*, or selecting from large lists of elements in a single reference, *there must be a motivation to make the combination* and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”). Thus, because Petitioner did not explain why or how a POSITA

would have combined these two separate embodiments of Sasaki, Petitioner cannot meet its burden of proving unpatentability of the challenged claims. *In re Magnum Oil.*, 829 F.3d at 1375 (“In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.” (quoting *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015))).

Petitioner relies extensively on Sasaki’s second server-to-terminal embodiment in mapping Sasaki to the claims. *See, e.g.*, Pet., 29-31. However, for certain claim elements, Petitioner relies on Sasaki’s first terminal-to-terminal embodiment, with no acknowledgement of switching between embodiments or addressing the differences between them. EX2007, ¶¶128-131. Although Sasaki states that the content recommendation system is applicable to a server, EX1004, ¶17, and that, in the server-to-terminal embodiment, one of the terminal devices is replaced by a server, *id.*, ¶115, it is not the case that the two embodiments are identical with the exception of swapping out a terminal device for a server. Sasaki describes the two embodiments in detail and differences between them, including the differences in the information transmitted by the terminal devices in each embodiment. EX2007, ¶¶110-123. These differences are material to Petitioner’s combination and Petitioner simply ignores them. EX2007, ¶¶147-152.

For example, Petitioner contends that “Sasaki teaches that its portable media player device can directly transmit location information (either GPS or radio wave positional information),” Pet., 34, and that “Sasaki teaches that the server infers the location of the user by having the portable media player device associated with the user directly transmit location information[.]” Pet., 41. But the teachings in Sasaki of transmitting location information relied on by Petitioner, EX1004, ¶¶69, 80-81, relate only to the terminal-to-terminal embodiment, where the terminal *sending* a recommendation sends location information with the recommendation. EX2007, ¶¶147-152. In the server-to-terminal embodiment, this terminal is replaced by the server. *Id.* Petitioner ignores this. *Id.*

The distinction between Sasaki’s two embodiments is material. In the terminal-to-terminal embodiment, which includes four variations, terminal devices connect directly with each other with no intermediate servers or access points. EX1004, ¶¶51-57, 84-86, 94-97, 103-104; see also ¶58 (“[T]he above connection may have forms used in communication standards such as IEEE 802.11x and Bluetooth, which are known as ad hoc network specifications, whereby ... a plurality of terminal devices connect to one another without using any access point[.]”). In each variation of the terminal-to-terminal embodiment, terminal devices transmit content recommendation information to each other, either in a unidirectional or bi-directional manner. EX1004, ¶¶59, 84, 100, 103. Sasaki

teaches that recommendation information sent by one terminal device to another can include the place of transmission. EX1004, ¶¶69, 71, 80, 81, Fig. 3B.

In contrast, in the server-to-terminal embodiment, terminal devices communicate directly with a server, not with each other. EX1004, ¶117. Once a server-to-terminal connection is established, the server determines whether it has content recommendation information that matches the preferences of the user of the terminal device. EX2007, ¶119. If so, the server then transmits the content recommendation information to the terminal device. EX1004, ¶120. The only information communicated from the terminal device to the server is identification information used to establish the connection (Sasaki, ¶117) and user preference information. EX1004, ¶130. Unlike in the terminal-to-terminal embodiment, the terminal device in the server-to-terminal embodiment does not communicate content recommendations or “place of transmission” to the server. EX1004, ¶¶112-130.

Petitioner does not explain why the portable media device would transmit location information to the server in Sasaki’s server-to-terminal embodiment when the portable device is the device receiving, rather than sending, a recommendation. This is particularly true because the server is described as being located at a “service spot,” *i.e.*, “a *predetermined area* in which various types of information are provided to users or members” such as “CD/DVD shops and bookstores [and]

sightseeing areas.” EX1004, ¶¶113-114. There would be no need for the portable device to transmit its location to the server in this embodiment because the location of the service spot is already known and communication happens only when the terminal device is close enough to receive an identifying signal from the server. *See id.*, FIG. 5, ¶54.

Thus, Petitioner’s asserted mapping of Sasaki to the claims impermissibly combines two distinct embodiments of Sasaki, without explaining why a POSITA would have done so. Accordingly, Petitioner fails to meet its burden to show the unpatentability of the challenged claims.

3. Petitioner’s combination of Sasaki and Ellis fails to teach that the portable media device “providing to a server, by a portable media player device, a current location of the portable media player device” as recited in independent claim 11 and similarly recited in independent claim 16 and dependent claim 6.

Claim 11 recites “*providing to a server, by a portable media player device, a current location of the portable media player device* to facilitate the server in inferring a current location of a user of the portable media player device.”

Petitioner alleges that Sasaki “teaches that the server infers the location of the user by having the portable media player device associated with the user directly transmit location information (either GPS or radio wave positional information)” Pet., 41, 55 (citing EX1004, ¶¶69, 81). Petitioner further alleges that Sasaki “teaches that location information can be ‘converted into map information

... or a building name or the like.” *Id.* (citing EX1004, ¶80). Petitioner fails to carry its burden to establish that Sasaki and Ellis disclose or render obvious a portable media player device that transmits its location to a server. EX2007, ¶¶146-168.

As discussed in the previous section, Petitioner impermissibly combines two distinct embodiments of Sasaki without explanation. *Id.*, ¶¶128-131. The problems with this combination are particularly apparent here. Petitioner relies on Sasaki’s teaching that the portable media device can transmit location information. Pet., 41, 55. To be sure, the first terminal-to-terminal embodiment of Sasaki discloses a portable terminal device transmitting location information to another portable terminal device. EX1004, ¶¶68-69, 80-81. However, Petitioner incorrectly asserts that Sasaki at paragraphs 69 and 81 teaches a portable device transmitting location information *to a server*. Pet., 41, 55. It does not. EX2007, ¶¶147-152.

In paragraphs 51-82, Sasaki describes “an example of an operation in a case in which two terminal devices communicate with each other ...” as part of its discussion of the terminal-to-terminal embodiment. EX1004, ¶¶51-82. There is no discussion of the server of the second embodiment in this example. EX2007, ¶¶147-152. While paragraph 81 describes that a terminal device can use radio waves from a plurality of base stations to determine its location, there is no discussion of the terminal device sending this location information to the server

that is providing recommendations, as claimed. EX2007, ¶154. Petitioner's assertion that paragraph 80 teaches a server using information representing the location to infer a location of the user of the mobile device is incorrect for the same reason. EX2007, ¶160. Paragraph 80 of Sasaki is part of the same example of the operation of the terminal-to-terminal embodiment as paragraphs 69 and 81; it merely teaches that the terminal devices can include GPS functionality to determine their location. EX2007, ¶160. Again, there is no teaching of a terminal device sending its location information to a server. EX2007, ¶160.

The teachings relied on in the Petition are unrelated to Sasaki's second embodiment where *the server* sends the content recommendation information. EX2007, ¶130. In the second embodiment, the portable device only *receives* recommendations from the server. EX1004, ¶¶112-130; EX2007, ¶130. In the institution decision, the Board stated that "Sasaki's server at least implicitly determines the location of the user's portable media device by communicating with it (i.e., determining that a specific user is local to, or in the vicinity of, the server)." DI, 20. But this is insufficient to meet the language of the claim 11, which requires "providing to a server, by a portable media player device, a current location of the portable media player device." Sasaki does not teach a portable media player device that sends location information to a server. EX2007, ¶¶130, 147-151; *see*

also EX2009, 162:2-6 (Dr. Houh, unable to identify any disclosure in Sasaki in which the terminal device transmits its location to the server).

Furthermore, Petitioner relies on Ellis for inferring the user's location. Pet., 41. Petitioner does not rely on Ellis for providing user location information *to a server*, and Ellis does not remedy the deficiencies of Sasaki discussed above. EX2007, ¶¶156-157, 161-163. Ellis's Enhanced Radio System (ERS) is simply a portable device that knows its own location. EX1005, ¶¶44, 225, 226; EX2007, ¶¶156-157, 161-163. The portable ERS uses its location information to determine available radio stations or identify events by using information stored locally on the ERS itself. *Id.*, ¶¶233-235. Ellis does not disclose the ERS sending information about its location to a server. EX2007, ¶¶156-157, 161-163.

Accordingly, Sasaki and Ellis—alone or in combination—do not disclose or render obvious a portable media player device that transmits its location to a server that provides recommendations, as required by independent claim 11 and similarly recited in independent claim 16 and dependent claim 6.

4. Petitioner's combination of Sasaki and Ellis fails to teach "accessing, by the server, one or more sources of information about venues or events proximal to a current location of the user" as recited in independent claim 1 and similarly recited in independent claim 21.

Claim 1 recites "accessing, by the server, one or more sources of information about venues or events *proximal to a current location of the user.*"

Petitioner relies in part on Sasaki's alleged disclosure of a portable terminal device determining its location and transmitting it to another portable terminal device. Pet., 34-35. Petitioner states that "Sasaki teaches that its portable media player device can directly transmit location information (either GPS or radio wave positional information)." *Id.*, 34 (citing EX1004, ¶¶69, 81). In concluding that the cited art renders this limitation obvious, Petitioner relies on "Sasaki's server in communication with a portable media player device that directly transmits information representing location information." Pet., 35. However, as explained above in Section III.B.3, Sasaki does not teach a portable device transmitting location information to a server. EX2007, ¶¶147-151; EX2009, 162:2-6. Further, Sasaki does not teach a server determining the location of a portable media player device through any other technique either. *Id.*, ¶¶152-153. The Petition relies on Ellis's disclosure of the portable ERS device using location information to access information about events and facilities local to the user. Pet., 34-35. However, Ellis does not teach a *server* performing this task. EX2007, ¶¶156-157. Therefore, contrary to Petitioner's allegations, none of the applied references, either alone or in combination, disclose a server that determines the location of the portable media player device. Pet., 34-35; EX2007, ¶¶146-157. The Petition, therefore, does not adequately explain how the applied art teaches a server that accesses information about venues or events *proximal to a current location of the user*. EX2007, ¶158.

Again, Dr. Houh’s testimony merely repeats the language from the Petition without additional explanation and is entitled to little or no weight. *Compare* Pet., 33-35, with EX1003, ¶¶91-96; *Xerox*, IPR2022-00624, Paper 9, 15-17; 37 C.F.R. § 42.65(a). Thus, Petitioner has not met its burden of showing that the applied art renders this limitation obvious.

5. Petitioner fails to establish a motivation to combine Sasaki and Ellis.

In addition to the missing elements discussed above, Petitioner fails to establish sufficient motivation to combine Sasaki and Ellis. EX2007, ¶¶116-127. Indeed, a POSITA would not have combined Sasaki and Ellis because the references address distinct problems. Ellis applies to radio content only, whereas Sasaki relates to content recommendations regarding various types of non-radio data. EX2007, ¶¶117-119.

Additionally, the manner in which the devices of Sasaki and Ellis receive content is very different. Ellis teaches a device that receives audio content through several forms of wireless communication. EX2007, ¶117. In contrast, other than “sample” content, Sasaki teaches that media content is purchased, such as using a personal computer, and then loaded onto the portable device. EX2007, ¶¶119-120. The variety of ways in which Ellis receives audio data also presents a technological barrier to combining the references. The device of Ellis would require a number of antennas and related components that would not be feasible to include in a device

with the extended storage and display requirements of Sasaki's terminal. EX2007, ¶121.

Highlighting the differences between radio and non-radio content, Ellis discusses certain advancements in television viewing functionality. For example, “[p]ersonal video recorders, such as those manufactured by TiVo, allow a user to easily record a television program, and also provide VCR-like controls for television programs.” EX1005, ¶5; EX2007, ¶122. Ellis refers to several patents related to playback of recorded television content. *Id.* However, according to Ellis, these patented advancements in television viewing are irrelevant to radio because “these types of improvements have been optimized for the needs of the television viewer.” *Id.*

Ellis explains that “[r]adio listeners typically have different needs than television viewers.” *Id.*, ¶6. EX2007, ¶122. For example, “television viewing typically happens in a fixed environment in a home, while radio listening often happens in varied, often mobile, environments.” *Id.* Additionally, “[a] television viewer may sit and watch a program through its completion” whereas “[a] radio listener more often listens casually while pursuing other activities, and may often switch between stations.” *Id.*

Ellis also identifies technological reasons why improving video and radio consumption requires different approaches. For example, “[b]ecause digitized

audio content requires much less memory than digitized video content, it is less expensive to store a significant amount of radio content.” *Id.*, ¶10. Additionally, “[a] radio tuner is also less costly than a television tuner, so a system that monitors multiple radio stations at once is quite feasible.” *Id.* In view of Ellis’s express discussion, a POSITA would not have combined Ellis and Sasaki. EX2007, ¶¶122-127.

The Petition and Dr. Houh’s declaration ignore these passages of Ellis in their discussion on motivation to combine. EX1003, ¶¶58-62; Pet., 24-26. Indeed, they must in order to provide their manufactured motivation to combine the references. Moreover, Dr. Houh’s declaration testimony substantially recites the content of the Petition without providing additional analysis or evidence on the issue of combining Sasaki and Ellis. EX1003, ¶¶59-63; Pet., 24-26. Thus, Dr. Houh’s declaration is therefore entitled to little or no weight on this issue. *Xerox*, IPR2022-00624, Paper 9 at 15-17; 37 C.F.R. § 42.65(a).

For these reasons, Ellis’s disclosure of determining a user’s preferences for radio content is inapplicable to the problem of determining preference information for other types of media disclosed in Sasaki, and a POSITA would not have been motivated to combine the references.

6. Conclusion as to Independent Claims 1, 11, 16, and 21

For the reasons discussed, Petitioner has not demonstrated that independent claims 1, 11, 16, and 21 would have been obvious in view of the asserted combination of Sasaki, Ellis, and Jacobi.

C. Petitioner fails to demonstrate obviousness of dependent claim 6.

In addition to the reasons discussed above for independent claim 1, dependent claim 6 would not have been obvious for the following additional reasons. Dependent claim 6 recites “[t]he method of claim 1, further comprising inferring by the server the current location of the user of the portable media player device, including *receiving by the server a current location of the portable media player device from the portable media player device* .” Similar to claims 11 and 16, claim 6 implicitly requires the portable media player device to transmit its location to the server. EX2007, ¶159.

The Petition incorporates its analysis of claim 1 and further relies on disclosures relating to terminal-to-terminal communications in Sasaki’s first embodiment. Pet., 41. The Petition also relies on Ellis’s disclosures of the ERS determining its own location. Pet., 41. As discussed above with respect to claims 11 and 16, Sasaki does not teach a portable media player device transmitting location information to a server. EX2007, ¶¶159-161. And Ellis discloses the ERS device determining and using its own location information; not transmitting its

location to a server. EX2007, ¶162. Here again, Dr. Houh’s testimony simply repeats the language from the Petition without additional explanation and is entitled to little or no weight. *Compare* Pet., 41-42, with EX1003, ¶¶114-117; *Xerox*, IPR2022-00624, Paper 9, 15-17; 37 C.F.R. § 42.65(a). Therefore, the Petition fails to meet the burden of showing that the prior art renders obvious claim 6.

IV. THE BOARD SHOULD NOT CREDIT DR. HOUH’S OPINIONS BECAUSE KEY PORTIONS OF HIS DECLARATION MERELY REPEAT THE PETITION.

The Board should not credit the declaration testimony of Petitioner’s proffered expert, Dr. Houh, because key portions of his declaration repeat, often *verbatim*, the arguments in the Petition.

“[C]onclusory expert testimony is inadequate to support an obviousness determination” *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019); *see also In re Magnum Oil* 829 F.3d at 1380 (“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements.”). The Board does not credit declaration testimony that “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support.” *Xerox*, IPR2022-00624, Paper 9 at 15-16 (emphasis in original); *see also id.* at 15 (“[T]he cited declaration testimony is conclusory and unsupported, adds little to

the conclusory assertion for which it is offered to support, and is entitled to little weight.”); 37 C.F.R. § 42.65(a).

As discussed above, portions of Dr. Houh’s declaration relating to motivation to combine contain no additional analysis beyond that presented in the Petition. For example, all three of the Petition’s grounds of unpatentability rely on combining Sasaki, Ellis, and Jacobi. Pet., 21. Such combinations require Petitioner to demonstrate “that a person of ordinary skill in the art would have been motivated to combine the prior art in the way claimed by the . . . claims at issue and had a reasonable expectation of success in doing so.” *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 991 (Fed. Cir. 2017). Dr. Houh’s opinions as to why a POSITA would have allegedly combined and reasonably expected success in combining Sasaki with Ellis and Sasaki-Ellis with Jacobi repeat, without additional support, the conclusory arguments in the Petition. *Compare* Pet., 24-29, *with* EX1003, ¶¶59-66. Such opinions are entitled to little or no weight, leaving key aspects of Petitioner’s challenge supported only by mere attorney argument.

As further noted above, Dr. Houh also simply repeats the language of the Petition in his analysis of specific claim limitations. For example, with respect to claim limitation [1.2], Dr. Houh’s declaration repeats almost the identical language from the Petition with the exception that Dr. Houh’s declaration merely adds block quotes from the references. *Compare*, Pet., 31-33, *with* EX1003, ¶¶84-90. Dr.

Houh similarly repeats the language from the Petition with respect to limitations [1.3] (*Compare*, Pet., 33-35, *with* EX1003, ¶¶91-96), and [6.0] (*Compare*, Pet., 41-42, *with* EX1003, ¶¶114-117). Accordingly, his testimony on these limitations should be given little or no weight.

V. CONCLUSION

For the reasons discussed above, Petitioner fails to demonstrate that the Sasaki-Ellis (and Jacobi) combination teaches or suggests key claim elements and that a POSITA would have been motivated to combine and reasonably expected success in combining Sasaki and Ellis. Petitioner, thus, has failed to meet its burden of showing that the challenged claims would have been obvious. As such, Patent Owner respectfully requests that the Board confirm the patentability of the challenged claims of the '960 patent.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner's Response complies with the type-volume limitation of 14,000 words, comprising 9,164 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).
2. This Patent Owner's Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S RESPONSE** and **EXHIBITS 2007-2019** were served electronically via e-mail on August 24, 2023, in their entireties on the following counsel of record for

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