

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE, LLC,
Patent Owner.

IPR2023-00246
Patent 9,141,960 B2

Before KARL D. EASTHOM, TERRENCE W. McMILLIN, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

Opinion for the Board filed PER CURIAM.

Opinion Concurring-in-Part and Dissenting-in-Part filed by CYGAN,
Administrative Patent Judge.

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

I. INTRODUCTION

A. *Background and Summary*

Google LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–25 of U.S. Patent No. 9,141,960 (Ex. 1001, the “’960 patent”). The Petition was accompanied by a declaration by Dr. Henry Houh. Ex. 1003 (“Houh Dec.”). Wildseed Mobile LLC (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”). Paper 6. We authorized additional briefing on certain matters. Exs. 3001, 3002. Petitioner filed a Reply to the Preliminary Response and Patent Owner filed a Sur-reply. Papers 7, 8. We instituted an *inter partes* review as to all claims and all grounds raised in the Petition. Paper 10 (“Dec. on Inst.”).

Patent Owner filed a Response (Paper 19, “PO Resp.”), accompanied by a declaration by Mr. Robert Stillerman (“Stillerman Dec.”). Petitioner filed a Reply (Paper 24, “Pet. Reply”), accompanied by a transcript of a deposition of Mr. Stillerman (Ex. 1023). Patent Owner filed a Sur-Reply (Paper 27, “PO Sur-Reply”), accompanied by a transcript of a deposition of Dr. Houh (Ex. 2009). The parties requested an oral hearing, and we held such a hearing on February 29, 2024. A transcript of the oral hearing has been entered into the record. Paper 33.

For the reasons set forth in this Final Written Decision pursuant to 35 U.S.C. § 318(a), we determine that Petitioner demonstrates by a preponderance of evidence that challenged claims 1–25 of the ’960 patent are unpatentable.

B. *Real Parties in Interest*

Petitioner identifies Google LLC and YouTube, LLC as the real parties in interest. Pet. 79. Petitioner identifies Google LLC as a subsidiary

of XXVI Holdings, Inc., which is a subsidiary of Alphabet Inc., but states that XXVI Holdings Inc. and Alphabet Inc. are not real parties in interest to this proceeding. *Id.* n.2. Patent Owner identifies Wildseed Mobile LLC as the real party in interest. Paper 5, 1.

C. *Related Matters*

The parties represent that the '960 patent is involved in *Wildseed Mobile LLC v. Google LLC et al.*, 3-22-cv-04928, (N.D. CA, filed August 29, 2022). Pet. 79; Paper 5, 1. Petitioner further represents that the '960 patent is involved in *Wildseed Mobile LLC v. Google LLC et al.*, 6-22-cv-00357 (W.D. TX, filed April 4, 2022); however, Patent Owner states that this is the original filing of the first-listed case. Pet. 79; Paper 5, 1. Petitioner further represents that the '960 patent is involved in *Wildseed Mobile LLC v. Google LLC et al.*, 6-21-cv-01245 (W.D. TX, filed Oct. 8, 2021); however, Patent Owner states that this case has been voluntarily dismissed. Pet. 79; Paper 5, 1.

Patent Owner represents that Petitioner has filed, at the same time that this Petition was filed, petitions for *inter partes* review against related family members U.S. Patent No. 10,251,021 (IPR2023-00244), U.S. Patent No. 10,959,040 (IPR2023-00245), U.S. Patent No. 10,869,169 (IPR2023-00247), and U.S. Patent No. 7,376,414 (IPR2023-00248). Paper 5, 1.

D. *The '960 Patent*

The '960 patent is titled "Venue and Event Recommendations for a User of a Portable Media Player Device." Ex. 1001, code (54). The '960 patent issued from Application Serial No. 12/144,532, filed on June 23, 2008, and claims priority to Provisional Application No. 60/945,677, filed

on June 22, 2007. *Id.* at codes (21), (22), (60). Figure 1, reproduced below, illustrates an environment implementing the disclosed invention:

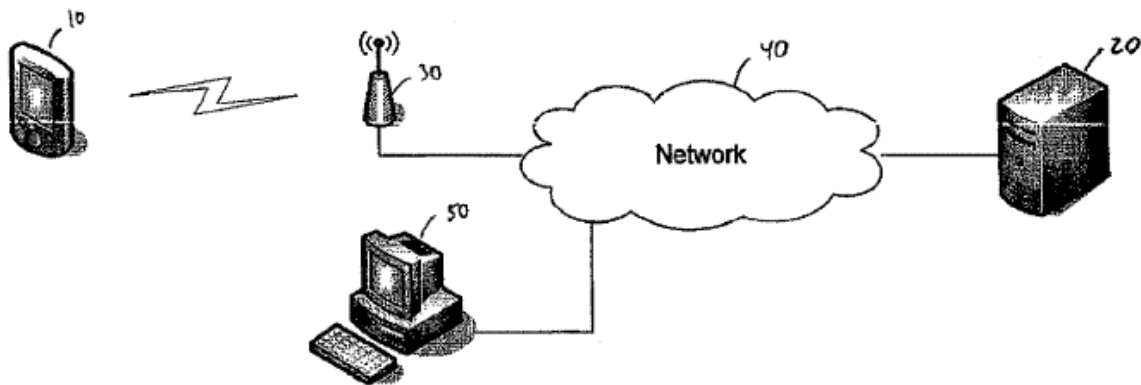


Figure 1 illustrates portable media player device 10 for storing media files associated with a user, wireless access point 30, network 40, computer 50 associated with media player device 10, and server 20 that “may infer a current location of the user[’s] . . . portable media player device 10,” and also “may transmit one or more recommendations for a venue or event, or information of interest to the user, e.g. to portable media player device 10.” Ex. 1001, 3:58–4:19.

The server “may determine one or more media preferences or interest for the user based in part upon the media and/or information about the media stored on or accessed using the portable media player device.” Ex. 1001, 5:19–22. Then,

the server may transmit a recommendation (or information) to a user, e.g. his portable music player device having jazz music stored on or accessed using the portable music player device for a club that plays live jazz or blues within a convenient walking or driving distance to the current location of the user and the portable media player device.

Id. at 6:5–10.

E. Illustrative Claim

Claim 1 is illustrative, and recites as follows:¹

[1.0] A method comprising:

[1.1] retrieving, by a server, a plurality of media stored on or accessed using a portable media player device, or information about said plurality of media;

[1.2] 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;

[1.3] accessing, by the server, one or more sources of information about venues or events proximal to a current location of the user;

[1.4] identifying, by the server, at least one of said venues or events as being of interest to the user based at least in part on the one or more entertainment preferences inferred by the server and the current location of the user;

[1.5] generating, by the server, a recommendation indicating the identified venue or event as a venue or event of interest to the user; and

[1.6] communicating, by the server, the recommendation to the user.

Ex. 1001, 8:5–25.

F. Evidence

Petitioner relies on the following evidence.

Name	Patent Document	Exhibit No.
Sasaki	U.S. Pat. Appl. Pub. No. 2006/0250994 A1	1004
Ellis	U.S. Pat. Appl. Pub. No. 2005/0020223 A1	1005
Jacobi	U.S. Pat. Appl. Pub. No. 2006/0195362 A1	1006
Teicher	U.S. Pat. Appl. Pub. No. 2006/0143214 A1	1007
Havinis	U.S. Pat. No. 6,169,899 B1	1008

¹ Petitioner's bracketing indicia have been added.

G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–25 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 5–6, 8–11, 15–16, 20–21, 25	103(a) ²	Sasaki, Ellis, Jacobi
2–4, 12–14, 17–19, 22–23	103(a)	Sasaki, Ellis, Jacobi, Teicher
7, 24	103(a)	Sasaki, Ellis, Jacobi, Havinis

II. ANALYSIS

A. Legal Standards

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, “would have been obvious at the time the invention was made to a person having ordinary skill in the art [to which said subject matter pertains].” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of non-obviousness.³ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Because the application from which the ’960 patent issued was filed before this date, the pre-AIA versions of §§ 102 and 103 apply.

³ Neither party presents evidence or arguments regarding objective evidence of non-obviousness.

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art on or before June 22, 2007

would have been knowledgeable and familiar with the field of portable devices and venue or event recommendations That person would have a bachelor’s degree in electrical engineering, or equivalent training, and approximately two years of experience working in the field Lack of work experience can be remedied by additional education, and vice versa.

Pet. 12–13 (citing Ex. 1003 ¶¶ 19–21).

Patent Owner states that its declarant “proposes a similar level of ordinary skill.” PO Resp. 7 (“a degree in computer science, computer engineering or related field and one year of experience in working with portable devices”), quoting Ex. 2007 ¶ 37. Determining the level of ordinary skill in the art involves various factors, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). The prior art of record also reflects the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). We agree with Patent Owner that the parties provide a similar assessment of the level of ordinary skill in the art, and adopt it because it is consistent with the ’960 patent and the asserted prior art.

C. Weight of Dr. Houh’s Testimony

Patent Owner argues that “[k]ey portions of Dr. Houh’s declaration repeat—often *verbatim*—the arguments presented in the Petition.” PO Resp. 43. Accordingly, Patent Owner asserts that Dr. Houh’s testimony is

“entitled to little or no weight.” *Id.* (citing *In re Magnum Oil Tools Int’l*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements.”); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–16 (P.T.A.B. August 24, 2022) (precedential) (“[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.”)).

Patent Owner directs attention to Petition pages 24–29 and the Houh Declaration at paragraphs 59–69. *Id.* at 44. Patent Owner contends that Dr. Houh’s opinions “repeat, without additional support, the conclusory arguments in the Petition.” *Id.* Patent Owner further argues that Dr. Houh’s testimony is deficient because, for example, it “repeats almost the identical language from the Petition with the exception that Dr. Houh’s declaration merely adds block quotes from the references.” PO Resp. 44.

Petitioner argues that the Petition cites to Dr. Houh’s testimony, not the other way around. Pet. Reply 24. Petitioner further argues that Dr. Houh’s conclusions are supported either by a citation to evidence, or “technical reasoning informed by his expertise.” *Id.* For example, Petitioner points to Dr. Houh’s explanation of the technical reasons why a person having ordinary skill in the art would have combined Sasaki and Ellis. *Id.* at 24–25 (citing Ex. 1003 ¶¶ 59–66). With respect to evidentiary support for Dr. Houh’s conclusions, Petitioner points to Dr. Houh’s reliance on Jellison (Ex. 1009), Lim (Ex. 1010), and Dua (Ex. 1011) in support of his analysis. *Id.* at 25 (citing Ex. 1003 ¶¶ 111, 222). Because of this support, Petitioner argues that Dr. Houh’s testimony is not conclusory and should be given appropriate weight. *Id.* at 24 (citing *Intellectual Ventures I LLC v. EMC*

Corp., 786 Fed. Appx. 1021, 1034 (Fed. Cir. 2019) (“[Patent owner] argues that the Board relied on [the expert’s] conclusory assertions to reach its finding. **But [the expert’s] declaration is not conclusory: it cites to several portions of [the prior art reference] to support his statements.**”).

Based on the foregoing discussion, Patent Owner fails to provide a sufficient reason to discount the weight of Dr. Houh’s testimony. We credit Dr. Houh’s testimony to the extent that it “articulate[s] specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools*, 829 F.3d at 1380.

D. Claim Construction

In an *inter partes* review, we construe a patent claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b).” 37 C.F.R. § 42.100(b) (2019). Under this standard, the words of a claim generally are given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Here, Petitioner contends that “the terms of the Challenged Claims should be given their plain and ordinary meaning, and no terms require specific construction.” Pet. 13. Patent Owner “agrees with Petitioner that the terms of the challenged claims should be given their plain and ordinary meaning,” and provides its characterization of that meaning for some terms. Resp. 7–10. Patent Owner asserts that the plain meaning of “plurality of media” is “*more than one media.*” *Id.* at 8. Patent Owner further asserts that the “inferring . . . preferences” in the claims does not encompass forming inferences based upon user-entered preferences. *Id.* at 8–10. However, as

detailed in our analysis of Petitioner’s challenge to claim 1, we determine that the claimed limitations are taught even under Patent Owner’s characterization of the plain and ordinary meaning of the terms. *See infra* § II.E.4.

For the foregoing reasons, no need exists to construe any claim terms expressly to resolve the parties’ disputes. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

E. Obviousness over Sasaki, Ellis, and Jacobi

Petitioner asserts that claims 1, 5–6, 8–11, 15–16, 20–21, 24, and 25 are unpatentable under § 103(a) as obvious over Sasaki, Ellis and Jacobi. Patent Owner provides arguments and evidence against these assertions.

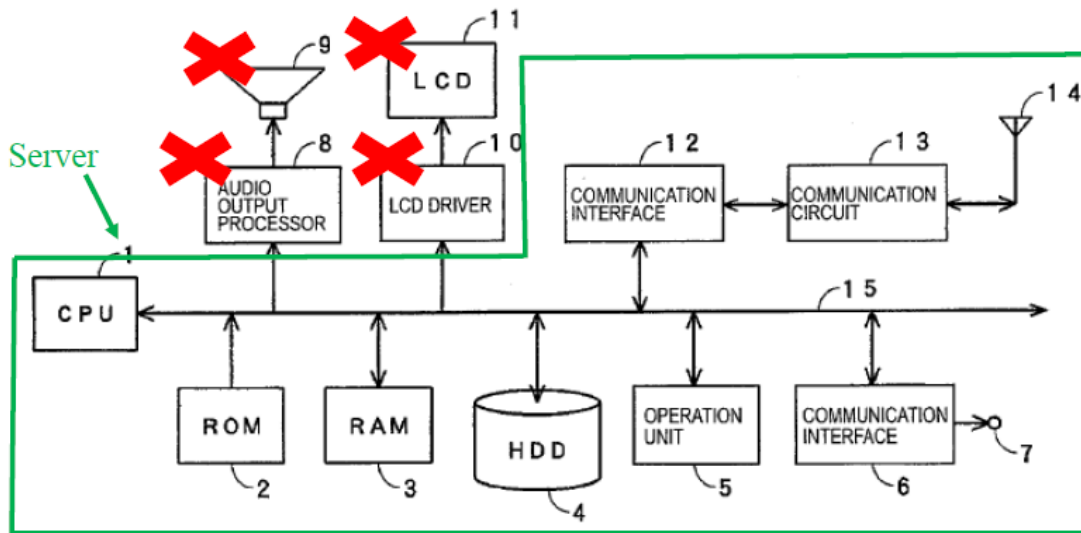
Upon consideration of Petitioner’s explanations and the totality of evidence on the complete trial record, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 5–6, 8–11, 15–16, 20–21, 24, and 25 of the ’960 patent are unpatentable.

1. Sasaki (Ex. 1004)

In a first embodiment, Sasaki relates to “[a] content recommendation system includ[ing] first and second communication devices which are connected to each other and in which content recommendation information is transmitted and received between both devices.” Ex. 1004, code (57). In a second embodiment, “content recommendation information is transmitted and received between a server at a service spot and a terminal device.” *Id.* ¶ 112. In both embodiments, terminal devices connect to a server. *Id.* ¶¶ 41, 47, 112. In general, “*the content recommendation system* according to the

[first] embodiment *is applicable to a server* (first communication device) and a communication device (second communication device).” *Id.* ¶ 17 (emphases added).

Sasaki’s Figure 1, as annotated by Petitioner, follows:



As annotated by Petitioner, Figure 1 above illustrates Sasaki’s server (green box). *See* Pet. 30. Sasaki’s server includes CPU (central processing unit) 1, ROM (read-only memory) 2, RAM (random access memory) 3, HDD (hard disk drive) 4, operation unit 5, communication interfaces 6, 12, communication circuit 13, and antenna 14. *See* Ex. 1004 ¶¶ 29, 112–113.

2. Ellis (Ex. 1005)

Ellis relates to “[a]n enhanced radio system . . . that provides for the capture and playback of one or more radio stations.” Ex. 1005, code (57). The system recommends content by “monitor[ing] the content listened to by the user, and automatically determin[ing] the groups liked and disliked by the user.” *Id.* ¶ 212. “Groups may be created by the user, programmer, or advertiser, based on a number of criteria.” *Id.*

“[A] group may be based on type of content, such as grouping all commercials, all songs, etc.” *Id.* ¶ 214. “[A] group may be based on a

category of content, such as bluegrass music, alternative rock, or other music genre.” *Id.* “[A] group may be based on a specific performing artist, and may contain all songs performed by that artist.” *Id.* “[A] group may be based a particular radio station, and may contain all content broadcast by that station.” *Id.*

Ellis describes collecting information about a user’s listening habits, e.g., “usage data.” Ex. 1005 ¶ 263. Ellis’s system uses a “central facility” for gathering data. *Id.* ¶ 236. Basically, the system acquires information about the user’s preferences and selects one or more stations to recommend to a user. *Id.* ¶ 220. “This may be done, for example, correlating the play list from each station to the list of songs, artists, and genres selected as likes and dislikes by the user, and choosing the closest match or matches.” *Id.*

The system may create scores by weighting matches for likes and dislikes:

[A] score may be created for each station by adding a value for each match to a like and subtracting a value for each match to a dislike, with each value weighted by the level of like or dislike specified by the user. A higher value may be added for a music genre match, a lower value for an artist match, and a still lower value may be added for a song match.

Id.

3. *Jacobi (Ex. 1007)*

Jacobi relates to recommendation systems for books, compact discs, videos, authors, artists, etc. Ex. 1007 ¶ 11. The system conveys the recommendations to the users on web pages, emails, or facsimile. *Id.*

¶ 74, Fig. 6.

4. *Analysis of Claim 1*

a) *Limitations [1.0]–[1.2]*

[1.0] A method comprising:

[1.1] retrieving, by a server, a plurality of media stored on or accessed using a portable media player device, or information about said plurality of media;

[1.2] 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

Petitioner asserts that limitation [1.0], to the extent limiting, and limitation [1.1] are rendered obvious by the combined teachings of Sasaki and Ellis. Petitioner points to Sasaki’s description of a “method for providing recommendation information concerning various types of content, such as music content and audio/visual (AV) content.” Pet. 29 (citing Ex. 1004, Abstr., ¶ 3).⁴ Petitioner further points to Sasaki’s description of the communication devices as a server and a terminal device which is portable for playing various types of content, such as music and images. *Id.* at 30 (citing Ex. 1004 ¶¶ 21, 113). Petitioner further points to Sasaki’s description of the server receiving and storing user preference information from the portable media device or a hard drive. *Id.* at 31 (citing Ex. 1004 ¶¶ 19, 98, 112, 126).

Petitioner further points to Ellis’s description of collecting information in a portable media player such as usage data, including content that the user heard or skipped over, and sending such information to a

⁴ Because Sasaki teaches a “method,” we need not determine whether [1.0] is limiting.

central facility; i.e., a server. *Id.* at 31 (citing Ex. 1005 ¶¶ 136–137, 263–265, 274).

Petitioner asserts that the server of Sasaki that receives user preference information directly from a portable media player device (or from a hard drive), in view of Ellis’s teaching of an individual network component that collects usage data about what a user listened to or accessed using a portable media player device renders obvious this limitation. *Id.* (citing Ex. 1003, ¶¶ 75–83).

Building on the above assertions, Petitioner asserts that limitation [1.2] is rendered obvious by a combination of Sasaki’s server storing preference information about different media content provided by its users, and Ellis’s techniques for inferring the entertainment preferences of a user based on media usage information. *Id.* at 32–33.

Petitioner points to Ellis’s description of its system “**monitor[ing] the content listened to by the user, and automatically determin[ing] the groups liked and disliked by the user.**” Pet. 32–33 (citing Ex. 1005 ¶ 212). Petitioner further points to Ellis’s description that its system “‘may also determine user preferences automatically’ (inferring) by ‘monitoring what content the user listens to’ in order to find ‘content of interest, i.e., content that matches the user’s preferences.’” *Id.* (citing Ex. 1005 ¶ 185). Petitioner further points to the description of Ellis’s system assigning points to a specific song, artist, genre, or grouping based on a listened-to item. *Id.* at 32–33 (citing Ex. 1005 ¶ 221).

Because Sasaki’s server stores user preferences about multiple types of content (music, still pictures, video, text), Petitioner asserts that adding Ellis’s technique of automatically determining a user’s preferences about content types based on monitoring usage information renders obvious

limitation 1.2. *Id.* (citing Ex. 1003 ¶¶ 84–90; Ex. 1004 ¶ 74). Petitioner asserts that Ellis also teaches that its techniques can be implemented in a network component and/or a central facility, and is therefore directly usable in a networked system such as Sasaki’s. *Id.* at 26 (citing Ex. 1005 ¶¶ 162, 236).

Patent Owner argues that Sasaki does not teach “inferring” a user’s preferences based “at least in part on a plurality of media or retrieved information about a plurality of media.” Resp. 19–29. Patent Owner argues that Sasaki does not teach “inferring” because it relies upon explicit user entry of content type and keyword preferences that are relied upon to recommend content that matches the user’s preferences. *Id.* at 8–10, 20–22 (citing Ex. 1004 ¶¶ 73, 85; Ex. 2019; Ex. 2007 ¶¶ 84–91). Patent Owner argues that the prosecution history of the ’960 patent supports this distinction. *Id.* at 23–24 (citing Ex. 1002, 210; Ex. 2007 ¶¶ 84–86). Patent Owner further argues that any keywords entered by the user in Sasaki are a categorization of the music, or the recommendation of various media once preference indication is already known, and not an indication of the user’s preferences. *Id.* at 23–25 (citing Ex. 1004 ¶¶ 73–74; Ex. 2007 ¶¶ 85, 87). Patent Owner further notes that Petitioner did not advance any unpatentability theory based upon Sasaki teaching “inferring,” but instead relies on Ellis to teach “inferring.” *Id.* at 22, 25 (citing Pet. 31–33).

With respect to the combination of Sasaki and Ellis, Patent Owner argues that such a combination only teaches inferring a user’s preferences based on audio media. Patent Owner argues, “Ellis discloses a system that only determines a user’s preferences for radio (i.e., audio) content.” *Id.* at 26–27 (citing Ex. 2007 ¶¶ 133–136). Patent Owner argues that the Petition provides no explanation how Ellis’s invention would be implemented in

Sasaki to infer preferences based on a plurality of media. *Id.* at 27 (citing Ex. 2007 ¶ 83). Patent Owner argues that Sasaki teaches that the recommended content, not the information used to form preferences, may be music, image, video, or text. *Id.* at 28 (citing Ex. 1004 ¶ 74).

Petitioner responds to these arguments by asserting that Ellis teaches “more than one media” by teaching different types of content, for example, in the form of plural songs, or songs and commercials. Pet. Reply 7 (citing Ex. 1005 ¶¶ 214, 230, 263). Petitioner alternately asserts that Sasaki explains that Sasaki teaches more than one type of media, including music, pictures, video, text, and audio, as part of its recommendation system. *Id.* at 8 (citing Ex. 1004 ¶ 74).

We determine that Petitioner relies upon, and persuasively shows, that the combination of Sasaki and Ellis teaches “inferring . . . one or more entertainment preferences of a user.” As Patent Owner recognizes, Ellis teaches inferring preferences from audio media, stating that “[t]he system may also determine user preferences automatically by monitoring what content the user listens to,” by “[f]or example, . . . add[ing] points to a specific song, artist, genre, or other type of item or grouping, based on the user listening to an entire item.” *See* Resp. 26 (quoting Ex. 1005 ¶¶ 185, 212); Pet. 35 (quoting same) (emphases omitted). The record further supports Petitioner’s assertion that a person having ordinary skill in the art would look towards information gathered about any of the media types in Sasaki. Although Patent Owner argues that Sasaki’s teaching of multiple media is limited to recommendations, its declarant Dr. Stillerman states that Sasaki is “a device in which design choices were made to accommodate a variety of media types,” and is “for providing recommendation information concerning various types of content, Such as music content and audio/visual

(AV) content.” Ex. 2007 ¶¶ 118, 125 (citing Ex. 1004 ¶¶ 1, 3, 46).

Dr. Stillerman states that Sasaki operates through “*preference information including content types*.” *Id.* ¶ 137. Although in Sasaki such preference information is entered by the user, Dr Stillerman’s testimony indicates that Sasaki desires preferences for each type of media. Consequently, the record supports Patent Owner’s contention that it would have been obvious to combine Sasaki’s multi-media preference and recommendation teachings with Ellis’s automatic gathering of preferences by inferring preferences from user interactions with media.

To the extent that Patent Owner argues that neither reference, considered by itself, teaches the “inferring” limitation, Petitioner relies on the combination. *See Bradium Techs. LLC v. Iancu*, 923 F.3d 1032, 1050 (Fed. Cir. 2019) (arguments individually attacking the references in an obviousness combination are not persuasive) (citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”)).

Patent Owner additionally argues that Petitioner’s Sasaki-Ellis combination does not teach that the inferring is performed by a server as required by the claim. Resp. 29–34. Patent Owner argues that Petitioner improperly combines teachings from Sasaki’s terminal-to-terminal embodiment with those of Sasaki’s server-to-terminal embodiment. *Id.* at 31 (citing Ex. 2007 ¶¶ 110–123). Patent Owner argues that the server-to-terminal embodiment does not communicate content recommendations to the server. *Id.* at 33. Patent Owner argues that Sasaki teaches that, in its terminal-terminal embodiment, that the user’s portable device may transmit content recommendation information to another portable device, but that

these embodiments are separate and unrelated. *Id.* at 29–34 (citing Ex. 1004 ¶¶ 51–57, 69, 71, 80–81, 84–86, 94–97, 103–104, 112–130). Patent Owner argues that because Sasaki’s server is described as providing various types of information to users or members, there would be no need for the terminal to provide content recommendations to the server. *Id.* at 33–34 (citing Ex. 1004, Fig. 5, ¶¶ 54, 113–114). Patent Owner further argues that Ellis’ Enhanced Radio System (ERS) device “determines user preference information *locally without the use of a server.*” *Id.* at 26 (citing Ex. 1005 ¶¶ 212, 221).

However, we determine that Petitioner’s asserted combination in which the inferring is performed by the server is supported by the complete trial record. As admitted by Patent Owner, Sasaki states that its content recommendation system is applicable to a server. *Id.* at 31 (citing Ex. 1004 ¶ 17). Dr. Stillerman describes the server embodiment as “an example where terminal device A is replaced by the server,” such that the server retains the architecture of the terminal except for audio and visual outputs. Ex. 2007 ¶ 103 (“server architecture is similar to the architecture of the common terminal with the absence of four components: the audio output processor, 8; speaker 9; LCD driver 10; and LCD 11”).

Petitioner does not solely rely on Sasaki to teach the claimed server, but also relies on the teachings of Ellis. We find such reliance supported by the record. Ellis further teaches that its techniques may “report usage data to a central facility,” and that the controller and memory may be one of multiple network components. Ex. 1005 ¶¶ 162, 236. Such usage data concerning listener usage and habits is applied to create ratings, which are used by the system to act on songs and other content including automatically switching the song. *Id.* ¶¶ 23, 46, 137; Ex. 1003 ¶ 142. Ellis’ (automatic)

remote processing of usage data through a network is consistent with Sasaki's (manual) remote processing of preference information updated by the user through the network. Ex. 1004 ¶¶ 85, 128; Resp. 25. Because both Sasaki and Ellis teach remote processing, with Sasaki teaching that the processing is performed on a server and with Ellis teaching that the processing is to infer preferences from information about media, we determine that Petitioner has shown the combination of teachings from Ellis and Sasaki to teach inferring, by the server . . . one or more entertainment preferences of a user.

To the extent that Petitioner relies upon a combination of Sasaki's embodiments, we take into account Sasaki's statement that the second embodiment is a modification of the first embodiment; i.e., by replacing terminal device A by the server. Ex. 1004 ¶ 113. Sasaki further details the structural differences between the embodiments, describing that those structural differences affect the audiovisual playback components, not the preference- or recommendation-related components. *Id.* Sasaki generally indicates that aspects of its content recommendation system apply to both embodiments. *See* Ex. 1004 ¶¶ 17 (“[T]he content recommendation system according to the [terminal/terminal] embodiment is applicable to a server (first communication device) and a communication device (second communication device).”), 112 (“Differently from the first [terminal/terminal] embodiment . . . in a second embodiment of the present invention, content recommendation information is transmitted and received between a server at a service spot and a terminal device.”). We find that this evidence supports any reliance by Petitioner on features of the second embodiment viewed as the structure of the first embodiment in which a terminal is replaced by the server. *See GUI Global Products, Ltd., v.*

Samsung Electronics Co., 2024 WL 1564694, *3 (Fed. Cir. April 11, 2024) (“Kim’s express statements again provide substantial evidence supporting the Board’s finding that a skilled artisan would have combined the watch-type and folder-type embodiments”); *Boston Scientific Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009) (stating, “[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness”).

For the foregoing reasons, we determine that Petitioner has shown, by a preponderance of the evidence, that the teachings of Sasaki and Ellis, in combination, teach limitations [1.0]–[1.2].

b) [1.3] *accessing, by the server, one or more sources of information about venues or events proximal to a current location of the user;*

Petitioner points to Sasaki’s teaching of “a *server* in communication with a *portable media player device*.” Pet. 34. Petitioner contends that Sasaki teaches transmitting location information (GPS or radio wave positional information) from its portable media player device. *Id.* (citing Ex. 1004 ¶¶ 69, 80, 81). Petitioner contends that this information is “necessary information” and part of the “content recommendation information.” *Id.* (quoting Ex. 1004 ¶ 68).

Petitioner also relies on Ellis’s “technique that uses ‘geographic position information’ to ‘acquire information about local events.’” *Id.* (quoting Ex. 1005 ¶¶ 233–234; citing Ex. 1005 ¶ 225 (“use global positioning system monitor 160 to determine the user’s location”)). Petitioner Owner also asserts that Ellis teaches that it “download[s] information about local events and facilities” from a “web site.” *Id.* (quoting Ex. 1005 ¶ 236).

Petitioner asserts that it would have been obvious to modify Sasaki's GPS-enabled portable media device and server communication system to include Ellis's technique of using the user's geographic location to access information about events and facilities local to the user in order to obtain local recommendation information. *Id.* at 35 (citing Ex. 1003 ¶¶ 91–96).

Patent Owner argues that neither reference nor their combination teaches a server that determines or uses the current location of the user that transmits its location to a server. Resp. 36–39. First, Patent Owner argues that Sasaki teaches that the server may send recommendations to the portable device, and that the user's portable device may transmit location information to another portable device, but that these are in separate and unrelated embodiments. *Id.* at 35–36 (citing Ex. 1004 ¶¶ 51–82, 130, 160; Ex. 2007 ¶¶ 147–152). Patent Owner argues that Ellis is relied upon for using its own geographic information to make local recommendations, but not for providing user location information to a server. *Id.* at 37 (citing Pet. 41; Ex. 2007 ¶¶ 156–157, 161–163).

Patent Owner's arguments are beyond the scope of claim 1 or attack the references' teachings individually. Limitation 1.3 requires the server to access sources of information about venues or events local to the user, but does not require the terminal to send its location information to the server.⁵

For the foregoing reasons, we determine that Petitioner has shown that the combined teachings of Sasaki and Ellis teach limitation 1.3.

⁵ As discussed further below, Patent Owner contends that claims 6, 11, and 16 recite such location limitations. For the reasons set forth below, we determine that these added limitations would have been obvious. Therefore, even if claim 1 is of similar scope regarding the location transmission, it would have been obvious for the reasons as further set forth in the analysis of claims 6, 11, and 16 below.

- c) *[1.4] identifying, by the server, at least one of said venues or events as being of interest to the user based at least in part on the one or more entertainment preferences inferred by the server and the current location of the user;*

Petitioner points to Ellis’s description of its “system . . . select[ing] one or more recommended events . . . by comparing information about each event with user information, and selecting events that most closely match user preferences.” Pet. 36 (citing Ex. 1005 ¶¶ 233–234) (emphases omitted). Petitioner asserts that the combination of Ellis’s system selection of events based on user preferences with Sasaki’s server-based recommendations to a portable media device renders obvious this limitation. *Id.* Patent Owner does not specifically contest this assertion. Upon review of the record, we determine that Petitioner’s assertion is supported and sufficient to teach limitation 1.4.

- d) *[1.5] generating, by the server, a recommendation indicating the identified venue or event as a venue or event of interest to the user;*
[1.6] communicating, by the server, the recommendation to the user.

Petitioner points to Sasaki’s description that its server provides content recommendation information to a user’s terminal device, and the above-disclosed combination with Ellis’s recommendation of venues or events. *Id.* at 37–38 (citing Ex. 1004 ¶ 115).

Petitioner further points to Jacobi’s generation of a recommendation message to a user, such as by creating a web page or email with links to information on items that are of interest to the user. *Id.* at 38 (citing Ex. 1006 ¶¶ 72, 74). Petitioner asserts that the combination of Jacobi’s generation of a recommendation message, in combination with the server-generated recommendation of events or venues of interest to the user taught by the combination of Sasaki and Ellis, renders obvious this limitation. *Id.*

at 38–39 (citing Ex. 1003 ¶¶ 106–109). Patent Owner does not specifically contest these assertions. Upon review of the record, we determine that Petitioner’s assertions are supported and sufficient to teach limitations 1.5 and 1.6.

e) Reasons to Combine

Petitioner asserts that a person having ordinary skill in the art would have found it obvious to combine the teachings of Ellis with those of Sasaki because Ellis teaches implementation details of a recommendation system that would be of use to those contemplating use of Sasaki’s recommendation system. Pet. 24. For example, Sasaki teaches providing recommendations based upon user preferences, and Ellis describes monitoring content accessed by the user to automatically determine user preferences in near-real time. *Id.* (citing Ex. 1004 ¶¶ 115, 212). Dr. Houh states that a person having ordinary skill in the art would recognize the benefit of having such preferences determined automatically, without reliance upon user input, and adapting to changing user interests. *Id.* (citing Ex. 1003 ¶ 61). Petitioner further asserts that such a combination would be the result of using known techniques (Ellis’s implementation details) to improve a similar system (Sasaki’s recommendation system) in the same way (to provide recommendations to a portable media player device). *Id.* at 26 (citing Ex. 1003 ¶ 63). Petitioner also asserts that the similarities in their systems, both having a portable user device, acquiring and saving user preferences, providing recommendations, implementation in Sasaki’s “server” and Ellis’s “central facility,” indicate that such a combination would have reasonable expectation of success. *Id.* at 25–26 (citing Ex. 1004 ¶ 141; Ex. 1005 ¶¶ 160, 162, 236; Ex. 1003 ¶ 62).

Patent Owner argues that a person having ordinary skill in the art would not have made such a combination because the references address distinct problems. Resp. 39. Patent Owner argues that Ellis applies to radio content that is received wirelessly on the device, and Sasaki relates to non-radio content that is purchased and then loaded onto the device, which “presents a technological barrier to combining the references” because 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.” *Id.* at 39-40 (citing Ex. 2007 ¶ 121). Patent Owner points to statements in Ellis distinguishing advances in television as irrelevant to radio; for example, television is watched at home, wherein a program is watched through completion, whereas radio involves mobile environments in which content is often switched. *Id.* at 40 (citing Ex. 1005 ¶ 6; Ex. 2007 ¶ 122). Patent Owner argues that Ellis’ statements should be extended to video content. PO Sur-reply 16. Patent Owner points to statements of Dr. Stillerman attesting that radio and audio components are cheaper than television and video components. Resp. 41. Patent Owner asserts that Petitioner and Dr. Houh have disregarded these passages in their assessment of obviousness. *Id.* Patent Owner concludes from these statements that “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.” *Id.*

On the complete trial record, Patent Owner’s arguments do not show a teaching away from the claimed invention or a lack of motivation to combine the references’ teachings. Even if Ellis teaches away from home-bound television systems, neither the invention nor Sasaki relates to a home-

bound television system; instead, both relate to portable media devices, and to which the alleged drawbacks of stationary televisions do not apply. Moreover, Sasaki itself is directed to both music and video preferences. *See, e.g.,* Ex. 1004 ¶ 74.

To the extent the systems include differences in types of media content, both systems focus on recommending media based on user preferences. For example, as summarized above, Petitioner persuasively shows that Sasaki and Ellis address similar problems associated with providing recommendations to users of portable digital media for all types of events. *See, e.g.,* Ex. 1004 ¶¶ 74, 114 (disclosing a recommendation system that collects information about different media content types, such as music, still pictures, video, and text to provide recommendations to guide purchases at facilities such as CD/DVD shops and bookstores, sightseeing areas, attraction places, art museums, museums, movie theaters, coffee shops, hotel lobbies, and other public facilities); Ex. 1005 ¶¶ 7, 15–17, 57, 162 (describing a system for controlling audio or other digital content data or software (including from radio stations or the Internet) and providing recommendations for music, shopping for music, concert venues, radio station events, etc.).

Although Patent Owner argues that Ellies and Sasaki each have technological features that would not be feasible to combine because of cost and an increase in the number of parts such as “antennas and related components,” Petitioner asserts that “the proposed combination relies on Ellis’s techniques for automatically determining the user’s preferences by monitoring the content *consumed* by the user—not how the content is *delivered* to the mobile device.” Pet. Reply 21. Petitioner argues, and we agree, that obviousness does not turn on whether the devices described by

Sasaki and Ellis would be physically combined, but instead, on whether a person having ordinary skill in the art would combine their teachings to render obvious the claimed invention. *See Allied Erecting and Dismantling Co., Inc. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016). Although Patent Owner points to an increase in cost and the number of parts as reasons not to combine the teachings of Sasaki and Ellis, the obviousness determination recognizes that “[a] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obvious motivation to combine;” rather, such facts should be weighed as a whole in such a determination. *Medichem S.A. v. Rolabo S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006). As summarized above, Petitioner’s reasons for combining the references (e.g., providing automatic recommendations based on determined preferences and digital consumption in real time and addressing similar problems), and the multi-media focus of Sasaki provide persuasive reasons for a person of ordinary skill in the art to combine their teachings despite an increase in cost and the number of parts in a resulting process or system.

Petitioner asserts that a person having ordinary skill in the art would have found it obvious to combine the teachings of Jacobi with those of Ellis and Sasaki because Jacobi teaches techniques for generating and displaying recommendations to a user that would be useful to those contemplating use of the recommendation system as proposed through the combined teachings of Sasaki and Ellis. Pet. 27 (citing Ex. 1003 ¶ 64). For example, Petitioner points to recommendation of local events and facilities on a display device in its proposed Sasaki-Ellis combination, and that Jacobi describes transmitting a recommendation message through a web page or email. *Id.* at 27–28 (citing Ex 1006 ¶ 74; 1003 ¶ 66). Petitioner asserts that a person

having ordinary skill in the art would recognize these recommendation generating details to expand the capabilities of the Sasaki-Ellis system, and thereby motivate their combination. *Id.* (citing Ex. 1003 ¶¶ 67). Petitioner further asserts that a person having ordinary skill in the art would have a reasonable expectation of success in their combination because Sasaki “already contemplates displaying text, images and icons to the user and that the user can access the server via the Internet,” and that Jacobi’s recommendation messages are generated via Web pages or email. *Id.* (citing Ex. 1004 ¶¶ 39, 128; Ex. 1006 ¶ 74; Ex. 1003 ¶ 68). Patent Owner does not specifically contest Petitioner’s assertions. We determine that Petitioner has provided a reasoned explanation, supported by the record evidence, sufficient to show that a person having ordinary skill in the art would have combined the teachings of Jacobi with those of Sasaki and Ellis.

f) Weight Accorded to Dr. Houh’s Attestations

Patent Owner argues that Dr. Houh’s declaration testimony should not be credited because “key portions of his declaration repeat, often *verbatim*, the arguments in the Petition.” PO Resp. 43. Patent Owner cites to language addressing limitation [1.2] that is substantially identical to that in the Petition except for the addition of block quotes from the references. *Id.* at 29, 44 (citing Pet. 31–33; Ex. 1003 ¶¶ 84–90). Patent Owner argues that Dr. Houh similarly repeats the language from the Petition with respect to limitation [1.3]. *Id.* at 39, 44–45 (citing Pet. 33–35; Ex. 1003 ¶¶ 91–96). Patent Owner further points to similar perceived defects in Dr. Houh’s testimony on accessing information proximal to a current location of a user, and on motivation to combine. *Id.* at 41 (citing Pet. 24–26; Ex. 1003 ¶¶ 58–62). On this basis, Patent Owner contends that “Dr. Houh’s testimony is thus entitled to little weight.” *Id.* (citing *Xerox Corp. v. Bytemark, Inc.*,

IPR2022-00624, Paper 9, 15–16 (PTAB 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”); *see also* PO Sur-reply 16–17.

Petitioner argues that “the Petition relies on Dr. Houh’s statements in his declaration, not the other way around. Moreover, Dr. Houh’s statements are entirely based on either a citation to evidence (e.g., the prior art) or technical reasoning informed by his expertise.” Pet. Reply 24. For example, Petitioner contends that in analyzing the motivation to combine Sasaki and Ellis, Dr. Houh relies on his expertise, supported by documentary evidence. *Id.* at 24–25 (citing Ex. 1003 ¶¶ 59–66, 111, 222 (citing Exs. 1009, 1010, 1011)).

In our Decision, we accord weight to Dr. Houh’s attestations consistent with his documentary support and his reasoned explanations based upon his relevant experience. For example, in our analysis of limitation [1.2], we credited Dr. Houh’s explanation of how teachings of Sasaki and Ellis would be combined to teach that limitation. *Supra* §II(E)(4)(a) (citing to Ex. 1003 ¶¶ 75–83). Dr. Houh’s analysis of what teachings from each referenced would be applied to teach limitation [1.2] was replete with citations to the texts of Sasaki and Ellis. Ex. 1003 ¶¶ 75–82. Dr. Houh’s statements as to why a person having ordinary skill in the art would have combined the teachings of Sasaki and Ellis is likewise based upon highlighting teachings from each individual reference and explaining their commonalities and advantages. *Id.* ¶¶ 60–62. Due to Dr. Houh’s citations to the record evidence to support his conclusions on these and the other issues for which we credit his testimony, we determine that his

testimony is not purely conclusory, and that it should be given weight commensurate with its support and explanation.

g) Determination

In view of the foregoing, we determine that Petitioner has shown, by a preponderance of the evidence, that each element of claim 1 has been taught or suggested by the combined references. Further, that Petitioner has shown, by a preponderance of the evidence, that a person having ordinary skill in the art would have reason to combine the references as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

5. Analysis of Claims 6, 11, and 16

Petitioner asserts that the combination of Sasaki, Ellis, and Jacobi renders the limitations of claims 6, 11, and 16 obvious. The Petition relies partly on its persuasive showing for claim 1, including its showing of a reasonable expectation of success and reasons for combining the references, to reach the additional limitations of claims 6, 11, and 16. *See* Pet. 41–42, 44–55.

As discussed below, Patent Owner disputes Petitioner’s showing as to limitations directed to the portable media device sending location information to a server. In particular, claim 6 depends from claim 1, and recites, “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.” Claim 11 similarly requires “providing to a server, by a portable media player device, a current location of the portable media player device.” Claim 16 similarly recites, “provide a server with a current location of the portable media player device.”

Petitioner asserts that Sasaki's server infers the location of the portable media player device through reception of GPS or radio wave positional information from the device. Pet. 41 (citing Ex. 1004 ¶¶ 69, 80–81). Petitioner relies upon Sasaki's GPS functionality, asserting that it is preserved as part of the terminal structure in the server-terminal embodiment. Pet. Reply 17. Petitioner points to Ellis's disclosure of a recommendation system in which an individual network component and/or a "central facility," "collect[s] . . . usage data." Pet. 23 (quoting Ex. 1005 ¶¶ 236, 263 (describing Fig. 37)), 26. Petitioner relies on Ellis to suggest downloading information about local events from a website based on GPS or other location information to improve Sasaki's server system by automatically providing real time event recommendations to users from a server based on media types and locations of the user's devices. *See* Pet. 34–35 (citing Ex. 1005 Fig. 28A–B, ¶¶ 225, 233–234, 236). Toward that end, Petitioner contends that "Ellis specifically teaches that its techniques can be implemented in a 'network component' and/or a 'central facility,'" with Ellis providing implementation details that an artisan of ordinary skill would have considered employing in Sasaki's server system in a predictable manner using known techniques. *Id.* at 26 (quoting Ex. 1005 ¶¶ 162, 236).

Patent Owner argues that claims 6, 11, and 16 "implicitly require[] the portable media player device to transmit its location to the server." PO Resp. 42 (citing Ex. 2007 ¶ 159). Patent Owner argues that Sasaki does not teach a portable media device transmitting location information to a server. *Id.* (citing Ex. 2007 ¶¶ 159–161). Patent Owner argues that location information is only transferred between terminals, and that the embodiment replacing one of the terminals with a server would replace the terminal sending the location with a server. *Id.* at 32 (citing Ex. 1004 ¶¶ 69, 80–81;

Ex. 2007 ¶¶ 147–152). Patent Owner argues that in Sasaki’s server embodiment, the server determines whether it has content recommendation that matches the preferences of the user of the terminal devices, and then transmits the content recommendation to the terminal device. *Id.* at 33 (citing Ex. 1004 ¶¶ 117, 120; Ex. 2007 ¶ 119). Patent Owner argues that Sasaki does not describe transmitting location information from the terminal device to the server, and that Petitioner does not explain why Sasaki would do so when the terminal device receives, not sends, the recommendation. *Id.* (citing Ex. 1004 ¶¶ 112–130). Patent Owner argues that there would be no need for such a location transmission, because the location of the service spot of the server “is already known and communication happens only when the terminal device is close enough to receive an identifying signal from the server.” *Id.* at 33–34 (citing Ex. 1004 ¶¶ 54, 113–114). Patent Owner argues that the terminal retains its GPS capabilities, but does not send its location information to a server. *Id.* at 35–36 (citing Ex. 2007 ¶ 160).

Patent Owner’s arguments are unavailing. As Petitioner shows and as determined above in connection with claim 1, Sasaki teaches a server in communication with portable media player. And as discussed in connection with limitation 1.3, “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. Reply 42 (citing Ex. 1004 ¶¶ 69, 81). As Petitioner also argues, “Sasaki also teaches that the place of transmission is ‘necessary information’ and is part of the ‘content recommendation information.’” *Id.* at 34 (citing Ex. 1004 ¶ 68). Petitioner also shows that Sasaki teaches that in the server-server embodiment, “the portable media player device transmit[s] the location information of the portable media player device to the server the

terminals send recommendation information to the server.” *Id.* at 55 (citing Ex. 1003 ¶¶ 156–158), *see also id.* at 30–31 (showing that Sasaki’s server is similar to Sasaki’s terminal and differs in only because it lacks audio processor 8, speaker 9, LCD driver 10 and LCD 11). The Petition also quotes Sasaki’s Abstract, which states that Sasaki’s “content recommendation system includes first and second communication devices which are connected to each other and *in which content recommendation information is transmitted and received between both devices.*” *Id.* at 44–45 (emphasis added) (quoting Ex. 1004, code (57)).

Based on the findings as outlined above, Sasaki contradicts Patent Owner’s assertion that Sasaki’s terminals do not send location information as part of sending recommendation information to Sasaki’s server. As further support for this teaching, Petitioner quotes paragraphs 112 and 113 of Sasaki. *See* Reply 15 (quoting Ex. 1004 ¶¶ 112–113); Pet. 30 (quoting Ex. 1004 ¶ 113). Specifically, as quoted in the Reply Sasaki states “[i]n a second embodiment of the present invention, *content recommendation information is transmitted and received between a server at a service spot and a terminal device.*” *Id.* (emphasis added) (quoting Ex. 1004 ¶ 112). As also quoted in the Reply, “the second embodiment is realized such that, in the above-described first embodiment, one terminal device (e.g., terminal device A) is replaced by a server at a service spot, and communication is performed between the server and terminal device B.” *Id.* (quoting Ex. 1004 ¶ 113). And as also quoted in the Reply, paragraph 113 specifically states that “[t]erminal device B used in the second embodiment is similar in configuration to the terminal device whose configuration is shown in FIG. 1, and has similar functions.” Ex. 1004 ¶ 113. In other words, as cited in the Petition and in the Reply, Sasaki shows that the terminals in both

embodiments have “similar functions” and therefore transmit location information with the recommendation information.

As Petitioner argues, “[t]hese statements indicate that the server-to-terminal embodiment *is* the terminal-to-terminal embodiment.” Reply 15 (citing Ex. 1003 ¶¶ 40–43). In other words, Petitioner shows that Sasaki’s server functions similarly to the terminal, so that the terminal and server each include the disclosed GPS functionality. *See id.* (arguing that “the same teachings are applied to the embodiment in which one device is a terminal and the other is a server” (citing Ex. 1004 ¶¶ 29, 112). As Petitioner also argues, “the terminal retains the GPS and other location technology in the server-to-terminal embodiment.” *Id.* at 15–16. As indicated above, Sasaki supports Petitioner because Sasaki discloses that sending location information to the terminal is necessary as part of the recommendation information sent by the terminal to the terminal in the terminal-terminal embodiment, and these teachings apply to the server in the terminal-server embodiment. *See* Ex. 1004 ¶¶ 68, 112–113, code (57).

The Sur-reply does not address the specific language of paragraph 112 as quoted in the Reply or otherwise undermine the thrust of its disclosure as relied upon by Petitioner. *See* Sur-reply 12–14 (arguing that Sasaki does not teach that “the *server* receives the location from the *portable media player* device” as claim 11 recites but not disputing that “Sasaki’s server at least implicitly determines the location of the user’s portable media device” as found in the Institution Decision). The Sur-reply does cite to Sasaki’s paragraphs 112 and 113 and concedes that “Sasaki states that the portable terminal device has ‘similar functions’ in both embodiments,” but Patent Owner maintains that “the terminal device in the server-to-terminal

embodiment does not communicate content recommendations or ‘place of transmission’ to the server.” *Id.* at 11–12 (citing Ex. 1004 ¶ 112–130). But Sasaki directly contradicts Patent Owner for the reasons noted above. *See* Ex. 1004 ¶ 112, code 57). For example, as found above, Sasaki specifically states that “*content recommendation information is transmitted and received between a server at a service spot and a terminal device.*” Reply 13 (emphasis added) (quoting Ex. 1004 ¶ 112). Other passages support the finding that Sasaki’s server *receives* recommendation information (and with that, location information), contrary to Patent Owner’s arguments otherwise. *See* Ex. 1004 code (57), ¶¶ 17–19 (generally describing the server), 68–69 (describing sending location information as necessary to recommendation information), 112–113 (describing similar functionality for the server including the sending and receiving of recommendation information).

Patent Owner contends that “Petitioner’s argument that the server-to-terminal embodiment is the terminal-to-terminal embodiment” and “retains the GPS technology” is untimely. *See* Sur-reply 10–11. Contrary to this assertion, Patent Owner otherwise contends that “the Petition incorrectly asserted that Sasaki’s paragraphs 69 and 81 disclosed a portable terminal device transmitting its location to a server.” *Id.* at 10. In other words, the thrust of the Petition is that Sasaki’s terminal sends location information to the server. Further, as discussed above, the Petition essentially alleges and shows that Sasaki’s server only differs from the terminal with respect to the “audio processor 8, speaker 9, LCD driver 10 and LCD 11 of the terminal device shown in Fig. 1.” Pet. 29–30 (quoting Ex. 1004 ¶ 113; annotating Fig. 1 to show the minor differences in hardware). As also discussed above, cited paragraph 113 specifically states that “[t]erminal device B used in the

second embodiment is similar in configuration to the terminal device whose configuration is shown in FIG. 1, and has similar functions.” Ex. 1004

¶ 113. In other words, as cited in the Petition, Sasaki shows that the terminals in both embodiments have “similar functions” and therefore transmit location information with the recommendation information. At most, the Reply simply fills in gaps as to this finding.

In addition, the Petition quotes Sasaki as stating that its “content recommendation system includes first and second communication devices which are connected to each other and . . . *content recommendation information is transmitted and received between both devices.*” See Pet. 29 (emphasis added) (quoting Ex. 1004, code (57)). This generic description involving “communication devices” includes in its ambit both terminals and servers based on the remaining descriptions of the terminal and server in Sasaki as discussed above. This further shows that Petitioner’s Reply arguments simply fill in the gaps to rebut Patent Owner’s arguments about Sasaki’s location information and combining of Sasaki’s embodiments and support the Petition’s initial position that Sasaki’s server and terminal include the same relevant hardware and corresponding overlapping functionality in both embodiments.

Sasaki also supports Petitioner’s showing that the two embodiments are similar in material functionality as it relates to another issue Patent Owner raises. That is, Patent Owner argues that “[t]here 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”). PO Resp. 34 (citing Ex. 1004 ¶ 54, Fig. 5). Contrary to this argument, Sasaki specifically states that

“[w]hen the terminal devices A and B are close to each other within a predetermined distance, a communication process is automatically initiated between both terminals.” Ex. 1004 ¶ 53. This is just like the communication between Sasaki’s server at the service location that communicates with the terminal, according to Patent Owner’s characterization.

Therefore, Sasaki does not support Patent Owner’s argument that there is no need to transfer location information from the terminal to the server, because in both embodiments, the two devices are close together and communicate with each other. The reason for transmitting the location information is “convenience” so that a user can “facilitate [the] purchase of content” “at a later time or . . . date,” aided by recalling where the information transfer occurred. *See* Ex. 1004 ¶¶ 80 (“When terminal devices A and B have GPS receiving functions as described above, by recording positional information at a transmitting or receiving time in a memory of either terminal device, convenience is obtained when referring to a receiving list.”), 132 (describing that terminals receive content recommendation information in both embodiments and can display it and play it back to “facilitate purchase of the content” “at a later time or . . . date”), 131 (referring to both embodiments as introductory material to paragraph 132).

As Patent Owner recognizes (Sur-reply 11), for the terminal-to-terminal embodiment, Sasaki specifically states that a terminal device transmits “content recommendation information” and that information includes “a place of transmission” (Ex. 1004 ¶ 59), which in turn, may include “GPS information . . . to specify the place of transmission” (*id.* ¶ 69). Similarly, for the terminal-to-server embodiment, “the server *stores a piece of content recommendation information*” to determine if it “matches a

preference of the member of terminal device B.” *Id.* ¶ 119 (emphasis added). And as found above, Sasaki states that “content recommendation information is transmitted and received between a server at a service spot and a terminal device.” *Id.* ¶ 112). Other Sasaki paragraphs describing the second embodiment or both embodiments support this finding. *See id.*

¶¶ 129 (the second embodiment includes “provision of content recommendation information . . . by transmitting a response request from a server and connecting a communication channel with a terminal device which receives the response request to respond to the server”), 130 (“[I]t is also possible to perform updating information in a server by transmitting user’s latest preference information from a terminal device to the server, and providing content recommendation information corresponding to the latest preference information.”), 131 (in both embodiments, “pieces of content recommendation information from many terminal devices can automatically be collected”).

In further support, as discussed above, Sasaki’s Abstract generically refers to “first and second communication devices” (instead of terminals or servers) and states that its “content recommendation system includes first and second communication devices which are connected to each other and . . . *content recommendation information is transmitted and received between both devices.*” *See* Pet. 29 (emphasis added) (quoting Ex. 1004, code (57)). This description is similar to that of paragraphs 17 and 112 and shows that for all the disclosed “devices” (i.e., servers or terminals), “*content recommendation information is transmitted and received between both devices.*” *See* Ex. 1004, code (57) (emphasis added). Sasaki further blurs argued distinctions between the embodiments by referring to “the embodiment” and noting that “[c]ontent recommendation information [is]

stored in storage means of the server” without limiting what device transmits the recommendation information that the server stores. *See id.* ¶ 17 (“[T]he content recommendation system according to the embodiment is applicable to a server (first communication device) and a communication device (second communication device)”). Also, installing the server at a service spot is merely a non-limiting “example.” *Id.*

In addition, Sasaki explicitly discloses that each terminal in the terminal-to-terminal embodiment connects to either a terminal or server without limiting the server to a fixed service spot location. *See* Pet. 49 (citing Ex. 1004 ¶ 41 (“[W]ireless communication can establish connection with a terminal device of the same model, or connection between the terminal device and an external device such as a server through a predetermined network.”)). Therefore, as Petitioner shows, Sasaki’s terminals and its servers each process, receive, and transmit the same or similar relevant information and are similar in functionality and structure with respect to issues involved here.

Patent Owner argues that Ellis does not provide the missing teaching of sending location of a device to a server. Patent Owner argues that Petitioner does not rely on this teaching. PO Sur-reply 12. Patent Owner argues that Ellis teaches a device that determines its own location, but that determined location is not transmitted to a server. PO Resp. 37, 42–43 (citing Ex. 2007 ¶ 162); PO Sur-reply 11–12.

These arguments are unavailing because as found above, Petitioner shows that Sasaki discloses sending location information from a terminal to a server. Moreover, even if Sasaki does not necessarily disclose transmitting location information to the server from a terminal, Petitioner persuasively contends that “Sasaki’s server in communication with a portable media

player device that directly transmits location information in view of Ellis's technique of using the user's geographic location to access information about events and facilities that are local to the user render obvious" in discussing limitation 1.3, which is similar to the disputed limitations of claim 6, 11, and 16. Pet. 35 (citing Ex. 1003 ¶¶ 91–96), 41 (similar showing for claim 6), 44–46 (similar showing for claim 11), 47–48 (similar showing for claim 16).

In other words, as found in connection with claim 1, Petitioner shows that Sasaki's server processes all manner of information, including consumer usage information, and that Ellis renders obvious processing similar information, which includes venue and user location information, in a server, in order to automatically provide preference information to a user. In Sasaki's terminal-server embodiment, there are only two places to process and store information, the terminal or the server. There is no dispute that Sasaki's server determines if user preferences match stored recommendations. As found above, the server-stored recommendations also include terminal location information. Petitioner shows further that Ellis teaches providing preferences based on location and other data such as user consumption data, with the latter processed at a central facility, thereby further suggesting processing at a server. *See* Pet. 22–24. Based on the similar teachings of Sasaki's recommendation system and Ellis's recommendation system, Petitioner persuasively shows that it would have been obvious to implement Ellis's similar recommendation technique to improve Sasaki's system by using Sasaki's server to implement details of

Ellis’s location-based technique to provide automatic location-based recommendations in near real-time instead of manually. *See id.* at 25–26.⁶

Consequently, we determine that Petitioner shows by a preponderance of the evidence, that claims 6, 11, and 16 would have been obvious over the combination of Sasaki, Ellis, and Jacobi.

6. *Analysis of Claims 5, 8–10, 15, 20–21, and 25*

a) *Claim 21*

Claim 21 recites a server having storage medium and processor coupled thereto, enabling the server to perform functions substantially identical to the steps recited in claim 1. Petitioner describes the recited functions as “substantially similar to” limitations [1.1]–[1.6], and applies the same assertions thereto. Pet. 58–59. Petitioner points to Sasaki’s server-terminal embodiment, in which the server has a memory (ROM 2) that stores control programs to be executed by a processor (CPU 1). Pet. 57–58 (citing Ex. 1004 ¶¶ 30, 41, 113, 165, 167–168, Fig. 1). Patent Owner does not specifically contest this assertion. We agree that Petitioner has shown the elements of claim 21 that are substantially identical to those in claim 1, as discussed above, and has shown that Sasaki teaches the additional elements. Therefore, Petitioner has shown, by a preponderance of the evidence, that claim 21 would have been obvious over the combination of Sasaki, Ellis, and Jacobi.

⁶ In our view, the perceptive focus of the Dissent advances specific arguments related to the location information not raised by Patent Owner based on treating the references individually, and without considering the collective teachings as advanced in the Petition (and as gap-filled in the Reply to address the Response).

b) Claims 5, 15, and 20

Claims 5, 15, and 20 further limit the event or venue of interest to “a worship, cultural, community, or political event or venue,” and that the recommendation is based on a podcast-inferred preference and an attribute of the event or venue. Petitioner asserts that Ellis teaches the comparison of user-inferred preferences and an attribute of an event or facility, and that Sasaki teaches providing recommendation information about places of “historical interest.” Pet. 39–41 (citing Ex. 1004 ¶ 139; Ex. 1003 ¶¶ 110–113). We agree that an event or a place of historical interest teaches at least one or more of a worship, cultural, community, or political venue or event. Patent Owner does not contest this assertion. Thus, Petitioner has shown that the combination teaches a recommendation based on an event or a place of historical interest of at least cultural or community venue or event.

Petitioner further asserts that Ellis’ description of a “radio show broadcast via the internet” would be recognized by a person having ordinary skill in the art as podcast media. Pet. 40 (citing Ex. 1009 ¶ 35 (“It may be desired to publish a portion of the radio program as a podcast.”); Ex. 1010, ¶ 2 (“A podcast is a digital recording of a radio broadcast or similar programme, made available on the Internet in a number of separate files for downloading to a personal audio player.”)). Patent Owner does not contest this assertion.

Petitioner’s showing that a podcast was a well-known and desirable type of an Internet radio podcast indicates that it is at least a suitable option for a non-podcast type of Internet radio broadcast. *See VirnetX, Inc. v. Apple, Inc.*, 665 F. App’x 880, 888 (Fed. Cir. 2018) (holding that “[s]ubstantial evidence supports the PTAB’s finding that Wesinger’s disclosure of the genus ‘computer’ encompasses the ‘notebook computer’

species”). Additionally, Dr. Stillerman testifies that both he and Dr. Houh agree that “downloading involves storing a media file and saving it in storage.” Ex. 1023 ¶¶ 47–48. Therefore, because Sasaki discloses downloading media (including audio media), it discloses downloading media files. It follows that Sasaki’s terminal devices are capable of downloading and storing podcasts, because podcasts, like generic audio media, are broadcast as media files and stored according to record evidence. *See id.*; Ex. 1010 ¶ 2.

Accordingly, Petitioner shows that it would have been obvious to one having ordinary skill in the art to include podcast media as one of the well-known and desirable audio media types disclosed by Sasaki as further suggested by Ellis’s Internet radio broadcasts. Consequently, we determine that Petitioner has shown that claims 5, 15, and 20 would have been obvious in view of the combined teachings of Sasaki, Ellis, and Jacobi.

c) Claims 8 and 9

Claim 8 further requires transmitting the recommendation to the portable media device. Claim 9 further requires that the transmitting be by a short message service (“SMS”), email, pager, or facsimile message, or by a call to the user. Petitioner relies upon Sasaki’s teaching of providing recommendation information to a terminal device, and Jacobi’s teaching of communicating recommended events by email or facsimile. Pet. 42–43 (citing Ex. 1004 ¶¶ 11, 132; Ex. 1003 ¶¶ 118–121; Ex. 1006 ¶ 74). Patent Owner does not provide arguments against these assertions. As detailed for claim 1, we agree that Sasaki’s server-terminal embodiment teaches sending recommendation to a terminal device. In view of Jacobi’s teaching of email or facsimile communication of recommendation information and the asserted reason to combine such teachings (Pet. 28–29), we determine that

Petitioner has shown that claims 8 and 9 would have been obvious in view of the combined teachings of Sasaki, Ellis, and Jacobi.

d) Claims 10 and 25

Claims 10 and 25 recite the further limitation of retrieving, by the server, the media or information about the media from a storage within the server. Petitioner points to Sasaki's hard disk drive ("HDD") 4 as a storage device within Sasaki's server. Pet. 44 (citing Ex. 1004, Fig. 1; Ex. 1003 ¶ 27). Petitioner further points to Sasaki's teaching that the server can retrieve preference information, which Petitioner states to be "usage data collected about what a user has listened to or accessed using a portable media player device," from a hard drive. *Id.* at 43 (citing Ex. 1004 ¶ 126). Patent Owner does not specifically contest this assertion.

Based on the record, we determine that Petitioner has shown persuasively that Sasaki teaches the additional elements. The "information about the media" finds antecedent basis in claims 1 and 21, respectively, for claims 10 and 25. For those claims, Petitioner ascribes the "information about the media" to the combined teachings of Sasaki's user preference information, which is received from a portable media device or a hard drive, and Ellis's usage data, which is sent to a central facility. Pet. 30–32 (citing Ex. 1004 ¶ 126 (from hard drive); Ex. 1005 ¶ 265 (to central facility)). In Petitioner's asserted combination, Petitioner characterizes the Sasaki-Ellis system as one that "captures" the user's preferences in near real-time. *Id.* at 25. Because Petitioner frames the combination as capturing usage data in a server, we agree that the asserted combination addresses the elements as recited in the claim. Further, we determine that Petitioner shows persuasively that it would have been obvious to have stored usage data on the server in the asserted combination. Therefore, Petitioner has shown, by a

preponderance of the evidence, that claims 10 and 25 would have been obvious over the combination of Sasaki, Ellis, and Jacobi.

F. Obviousness over Sasaki, Ellis, Jacobi, and Teicher

1. Teicher (Ex. 1007)

Teicher is titled, “Method and Apparatus for Arranging Social Meetings.” Ex. 1007, code (54). Teicher describes a computerized service in which subscribers fill in wish lists specifying their interests and their availabilities. *Id.* code (57). Teicher’s system notifies the subscribers if other subscribers are interested in the same attraction, favor each other’s company, and are free at the same time. *Id.*

2. Claims 2–4, 12–14, 17–19, and 22–23

Claims 2–4, 12–14, 17–19, and 22–23 recite further limitations as to the venue of interest. Claims 2, 12, 17, and 22 limits the venue to a club or church; claims 3, 13, 18, and 23 to a theatre or cinema, and claims 4, 14, 19, and 23 (in an alternative limitation) to a museum or gallery. Petitioner asserts that these limitations are taught by Teicher, which describes recommendations of clubs, theatres, and museums as venues of interests for subscribers to jointly attend. Pet. 64–69. (citing Ex. 1007 ¶ 7). Petitioner asserts that it would have been obvious to a person having ordinary skill in the art to “apply Teicher’s techniques of recommending different types of attractions to the event and facility recommendations of Sasaki-Ellis-Jacobi” because having more types of attractions per Teicher would broaden the usefulness of the more limited scope of attractions of Sasaki-Ellis-Jacobi. *Id.* at 62–63. Patent Owner does not contest these assertions. We determine that Petitioner persuasively shows that Teicher teaches the additional elements. Therefore, Petitioner has shown, by a preponderance of the

evidence, that claims 2–4, 12–14, 17–19, and 22–23 would have been obvious over the combination of Sasaki, Ellis, and Jacobi.

G. Obviousness over Sasaki, Ellis, Jacobi, and Havinis

1. Havinis (Ex. 1008)

Havinis is titled, “System and Method for Providing Historical Data for Location Services.” Ex. 1008, code (54). Havinis is directed to a telecommunications system for providing location information concerning subscribers. *Id.* at code (57). Havinis aims to “implement a mechanism to provide location information along with the age of that location information to the requesting location application even if the mobile terminal to be positioned is not currently reachable, and therefore, current location information is not available.” *Id.* at 3:1–6.

2. Claims 7 and 24

Claim 7 recites the further limitation, “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 an access point through which the portable media player device establishes a network connection to the server.” Claim 24 recites a similar requirement for the server to determine the current location of the user from either the portable media player or from an intervening access point on the server network.

Petitioner asserts that Havinis teaches a server’s receipt of a location of a mobile device through a transceiver station; i.e., an access point. Pet. 76–77 (citing Ex. 1008, 4:31–38). Petitioner asserts that claims 7 and 24 are taught by Havinis’ access point-mediated location reception combined with Sasaki’s server that receives location information from its portable media player device. *Id.* at 77 (citing Ex. 1003 ¶¶ 224–229). Petitioner asserts that

a person having ordinary skill in the art at the time the invention was made would find it desirable to employ Havinis' non-GPS based location monitoring system to provide additional functionality in the GPS-based system of Sasaki and Ellis. *Id.* at 74–75 (citing Ex. 1003 ¶ 218).

Petitioner's showing, including its showing of a reasonable expectation of success, is persuasive. Patent Owner does not challenge Petitioner's showing. *See* PO Resp.

Based on the record, we determine that Petitioner shows by a preponderance of the evidence, that claims 7 and 24 would have been obvious over the combined teachings of Sasaki, Ellis, Jacobi, and Havinis.

III. CONCLUSION

For the reasons discussed above, Petitioner has shown by a preponderance of the evidence that claims 1–25 of the '960 patent are unpatentable. Our conclusions are summarized in the table below.

Claims	35 U.S.C. §	Reference(s) / Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 5–6, 8–11, 15–16, 20–21, 25	103(a)	Sasaki, Ellis, Jacobi	1, –6, 8–11 15– 16, 20–21 0– 21, 25	
2–4, 12–14, 17–19, 22–23	103(a)	Sasaki, Ellis, Jacobi, Teicher	2–4, 12–14, 17–19, 22–23	
7, 24	103(a)	Sasaki, Ellis, Jacobi, Havinis	7, 24	
Overall Outcome			1–25	

IV. ORDER

Accordingly, it is

ORDERED that Petitioner establishes by a preponderance of evidence that challenged claims 1–25 are unpatentable;

and

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. § 90.2.⁷

⁷ 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. 16654 (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).

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE, LLC,
Patent Owner.

IPR2023-00244
Patent 10,251,021 B2

Opinion Concurring-in-Part and Dissenting-in-Part filed by CYGAN,
Administrative Patent Judge.

I respectfully dissent from the majority's decision finding claims 6–7, 11–20, and 24 obvious because Petitioner does not sufficiently explain, and the record does not support, that the asserted combination teaches a recommendation sent from the server that is based upon a location received from a portable media player device, as explicitly recited in claims 6, 7, 11, 16, and 24. I concur in the decision for claims 1–5, 8–10, and 21–23, except as to the alternate determination for limitation [1.1.3] that the server receives location information from the media device.

The majority opinion focuses on the whether the server has the functionality to send location from a terminal to a server. Maj. Op. 31–32. The majority opinion decision further points to Sasaki's teaching that

“sending location information to the terminal is necessary as part of the recommendation sent by the terminal to the terminal . . . and these teachings apply to the server in the terminal-server embodiment.” *Id.* at 33. The majority opinion further relies on a generic statement in Sasaki that content recommendation information is transmitted and received between a server and terminal. *Id.* at 32–34 (citing Ex. 1004 ¶ 112).

However, claims 6, 7, 11, 16, and 24 are not satisfied merely by a terminal capable of sending location data. Nor are they satisfied by a terminal that sends location data with a recommendation to a server. Instead, claim 11 (as an example) requires the portable media player device to transmit the current location of the portable media device to the server, and in response, the server sends recommendations based upon that received current location back to the same portable media player device. The recommendation must be based on the location data – it cannot be transmitted with it. In Sasaki, the provision of the recommendation is the final step, not a precursor to further recommendations. Petitioner does not assert, nor does the record show, that Sasaki’s location-based recommendations are used in the claimed manner; i.e., to provide the claimed recommendation based upon current location data. Moreover, claim 11 requires the server to provide a recommendation based upon “inferred preferences of the user and the location information,” not an earlier-transmitted set of location-bearing recommendations.

To be clear, there is no embodiment in Sasaki that transmits location information except with the recommendation information. Sasaki’s sole described purpose of receiving location information is for recording where recommendations were received by the terminal so as to enable the user to later “search for a favorite piece of content on the basis of pieces of content

recommendation information”; e.g., by the received location. Ex. 1004, Fig. 3B, ¶¶ 59, 71–72. Sasaki’s location teachings are inexorably tied with receipt of a recommendation. There is no indication in Sasaki that location would be transmitted for any other purpose, or at any other time, than with the recommendation information. Consequently, no matter how one combines Sasaki’s different embodiments, Sasaki does not teach sending location data except with recommendation data.

Petitioner does not acknowledge the nature of Sasaki’s location teachings, and does not explain how and why they teach the requirement that location data received from a portable media player be the basis of recommendations made at the server and transmitted back to the portable media player. Consequently, I find that Petitioner has not shown, by a preponderance of the evidence, that claims 6, 7, 11, 16, and 24, and claims dependent therefrom, would have been obvious over the relied-upon teachings of Sasaki and Ellis.

The majority opinion also advances an alternate determination that the structure of Sasaki combined with the GPS of Ellis teaches this limitation. Maj. Op. 38–40. The majority opinion relies upon Ellis’ teachings that its remote device determines its own location, that it downloads information about local events, and that its techniques can be implemented in a central facility, which in the combination, would be Sasaki’s server. *Id.* at 39. However, the majority opinion does not explain how Ellis, not relied upon for sending a location anywhere, would remedy the lack of such a teaching in Sasaki.

Moreover, any determination that relies upon Ellis to teach transmitting location from a remote device would go beyond the scope of Petitioner’s assertions. Petitioner relies solely upon Sasaki for teaching

transmission of the location information. Petitioner states that the location transmission is taught by “Sasaki’s server in communication with a portable media player device that directly transmits information representing location information in view of Ellis’ technique of using the user’s geographic location to access information about events and facilities that are local to the user.” Pet. 35. Petitioner confirms this position, stating, “Sasaki teaches receiving location information representing the location of the user and Ellis teaches a technique that uses the geographic location of the user to acquire a set of events and facilities that are local to the user. *Id.* at 36. Petitioner again relies solely on Sasaki in its assertions for claims 6, 7, 11, 16, and 24, stating “Sasaki teaches . . . that the portable media player device associated with the user directly transmit[s] location information.” *Id.* at 41. Thus, Petitioner relies on Sasaki’s server-terminal connection, not Ellis’ remote device-central facility connection, to teach sending location to a server. The majority opinion does not explain how the combined teachings of Sasaki and Ellis would teach that which either does not.

Because Petitioner relied only on Sasaki for the location transmission in claims 6, 7, 11, 16, and 24, the majority opinion’s reliance on Ellis or some emergent property of the Sasaki-Ellis combination for the location transmission is beyond the scope of the Petitioner’s assertions. Our reviewing court has limited our review to the unpatentability theories presented by the Petitioner. *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.”). For this reason also, I do not agree with my

brethren's decision to find claims 6, 7, 11, 16, and 24, and claims dependent therefrom, obvious on this manner of combining Sasaki and Ellis.

In summary, I disagree with the portions of the majority opinion relying on Sasaki to teach location information being provided to its server by its terminal other than with recommendation information, and with the portions of the majority opinion raising a new Sasaki-Ellis combination in which Ellis provides any teaching of transmitting location information. For the foregoing reasons, I concur-in-part and dissent-in-part from the majority opinion.

IPR2023-00246
Patent 9,141,960 B2

FOR PETITIONER:

Andrew S. Ehmke
Raghav Bajaj
Calmann J. Clements
HAYNES AND BOONE, LLP
andy.ehmke.ipr@haynesboone.com
raghav.bajaj.ipr@haynesboone.com
calmann.clements.ipr@haynesboone.com

FOR PATENT OWNER:

Sal Lim
David L. Alberti
KRAMER ALBERTI LIM & TONKOVICH LLP
slim@krameralberti.com
dalberti@krameralberti.com

Michael D. Specht
Jason A. Fitzsimmons
Richard M. Bemben
Jennifer Chagnon
Steven Pappas
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
mspecht-ptab@sternekessler.com
jfitzsimmons-ptab@sternekessler.com
rbemben-ptab@sternekessler.com
jchagnon-ptab@sternekessler.com
spappas-ptab@sternekessler.com