

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPOTIFY USA INC.
Petitioner,

v.

MANUEL TIJERINO
Patent Owner.

Patent No. 9,146,925

Inter Partes Review No. IPR2025-01280

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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EXHIBIT LIST

Exhibit Description	Exhibit #
U.S. Patent No. 9,146,925 to Tijerino (“the ’925 Patent”)	EX1001
Prosecution History of U.S. Patent No. 9,146,925	EX1002
Declaration of William Rosenblatt in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,146,925	EX1003
<i>Curriculum Vitae</i> of William Rosenblatt	EX1004
U.S. Patent No. 10,373,420 to Dion et al. (“Dion”)	EX1005
U.S. Patent No. 6,308,204 to Nathan et al. (“Nathan-204”)	EX1006
U.S. Patent No. 9,608,583 to Nathan et al. (“Nathan-109”)	EX1007
DEEPAK ALUR ET AL., CORE J2EE PATTERNS: BEST PRACTICES AND DESIGN STRATEGIES, 2ND ED. (Sun Microsystems Press 2001).	EX1008
ANDREW S. TANENBAUM, MODERN OPERATING SYSTEMS (Prentice-Hall, Inc. 2nd ed. 2002).	EX1009
HAROLD ABELSON ET AL., STRUCTURE AND INTERPRETATION OF COMPUTER PROGRAMS, 2ND ED. (MIT Press 1996).	EX1010
U.S. Patent Appl. Pub. No. 2004/0243482 to Laut (“Laut”)	EX1011
U.S. Patent No. 7,469,208 to Kincaid (“Kincaid”)	EX1012
U.S. Patent Appl. Pub. No. 2008/0137881A1 to Bongiovi (“Bongiovi”)	EX1013
LEONARD RICHARDSON ET AL., RESTFUL WEB SERVICES (O’Reilly Media, Inc. 2007).	EX1014

Exhibit Description	Exhibit #
ANDREW S. TANENBAUM, STRUCTURED COMPUTER ORGANIZATION (Prentice-Hall 6th ed. 2013).	EX1015
Scheduling Order (Dkt. 22) in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)	EX1016
Defendant's Motion to Dismiss and related briefing (Dkt. 13, 25, 28) in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)	EX1017
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LegalMetric District Report, New York Southern District Court in Patent Cases, January 2020-January 2025	EX1020
LegalMetric District Report, Louisiana Eastern District Court in Patent Cases, January 2020-January 2025	EX1021
Federal Court Management Statistics, December 2024 (available at https://www.uscourts.gov/data-news/reports/statistical-reports/federal-court-management-statistics/federal-court-management-statistics-december-2024)	EX1022
Associated Press, <i>Digital music service Spotify launches in US</i> (July 14, 2011)	EX1023
<i>Introducing Spotify Fan Insights</i> (November 17, 2015) (https://artists.spotify.com/blog/introducing-spotify-fan-insights)	EX1024
<i>An Overview of Spotify for Artists</i> (April 18, 2017) (https://artists.spotify.com/en/blog/an-overview-of-spotify-for-artists)	EX1025

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Exhibit J to Complaint (Dkt. 1-6) in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)	EX1026
Oct. 6, 2025 Email from the Board to the parties authorizing reply briefing	EX1027 (NEW)
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USPTO Prosecution History of U.S. Patent Appl. No. 11/744,228	EX1029 (NEW)
Screen capture of USPTO Public Search portal for U.S. Patent No. 9,149,925	EX1030 (NEW)
USPTO Prosecution History of PCT Appl. No. PCT/US2008/56572	EX1031 (NEW)

Petitioner Spotify USA Inc. (“Petitioner”) submits this Reply to the Patent Owner Preliminary Response (“POPR,” Paper 6). The Board authorized the Reply in its email to the parties dated October 6, 2025 (EX1027).

I. INTRODUCTION

Petitioner seeks to correct inaccuracies in the POPR regarding the priority date of the ’925 patent. As explained in the Petition (Paper 2), the ’925 patent is not entitled to a filing date before July 27, 2010. (Petition, 1-2.) The application that became the ’925 patent was filed on that date, and the ’925 patent as allowed and granted does not claim priority to any other application. (EX1001.)

Nevertheless, in the POPR, and in subsequent emails to the Board, Patent Owner suggests that the ’925 patent is a continuation of U.S. Patent Appl. No. 11/744,228 (“’228 application”)¹ and claims priority to that application. (POPR, 7, 22-23, 49; *see* EX1027, EX1028.) Patent Owner also suggests that PCT application PCT/US2008/56572 (“PCT application”), published as Int’l. Pub. No. WO2008/137208, “establish[es] priority.” (POPR, 22-23, 49, 57; *see* EX2003.) Patent Owner is incorrect.

Specifically, the application that became the ’925 patent initially claimed priority to the ’228 application, but that priority claim was deleted by Patent

¹ The POPR’s reference to Appl. No. 11/744,731 (“Skin Treatment Preparation”) is understood to be an erroneous reference to the ’228 application.

Owner during prosecution. (EX1002, 306, 311, 316.) Patent Owner's deletion was made clearly and deliberately, through patent counsel. Further, the original priority claim was improper because the '925 patent was filed after Patent Owner abandoned the '228 application. 35 U.S.C. § 120. And the '925 patent never included any claim of priority to the PCT application. In any event, these alleged priority applications are limited disclosures that cannot alone support any of the challenged claims, as the Examiner found without any rebuttal by Patent Owner.

II. THE '925 PATENT DOES NOT CLAIM PRIORITY TO ANY OTHER DOCUMENT

A. The '925 Patent Application Initially Claimed Priority to the '228 Application, but Patent Owner Expressly Deleted it

When the '925 patent was filed on July 27, 2010, it initially claimed priority to the '228 application as a continuation-in-part. (EX1002, 77.) The Examiner indicated in a 2014 Office Action that the minimal '228 application “fails to provide adequate support or enablement ... As such, the priority date for the instant application is the filing date, 7/27/2010.” (EX1002, 273.) Patent Owner responded by deleting the priority claim, and by amending the specification to remove its sole reference to the '228 application. (EX1002, 306, 311, 316.) The USPTO accordingly issued a Corrected Filing Receipt, reflecting the deletion, and the patent issued without any priority claim reflected. (EX1002, 448; EX1001.)

In correspondence to the Board, Patent Owner asserted that he “did not disclaim or revoke the domestic-benefit claim” to the ’228 application. (EX1027, 1-2.) The record contradicts that assertion: Patent Owner’s deletion of its initial priority claim was clear and deliberate. (*See* EX1002, 316 (“Applicant has deleted the claim of priority to Application no. 11/744,228.”), 306 (requesting correction of “Domestic Priority data as claimed by applicant” in the Filing Receipt to recite “None”), 311 (amending specification to delete “This application is a continuation-in-part of application Ser. No. 11/744,228, filed May 4, 2007”).) And Patent Owner made no attempt to amend the Corrected Filing Receipt, reflecting the deleted priority claim, despite being urged to “verify the accuracy of the data” and request correction if an error was noted. (EX1002, 448-49.)

Patent Owner incorrectly suggests that USPTO’s public records show a claim of priority to the ’228 application. (EX1027, EX1028.) For example, in Patent Owner’s screenshots, apparently from the USPTO’s Patent Public Search tool, the ’925 patent application initially claimed priority to the ’228 application. (EX1028, 1, 3.) But the same search tool shows, consistent with continuity data on Patent Center, that the issued ’925 patent does not include any priority claim. (EX1030.) This correctly reflects that the priority claim was deleted after the application was filed, and before the ’925 patent issued.

Even if Patent Owner had not deleted the priority claim to the ’228

application, he could not have claimed priority to that application because he abandoned it before filing the application for the '925 patent. 35 U.S.C. § 120. On January 27, 2010, a Final Office Action specified a shortened statutory response period of three months, and the application lapsed when Patent Owner failed to respond or extend. (EX1029, 3-7, 1-2.) The abandonment was effective April 28, 2010, *i.e.*, the day after the shortened statutory period—and three months before the '925 patent application was filed on July 27, 2010. (*See* MPEP § 711.04(a).)

B. The '925 Patent Never Claimed Priority to the PCT Application

The '925 patent never included any priority claim to the PCT application and is not entitled to the benefit of its filing date. (EX1001; EX1002.) The POPR suggests that the PCT application claims priority to U.S. Provisional Appl. No. 60/908,484. (POPR, 22-23.) However, this provisional application is directed to a “Catheter Adapter Apparatus” and is unrelated to the '925 patent or the PCT application, undermining any priority claim. The PCT application claims priority only to the '228 application. (*See* EX1031.)

III. THE '228 DISCLOSURE AND PCT APPLICATION DO NOT SUPPORT ANY OF THE CHALLENGED CLAIMS

Even if the '925 patent claimed priority to the '228 application (which it does not), or to the PCT application (which it also does not), it still cannot be entitled to any priority date earlier than July 27, 2010—the date the '925 patent was filed. The '925 patent could have been at most a continuation-in-part, not a

continuation as Patent Owner now incorrectly suggests, because the '925 patent includes 48 pages of figures and a 94-paragraph written description; far more than what was included in the disclosure of the '228 application.² (EX1002, 2-66; EX1029, 106-110; *see* MPEP § 211.05(B) (“The disclosure of a continuation application must be the same as the disclosure of the prior-filed application.”).)

A patent claim can be entitled to the benefit of an earlier application only if every limitation of the claim is supported by the earlier application. *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 906 (Fed. Cir. 2018). Here, as the Examiner recognized, the '228 application “fails to provide adequate support or enablement” for the claims. (EX1002, 273.) For example, all challenged claims were allowed only after Patent Owner amended them—at the Examiner’s express suggestion—to recite compressing audio signals, and analyzing them for determining an RMS value. (EX1001, 9:66-12:44; EX1002, 408, 412.) These limitations are not supported by the '228 application. Rather, as Patent Owner and Examiner indicated, they are based on paragraph 0081 of the '925 patent’s specification—disclosure that is nowhere to be found in the '228 application. (EX1002, 408, 412.) The challenged claims are thus not entitled to any priority date before the July 27, 2010 filing.

² The disclosure of the PCT application is substantially identical to that of the '228 application, and also cannot support the challenged claims. (EX1029; EX2003.)

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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE was served as of the below date via e-mail (by agreement) to Patent Owner (Pro Se):

Manuel Tijerino
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Dated: October 14, 2025

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