

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

S.M.R INNOVATIONS LTD and Y.M.R TECH LTD,
Patent Owner.

IPR2024-01047
Patent 9,699,223 B2

Before STACEY G. WHITE, CHRISTOPHER L. OGDEN, and
MARY C. HOFFMAN, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 5, 7–11, 13–16, 18–20, and 22 of U.S. Patent No. 9,699,223 B2 (Ex. 1001, “the ’223 patent”). Paper 2 (“Pet.”). S.M.R Innovations LTD and Y.M.R Tech LTD (collectively, “Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 7, “Prelim. Reply”) regarding the impact of the transfer of the related district court case on Patent Owner’s arguments regarding discretionary denial.

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons stated below, we determine that Petitioner has not established a reasonable likelihood that it would prevail with respect to at least one claim. We, therefore, deny Petitioner’s request to institute *inter partes* review of the challenged claims on the asserted grounds.

A. Related Matters

The parties identify the following *inter partes* reviews involving patents related to the ’223 patent: IPR2024-01048 (U.S. Patent No. 10,547,648); IPR2024-01049 (U.S. Patent No. 8,711,866); and IPR2024-01050 (U.S. Patent No. 7,969,990). Pet. 73; Paper 4, 3. The parties identify the following district court cases involving one or more of these related patents: *S.M.R Innovations LTD, et al. v. Apple Inc.*, 6:23-cv-479-ADA

(W.D. Tex.)¹; *S.M.R Innovations LTD, et al. v. Samsung Electronics Co., Ltd., et al.*, 4:20-cv-641-SDJ (E.D. Tex.) (terminated); *S.M.R Innovations LTD, et al. v. Samsung Electronics Co., Ltd., et al.*, 4:20-cv-641-SDJ (W.D. Tex.) (terminated); and *S.M.R Innovations LTD, et al. v. Motorola Mobility LLC*, 1 :22-cv-592-CFC-SRF (D. Del.) (terminated). Pet. 73; Paper 4, 4.

B. The '223 patent

The '223 patent is titled “Routing of Data Including Multimedia Between Electronic Devices.” Ex. 1001, code (54). The '223 patent “relates to . . . rerouting of incoming communications that may or may not include multimedia to devices other than the initial receiving device.” *Id.* at 1:20–24. The '223 patent discloses that mobile communication devices typically have data processing ability that allows them to handle multimedia, and different types of devices are able to communicate with each other via a network thereby allowing data to be directed or routed from one device to another. Ex. 1001, 1:33–38. Media playing devices include both mobile devices, such as cell phones, PDAs, and handheld devices, and non-mobile devices such as land/fixed line phones, computer monitors, Hi-Fi sets, and speakers. *Id.* at 1:49–53. Media types include voice, text, images, and video. *Id.* at 1:53–57. Although data such as multimedia data, can be directed or routed from one device to another device, the playing of multimedia data is limited to the device on which it is received, or to those in which the data originates. *Id.* at 1:38–45. Further, mobile devices have relatively poor multimedia capabilities in comparison with other devices. *Id.*

¹ On November 14, 2024, a motion to transfer venue was granted thereby transferring this proceeding to the Northern District of California. Paper 7, 1; Ex. 1032 (order granting transfer).

at 1:60–65. The '223 patent purports to resolve these problems by providing “the user with the ability to select a target device, based on the type of multimedia content, and furthermore to choose a device for play or storage of the content independently of the initially targeted or originating device.” *Id.* at 2:17–28.

Figure 1 of the '223 patent, shows a plurality of electronic devices in the vicinity of one another such that communications can be rerouted, and is reproduced below. Ex. 1001, 4:9–12.

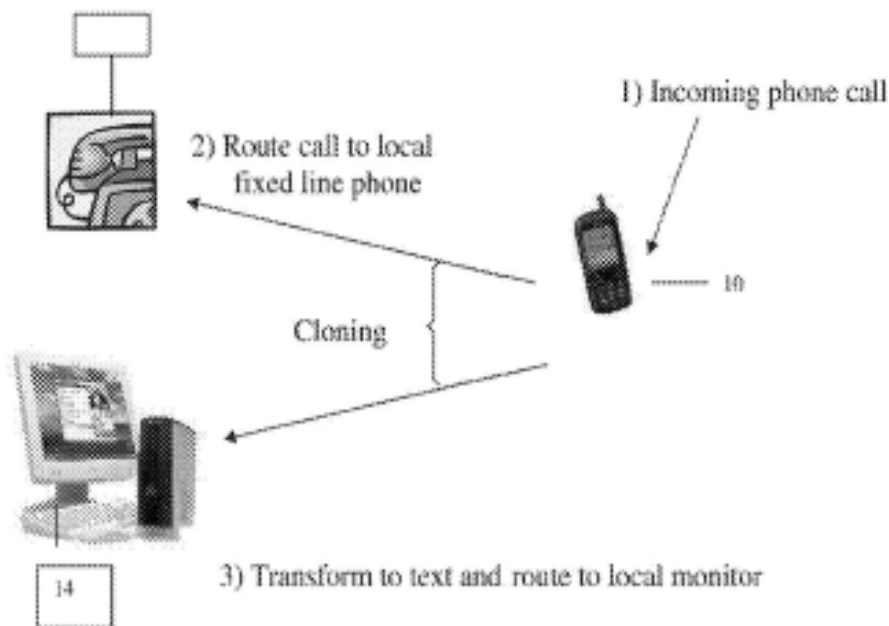


Fig. 1

Figure 1 above shows cellular telephone 10 in proximity to fixed telephone 12² and computer monitor 14. *Id.* at 5:52–54. An incoming call is received at cellular telephone 10, which detects the presence of the other devices such as fixed telephone 12 and computer monitor 14 and allows the user to retain

² The '223 patent specification discusses a reference number 12 in relation to the fixed telephone depicted in Figure 1. Ex 1001, 5:52–53. Based on this we surmise that reference number 12 was inadvertently omitted in the box above the fixed line phone icon in Figure 1.

the call at cellular telephone 10 or alternatively to transfer or reroute it to either of the other devices. *Id.* at 5:56–64. Software may be used to convert voice signal to text for viewing at computer monitor 14. *Id.* at 5:67–6:2.

Figure 2 of the '223 patent, is a block diagram of a rerouting apparatus for attachment to an electronic device, and is reproduced below. Ex. 1001, 4:13–16.

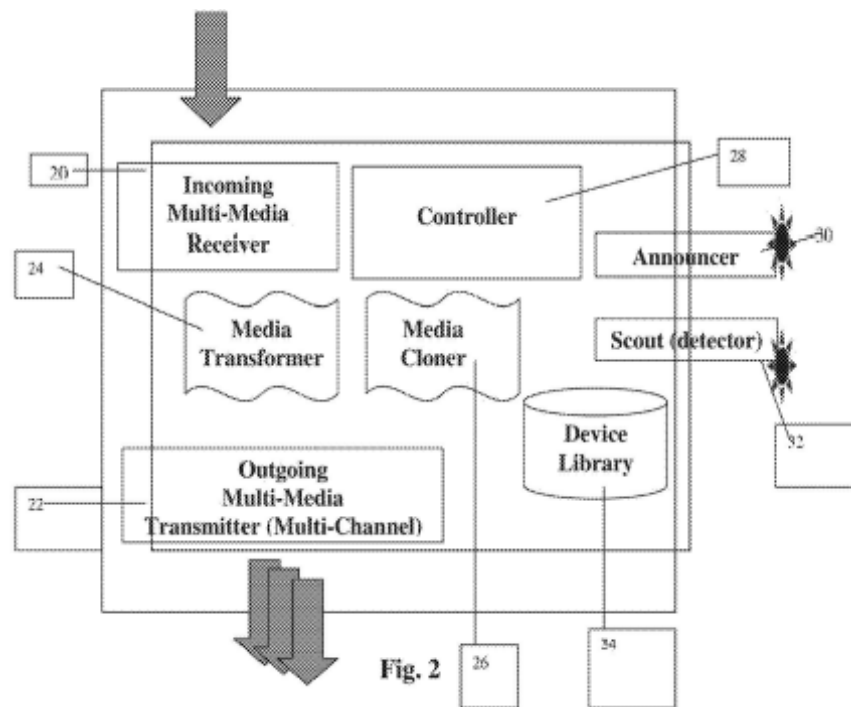


Figure 2, above, shows a rerouting apparatus including incoming multi-media receiver 20 for capturing media content and passing it to one of the other components in the device, such as outgoing multi-channel multi-media transmitter 22, which directly transmits media streams to external devices. *Id.* at 6:34–41. Multi-channel multi-media transmitter 22 comprises a multichannel port which is able to transmit several media types to several devices at the same time. *Id.* at 6:41–43. The electronic device also includes transformer 24 for transforming incoming media for output. *Id.* at 6:44–46. Media cloner 26 duplicates input channel content from multi-

media receiver 20 into output channels. *Id.* at 6:57–60. Controller 28 manages components of the electronic device relative to the media transfer. *Id.* at 6:63–67.

Selecting destinations and media types to allow other devices to receive availability information is accomplished via announcer device 30, scout device 32, and device library 34. *Id.* at 7:22–26. In particular, announcer device 30 announces the availability or unavailability of a current device for accepting routed media. *Id.* at 7:27–46. Scout device 32 scans to find other devices to determine their status which can be “free or busy.” *Id.* at 7:62–67. The announcer and scout may be actively transmitting and receiving information or they may be passive (e.g., a barcode sticker on a phone and bar code reader). *Id.* at 7:47–51. Device library 34 contains information needed for communicating with various devices, such as usage related information, expected media formats, transmission technology specifications including protocols, and pre-defined user preferences. *Id.* at 8:1–8.

C. Illustrative Claim

Claims 1, 5, 7–11, 13–16, 18–20, and 22 are challenged, and claims 1, 14, and 22 are independent claims. Claim 1 is illustrative of the subject matter at issue and reproduced below.

[1(Pre)] A method of routing media data stream, comprising:

[1(a)] wirelessly receiving at a mobile device, from an external source via a local wireless communication network, a media data stream transmitted according to a streaming protocol and comprising media content selected from a group consisting of: audio content and video content;

[1(b)] scanning said local wireless communication network using said mobile device to identify a plurality of devices, identified as

compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network;

[1(c)] selecting, based on a user interaction made with said mobile device and while said media data stream is streamed to said mobile device from said external source according to said streaming protocol, one of said plurality of devices;

[1(d)] setting up a wireless communication link with said selected compatible device via said local wireless communication network;

[1(e)] causing a routing of said media data stream of media content to said selected device via said wireless communication link for streaming said media data stream according to said streaming protocol for presentation of said media content by a media player of said selected device.

Ex. 1001, 12:52–13:12 (bracketed designations added by Petitioner (*see* Pet. 75)).

D. Asserted Grounds of Unpatentability

Petitioner, supported by the declaration of Dr. Sayfe Kiaei (Ex. 1003), asserts the following grounds of unpatentability (Pet. 4)³:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 5, 8, 10, 11, 14–16, 18–20, 22	103	Zhang, ⁴ Moore, ⁵ Rofheart ⁶

³ We apply the pre-AIA version of 35 U.S.C. § 103 because the claims at issue appear to have an effective filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”). *See* Ex. 1001, codes (22), (63), (60).

⁴ U.S. Patent No. 7,536,182 B2, issued May 19, 2009 (Ex. 1004, “Zhang”).

⁵ U.S. Patent No. 7,295,809 B2, issued Nov. 13, 2007 (Ex. 1005, “Moore”).

⁶ U.S. Patent No. 7,058,414 B1, issued June 6, 2006 (Ex. 1006, “Rofheart”).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
7, 13	103	Zhang, Moore, Rofheart, Thornton ⁷
9	103	Zhang, Moore, Rofheart, Liversidge ⁸
10	103	Zhang, Moore, Rofheart, Angelo ⁹

II. ANALYSIS

A. *Level of Ordinary Skill in the Art*

In order to determine whether an invention would have been obvious at the time the application was filed, we consider the level of ordinary skill in the pertinent art at the critical time. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The resolution of this question is important because it allows us to “maintain[] objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). In assessing the level of ordinary skill in the art, various factors may be considered, 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) (quotation omitted). Generally, it is easier to establish obviousness under a higher level of ordinary skill in the art. *Innovention Toys, LLC v. MGA Entm’t, Inc.*, 637

⁷ U.S. Patent No. 7,574,474 B2, issued Aug. 11, 2009 (Ex. 1007, “Thornton”).

⁸ U.S. Patent Appl. Pub. No. 2002/0076025 A1, published June 20, 2002 (Ex. 1008, “Liversidge”).

⁹ U.S. Patent Appl. Pub. No. 2003/0061493 A1, published Mar. 27, 2003 (Ex. 1009, “Angelo”).

F.3d 1314, 1323 (Fed. Cir. 2011) (“A less sophisticated level of skill generally favors a determination of nonobviousness . . . while a higher level of skill favors the reverse.”).

Petitioner asserts that a person of ordinary skill in the art “would have had a master’s degree in computer engineering, electrical engineering, or a related field, with at least 2 years of experience with wireless communications.” Pet. 3 (citing Ex. 1003 ¶¶ 28–30). Petitioner also states that “[a]dditional education or experience might substitute for the above requirements.” *Id.*

Patent Owner contends that a person of ordinary skill in the art “would have had a Bachelor’s degree in Computer Science, Computer Engineering, Electrical Engineering, or a related field in computing technology, and at least two years’ experience in wireless communication and mobile devices including multimedia streaming, or equivalent education, research, experience, and knowledge.” Prelim. Resp. 3.

The level of ordinary skill in the art usually is evidenced by the references themselves. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). Patent Owner’s definition of a person of ordinary skill in the art is similar to Petitioner’s definition with some variation in the amount of education and specificity as to the experience required. As Petitioner’s description of a person of ordinary skill appears commensurate with the subject matter before us, we apply Petitioner’s definition for purposes of this Decision. We note, however, that our determination in this proceeding would be the same under either formulation.

B. Claim Construction

We interpret claim terms 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). In this context, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (citations omitted) (en banc).

Petitioner “applies the plain and ordinary meaning of all claim terms as understood by a [person of ordinary skill in the art]” and does not propose construction of any claim term. Pet. 4. Patent Owner also does not propose construction of any claim term. *See generally*, Prelim. Resp.

Based on the record before us, we see no need for express construction of any term for the purposes of this Decision. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”).

C. Overview of the Asserted Prior Art

1. Zhang (Ex. 1004)

Zhang is titled “Method and System for Extending the Capabilities of Handheld Devices Using Local Resources,” and “relates to . . . a helper environment for extending the capabilities of handheld devices by using nearby devices.” Ex. 1004, code (54), 1:8–10. Figure 1 of Zhang illustrates a helper environment and is reproduced below. *Id.* at 2:65–66.

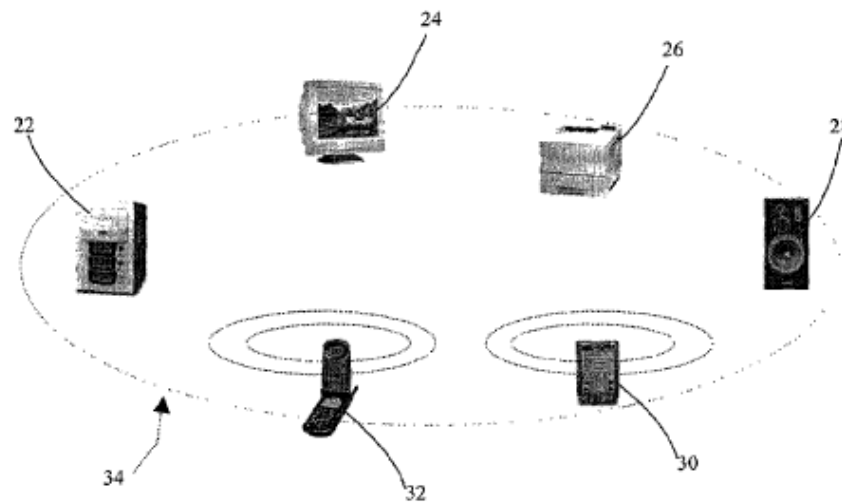


Fig. 1 A Helper Environment

Figure 1, above, shows helper environment 34 consisting of two mobile devices: PDA 30 and cellular phone 32; and four helper servers that offer helper services: storage device 22, display device 24, printing device 26, and audio device 28.¹⁰ *Id.* at 3:25–29. Helper environment 34 “provides a framework wherein mobile devices can use the devices around them to extend their limited capabilities.” *Id.* at 3:29–31. In one embodiment, PDA 30 cannot display or can only display in very primitive quality such that with helper environment 34, PDA 30 “automatically locates a nearby helper server 24 that has a big screen and is capable of displaying the content.” *Id.* at 3:32–37. PDA 30 then establishes a connection with helper server 24, transfers the content to helper server 24 for display, and PDA 30 becomes a remote control device to control the display of the content on helper server 24. *Id.* at 3:37–40. As an example of remote control and in the case of streaming data, commands such as stop, resume, and fast forward may be

¹⁰ Zhang interchangeably refers to these as either a “device” or a “server.”

issued to the server. *Id.* at 8:13–18. In general, a handheld device can interact with the helper environment pertaining to “[d]evice discovery” by identifying nearby helper servers, pertaining to “[s]ervice query” by querying servers to determine if they can provide helper service, pertaining to “[r]equest transfer” by selecting a server and delegating a task, and pertaining to “[r]emote control” by providing a control interface to the handheld device. *Id.* at 3:44–56.

Figure 4 of Zhang is a flowchart of a method for remotely accessing a resource and is reproduced below. Ex. 1004, 4:5–6.

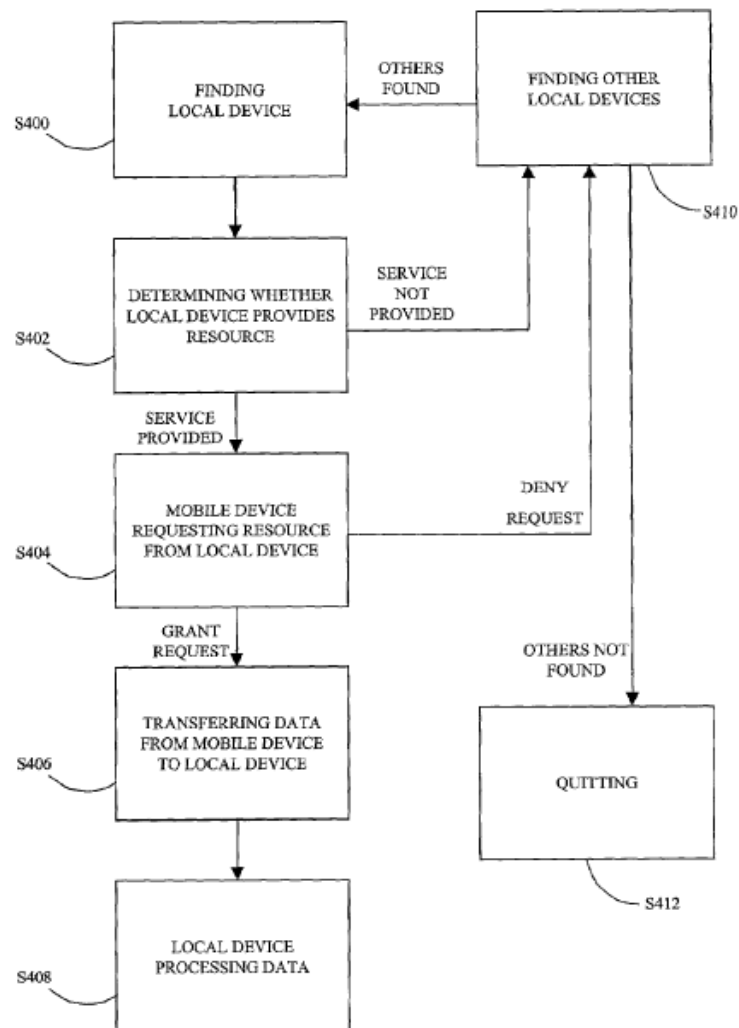


FIG. 4 Remotely Accessing A Resource

Figure 4, above, shows a flowchart for remotely accessing a resource. *Id.* at 3:5–6. The process starts at step S400 in which a local device that offers a helper service is found; then at step S402, the local device is queried to determine whether it offers the helper service needed by the handheld device. *Id.* at 3:62–64. If the local device does not offer the needed helper service, the handheld device attempts to locate other local devices that offer services (at step S410) and quits if none are found (at step S412). *Id.* at 3:61–67. At step S402, if the local device does offer the needed helper service, then the handheld device requests the helper service at step S404. *Id.* at 4:1–2. Thereafter, if the local device denies the request, the handheld device again attempts to locate other local devices that offer helper services at step S410 and again quits if none are found S412. *Id.* at 4:2–5. Then, if the local device grants the request, the handheld device begins transferring data to the local device at step S406 and then, the local device operates on the received data at step S408. *Id.* at 4:5–8.

2. *Moore (Ex. 1005)*

Moore is titled “Portable Audio Playback Device with Bass Enhancement,” and “relates to portable audio devices capable of communicating with external audio systems to provide enhanced audio playback.” Ex. 1005, code (54), 1:6–9. Moore discloses that small speakers used in portable audio devices cannot generate significant bass output such that their “audio playback often lacks the full range sound available from audio systems employing full-size speakers.” *Id.* at 1:19–27. Accordingly, Moore “provides a method and apparatus to enhance audio playback from a portable audio device by wirelessly linking the portable audio device to an

external audio system offering extended audio output capabilities.” *Id.* at 1:41–44.

Figure 1 of Moore, reproduced below, shows a system for audio playback enhancement. Ex. 1005, 2:36–37.

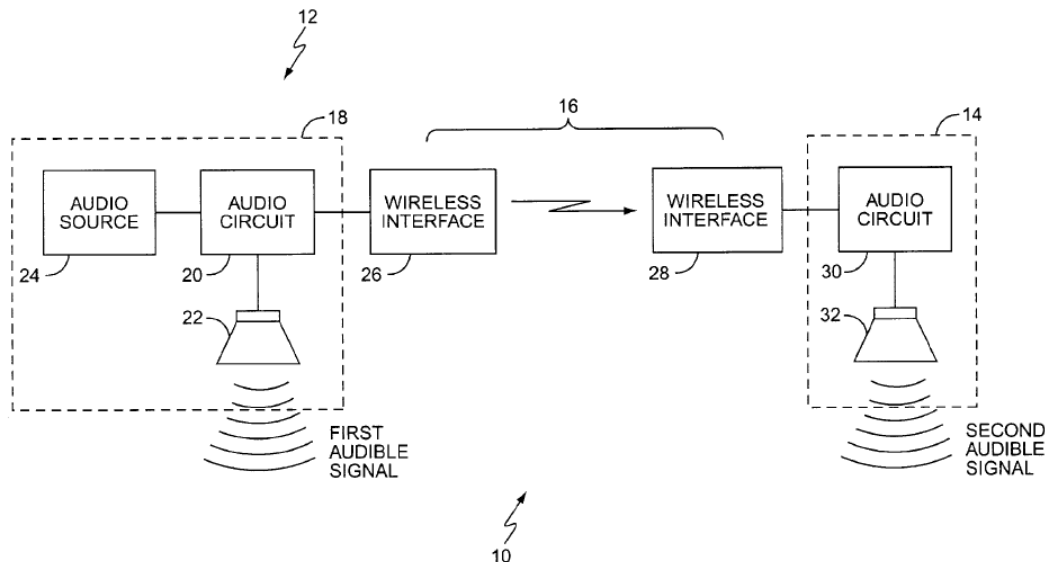


FIG. 1

As shown in Figure 1, audio playback system 10 includes portable audio device 12 and external audio system 14 communicating over wireless link 16. *Id.* at 3:50–55. Portable audio device 12 “provides local audio playback, which is enhanced by audio playback at audio system 14 responsive to a playback enhancement signal transmitted from device 12 to audio system 14 via wireless link 16.” *Id.* at 2:56–58. In one embodiment, portable audio device 12 includes audio playback unit 18 having audio circuit 20, one or more speakers 22, and audio source 24, and also wireless interface 26 for communicating via wireless link 16. *Id.* at 2:63–67. Second wireless interface 28 is associated with or included in audio system 14, which comprises audio circuit 30 and one or more speakers 32. *Id.* at 2:67–3:3. Speakers 22 of portable audio device 12 “are physically small and lack

the frequency range of full-size speakers” whereas speakers 32 of external audio system 14 have lower frequency range of woofers and subwoofers. *Id.* at 3:4–14.

3. *Rofheart (Ex. 1006)*

Rofheart is titled “Method and System for Enabling Device Functions Based on Distance Information,” and “relates to . . . enabling communications functions in a local wireless device based on a distance between the local wireless device and a remote wireless device.” Ex. 1006, code (54), 2:4–8. Rofheart discloses that in the proliferation of handheld computers which made data exchange between wireless devices such as mobile phones, laptops, and handheld devices more common, “various wireless communications technologies including infrared technology and radio frequency (RF) technology have emerged to provide the wireless connectivity between devices.” *Id.* at 2:10–16. Rofheart’s aim “is to provide a method, system and computer program product for enabling communications between wireless devices without the need for close proximity fixed orientation between the wireless devices.” *Id.* at 3:41–45.

Figure 3 of Rofheart, reproduced below, shows a wireless network in which a plurality of wireless devices may exchange information. Ex. 1006, 5:15–16.

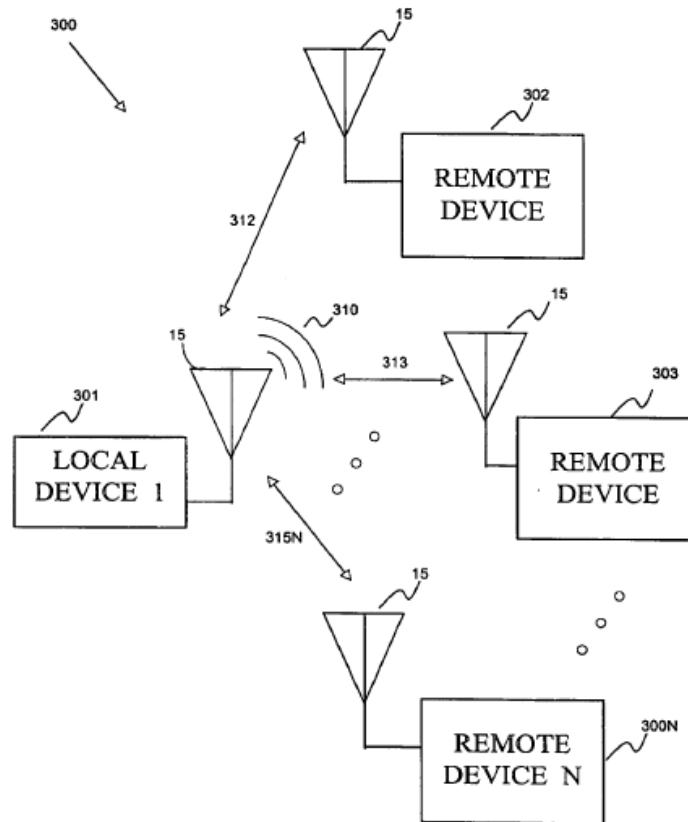


FIGURE 3

Figure 3 above shows wireless network 300 that “may be WPAN, WLAN or some other wireless network in which wireless devices make point to point connections, or point to multipoint connections on the shared channel of a piconet.” *Id.* at 17:14–17. Wireless network 300 includes local device 301 linked to first remote device 302, second remote device 303, and N number of additional remote devices 300N, via UWB (ultra-wide band) links 312, 313, and 315N, respectively. *Id.* at 17:17–22. “The UWB links are full duplex communications links that carry data, voice, video, or any other analog or digital information.” *Id.* at 17:22–24. Local device 301 and each remote device (e.g., 302, 303) include a UWB transceiver that transmits and receives a UWB signal via UWB antenna 15. *Id.* at 17:41–45. A process for enabling device functions based on distance information that includes a

medial access control (MAC) protocol is used and “[e]xamples of multiple access protocols may be found in the IEEE 802.11 standard.” *Id.* at 17:56–18:11. Rofheart discloses that “a local device may display a positional map of all users in relation to the local device so that the user of the local device may select those remote devices that the user wants to communicate with.” *Id.* at 18:54–58.

4. *Thornton (Ex. 1007)*

Thornton is titled “System and Method for Sharing and Controlling Multiple Audio and Video Streams.” Ex. 1007, code (54). Thornton discloses that

[a]t least one multimedia presentation is selected by a user of a first device, accessed from a storage source, and presented to the user. Simultaneously, information is transmitted to at least a second device to cause the selected multimedia presentation to be presented by the at least second device without the at least second device receiving input from a second user. Continuous media streams from the first user may be captured and transmitted to the second device. The presenting of the multimedia presentation on the first device is coordinated with the presenting of the multimedia presentation on the second device. The presenting of the captured media streams on the second device is coordinated with the capturing of those streams and the presenting of the multimedia presentation on the second device. Users may individually control the multimedia presentations and the captured media streams.

Id. at code (57).

5. *Liversidge (Ex. 1008)*

Liversidge is titled “Method and System for Automatic Handling of Invitations to Join Communications Sessions in a Virtual Team Environment.” Ex. 1008, code (54). Liversidge discloses using information that includes “a respective personal identifier 8 of each team member, a

respective personal profile 10 relating to a role and/or environment of the team member, and communications information 12 indicative of the availability of the respective team member for participating in various types of communications.” *Id.* ¶ 62. A “profiles” category is used to “enabl[e] the team member to select a previously defined personal profile as their current profile” and an “EditProfiles” option is used to “enabl[e] the user to create and edit each of their personal profiles.” *Id.* ¶ 90.

6. *Angelo (Ex. 1009)*

Angelo is titled “Portable Voice Encrypter.” Ex. 1009, code (54). Angelo’s portable voice device “includes a CPU executing security software to perform the encryption and decryption functions.” *Id.* at code (57)

D. *Petitioner’s Patentability Challenge*

Petitioner alleges that claims 1, 5, 8, 10, 11, 14–16, 18–20, and 22 would have been obvious over Zhang, Moore, and Rofheart, citing the Declaration of Dr. Sayfe Kiaei for support. Pet. 4, 10–61 (citing Ex. 1003). Patent Owner opposes. Prelim. Resp. 3–13.

For reasons discussed below, we determine that Petitioner has not shown a reasonable likelihood that it would prevail in its obviousness challenge based on Zhang, Moore, and Rofheart.

1. *Independent Claims 1, 14, and 22*

Independent claim 1 recites, in relevant part,

scanning said local wireless communication network using said mobile device to identify a plurality of devices, identified as compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network.

Ex. 1001, 12:58–65 (limitation 1b) (emphasis added). Independent claims 14 and 22 recite similar language. *Id.* at 13:63–65 (limitation 14b); 14:56–64 (limitation 22c). Petitioner relies on the same disclosures from Zhang as modified by Rofheart to teach these limitations from claims 1, 14, and 22. Pet. 21–31, 52–54, 62. Thus, this discussion applies to Petitioner’s assertions regarding each of the challenged independent claims.

Petitioner argues Zhang discloses the claimed scanning and identifying compatible devices to handle media content through its discussion of a mobile device scanning Zhang’s helper framework to locate a nearby helper server that “is capable of displaying the content.” Pet. 22 (citing Ex. 1004, 3:32–43). Petitioner directs us to Zhang’s mobile device performing the following steps:

- (1) ***Device discovery***: The handheld device identifies the nearby helper servers.
- (2) ***Service query***: The handheld device queries the identified helper servers to determine if they are capable of providing the helper service.
- (3) ***Request transfer***: The handheld device selects a helper server and delegates the task to it.
- (4) ***Remote control***: The helper server returns a remote control interface description to the handheld device.

Id. at 22 (citing Ex. 1004, 3:44–56, 6:40–44). According to Petitioner, “[t]he first two steps—‘device discovery’ and ‘service query’—identify devices compatible (i.e., capable) of handling the media content.” *Id.* (citing Ex. 1004, 3:25–64, 4:1–5, 4:35–45).

Rofheart is relied upon for its discussion of a plurality of devices of which the user may select for transmitting data. *Id.* at 26 (citing Ex. 1006, 2:4–16, 4:61–63). Petitioner asserts that one of ordinary skill in the art

“would have recognized the benefit of providing users control to select one or more of a plurality of devices, rather than always connecting to the first identified available compatible device, as taught by Zhang.” *Id.* at 29 (citing Ex. 1003 ¶¶ 122–126). Petitioner also relies upon on Rofheart’s teaching of the use of ultra-wide band technology (“UWB”). *Id.* at 27 (citing Ex. 1006, 15:23–63; 17:13–18). Petitioner argues that “further implementing Rofheart’s UWB wireless technology in Zhang provides more precise information about the helper server locations, giving users more insight into the available helper servers and more control over rerouting data to the most desirable server.” *Id.* at 30¹¹.

We are not persuaded that Petitioner has demonstrated that the cited art teaches scanning to identify a plurality of devices “identified as compatible to handle said media content,” as recited in the independent claims. The ’223 specification describes the system scanning “to find out about compatible equipment in the vicinity.” Ex. 1001, 2:39–40. This allows the user to “select between available compatible equipment.” *Id.* at 2:42–44. Petitioner’s declarant, Dr. Kiaei states that

[t]he Challenged Claims require a mobile device that wirelessly receives a media data stream, *scans a local wireless network for a device that can handle the media data stream*, selects a compatible device, sets up a wireless link with the compatible device, and routes the media data stream from the mobile device to the compatible device according to a streaming protocol such that the content can be played by the compatible device’s media player.

Ex. 1003 ¶ 70 (emphasis added) (citing claim 1 of the ’223 patent). This accords with Patent Owner’s description of the claims as having a “distinct

¹¹ Moore is also relied upon in the ground, but for limitations that are not at issue here. *See* Pet. 12–21.

feature of scanning a wireless communication network by the mobile device receiving the streaming data for re-routing, *to identify devices connected to the wireless network, are identified as capable to handle the routed media content.*” Prelim. Resp. 5–6 (emphasis added) (citing Ex. 1002, 237–238). Thus, we understand the recited language to require scanning to find devices that have been identified as compatible, not just scanning to find devices and later determining which of those devices, if any, are compatible.

Zhang, on the other hand, scans to find devices in the network, but that scan does not seek out devices identified as compatible. Specifically, Zhang scans to find its “helper environment” which is composed of “devices around them.” Ex. 1004, code (57); *see also id.* 2:16–20. The first step of Zhang’s process is to find “a local device [that] offers helper service.” *Id.* at 3:62–63. In the next step, Zhang then interrogates the device it scanned for in order to find out whether that device offers the necessary service. *Id.* at 3:63–4:5. In other words, Zhang is not scanning for compatible devices, but rather it is scanning for any device around it and then asking whether the device provides the necessary service.

We find this to be insufficient because the claim is not merely seeking to identify a compatible device, but rather it is scanning “to identify a plurality of devices, identified as compatible to handle said media content.” Thus, for these claims it is not enough that the network be scanned for devices; instead, the network must be scanned for devices “identified as compatible.” The inclusion of Rofheart does not address this issue. Rofheart is relied upon to teach “that a local device identifies and connects with a plurality of remote devices.” Pet. 29. According to Petitioner, one of ordinary skill in the art would have used Rofheart’s teaching to improve

Zhang by adding “the benefit of providing users control to select one or more of a plurality of devices, rather than always connecting to the first identified available compatible device, as taught by Zhang.” *Id.* As such, neither of the cited references addresses the recited scanning for devices identified as compatible.

Accordingly, based on the record before us, we determine that Petitioner has not established a reasonable likelihood of prevailing on its assertion that claims 1, 14, and 22 would have been obvious over Zhang, Moore, and Rofheart.

2. *Analysis of Claims 5, 8, 10, 11, 15, 16, and 18–20*

Petitioner asserts that dependent claims 5, 8, 10, 11, 15, 16, and 18–20 would have been obvious over Zhang, Moore, and Rofheart. Pet. 44–48, 57–59. Petitioner’s assertions do not remedy the above noted deficiency regarding the independent claims. As such, on the record before us, we are not persuaded that Petitioner’s cited evidence demonstrates a reasonable likelihood that Petitioner would prevail as to its assertion that claims 5, 8, 10, 11, 15, 16, and 18–20 would have been obvious over Zhang, Moore, and Rofheart.

E. *Grounds 2–4*

Petitioner challenges dependent claims 7, 9, 10, and 13 over obviousness grounds based on Zhang, Moore, and Rofheart with Thornton, Liversidge, or Angelo. Pet. 62–71. Petitioner’s assertions do not remedy the above noted deficiency regarding the independent claims. As such, on the record before us, we are not persuaded that Petitioner’s cited evidence demonstrates a reasonable likelihood that Petitioner would prevail in its contentions based on claims 7, 9, 10, and 13 as obvious over the cited art.

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(A)

Patent Owner argues the Board should exercise its discretion under 35 U.S.C. § 314(a) and deny institution in light of the parallel litigation involving the '223 patent. Prelim. Resp. 13–18. We do not reach those issues in light of our assessment of the merits of the Petition, as discussed above.

IV. CONCLUSION

For the foregoing reasons, we have determined that Petitioner has not established a reasonable likelihood of prevailing with respect to any claims. Thus, we do not institute an *inter partes* review.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied, and no *inter partes* review is instituted.

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