

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VL COLLECTIVE IP LLC,
Patent Owner.

IPR2023-00891
Patent 8,605,794 B2

Before KARL D. EASTHOM, JEFFREY S. SMITH, and
DAVID C. McKONE, *Administrative Patent Judges*.

Opinion for the Board filed by Administrative Patent Judge EASTHOM.

Opinion Concurring filed by Administrative Patent Judge McKONE.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Unified Patents, LLC (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–22 of U.S. Patent No. 8,605,794 B2 (Ex. 1001, “the ’794 patent”). Paper 2 (“Pet.”). VL Collective IP LLC (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we grant the Petition and institute an *inter partes* review. The Board has not made a final determination regarding the patentability of any claim.

I. BACKGROUND

A. The ’794 Patent

The ’794 patent describes methods and devices that “enable[] content-related first and second data segments to be synchronized.” Ex. 1001, 2:24–27.

Figure 1 of the '794 patent follows:

FIG 1

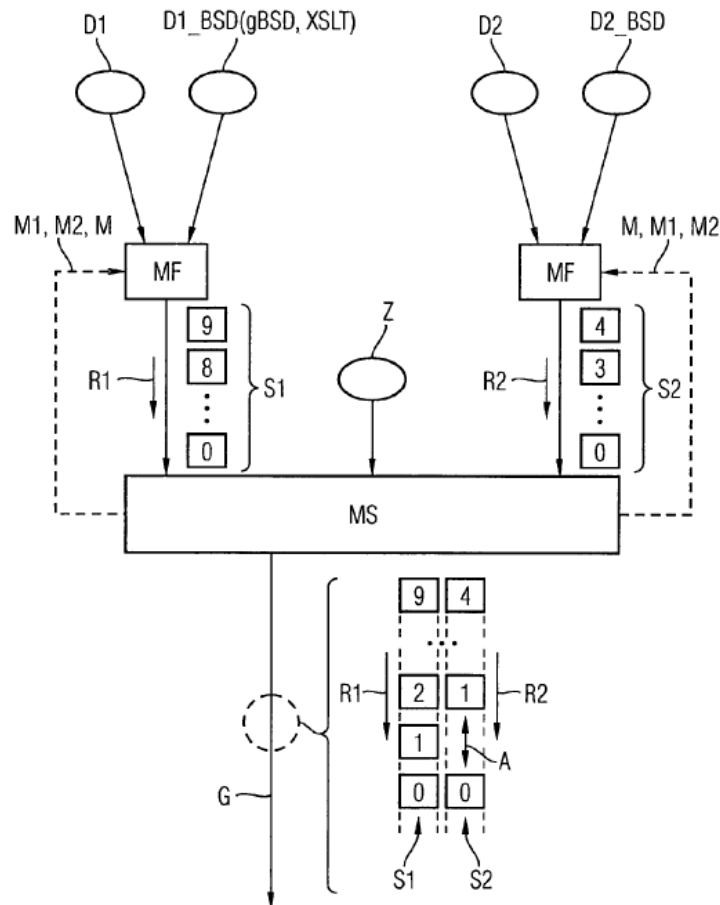


Figure 1 is a block diagram of a system and video and audio data streams that the system synchronizes. *Id.* at 3:46–47, 3:65–4:1. In the drawing, D1 represents the video data stream, illustrated as segmented into ten data segments S1. *Id.* at 4:3–5. Similarly, D2 represents the audio data stream, illustrated as segmented into five data segments S2. *Id.* at 4:6–8.

Synchronization module MS synchronizes the video and audio segments “on the basis of a predefinable assignment rule Z.” Ex. 1001, 5:10–13. In the illustrated example, where the number of video data segments is twice the number of audio data segments, assignment rule Z

outputs each audio data segment with every second video data segment (as indicated in the lower right portion of the drawing). *Id.* at 5:38–58. The ’794 patent describes other examples of assignment rules that may be applied. *Id.* at 5:59–6:42.

B. Illustrative Claim

Independent claim 1 is representative and follows:

1.[pre] A method for synchronizing content-related first data segments of a first data file and content-related second data segments of a second data file, the method comprising:

[a][1]sequentially outputting, by a device for synchronizing content-related data, the content-related first data segments and the content-related second data segments according to their chronological sequence in such a way that [a][2] each of the content-related second data segments is output together with an associated one of the content-related first data segments on the basis of an assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–22 on the following grounds. Pet. 3.

Claim(s) Challenged	35 U.S.C. §¹	References
1–5, 9–13, 15–17, 20, 21	102(a), 102(e)	Comps ²

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C §§ 102, 103(a) (effective Mar. 16, 2013). Petitioner contends that “the earliest possible priority date of . . . the ’794 patent is April 12, 2005.” Pet. 11 (citing Ex. 1001, codes (22), (30), (86). Patent Owner does not dispute this “for purposes of its Preliminary Response.” Prelim. Resp. 12. Accordingly, we apply the pre-AIA version of §§ 102, 103(a).

² US Pat. No. 7,386,782 B2, filed Sept. 13, 2001, issued June 10, 2008. Ex. 1004.

Claim(s) Challenged	35 U.S.C. § ¹	References
6–8, 22	103(a)	Comps, Wan ³
14	103(a)	Comps, Ahn ⁴
18, 19	103(a)	Comps, Kim ⁵

Petitioner also relies on a Declaration by Benjamin B. Bederson, Ph.D. Ex. 1003.

E. Real Parties in Interest

Petitioner identifies itself as a real party in interest. Pet. 1. In addition to itself, Patent Owner identifies its parent, VL IP Holdings LLC, and VideoLabs, Inc., which is a parent of VL IP Holdings LLC, as real parties in interest. Paper 4, 2.

F. Related Matters

The parties collectively identify the following related matters as involving the '794 patent: *VideoLabs, Inc. v. Netflix Inc.*, No. 1:22-cv-00229 (D. Del.); *VideoLabs, Inc. v. Amazon.com, Inc.*, No. 6:22-cv-01167 (W.D. Tex.); *VideoLabs, Inc. v. Amazon.com, Inc.*, No. 2:22-cv-01451 (W.D. Wash.); *VideoLabs, Inc. v. Amazon.com, Inc.*, No. 6:22-cv-00079 (W.D. Tex.); *Starz Entertainment, LLC v. VL Collective IP, LLC*, No. 1:21-cv-01448 (D. Del.); *VideoLabs, Inc. v. Apple Inc.*, No. NDCA-3-23-cv-01307 (N.D. Cal.); *Unified Patents, LLC v. VL Collective IP, LLC*, IPR2022-01086, Paper 37 (PTAB Dec. 15, 2023) (final written decision holding

³ US Pub. No. 2004/0024898 A1, published Feb. 5, 2004. Ex. 1005.

⁴ US Pub. No. 2004/0098398 A1, published May 20, 2004. Ex. 1006.

⁵ US Pub. No. 2003/0101364 A1, published May 29, 2003. Ex. 1007.

claims 1, 3, 5, 9, 12, 13, and 15 unpatentable, and claims 20 and 21 not unpatentable).⁶ Pet. 1; Paper 4, 2; Paper 7, 2.

II. ANALYSIS

A. Legal Principles

Under 35 U.S.C. § 102, anticipation requires a single prior art reference to disclose each and every element in a claim, arranged as recited in the claim. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). However, “the reference need not satisfy an *ipsissimis verbis* test.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009); *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990). Prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Under 35 U.S.C. § 103(a), a claim is unpatentable for obviousness 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 skill in the art; and (4) when in evidence (none

⁶ Patent Owner indicates that if it “prevails in” IPR2022-01086, it “intends to seek termination of this Petition on the theory that Petitioner is a real party-in-interest in IPR2022-01086.” Prelim. Resp. 35 (citing 35 U.S. Code § 315 (e), 35 U.S.C. §§ 314(a), 325(d); *Samsung Electronics Co., Ltd. v. MemoryWeb, LLC*, IPR2022-00222, Paper 44 (PTAB Aug. 22, 2023)).

here), objective indicia of nonobviousness, i.e., secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); accord *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person of ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Petitioner proposes that a person of ordinary skill in the art “would have had a bachelor’s degree in electrical or computer engineering, or a

closely related scientific field such as computer science, and two years of work experience with streaming multimedia.” Pet. 12. Petitioner adds that “[a] lack of experience could be remedied with additional education (e.g., a master’s degree), and likewise, a lack of education can be remedied with additional work experience (e.g., 4–5 years).” *Id.* (citing Ex. 1003 ¶ 30). Patent Owner does not propose a different level. Prelim. Resp. 13–14 (asserting that “[f]or present purposes, this Preliminary Response establishes that Petitioner’s arguments fail even under its preferred definition of the level of ordinary skill.”).

Petitioner’s proposal is consistent with the level of skill reflected by the prior art, and supported by the testimony of Dr. Bederson, and we adopt it for purposes of this Decision. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art).

C. Claim Construction

The Board uses “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). “Petitioner applies the plain and ordinary meaning of all claim terms and contends that no claim terms require specific construction to resolve the unpatentability issues presented herein.” Pet. 21. Patent Owner proposes certain constructions, but at this juncture, it is not necessary to construe any term explicitly for purposes of this Decision. *See* Prelim. Resp.

13–27; *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))).

Nevertheless, we address some of Patent Owner’s claim construction positions. With respect to the preamble, we address it in light of Patent Owner’s arguments and the analysis of whether the Petition shows that Comps anticipates claim 1.

With respect to the claim term “content-related . . . data segments,” the specification states that “*the term “content-related” is understood to mean that first and second data segments have a syntactical meaning . . . , such as e.g. a plurality of succeeding second data segments represent the speech signal of a specific speaker within a dialog sequence.*” Ex. 1001, 4:9–22 (emphasis added).⁷ We agree with Patent Owner that the emphasized sentence defines the term “content-related.” Prelim. Resp. 14–15.⁸

However, for reasons similar to those discussed in the final written decision in IPR2022-01086, Paper 37 at 15–19, we determine that the “content-related” data segments do not support Patent Owner’s proposal,

⁷ The ellipses represents omission of the phrase “*within the respective data file*” because, as discussed above, we need not decide if the preamble (which introduces the data files) is limiting with respect to requiring data files. As discussed below, Petitioner’s showing includes relying on separate data files in Comps.

⁸ We also recognize that whether two segments have “syntactical meaning” between them may be somewhat subjective as discussed in the analysis of Petitioner’s challenges below.

namely “data segments ordered in a file such that they will present the file’s contents in their intended presentation order when rendered sequentially.” *See* Prelim. Resp. 14; IPR2022-01086, Paper 37 at 15–18. Contrary to Patent Owner’s arguments, the “syntactical meaning” as disclosed in the specification does not require “a sequential, chronological nature” specified by the content relationship, because claims 1 and 9 separately recite that feature by requiring “outputting . . . the content-related first data segments and the content-related second data segments according to their chronological sequence.” *See* Prelim. Resp. 17 (agreeing that “[i]ndependent claims 1 and 9 require outputting the data segments “sequentially” and “according to their chronological sequence.”). Claim 22 recites a similar feature, namely, “sequentially outputting, by a device for synchronizing content-related data, in a chronological sequence, each of the assigned content-related first data segments and the assigned content-related second data segments.”

D. Overview of Comps (Ex. 1004)

Comps’s system relates to synchronizing data output from “at least two separate computer files (track 1, track 2) called the first file, the second file, etc.” Ex. 1004, code (57). In Comps’s method, “at least one synchronization command is inserted in each file, characterized in that said synchronization command is inserted before each event-related command characterizing an important event.” *Id.*

Comps describes the data as follows:

Each track of the file 50 can contain a single type of data. For example, track 60 can be a MIDI (Musical Instrument Digital Interface) format track for sound, track 70 can contain a sequence of pictures, and track 80 can contain sequences of texts. The

different tracks may be intended to be scanned by microprocessors and presented simultaneously to a user. The different microprocessors therefore scan the tracks at the same time.

Ex. 1004, 2:60–67.

Figure 3 of Comps follows:

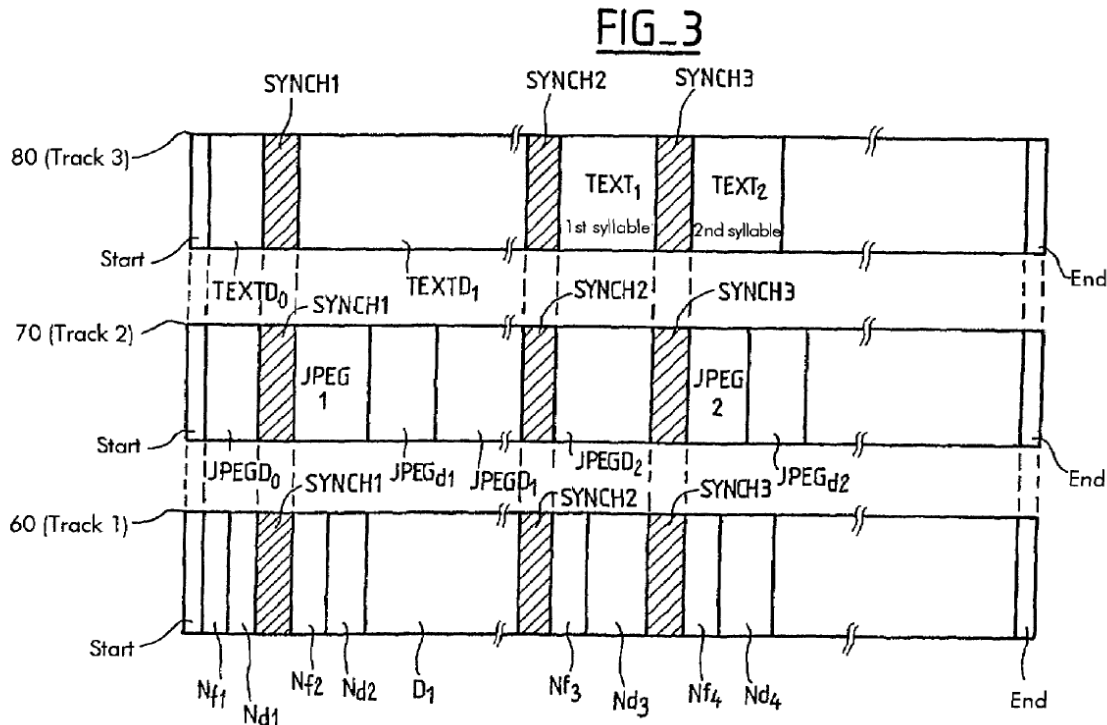


Figure 3 illustrates an embodiment of Comps’s method. “The different tracks [i.e., Tracks 1–3] may be intended to be scanned by microprocessors and presented simultaneously to a user.” Ex. 1004, 2:64–68. To ensure the processors do not lose synchronization, a master processor reads Track 1, and the SYNCH commands “force[] the other microprocessors in charge of the other tracks, referred to as slaves, to synchronize with it.” *Id.* at 3:48–54.

After the start and playing of a first note Nf₁ for duration Nd₁ on Track 1, the SYNCH1 command signifies that second musical note field Nf₂

(for duration Nd_2) on Track 1 is output in synch with first image field JPEG1 (for duration $JPEGd_1$) on Track 2. Ex. 1004, 3:7–4:28, Fig. 3. The TEXTD₁ field on Track 3 represents a “waiting time[] between texts.” *Id.* at 3:41. Similarly, after a waiting period D_1 in Track 1, the SYNCH2 command signifies that second musical note field Nf_3 (for duration Nd_3) on Track 1 is output in synch with text field TEXTD₁ on Track 3. *See id.* at 3:8–4:24.

E. Challenges over Comps

Petitioner asserts that Comps anticipates claims 1–5, 9–13, 15–17, 20, and 21. Pet. 3, 26–49.

1. Independent Claim 1

In its anticipation challenge of independent claim 1, Petitioner draws the following correspondences between elements recited in the claim and disclosure by Comps: (1) the recited “content-related first data segments” and musical note fields on Comps’s Track 1; (2) the preamble’s “first data file” and Comps’s Track 1; (3) the recited “content-related second data segments” and Comps’s video or text fields on Comps’s Tracks 2 and 3, respectively; (4) the recited “second data file” and Comps’s Track 2 (or Track 3); (5) the recited “device for synchronizing content-related data” and Comps’s computer system of multiple processors; and (6) the recited “assignment rule” and Comps’s execution of the SYNCH commands. Pet. 26–35.

Petitioner supports its showing with the following annotated version of Comps’s Figure 3 (Pet. 14):

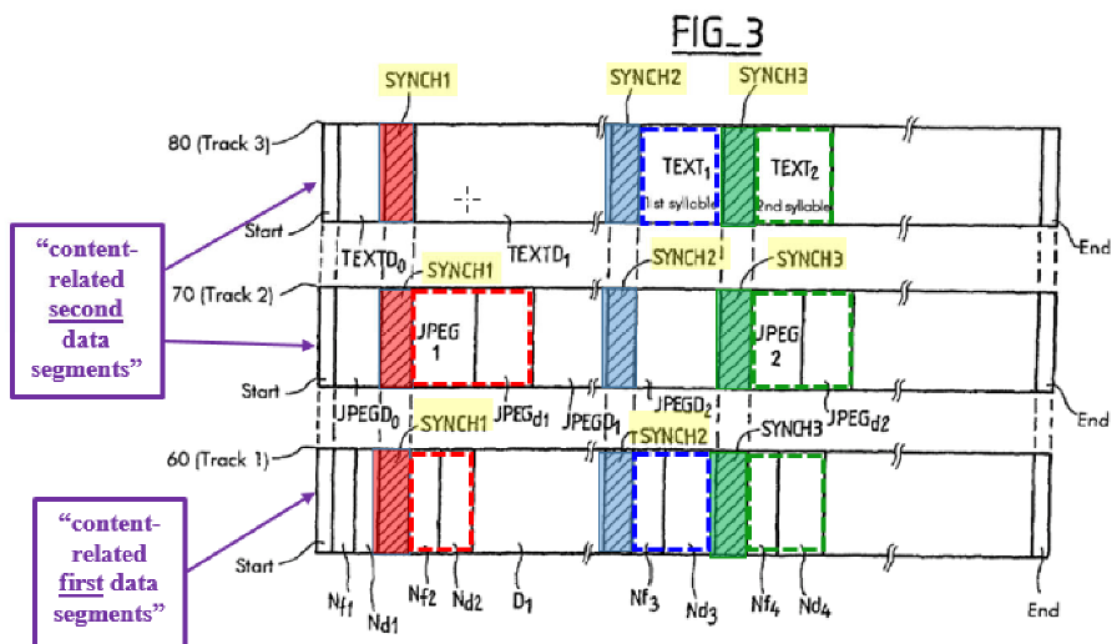


Figure 3 above illustrates how Petitioner reads the claimed first and second content related data segments onto Comps’s disclosure. Pet. 34. As annotated by Petitioner, Figure 3 illustrates content-related first data segments $Nf_2:Nd_2$ (red) output in synch with content-related second data segments JPEG₁ (red). Similarly, it illustrates content-related first data segments $Nf_3:Nd_3$ (blue) output in synch with content-related second data segments TEXT₁ (blue). Similarly, it illustrates content-related first data segments $Nf_4:Nd_4$ (green) output in synch with content-related second data segments JPEG₂ and TEXTD₂ (green).

Petitioner contends that “tracks 60, 70, and 80 in Comps have inserted SYNCH commands that control which content from each track is synchronized with content from the other tracks, so that they can be ‘output together’ or transmitted together simultaneously.” Pet. 33.

Patent Owner disputes the sufficiency of Petitioner’s showing “[b]ecause Comps is fundamentally about synchronizing a *subset* of events

in a track instead of *each* event (which Petitioner equates to the claimed ‘data segments’).” Prelim. Resp. 28. Patent Owner observes that “Petitioner identifies JPEG₁/JPEG_{d1} and JPEG₂/JPEG_{d2} as the ‘content-related second data segments’ (or alternatively TEXT₁ and TEXT₂).” *Id.* at 28–29 (citing Pet. 27–28).⁹ According to Patent Owner, however, “[t]he events JPEGD₀, JPEGD₁, and JPEGD₂ in Track 2 (or TEXTD₀ and TEXTD₂ in Track 3) are not identified as content-related data segments, and are not output together with events in Track 1 on the basis of a SYNCH command.” *Id.* at 28–29.

According to Patent Owner, Petitioner “appears to take the position that certain events are ‘content-related . . . data segments’ while other events are not.” Prelim. Resp. 30 (“In particular, Petitioner appears to contend that certain sound, text, and picture fields (e.g., Nf₂, JPEG₁, TEXT₁), as well as the durations of those fields (e.g., Nd₂ and JPEG_{d1}), are “content-related . . . data segments,” while other duration information is not (e.g., D₁, JPEGD₁, TEXTD₁).”). Patent Owner asserts that “[t]here is no valid basis to draw these distinctions,” even though “Comps does distinguish between important and unimportant events,” and “any type of event can fall in either category.” *Id.* at 31. Patent Owner also argues that “all petitioned claims require outputting ‘each’ content-related . . . data segment for the two data files, and not just a subset of them.” *Id.* at 32.

Patent Owner also argues that Comps’s content-related first and second data segments “are not output sequentially because fields such as D1

⁹ Comps’s Figure 3 employs a subscript for text commands (e.g., TEXT₁), but other portions of Comps do not employ a subscript for the same command (e.g., TEXT1). *Compare* Ex. 1004, Fig. 3, *with* 3:39–40. This decision does not employ the subscript unless quoting a party.

in Track 1, JPEGD₁ and JPEGD₂ in Track 2, and TEXTD₁ in Track 3 are output in between the alleged content-related data segments.” Prelim. Resp. 34 (citing Ex. 1004, 3:22–43, 3:57–4:2). Patent Owner also argues that Comps’s system at certain times does not execute all “events” because it skips to the next SYNCH command when a slave microprocessor lags behind the master. *See id.* (citing Ex. 1004, 4:25–57). Patent Owner summarizes that Petitioner “ends up relying on events that are not in chronological order” because Petitioner only “maps a subset of the events in the tracks to the data segments limitations and skip[s] multiple events.” *Id.*

Depending on how one reads the Petition, Patent Owner’s arguments may have some merit in relation to Petitioner’s grouping of two image segments in Track 2, JPEG1:JPEGd₁, and the two image segments JPEG2:JPEGd₂, identified generally as the claimed “content-related second data segments.” *See* Pet. 27–28. If each isolated time duration represented as JPEGd₁ and JPEGd₁ is an isolated content-related second data segment per the Petition, then Petitioner’s showing is deficient, because Petitioner fails to show how Comps’s system outputs these isolated “content-related data segments . . . together with an associated one of the content-related first data segments on the basis of an assignment rule,” as claim 1 requires. *See* Pet. 28 (annotating Ex. 1004, Fig. 3). On the other hand, it appears on this preliminary record that instead of that reading, Petitioner reads a single claimed data segment onto both data commands/events JPEG2:JPEGd₂ in Comps. Under this reading, it appears that Petitioner contends that JPEG1:JPEGd₁ and JPEG2:JPEGd₂ are content-related second data segments, output together with content-related first data segments Nf₃ and Nf₄, respectively. *See id.* (annotating Ex. 1004, Fig. 3). During trial, the

parties will have the opportunity to address this issue more fully, namely, whether the claimed “content-related second data segment” reads on Comps’s related data segments (e.g., JPEG2:JPEGd₂).

In any event, for institution purposes on this preliminary record, Petitioner sufficiently reads the claimed content-related second data segments separately onto text (TEXT1 and TEXT2) in Track 3, which the processors output in synchronization with content-related first data segments, namely notes Nf₃ and Nf₄, respectively, in Track 1. Pet. 28. Regarding this relied upon text, Comps states that “two syllables represented by the fields TEXT1 and TEXT2 *must be presented to the user.*” *Id.* at 3:39–40 (emphasis added). Comps’s Figure 3 specifies TEXT1 is a first syllable and TEXT2 is a second syllable. *See* Pet. 28 (annotating Ex. 1004, Fig. 3). Accordingly, for purposes of institution, Petitioner sufficiently maps each of these text fields to an “associated one of the content-related first data segments [Nf₃ and Nf₄, respectively] on the basis of an assignment rule [the SYNCH process],” as claim 1 requires.

Because Comps illustrates these text segments as immediately following a SYNCH command, Comps’s slave microprocessor does not skip over them in the event of a lag of the slave relative to the master microprocessor. *See* Ex. 1004, Fig. 3; Pet. 28. Comps discloses that “track 3 contains only data corresponding to text messages.” Ex. 1004, 3:18–19. It appears on this preliminary record, based on the data in Figure 3 and the lack of a disclosure in Comps of time duration fields, that Comps contemplates implementing each text segment representing a syllable (or word) with a synch command, without adding any time duration data to it (although this may depend on the data file to be synchronized). *See* Ex. 1004, Fig. 3. In

other words, on the preliminary record, Comps does not specifically disclose text time duration fields (but does disclose time waiting fields TEXTD₀ and TEXTD₁). *See* Ex. 1004, 3:40–41.

On this preliminary record, Petitioner’s grouping of text, images, and notes as content-related is logical, contrary to Patent Owner’s arguments otherwise. The term “content-related” is somewhat subjective because there is not much guidance in the ’794 patent specification as to what a “syntactical meaning” encompasses in the definition provided in the ’794 patent specification: “[T]he term “content-related” is understood to mean that first and second data segments have a syntactical meaning . . . , such as e.g. a plurality of succeeding second data segments represent the speech signal of a specific speaker within a dialog sequence.” Ex. 1001, 4:14–19. The ’794 patent specification also indicates that “content-related” includes “sections of the data file . . . such as e.g. individual images of a video sequence.” *Id.* at 4:19–21. It appears that in general, according to the ’794 patent specification, data segments such as images in a sequence have a “syntactical meaning” with one another.

Comps generally and similarly states that its data is in a sequence or is part of a sound track: “[T]rack 60 can be a MIDI (Musical Instrument Digital Interface) format track for sound, track 70 can contain a sequence of pictures, and track 80 can contain sequences of texts.” Ex. 1004, 2:61–64. Comps also generally states that a “user . . . sees text and pictures whilst hearing sounds.” *Id.* at 1:24–25. Comps also describes a “problem” as “match[ing] the text to the music and the pictures, i.e. to synchronize the different types of data contained in the same multimedia file.” *Id.* at 1:26–28.

Therefore, Comps generally tracks the '794 patent as suggesting that its music, pictures, and text have a syntactical meaning that can be synchronized together to form a coherent output for a user. Patent Owner does not specifically argue at this point that Comps's data segments are not "content-related." *See* Prelim. Resp. 19–27.

With respect to particular data relied upon by Petitioner, Comps states that "two JPEG images represented by the fields JPEG1 and JPEG2 [in Track 1] *must be presented* to the user for a given time represented by the field JPEGd₁ for the image JPEG1 and the field JPEGd₁, for the image JPEG2." Ex. 1004, 3:32–35. Similarly, regarding text, Comps states that "two syllables represented by the fields TEXT1 and TEXT2 [in Track 3] must be presented to the user." *Id.* at 3:39–40. Comps's Figure 3 identifies TEXT1 as a first syllable and TEXT2 as a second syllable. *See* Pet. 28 (annotating Ex. 1004, Fig. 3). Comps also groups important sound data, such as Nf₂:Nd₂, together. Here, Comps describes "the second note" as "corresponding to the second fields N[f]₂ and Nd₂, [which] *must be heard* at the moment the first picture is displayed." *See* Ex. 1004, 3:58–60 (emphasis added); Pet. 28 (annotating Ex. 1004, Fig. 3), 31 (relying on Comps's disclosure as playing notes on Track 1). As Patent Owner recognizes, the duration field Nd₂ tells the master processor how long to play the second note Nf₂. *See* Ex. 1004, 3:22–30; Prelim. Resp. 30. Therefore, on this preliminary record, Comps provides a sufficient basis for Petitioner to treat text, images, notes, and duration data, as "content-related."

In contrast, on this preliminary record, "other duration information . . . (e.g., D₁, JPEGD₁, TEXTD₁)" does not appear to relate in content to other data segments because as Patent Owner argues, these fields represent "the

absence of sound[, text,] or video.” *See* Prelim. Resp. 31. Comps describes this information as “waiting time” information (time between successive notes, images and text), not “duration” information. *See* Ex. 1004, 3:29–30, 36–37. In other words, these “waiting time” data fields do not contain *content*, and they do not describe how long (the duration) to play preceding (or succeeding) *content* like fields JPEGd₁ and Nd₂. Therefore, Petitioner’s treatment of these fields as not “content-related” is sufficient for institution purposes. *See* Pet. 28.

As Patent Owner argues, Comps’s slave processors execute the unimportant waiting times when there is no skip by a slave processor to a successive SYNCH command. *See* Ex. 1004, 3:5–7 (“Each track also contains data organized in the form of commands which are executed sequentially by the microprocessor (for example to display a picture or a text).”); *id.* at 3:55–56 (“Some notes must correspond *to the display* of an image or a syllable.” (emphasis added)), 4:18–50 (describing SYNCH process involving slave processor skips to next important command); Prelim. Resp. 35. Contrary to Patent Owner’s arguments (Prelim. Resp. 34–35), however, executing these unimportant waiting times does not cause Comps’s processors to transmit or display the content-related segments

(notes, text, images) out of sequential order.¹⁰ On this preliminary record, claim 1's sequential ordering does not require that content-related segments must follow each other with no time lag (waiting time) between them. Rather, as presented by Patent Owner, the assignment rule for the '794 patent results in a time lag (a waiting time) between audio data segments S2. *See* Prelim. Resp. 5 (discussing Ex. 1001, Fig. 1). And if the slave processor skips over unimportant waiting time events, as Patent Owner argues occurs during a skip, Comps's system still outputs the content-related data segments in sequential order (albeit without the waiting time delays between some of the content-related data segments). *See* Pet. 28 (annotating Ex. 1004, Fig. 3).

Accordingly, on this preliminary record, Petitioner sufficiently shows that Comps's system displays or plays the important events (the content-related note, image, or text segments) chronologically and sequentially as claim 1 requires, regardless of whether the processors account for the unimportant waiting times or skip over them. *See* Pet. 32–34 (highlighting content-related data segments for output).

As indicated above, text fields (TEXT1, TEXT2) do not include time duration information for displaying the text syllables in the example of

¹⁰ According to the '794 patent, “the term ‘output’ is understood to mean that first and second data segments are, for example, transmitted, stored together or passed on to a processing unit.” Ex. 1001, 2:43–46. However, in the context of claim 1, it appears that an output may also include transmitting for display, such as in a television. *See id.* at 1:23–63 (describing television signals suitable for different formats). Petitioner relies on storing the data together on tracks and/or transmitting the data as outputs for viewing or hearing by a user as satisfying the output limitation of claim 1. *See* Pet. 32–34. This is sufficient for institution purposes

Figure 3, so the slave processor can only skip unimportant waiting times in the event of a slave processing lag for Track 3. *See* Ex. 1004, 4:30–50.

Other than the unavailing argument that claim 1 does not allow for skipping over unimportant waiting times (addressed above), Patent Owner’s arguments do not address Petitioner’s sufficient showing that relies only on notes and text content-related data (i.e., data in Tracks 1 and 3) as satisfying claim 1. *See* Pet. 28 (“The sound segments in track 60 and the text segments in track 80 shown in Comps, Figure 3 could also correspond to ‘content-related first data segments’ and ‘content-related second data segments’ of claim 1, respectively.”); Ex. 1004, Fig. 3.

Patent Owner argues that “Petitioner is also incorrect that JPEGd₁ and JPEGd₂ are assigned to data segments in Track 1 based on an assignment rule, as there is no preceding SYNCH command for these events.” PO Resp. 32 (citing Pet. 27–28, 36). However, even if Patent Owner’s characterization is correct, as noted above, Petitioner alternatively relies on text fields (TEXT1, TEXT2) that each immediately precede a SYNCH command. *See* Pet. 28. Patent Owner’s argument regarding Track 1’s image duration times also does not address the claim interpretation identified above wherein the Petition appears to read a claimed “one of the content-related second data segments” onto a data segment defined as JPEG1:JPEGd₁, and a corresponding claimed “one of the content-related first data segments” onto a data segment defined as Nf₂:Nd₂. *See* Pet. 27–28.

Regarding Patent Owner’s argument that “all petitioned claims require outputting ‘each’ content-related . . . data segment for the two data files, and not just a subset of them” (Prelim. Resp. 32), it is not clear at this stage that the claim requires synchronizing every data segment for the two

data files rather than a plural number of content-related data segments. The specification of the '794 patent states that “[b]y way of the method according to at least one embodiment of the invention, it is made possible in a simple manner to synchronize content-related first and second data segments.” Ex. 1001, 2:36–39. This “embodiment of the invention” does not mention the preamble phrase “data file.” See *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (Interpreting the claim to exclude an embodiment in the specification “is rarely, if ever, correct and would require highly persuasive evidentiary support, which is wholly absent in this case.”); *Catalina Marketing Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 810 (Fed. Cir. 2002) (“Moreover, deletion of the disputed phrase from the preamble of Claim 1 does not affect the structural definition or operation of the terminal itself. The claim body defines a structurally complete invention.”). Even treating the preamble as limiting, it appears on this preliminary record that the claim requires only that “content-related first data segments of a first data file” be synchronized with some unspecified number of “content-related data segments of a second data file.” *Id.* at 7:45–47.¹¹ In other words, claim 1 does not specify how many content-related data segments the method synchronizes (whether in a file or not). Assuming that the term “each” means “every” in the phrase

¹¹ For example, the preamble does not recite “[a] method for synchronizing content-related first data segments of a first data file *with each* content-related second data segment of a second data file.” So even if the preamble is limiting in that it requires a first and second data file, it is agnostic as to how many second data segments of a second data file that the method synchronizes. It follows that the subsequent phrase “each of the content-related second data segments” means “each of the content-related second data segments” of a plurality of such content-related second data segments.

“each of the content-related second data segments,” this phrase refers to “the content-related second data segments” introduced earlier in the body of the claim, which in turn refers to the phrase “content-related second data segments” in the preamble, neither of which specify a number of second data segments. Therefore, it is possible for this recitation to be met even if only a *plural number* of the respective content-related data segments from the respective data files are synchronized. Therefore, on this preliminary record, Petitioner sufficiently shows that synchronizing and outputting two data segments of the text file with two data segments of the sound file as shown by Figure 3 of Comps meets this limitation.¹²

¹² Even if we were to agree with Patent Owner’s claim construction, Petitioner’s showing at least with respect to Comps’s TEXT segments is sufficient for institution purposes because an artisan of ordinary skill would “at once envisage” all of Comps’s (content-related) TEXT commands in Track 3 (e.g., TEXT1, TEXT2) and all of its waiting times (e.g., TEXTD₁), of a contemplated text file, will *each* follow a SYNCH command (as the three examples do in Figure 3) and are the only types of commands or data segments contemplated throughout Track 3. Thus, a skilled artisan would “at once envisage” an example of a data file with two content-related second data segments TEXT1, TEXT2, where “each of the content-related second data segments is output together with an associated one of the content-related first data segments” Nf₃, Nf₄ as claimed. Further, even were we to consider TEXTD₁ as content-related, it is output together with associated first data segment Nf₂. See *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015) (“[A] reference can anticipate a claim even if it ‘d[oes] not expressly spell out’ all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would ‘at once envisage’ the claimed arrangement or combination.” (alteration in original) (quoting *In re Petering*, 301 F.2d 676, 681 (1962))); see *id.* at 1382 (A “person of skill in the art reading Grab would immediately envisage examples using one metal as a binder and one type of coating.”).

Based on the foregoing discussion, Petitioner sufficiently establishes for purposes of institution a reasonable likelihood that it would prevail in showing that Comps anticipates claim 1.

2. Independent Claim 9

Petitioner's analysis of independent claim 9 relies on its analysis of independent claim 1, adapted to account for the fact that claim 9 recites a "device" rather than a "method." Pet. 42–43. Based on the foregoing discussion of claim 1, we determine that Petitioner sufficiently establishes for purposes of institution a reasonable likelihood that it would prevail in showing that Comps anticipates claim 9. Patent Owner groups claims 1 and 9 together and presents the unavailing arguments discussed above in connection with claim 1. *See* Prelim. Resp. 28–35.

3. Dependent Claims

Each of claims 2–5, 9–13, 15–17, 20–21 depends directly or indirectly from one of independent claims 1 or 9. Petitioner provides citation to Comps and the testimony of Dr. Bederson to support its showing of anticipation. *See* Pet. 35–49. On this preliminary record, we determine that Petitioner sufficiently establishes for purposes of institution a reasonable likelihood that it would prevail in showing that Comps anticipates claims 2–5, 9–13, 15–17, 20–21. Patent Owner relies on its arguments with respect to claim 1, which are unavailing for the reasons discussed above. *See* Prelim. Resp. 28–35.

F. Challenges over Comps and Wan

Petitioner challenges claims 6–8 and 22 as unpatentable for obviousness over Comps and Wan. Pet. 50–59. Petitioner identifies particular passages in the prior art as teaching or suggesting the subject

matter additionally recited in these dependent claims and provides reasons for combining the teachings. *Id.*

Petitioner's showing is sufficient for purposes of institution. *See* Pet. 50–59. Patent Owner groups claims 1, 9, and 22 together and presents the unavailing arguments discussed above in connection with claim 1. *See* Prelim. Resp. 28–35.

On this preliminary record, we determine that Petitioner establishes a reasonable likelihood that it would prevail in showing that the subject matter of claims 6–8 and 22 would have been obvious over Comps and Wan.

G. Challenges over Comps and Anh

Petitioner challenges claims 6–8 and 22 as unpatentable for obviousness over Comps and Wan. Pet. 64–68. Petitioner identifies particular passages in the prior art as teaching or suggesting the subject matter additionally recited in these dependent claims and provides reasons for combining the teachings. *Id.*

Petitioner's showing is sufficient for purposes of institution. *See* Pet. 64–68. Patent Owner groups claims 1, 9, and 22 together and presents the unavailing arguments discussed above in connection with claim 1. *See* Prelim. Resp. 28–35.

On this preliminary record, we determine that Petitioner establishes a reasonable likelihood that it would prevail in showing that the subject matter of claims 6–8 and 22 would have been obvious over Comps and Anh.

H. Challenges over Comps and Kim

Petitioner challenges claims 18 and 19 as unpatentable for obviousness over Comps and Wan. Pet. 68–72. Petitioner identifies particular passages in the prior art as teaching or suggesting the subject

matter additionally recited in these dependent claims and provides reasons for combining the teachings. *Id.*

Petitioner's showing is sufficient for purposes of institution. *See* Pet. 68–72. Patent Owner groups claims 1, 9, and 22 together and presents the unavailing arguments discussed above in connection with claim 1. *See* Prelim. Resp. 28–35.

On this preliminary record, we determine that Petitioner establishes a reasonable likelihood that it would prevail in showing that the subject matter of claims 18 and 19 would have been obvious over Comps and Anh.

III. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail in showing that at least one of the challenged claims is unpatentable. Accordingly, we institute *inter partes* review as to all challenged claims and grounds presented in the Petition. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); 37 C.F.R. § 42.108(a).

IV. ORDER

In consideration of the foregoing, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–22 of the '794 patent on all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, commencing on the entry date of this Decision.

McKONE, *Administrative Patent Judge*, concurring:

I disagree with the Majority’s reading of claim 1 (and the similar readings of claims 9 and 21) that would allow a showing of anticipation by showing that only some of a plurality of content-related second data segments of a second data file are output together with associated ones of content-related first data segments of a first data file. Rather, claim 1 recites “*each* of the content-related second data segments is output together with an associated one of the content-related first data segments.” According to claim 1, the content-related second data segments are “of a second data file.” Thus, according to the plain meaning of claim 1, each¹ content-related second data segment of a second data file, rather than certain ones of a subset, is output together with an associated content-related first data segment of a first data file.² Contrary to the Majority’s reading, claim 1 does not recite that only a “plurality” or “subset” of the content-related second data segments of the second data file need be associated.

This is consistent with the Specification. For example, as shown in Figure 1, each/every one of second data segments S2 is associated with a

¹ It is unclear whether the Majority considers “each” to be less than “every.” However, “each” means “[e]very one of a group considered individually,” and, thus, does mean “every.” THE AMERICAN HERITAGE COLLEGE DICTIONARY 439 (4th ed. 2004). Here, I would consider the content-related second data segments of the second data file to be the “ones” (segments) of a “group” (file).

² Note, however, that not every content-related first data segment need be output with an associated content-related second data segment. Claim 1 only recites that each content-related second data segment is output together with a content-related first data segment. Consistent with the specification, as noted below, some first data segments might be left unassociated, while no second data segment is left unassociated.

first data segment S1. Ex. 1001, 5:35–58. First data segment S1(1) is left unassociated. But each of segments S2(0)–(4) is associated with a corresponding S1 segment. *Id.* The same is true with the example of Figure 5. Each/every segment in S2, S2(0)–(4), is associated with a segment from S1, while some segments in S1 are left unassociated with a segment in S2. *Id.* at 6:4–27. Thus, the Specification is consistent with claim 1’s recitation that “*each* of the content-related second data segments is output together with an associated one of the content-related first data segments.”

I also do not agree that “first data file” and “second data file” can be read out of the claims. The “content-related first data segments” are “of a first data file” and the “content-related second data segments” are “of a second data file.” The recitations of the first and second data files specify, and limit, which data segments are operated on by the method of claim 1. I disagree that the Specification provides examples of content-related data segments outside the context of data files. However, claim 1 recites first and second data files, so, to the extent that the Specification provides examples of data segments outside the context of files, those examples do not correspond to claim 1. All examples described in detail in the Specification are in the context of data files. Ex. 1001, 3:65–7:20.

On the preliminary record, I am persuaded that Comps does not leave second content-related data segments unassociated with content-related first data segments. Thus, I agree that we should institute a trial. Nevertheless, should the complete record after a trial show that Comps does leave content-related second data segments unassociated with content related first data segments, the Majority should revisit its construction of claim 1. My

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concerns apply equally to the substantially similar claim language of claims 9 and 22.

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