

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPOTIFY USA INC.,
Petitioner,

v.

MANUEL TIJERINO,
Patent Owner.

IPR2025-01280
Patent 9,146,925 B2

Before ST. JOHN COURTENAY III, GEORGIANNA W. BRADEN, and
KEVIN C. TROCK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

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

Spotify USA Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–17 (“the challenged claims”) of U.S. Patent No. 9,146,925 (Ex. 1001, “the ’925 patent”). Petitioner also filed a Declaration of Mr. William Rosenblatt with the Petition. *See* Ex. 1003. Manuel Tijerino (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On October, 9, 2025, additional briefing by the parties regarding the priority of the ’925 patent was authorized by the Board. *See* Section VIII *infra*. Petitioner filed a Reply to Patent Owner’s Preliminary Response. Paper 8 (“Reply”). Patent owner filed a Sur-reply. Paper 9 (“Sur-reply”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2022). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “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.”

Upon consideration of the Petition, the Preliminary Response, the Reply, the Sur-reply, and the evidence of record, for the reasons given below we determine the information presented in the Petition demonstrates there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the ’925 patent.

Accordingly, we institute an *inter partes* review of claims 1–17 of the ’925 patent based upon the first asserted ground of unpatentability set forth in the Petition. Pet. 11–42.

I. INTRODUCTION

A. *Real Parties in Interest*

Petitioner identifies Spotify AB and Spotify Technology S.A. as the real parties-in-interest. Pet. 105–106. Patent Owner identifies himself, Manuel Tijerino, as the real party-in-interest. Paper 4, 1. Based upon our review of the record, we observe Patent Owner, Manuel Tijerino, appears to be representing himself *pro se* in this IPR proceeding. *Cf.* Ex. 2107, 2 (“This matter arises from a patent infringement action filed by Tijerino, proceeding *pro se* and *in forma pauperis*, in the Eastern District of Louisiana.”).

We encourage Patent Owner to avail himself of legal representation to avoid the possible forfeiture of any legal rights. *Cf.* Ex. 2112, 2 (“Tijerino’s RFAs are the latest in a series of improper filings and unauthorized discovery requests, which the Court has warned him may result in sanctions. These RFAs were plainly designed to unduly burden Spotify.”). If Patent Owner is an attorney representing himself *pro se*, Patent Owner should consider advising the Board of such status.¹

B. *Related Matters*

The parties identify the following related district court case involving the ’925 patent: *Tijerino v. Spotify USA Inc.*, Case No. 2:24-cv-02290 (E.D. La.). Ex. 2107. From Exhibit 2107, we understand that a motion to transfer

¹ If Patent Owner needs further assistance in this regard, we encourage Patent Owner to contact the United States Patent and Trademark Office’s *pro se* Assistance Program:
<https://www.uspto.gov/patents/basics/using-legal-services/pro-se-assistanceprogram>

venue filed by Spotify was granted, and the District Court case in the Eastern District of Louisiana has been transferred to the District Court in the Southern District of New York (*See Tijerino v. Spotify USA, Inc.*, Case No., 1:25-cv-08176-ER (S.D.N.Y.)). *See* Prelim. Resp. 1.

C. The '925 patent

The '925 patent is entitled “User Defined Internet Jukebox Kiosks Set Top Box,” and “relates to systems and methods for exposing local artists to the masses.” Ex. 1001, code (54), 1:1–2, 1:6–7. The '925 patent discloses that “[c]urrent internet jukeboxes serve media in digital format,” and artist have to pay “to get a digital record” such that “artists still have to audition, submit, and practically beg . . . companies to put their music in their systems.” *Id.* at 1:11–22. The '925 patent endeavors to allow artists “to easily upload their media to a website that is directly linked to an internet jukebox, kiosk, and/or set top box.” *Id.* at 1:32–35.

The '925 patent describes providing an artist “with an interface to enroll, pay a membership fee, [and] upload media to a server.” *Id.* at 2:24–26.” As a result, media is instantly transferred to a system of internet jukeboxes in various establishments, which (1) “provid[es] for instant availability for playback of media by customers on internet jukeboxes in a venue or establishment after uploading by the artist to the server,” and (2) “provid[es] the system of internet jukeboxes with programming to maintain an account for the musician allowing the artist to earn fees and royalties from playback of the media and to provide for automated payment of rent, and other fees due to the venue, the service provider and other licensing agencies.” *Id.* at 2:26–35.

D. Illustrative Claim

Petitioner challenges claims 1–17 of the '925 patent. Pet. 1, 4. Claims 1 and 3 are the independent claims. Claim 1 is illustrative of the challenged claims, and recites the following (Petitioner's bracketing and identifiers added):

1[Preamble]. A computer implemented method for real time music distribution of new media tor [sic] allowing an artist to control availability of the new media for playback in public venues via a jukebox, the method comprising:

[A] providing, by a processor, a user interface to interact with a system;

[B] providing, by the processor, a user interface to add the user to the system;

[C] providing, by the processor, a user interface to create an account;

[D] providing, by the processor, a user interface to log into the system;

[E] providing, by the processor, a user interface to add the new media to the system, wherein the new media is new if not previously stored in the system;

[F] receiving, by the processor, the new media added to the system

[G] automatically identifying, by the processor, metadata for the new media and storing the metadata in a database;

[H] storing, by the processor, the new media in a central storage device, wherein the storing automatically enables the new media to be requested by the jukebox for playback over the Internet by providing to a client software installed in the jukebox,

access to the database storing the metadata for the new media, via an API call over the Internet;

[I] automatically analyzing, by the processor, audio signals of the new media for determining a root mean square (RMS) value, wherein the RMS value is further mathematically manipulated for obtaining a positive RMS value less than 1;

[J] storing, by the processor, the obtained RMS value less than 1 as metadata for the new media;

[K] providing, by the processor, the metadata for the new media over the Internet in response to the API call for display by the jukebox

[L] receiving, by the processor, a request from the jukebox for playback of the new media associated with the displayed metadata;

[M] in response to the request, streaming by the processor the requested new media to the jukebox for playing audio corresponding to the streamed portion of the new media;

[N] automatically calculating, by the processor, amounts earned by an artist and a venue playing the new media; and

[O] receiving, by the processor, indication of payment of the amount earned,

[P] wherein, the audio signals of the new media are normalized by the processor or jukebox by applying gain to the signals based on the obtained positive RMS value less than 1, and

[Q] wherein, the audio signals of the new media are further compressed for reducing a dynamic range of the signal based on a preset compression ratio and a preset threshold value.

Ex. 1001, 9:66–10:55.

E. The Asserted Challenges to Patentability

Petitioner challenges claims 1–17 of the ’925 patent based upon the following proposed grounds of unpatentability:

Grounds	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1	1–17	103(a) ²	Laut, Kincaid, Bongiovi
2	1–17	103(a)	Dion, Nathan

Pet. 4. Patent Owner disputes that Petitioner has shown sufficiently its asserted grounds of unpatentability render the challenged claims obvious.

See generally Prelim. Resp.

F. Prior Art of Record

Petitioner submits the following asserted references as evidence:

Name ³	Reference	Issue or Publication Date	Exhibit(s)
Dion	U.S. Pat. No. 10,373,420 B2	Aug. 6, 2019	Ex. 1005
Nathan	U.S. Pat. No. 7,107,109 B1	Sept. 12, 2006	Ex. 1007
Laut	U.S. Pat. App. Pub. No. 2004/0243482 A1	Dec. 2, 2004	Ex. 1011
Kincaid	U.S. Pat. No. 7,469,208 B1	Dec. 23, 2008	Ex. 1012
Bongiovi	U.S. Pat. App. Pub. No. 2008/0137881 A1	June 12, 2008	Ex. 1013

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, effective on March 16, 2013. The ’925 patent claims the benefit of filing dates before the effective date of the applicable AIA amendments. *See* Ex. 1001, code (22). Therefore, we refer to the pre-AIA version of 35 U.S.C. § 103.

³ First named author or inventor only.

a. Summary of Dion (Ex. 1005)

Dion is titled “digital downloading jukebox with enhanced communication features.” Ex. 1005, code (54) (capitalization omitted). Dion relates “to digital downloading jukebox systems of the type which typically include a central server and remote jukebox devices that communicate with the central server for royalty accounting and/or content updates,” providing “user-tailored music management, communications, and other tools for recognized users using the jukebox system.” *Id.* at 1:26–33.

Dion describes replacing standalone phonorecord and CD jukeboxes with “digital downloading jukeboxes that are controlled by and communicate with a central server.” *Id.* at 2:35–38. Dion also describes “leveraging the data collected by jukeboxes and tying users to an online community” to establish “a mixed real-and-virtual community.” *Id.* at 5:37–40.

Dion discloses a jukebox system with a central server, communications network, and remote jukebox devices, each connected to its own local server. *Id.* at 9:1–7. The central server “includes a master library of songs,” and “[e]ach of the jukebox devices includes a subset of the master library on a local storage device of the jukebox.” *Id.* at 9:7–10. Dion’s “central server may be used to individually manage the contents of the jukebox device, by monitoring usage of an updating the subset of songs on each of the jukebox devices with the intent of maximizing the usage thereof” and “periodically receiv[ing] data from each of the jukeboxes for the purpose of royalty accounting and payment for songs played.” *Id.* at 9:10–17.

b. Summary of Nathan '109 (Ex. 1007)

Nathan is titled “process for adjusting the sound volume of a digital sound recording.” Ex. 1007, code (54) (capitalization omitted). Nathan relates “to a process for adjusting the sound volume of a digital sound recording reproduced by an item of equipment,” and is “intended to be used during the reproduction of a digital recording in the form of a data file by means of a sound card, for example, of an audiovisual reproduction system, such as a jukebox.” *Id.* at 1:7–12.

Nathan describes that, “between two recordings of different types of music, it is necessary to modify the sound level setting between two recordings, to obtain a reproduction with the same sound level for two different recordings with different original sound levels.” *Id.* at 1:30–34. To address this need, Nathan discloses “a process for adjusting the sound level of a digital sound recording making it possible to obtain identical sound levels in different recordings, irrespective of the differences in the digital sound recording level existing initially between each of the recordings.” *Id.* at 1:40–45.

c. Summary of Laut (Ex. 1011)

Laut is titled “method and apparatus for multi-way jukebox system.” Ex. 1011, code (54) (capitalization omitted). Laut relates to a “multi-way jukebox system including networked jukeboxes where content (i.e., audio, video/graphics, text) can be selectively transmitted for viewing, listening, reading, etc. to any jukebox in the network from any other jukebox in the network or from a management device.” *Id.* ¶ 2.

Laut describes the jukebox system controller including “processes for scheduling, prioritizing content, routing signals and messages, transmitting content, receiving content, playing content, accepting fees,

transmitting/receiving data, coupling to a network, verifying payment,” and “storing content to memory, filtering content signals for karaoke play, displaying content information on a display, etc.” *Id.* ¶ 30. Laut describes using “statistical information for content . . . such as number of times played at current venue, number of times played at selected venue, overall times played throughout the network, number of times played in different zones (i.e., states, countries, cities, etc.).” *Id.* ¶ 55.

d. Summary of Kincaid (Ex. 1012)

Kincaid is titled “method and apparatus for automatically normalizing a perceived volume level in a digitally encoded file.” Ex. 1012, code (54) (capitalization omitted). Kincaid relates to “a method and apparatus that automatically normalizes the volume of a recording based upon both the selectivity and the sensitivity of the human auditory system.” *Id.* at 1:20–23.

Kincaid describes “a computationally efficient and automatic method and apparatus for *normalizing* volume between any number of digitally encoded multimedia asset files . . . such that the perceived volume between each of the files is substantially equivalent.” *Id.* at 1:51–55 (emphasis added).

e. Summary of Bongiovi (Ex. 1013)

Bongiovi is titled “system and method for digital signal processing.” Ex. 1013, code (54) (capitalization omitted). Bongiovi relates “to digitally processing an audio signal in a manner such that studio-quality sound that can be reproduced across the entire spectrum of audio devices.” *Id.* ¶ 4.

Bongiovi describes “a need for a system that can reproduce studio-quality sound in a vehicle.” *Id.* ¶ 10. In order to meet this need, Bongiovi discloses “a method of digitally processing an audio signal in a manner such

that studio-quality sound that can be reproduced across the entire spectrum of audio devices.” *Id.* ¶ 11.

G. Testimonial Evidence

To support its challenges, Petitioner additionally relies upon the declaration of William Rosenblatt. *See generally* Ex. 1003. Mr. Rosenblatt states, “I have been retained by counsel for Spotify USA Inc. (‘Petitioner’ or ‘Spotify’) in connection with the proceeding identified above.” Ex. 1003, 6. “I submit this declaration in support of Spotify’s Petition for *Inter Partes* Review of United States Patent No. 9,146,925.” *Id.* Mr. Rosenblatt’s C.V. indicates he received a “B.S.E. (*cum laude*) in Electrical Engineering and Computer Science, Princeton University, 1983,” and a “M.S. in Computer and Information Science, University of Massachusetts, 1990.” Ex. 1004, 3.

At this stage of the proceeding, Patent Owner does not submit testimonial evidence.

II. LEVEL OF ORDINARY SKILL IN THE ART

We consider the asserted grounds of unpatentability in view of the understanding of a person of ordinary skill in the art (“POSITA”). 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) (quoting *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)). “[O]ne or more factors may predominate.” *Id.*

Relying on the declaration testimony of Mr. Rosenblatt, Petitioner contends that an ordinarily skilled artisan for the '925 patent “would have had a Bachelor of Science degree and a Masters [sic] degree in Computer Science, Electrical Engineering, Computer Engineering, or an equivalent field, as well as one to two years of academic or industry experience in computer-based systems for digital audio distribution and playback, or comparable industry experience.” Pet. 3 (citing Ex. 1003 ¶ 28). Petitioner further asserts that the ordinarily skilled artisan “would have been knowledgeable about audio signal processing techniques, such as gain normalization and dynamic range compression, and software engineering.” *Id.*

At this stage, Patent Owner does not specifically address the level of skill of the ordinary artisan. *See generally* Prelim. Resp.

For purposes of this Decision, we adopt Petitioner’s definition of the level of ordinary skill in the art. On the present record, we are satisfied that this definition comports with the level of skill necessary to understand and implement the teachings of the '925 patent and the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that the prior art itself can reflect appropriate level of ordinary skill in art).

III. CLAIM CONSTRUCTION

We interpret the claims of the challenged '925 patent using the same claim construction standard that would be used to construe the [claims] in a civil action under 35 U.S.C. 282(b), including construing the [claims] in accordance with the ordinary and customary meaning of such [claims] 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) (2023).

Accordingly, our claim construction standard is the same as that of a district court. *See id.* Under the standard applied by district courts, claim terms are generally given their plain and ordinary meaning, as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). “There are only two exceptions to this general rule: (1) when a patentee sets out a definition and acts as his own lexicographer, or (2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

Section 42.104(b)(3) requires that the Petition identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3).

Here, Petitioner contends no claim construction is necessary to resolve the invalidity challenges presented. Pet. 3. Petitioner also states: “[i]f trial is instituted, Petitioner reserves its right to address construction of any terms raised at trial, or in the related district court action.” *Id.* n.1.

In contrast, Patent Owner incorrectly “applies the broadest reasonable interpretation (BRI) standard, consistent with the intrinsic record,” and asserts that under BRI “Petitioner’s interpretations of key claim terms are overly narrow and mischaracterize the invention.” Prelim. Resp. 2.

Under BRI, Patent Owner sets forth its constructions for the claim terms “processor,” “venue,” “automatically calculating,” “receiving indication of payment,” and “real-time.” Prelim. Resp. 2–9. Patent Owner summarizes its claim construction on page 9 of the Preliminary Response, as follows:

The proper constructions, consistent with the intrinsic record, are:

- Processor = server processor
- Venue = territory of use
- Automatically calculating = tallying play counts, not payments or reporting
- Receiving indication of payment = server acknowledgment, not cash handling
- Real-time = server process control (immediate or scheduled)

Prelim. Resp. 9.

Patent Owner urges: “[u]nder these constructions, Petitioner’s cited art cannot meet the limitations of the challenged claims.” *Id.*

Patent Owner incorrectly interprets the issued ’925 patent claim terms under BRI. Prelim. Resp. 2. Accordingly, at this stage of the proceeding, we decline to consider Patent Owner’s proposed constructions for claim 1 under the legally incorrect broadest reasonable interpretation standard, which is only applicable during prosecution before a patent examiner. As emphasized above, in interpreting the claims of the ’925 patent, we “us[e] the same claim construction standard that would be used to construe the claim[s] in a civil action under 35 U.S.C. [§] 282(b).” *See* 37 C.F.R. § 42.100(b) (2023).

We further emphasize that we construe claim terms only as relevant to the parties’ contentions and only to the extent necessary to resolve the issues in dispute. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Based on our review of the current record, we determine that no express construction of any term is necessary to resolve this case for purposes of institution. We leave it to the parties to further develop during

trial any dispute regarding the claim construction of particular claim terms under the proper *Phillips* standard applied to IPR proceedings. *See Phillips*, 415 F.3d at 1313.

IV. PRINCIPLES OF LAW

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to Patent Owner except in certain limited circumstances.⁴ *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review); *see also In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016) (“Where, as here, the only question presented is whether due consideration of the four *Graham* factors renders a claim or claims obvious, no burden shifts from the patent challenger to the patentee.”).

A patent claim is unpatentable under 35 U.S.C. § 103 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

⁴ For example, as applicable here, “for a patent’s claims to be entitled to an earlier priority date, the patentee must demonstrate that the claims meet the requirements of 35 U.S.C. § 120.” *In re NTP, Inc.*, 654 F.3d 1268, 1276 (Fed. Cir. 2011). *See infra* section VIII (“Priority”).

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) when in evidence, objective evidence of nonobviousness.⁵ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Objective indicia of nonobviousness, such as “commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Id.* When conducting an obviousness analysis, we consider a prior art reference “not only for what it expressly teaches, but also for what it fairly suggests.” *Bradium Techs. LLC v. Iancu*, 923 F.3d 1032, 1049 (Fed. Cir. 2019) (quoting *In re Baird*, 16 F.3d 380, 383 (Fed. Cir. 1994)).

“[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 550 U.S. at 416 (citing *United States v. Adams*, 383 U.S. 39, 50–51 (1966)). An obviousness inquiry is not limited to the prior art’s preferred embodiment. *See, e.g., Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1370 (Fed. Cir. 2007). We also recognize that prior art

⁵ Patent Owner does not present arguments or evidence of secondary considerations (i.e., objective indicia of non-obviousness) in its Preliminary Response. *See generally* Prelim. Resp. Therefore, secondary considerations do not constitute part of our analysis.

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) (citing *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)).

A patent claim “is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 550 U.S. at 418. An obviousness determination based on a combination of references requires finding “both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367–68 (Fed. Cir. 2016) (quoting *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1360 (Fed. Cir. 2012)); *see KSR*, 550 U.S. at 418 (for an obviousness analysis, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does”).

“Although the *KSR* test is flexible, the Board ‘must still be careful not to allow hindsight reconstruction of references . . . without any explanation as to *how* or *why* the references would be combined to produce the claimed invention.’” *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016) (quoting *Kinetic Concepts*, 688 F.3d at 1368). Further, an assertion of obviousness “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); *accord In re NuVasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (stating that “conclusory statements” amount to an “insufficient articulation[] of motivation to

combine”; “instead, the finding must be supported by a ‘reasoned explanation’” (quoting *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002)); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.”).

V. ALLEGED RATIONALE TO MODIFY LAUT WITH THE TEACHINGS OF KINCAID

A. *Rationale to Combine Laut with Kincaid*

Petitioner notes that “Laut’s jukebox is configured to play audio tracks spanning many different artists and genres (*e.g.*, Rock/Pop, Holiday Theme, Love Songs), and provided from various sources (*e.g.*, uploaded by users as described for element [E]).” Pet. 27 (citing Ex. 1011 ¶ 48, Fig. 4C; Ex. 1003 ¶ 65). Petitioner asserts that the “POSITA would understand such audio tracks to vary widely in perceived loudness, owing to differences in how the tracks are recorded, mixed, and mastered; genre expectations (*e.g.*, rock tracks may be generally louder than folk songs or ballads); or artists’ or record producers’ own loudness preferences.” *Id.* (citing Ex. 1003 ¶ 65).

Petitioner asserts that “Laut’s jukebox would thus face a problem identified in Kincaid: differences in perceived volume between audio tracks are undesirable for listeners, and manually readjusting the perceived volume for each track would disrupt an ‘otherwise ... effortless and enjoyable listening experience.’” *Id.* (citing Ex. 1012, 1:35–43; Ex 1003 ¶ 65). Petitioner contends the “POSITA would seek to ensure consistent loudness

across tracks to maximize customer satisfaction and would thus be motivated to combine Kincaid with Laut in order to correct these problems.” *Id.* (citing Ex. 1003 ¶ 65). Petitioner argues that the “POSITA’s motivation would have been at least partially financial: improving the listeners’ experiences could increase demand for the jukebox, leading to more frequent usage and thus increased revenue.” Pet. 27–28 (citing Ex. 1011 ¶¶ 4, 6; Ex. 1003 ¶ 65).

B. Patent Owner’s Response

Patent Owner advances no substantive arguments regarding Petitioner’s proposed rationale to modify Laut with the teachings of Kincaid. *See generally* Prelim. Resp. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

C. The Board’s Preliminary Analysis — Rationale to Combine Kincaid with Laut

At this stage of the proceeding, based on the express disclosures of Kincaid and Laut, we are persuaded Petitioner’s rationale is sufficient to show that a “POSITA would seek to ensure consistent loudness across tracks to maximize customer satisfaction and would thus be motivated to combine Kincaid with Laut in order to correct these problems.” Pet. 27 (citing Ex. 1003 ¶ 65).

Moreover, we credit Mr. Rosenblatt’s testimony that the “POSITA’s motivation would have been at least partially financial: improving the listeners’ experiences could increase demand for the jukebox, leading to

more frequent usage and thus increased revenue.” Ex. 1003 ¶ 65 (citing Ex. 1011 ¶¶ 4, 6).

D. Reasonable Expectation of Success in Modifying Laut with Kincaid

Petitioner argues that the “POSITA would have had a reasonable expectation of success in combining Laut and Kincaid.” Pet. 28 (citing Ex. 1003 ¶ 66). Petitioner asserts that “Kincaid’s techniques are broadly applicable to music playback devices and can be implemented in ‘any number and type of devices where computational resources are limited such as multimedia asset players’—analogous to Laut’s computer-based jukebox.” *Id.* (citing Ex. 1012, 1:56–59; Ex. 1003 ¶ 66).

Petitioner notes that “Kincaid’s volume normalization is implemented via CPU 410, analogous to CPU 221 of Laut’s controller 220.” *Id.* (citing Ex. 1012, 9:6–51, Fig. 4; Ex. 1011 ¶¶ 29–30; Ex. 1003 ¶ 66). Petitioner argues that “Kincaid and Laut also share other analogous and familiar computer components, such as memory, storage devices, and network interfaces; connect to the Internet to receive audio data; and share common data file formats, including the MP3 audio format.” *Id.* (citing Ex. 1011 ¶¶ 31, 87; Ex. 1012, 1:25–47, 8:52–64; Ex. 1003 ¶ 66).

Petitioner concludes that “Laut and Kincaid are thus easily combined based on familiar components.” *Id.* (citing Ex. 1003 ¶ 66). Petitioner further notes that “Kincaid describes its normalization techniques in detail, thus minimizing any guesswork required of the POSITA in making the combination.” *Id.* (citing, e.g., Ex. 1012, 4:24–5:32; Ex. 1003 ¶ 66).

E. Patent Owner’s Response

Patent Owner advances no substantive arguments regarding Petitioner’s proposed explanation that a POSITA would have had a reasonable expectation of success in combining Laut and Kincaid. *See generally* Prelim. Resp. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

F. The Board’s Preliminary Analysis – Alleged Reasonable Expectation of Success in Combining Kincaid with Laut

At this stage, we are persuaded that Petitioner’s statement and the cited evidence support a reasonable expectation of success: “Laut and Kincaid are . . . easily combined based on familiar components.” Pet. 28 (citing Ex. 1003 ¶ 66). Moreover, we credit Mr. Rosenblatt’s testimony that “Kincaid’s techniques are broadly applicable to music playback devices, and can be implemented in ‘any number and type of devices where computational resources are limited such as multimedia asset players’—analogous to Laut’s computer-based jukebox.” Ex. 1003 ¶ 66 (quoting Ex. 1012, 1:56–59).

VI. ALLEGED RATIONALE TO MODIFY LAUT AND KINCAID
WITH THE TEACHINGS OF BONGIOVI

A. Rationale to Combine Laut and Kincaid with Bongiovi

Petitioner argues that the “POSITA would have been motivated to combine Bongiovi with Laut and Kincaid.” Pet. 39–40 (citing Ex. 1003 ¶ 83). Petitioner contends the “POSITA would have sought out specific

techniques for improving audio quality in high-noise environments, such as the bars and restaurants in which Laut’s jukeboxes are typically installed.” Pet. 40 (citing Ex. 1011 ¶¶ 17, 29, 101; Ex. 1003 ¶ 83).

Petitioner asserts that “[t]his problem is addressed by Bongiovi: dynamic range compression reduces the difference in amplitude between the loudest and quietest elements of the signal.” Pet. 40 (citing Ex. 1013 ¶¶ 14–20; Ex. 1003 ¶ 83). Petitioner notes that “[a]fter reducing the signal’s peak levels, the overall output gain can then be increased (*e.g.*, at stage 109 of Fig. 1), thus increasing a track’s overall loudness without exceeding an audio system’s maximum allowable levels. *Id.* (citing Ex. 1013 ¶¶ 51, 116–117, Fig. 1; Ex. 1003 ¶ 82).

Petitioner asserts that “[t]his produces a ‘constant output level of rich, full sound’” even in high-noise environments such as clubs and theatres. *Id.* (citing Ex. 1013 ¶¶ 14–20; Ex. 1003 ¶ 83). Petitioner notes that “[f]or example, Bongiovi permits ‘studio-quality sound’ in a high-noise environment with an 80 dB noise floor and a 110 dB sound threshold—ambient sound levels that could otherwise make it difficult to hear quieter portions of uncompressed audio tracks.” *Id.* (citing Ex. 1013 ¶ 17; Ex. 1003 ¶ 83).

Petitioner further notes that “Kincaid expressly suggests combining its loudness adjustment with ‘peak limiting,’ such as the peak level reduction in Bongiovi’s dynamic range compression, in order to ‘guard against over amplification’ and thus further improve audio quality.” Pet. 40–41 (citing Ex. 1012, 4:15–19; Ex. 1003 ¶ 84). Petitioner contends that the “POSITA would also recognize that mere volume adjustment from one song to the next (as disclosed in Kincaid) would not optimize the experience for patrons of high-noise jukebox venues which, like the public venues disclosed in

Bongiovi, did not do justice to music recordings with wide dynamic range (*i.e.*, the soft passages being obscured by ambient noise).” Pet. 41 (citing Ex. 1003 ¶ 84). Petitioner concludes: “The POSITA thus would have been motivated to combine Laut and Kincaid with the audio compression techniques of Bongiovi, which instruct the POSITA how to use computer-enabled audio devices—analogue to Laut’s jukeboxes—to obtain more appropriate sound quality for high-noise jukebox environments.” *Id.* (citing Ex. 1013 ¶¶ 11, 15–20; Ex. 1003 ¶ 84).

B. Patent Owner’s Response

Patent Owner advances no substantive arguments regarding Petitioner’s proposed rationale to modify Laut and Kincaid with the teachings of Bongiovi. *See generally* Prelim. Resp. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

C. The Board’s Preliminary Analysis — Alleged Rationale to Combine Kincaid and Laut with Bongiovi

At this stage, we are persuaded Petitioner’s proposed rationale is sufficient to preliminarily show that a “POSITA would have sought out specific techniques for improving audio quality in high-noise environments, such as the bars and restaurants in which Laut’s jukeboxes are typically installed.” Pet. 40 (citing Ex. 1011 ¶¶ 17, 29, 101; Ex. 1003 ¶ 83). Thus, based on the current record we are persuaded by Petitioner that the POSITA would have had reason to “combine Laut and Kincaid with the audio compression techniques of Bongiovi, which instruct the POSITA how to use computer-enabled audio devices—analogue to Laut’s jukeboxes—to obtain

more appropriate sound quality for high-noise jukebox environments.” *Id.* (citing Ex. 1013 ¶¶ 11, 15–20; Ex. 1003 ¶ 84).

We further credit Mr. Rosenblatt’s testimony that “Bongiovi is broadly applicable to the ‘entire spectrum of audio devices,’ spanning a range including MP3 players, computers, and home theater systems, which the POSITA would understand to include Internet jukeboxes.” Ex. 1003 ¶ 85 (citing Ex. 1013 ¶¶ 11, 20, 143).

D. Reasonable Expectation of Success in Modifying Laut and Kincaid with Bongiovi

Petitioner contends that the “POSITA would have had a reasonable expectation of success in making the combination.” Pet. 41 (citing Ex. 1003 ¶ 85). Petitioner argues that “Bongiovi’s audio processing is implemented using computer audio devices, with processors such as the CPUs found in Laut and Kincaid.” *Id.* (citing Ex. 1013 ¶¶ 19, 52, 70; Ex. 1011 ¶¶ 71; Ex. 1012, 8:6–51, Fig. 4; Ex. 1003 ¶ 85). Petitioner notes that “[a]udio data is in the same MP3 file format preferably used in Laut and in Kincaid.” *Id.* (citing Ex. 1013 ¶¶ 20–23, 52; Ex. 1011 ¶¶ 31, 87; Ex. 1012, 1:25–47, 8:52–64; Ex. 1003 ¶ 85).

Petitioner argues that “Bongiovi is broadly applicable to the ‘entire spectrum of audio devices,’ which the POSITA would understand to include Internet jukeboxes.” Pet. 41–42 (citing Ex. 1013 ¶¶ 11, 20, 143; Ex. 1003 ¶ 85). Petitioner further argues that “Bongiovi provides detailed implementation guidance—including source code examples with detailed explanations—for programming a processor, such as in controller 220 of Laut’s jukebox, to implement its compression techniques.” Pet. 41 (citing Ex. 1013 ¶¶ 131–143; Ex. 1003 ¶ 85).

E. Patent Owner’s Response

Patent Owner advances no substantive arguments regarding Petitioner’s proposed explanation that a POSITA would have had a reasonable expectation of success in combining Laut and Kincaid with the teachings of Bongiovi. *See generally* Prelim. Resp. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

F. The Board’s Preliminary Analysis – Alleged Reasonable Expectation of Success in Combining Kincaid and Laut with Bongiovi

At this stage, we are persuaded that Petitioner’s statement and the cited evidence support a reasonable expectation of success: “Bongiovi is broadly applicable to the ‘entire spectrum of audio devices,’ which the POSITA would understand to include Internet jukeboxes.” Pet. 41–42 (citing Ex. 1013 ¶¶ 11, 20, 143; Ex. 1003 ¶ 85).

VII. ALLEGED OBVIOUSNESS OVER LAUT, KINCAID, AND BONGIOVI

Petitioner contends that claims 1–17 of the ’925 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Laut, Kincaid, and Bongiovi. Pet. 5–56. Patent Owner opposes. *See* Prelim. Resp. 11–22. We also have considered the Declaration by Mr. Rosenblatt, as cited by Petitioner in support of institution. *See generally* Ex. 1003.

A. *Claim 1*

As noted above under section III (Claim Construction), on page 9 of the Preliminary Response, Patent Owner argues that Petitioner fails to meet claim terms A–F, which Patent Owner contends mean the following:

- [A]⁶ Processor = server processor
- [B] Venue = territory of use
- [C] Automatically calculating = tallying play counts, not payments or reporting
- [D] Receiving indication of payment = server acknowledgment, not cash handling
- [E] Real-time = server process control (immediate or scheduled)

Prelim. Resp. 9.

For claim term [F], Patent Owner refers not to a claim term, but rather to the topic of “Continuation Priority and Parent Claim Support,” which we address *infra* under section VIII (Priority). Prelim. Resp. 7.

As also noted above under section III, Patent Owner incorrectly interprets the issued ’925 patent claim terms under the broadest reasonable interpretation standard applied by a patent examiner during prosecution. *See* Prelim. Resp. 2.

Patent Owner also appears to read limitations from the ’925 patent specification into the patent claims. *See In re Am. Acad. of Science Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) (“We have cautioned against

⁶ For clarity, we emphasize the above claim terms (as listed by Patent Owner, Prelim. Resp. 9) correspond to uppercase letters A–E, as used by Patent Owner in its Preliminary Response (pages 2–9), which *should not be confused with the uppercase claim 1 steps* [A]–[Q] we have adopted from the Petition for the respective limitations [A]–[Q] of claim 1, as set forth *infra*. *See* Pet. 110–111 (“Claims Appendix”). This annotation does not impact our analysis.

reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.”). We decline to read such limitations into the claim for our analysis.

We address *infra* the challenged claim 1 steps, using the annotation [Preamble] [A]–[Q], as mapped by Petitioner to the corresponding portions of the cited references for the challenge based on Laut, Kincaid, and Bongiovi.

1. Preamble [Preamble]

The preamble of claim 1 recites: “[a] computer implemented method for real time music distribution of new media tor [sic] allowing an artist to control availability of the new media for playback in public venues via a jukebox, the method comprising.” Ex. 1001, 1:66–2:2.

Generally, a preamble does not limit a claim. *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002). However, we need not decide whether the preamble limits claim 1, because based on the current record and for the reasons stated by Petitioner and supported by Mr. Rosenblatt’s testimony, Petitioner establishes sufficiently for purposes of institution that Laut teaches the preamble of claim 1. *See* Pet 11 (citing Ex. 1011 ¶¶ 30, 73, 29, 105; Ex. 1003 ¶ 41).

Based upon our review of the record, we credit Mr. Rosenblatt’s testimony that “in Laut, a user, *e.g.*, an artist, can use a computer-networked jukebox with a controller 220 to ‘upload content that is desired to be played on any or all of the available jukebox systems that are coupled to the network.’” Ex. 1003 (citing Ex. 1011 ¶¶ 30, 73). Additionally, Laut

persuasively describes that the “user can select any/all jukebox systems at different venues to play the content.” Ex. 1011 ¶ 30.

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony as relied upon by Petitioner. *See* Ex. 1003 ¶ 41. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the terms “public venues” and “real time” have specific meaning that Petitioner fails to meet. We decline, however, to limit the term “public venues” as recited in the preamble of claim 1 to “a territory of use” as argued by Patent Owner, because claim 1 is silent regarding the argued language “a territory of use.” Prelim. Resp. 2–5, 9. Additionally, we decline to limit the “real time” term recited in the preamble of claim 1 to a “server-controlled process timing for distribution of new media once uploaded, whether immediate or scheduled,” as argued by Patent Owner on page 6 of the Preliminary Response, because Patent Owner is arguing limitations that are not recited in the preamble of claim 1.

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach the preamble of claim 1 [Preamble].

2. Step [A]

Step [A] of claim 1 recites: “providing, by a processor, a user interface to interact with a system.” Ex. 1001, 10:3–4.

Petitioner argues step [A] is taught by Laut. Pet 11–14 (citing Ex. 1011 ¶¶ 29–32, 48, 49, Fig. 2A, Fig. 4C; Ex. 1003 ¶¶ 42–44).

Based upon our review of the current record, we are persuaded by Petitioner’s arguments and citations to the evidence. Additionally, we credit Mr. Rosenblatt’s testimony that Laut teaches: “User interface 240 can be accessed by a user to interact with the jukebox system by, *e.g.*, selecting content choices; entering a user identification and password; and selecting a venue for content playback.” Ex. 1003 (quoting Ex. 1011 ¶ 32). We also credit Mr. Rosenblatt’s testimony that “[t]he POSITA would understand user interface 240 to be provided by the processor, *e.g.*, controller 220, at least because controller 220 ‘includes processes for ... displaying content information on a display, which is a function of user interface 240.’” *Id.* (quoting Ex. 1011 ¶¶ 29–32).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony as relied upon by Petitioner. *See* Ex. 1003 ¶¶ 42–44. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [A] of claim 1.

3. *Step [B]*

Step [B] of claim 1 recites: “providing, by the processor, a user interface to add the user to the system.” Ex. 1001, 10:5–6.

Petitioner argues step [B] is taught by Laut. Pet 11–14 (citing Ex. 1011 ¶¶ 42–46, 60; Ex. 1003 ¶ 45).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Laut discloses that the user can have a personal account with the jukebox system, with an associated identification and password for security, that permits the user to store personal content selections and other data.” Ex. 1003 ¶ 45 (citing Ex. 1011 ¶¶ 42–46, 60). We also credit Mr. Rosenblatt’s testimony, as follows:

A POSITA would understand that the user’s account must be added before it can be used; and that the user interface 240, as the user’s mechanism for accessing and logging in to the jukebox system, is the most sensible interface for creating an account and thereby adding the user. User interface 240 is provided by the processor as described for element [A].

Ex. 1003 ¶ 45.

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony as relied upon by Petitioner. *See* Ex. 1003 ¶ 45. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [B] of claim 1.

4. *Step [C]*

Step [C] of claim 1 recites: “providing, by the processor, a user interface to create an account.” Ex. 1001, 10:7–8.

Petitioner maps Step C identically to Step B as mapped *supra* to Laut, as discussed in Mr. Rosenblatt’s testimony. Pet. 15 (“*See* element [B]” (citing Ex. 1003 ¶ 46)).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Laut meets this element as described above for element [B].” Ex. 1003 ¶ 46.

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut as relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶ 46. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [C] of claim 1.

5. *Step [D]*

Step [D] of claim 1 recites: “providing, by the processor, a user interface to log into the system.” Ex. 1001, 10:9–10.

Petitioner argues step [D] is taught by Laut. Pet 15–16 (citing Ex. 1011 ¶¶ 32, 24–46, 73, 89, Fig. 4C; Ex. 1003 ¶ 47).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Laut discloses that the user can access user interface 240 to enter his or her user identification and password to log into the system.” Ex. 1003 ¶ 47 (citing Ex. 1011 ¶¶ 32, 24–46, 73, 89, Fig. 4C (annotated)).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶ 47. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [D] of claim 1.

6. *Step [E]*

Step [E] of claim 1 recites: “providing, by the processor, a user interface to add the new media to the system, wherein the new media is new if not previously stored in the system.” Ex. 1001, 10:11–13.

Petitioner argues step [E] is taught by Laut. Pet 15–16 (citing Ex. 1011 ¶¶ 34, 73; Ex. 1003 ¶¶ 49–50).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Laut discloses that a user can ‘upload content that is desired to be played on any or all of the available jukebox systems that are coupled to the network’ and ‘any/all jukebox systems at different venues to play the content.’” Ex. 1003 ¶ 49 (citing Ex. 1011 ¶ 73). We further credit Mr. Rosenblatt’s testimony that Laut teaches that “a user can remotely log on to a website, *i.e.*, via user interface 240, by entering a user identification and password to upload content.” *Id.* ¶ 50 (citing Ex. 1011 ¶ 73). We also credit Mr. Rosenblatt’s testimony that “[u]ser interface 240 is provided by the processor as described for element [A].” *Id.*

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony as relied upon by Petitioner. *See* Ex. 1003 ¶¶ 49–50. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [E] of claim 1.

7. *Step [F]*

Step [F] of claim 1 recites: “receiving, by the processor, the new media added to the system.” Ex. 1001, 10:14–15.

Petitioner argues step [F] is taught by Laut. Pet 18 (citing Ex. 1011 ¶¶ 30; Ex. 1003 ¶¶ 51).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that the “new media is received by the processor in Laut: the processor provides the user interface 240 via which the new media is added . . . , and further ‘includes processes for . . . receiving content’ such as the new media.” Ex. 1003 ¶ 51 (citing Ex. 1011 ¶ 30).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony as relied upon by Petitioner. *See* Ex. 1003 ¶ 51. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [F] of claim 1.

8. *Step [G]*

Step [G] of claim 1 recites: “automatically identifying, by the processor, metadata for the new media and storing the metadata in a database.” Ex. 1001, 10:17–18.

Petitioner argues step [G] is taught by Laut. Pet 18–20 (citing Ex. 1011 ¶¶ 48–52, 56, 60–62, 73, 94, Fig. 4C, Fig. 7; Ex. 1003 ¶¶ 52–53).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “[o]nce a song is uploaded in Laut, it is rated according to a ‘standard audio/video rating system.’” Ex. 1003 ¶ 52 (citing Ex. 1011 ¶¶ 48, 73, 94). We further credit Mr. Rosenblatt’s testimony that the “POSITA would understand a rating of a song to be a metadata element for that song. The rating is stored in a database, along with other metadata such as year, artist name, title, and genre; the metadata can be searched and used to limit or control what is played on a particular jukebox.” *Id.* (citing Ex. 1011 ¶¶ 48–52, 56, 60–62, Fig. 7).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 52–53. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [G] of claim 1.

9. *Step [H]*

Step [H] of claim 1 recites: “storing, by the processor, the new media in a central storage device, wherein the storing automatically enables the new media to be requested by the jukebox for playback over the Internet by providing to a client software installed in the jukebox, access to the database storing the metadata for the new media, via an API call over the Internet.” Ex. 1001, 10:19–25.

Petitioner argues step [H] is taught by Laut. Pet 20–24 (citing Ex. 1011 ¶¶ 30, 34, 48–52, 56, 60–62, 86, 87, 96–100, Figs. 7, 14, 16; Ex. 1003 ¶¶ 55–59; Ex. 1002 ¶ 412 (April 29, 2015, Interview Summary)).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “[a]s described for element [E], a user in Laut uploads a song, or other new media, automatically making it available for playback on ‘any or all of the available jukebox systems that are coupled to the network.’” Ex. 1003 ¶ 55 (citing Ex. 1011 ¶ 73). We further credit Mr. Rosenblatt’s testimony that the “jukeboxes utilize installed client software (*e.g.*, user interface 240, menu 700 in the figure below) to request playback of the song over the Internet, *e.g.*, by searching for the song’s metadata (genre, rating, etc.) in the database as described for element [G].” *Id.* (citing Ex. 1011 ¶¶ 48–52, 56, 60–62,

Fig. 7). Moreover, we credit Mr. Rosenblatt’s testimony that Figure 16 of Laut “illustrates a process of selecting content for playback, with content selected at block 1605, from a menu for accessing metadata from the database, as described above.” *Id.* ¶ 56 (citing Ex. 1011 ¶¶ 96–100, Fig. 16 (annotated)).

Lastly, we credit Mr. Rosenblatt’s testimony that “[t]o the extent not expressly disclosed, it would have been obvious to the POSITA for the jukebox to gain access to the database via an API call over the Internet.” *Id.* ¶ 59. As Mr. Rosenblatt testifies: “the Examiner recognized, [that] the claimed API call is ‘equivalent to making a general request for a media/song list.’” *Id.* (citing Ex. 1002, 412 (April 29, 2015 Interview Summary)). We credit Mr. Rosenblatt’s testimony that “Laut discloses that the jukebox communicates with the database through user interface 240 actions to request and retrieve a song.” *Id.* We also credit Mr. Rosenblatt’s testimony that the “POSITA would understand ‘API call’ to be a generic term of art that encompasses a range of ubiquitous and well-understood mechanisms suitable for a client passing information to and invoking functionality on a server via the Internet, *e.g.*, for communicating a song request from the jukebox to the database as disclosed in Laut.” *Id.*

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 55–59. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [H] of claim 1.

10. Step [I]

Step [I] of claim 1 recites: “automatically analyzing, by the processor, audio signals of the new media for determining a root mean square (RMS) value, wherein the RMS value is further mathematically manipulated for obtaining a positive RMS value less than 1.” Ex. 1001, 10:26–30.

Petitioner argues step [I] is taught by Kincaid. Pet 24–26 (citing Ex. 1012, 1:25–47, 4:13–15, 4:64–5:32, 6:59–62, 8:6–51, 11:48–58 (claim 22), Fig. 4; Ex. 1003 ¶¶ 60–64).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that Kincaid discloses that the “perceived acoustic power is determined by ‘calculating a root mean square value (RMS)’ of average weighted power values for the audio signal.” Ex. 1003 ¶ 61 (citing Ex. 1012, 11:48–58 (claim 22)). We also credit Mr. Rosenblatt’s testimony that “Kincaid discloses computing a track’s ‘average weighted power value’ (P_{power}), which is ‘proportional to the square of waveform amplitude’; and then calculating the square root of that value.” *Id.*

We further credit Mr. Rosenblatt’s testimony that the “POSITA would understand these operations to meet calculating an RMS value (*e.g.*, the

POSITA would understand ‘mean’ as ‘average’).” *Id.* (citing Ex. 1012, 4:64–5:27). We additionally credit Mr. Rosenblatt’s testimony that “[i]n Kincaid, CPU 410 performs the above analysis.” *Id.* ¶ 64 (citing Ex. 1012, 8:6–51, Fig. 4). Lastly, we credit Mr. Rosenblatt’s testimony that the “corresponding component in Laut, *i.e.*, CPU 221 of controller 220, would implement the analysis of Kincaid’s CPU 410” in the proposed combination under Ground 1. *Id.*

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Kincaid as relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 60–64. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [I] of claim 1.

11. Step [J]

Step [J] of claim 1 recites: “storing, by the processor, the obtained RMS value less than 1 as metadata for the new media.” Ex. 1001, 10:31–32.

Petitioner argues step [J] is taught by Kincaid. Pet 29 (citing Ex. 1012, 7:39–47, 7:53–56, 9:21–25; Ex. 1003 ¶¶ 67.

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Kincaid discloses that the normalization gain factor $G_{n,scaled}$ —less than 1, and obtained from the RMS value, as described for element [I]—is associated with the audio track as metadata.” Ex. 1003 ¶ 67 (citing Ex. 1012, 7:39–41, 9:21–25).

We also credit Mr. Rosenblatt’s testimony that the ‘normalization gain factor can belong to a normalization information tag, which can be incorporated into the audio file to form a ‘tagged’ audio file.” *Id.* (citing Ex. 1012, 7:41–47, 9:21–25). We further credit Mr. Rosenblatt’s testimony that the “tagged audio file can be stored in a music library and made available for playback.” *Id.* (citing Ex. 1012, 7:53–56). We further credit Mr. Rosenblatt’s testimony at this stage that the “POSITA would understand the audio file with its metadata to be stored by the processor as described for element [G].” *Id.*

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Kincaid as relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 67. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [J] of claim 1.

12. Step [K]

Step [K] of claim 1 recites: “providing, by the processor, the metadata for the new media over the Internet in response to the API call for display by the jukebox.” Ex. 1001, 10:33–35.

Petitioner argues step [K] is taught by Laut. Pet 29 (referring to the discussion of an API call in limitation [H]; citing Ex. 1011 ¶¶ 32, 74, Fig. 2A, Fig. 4C; Ex. 1003 ¶¶ 68.

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that Laut meets element [K] “as described for element [H].” Ex. 1003 ¶ 68. We also we credit Mr. Rosenblatt’s testimony that “Laut discloses that metadata such as the artist and song title is displayed on display 290 and/or display 210 of the jukebox via user interface 240.” *Id.* (citing Ex. 1011 ¶ 74, Fig. 4C). At this stage, we further credit Mr. Rosenblatt’s testimony that the “metadata is provided by the processor over the Internet at least because controller 220 provides the metadata to user interface 240 and display 210 by a wireless connection, such as WiFi, which the POSITA would understand to include a wireless Internet connection.” *Id.* (citing Ex.1011 ¶ 32, Fig. 2A).

Lastly, we credit Rosenblatt’s testimony that “Kincaid discloses that the audio file is ‘tagged’ with the normalization gain factor metadata, and the tagged file is downloaded to the audio playback device.” *Id.* ¶ 69 (citing Ex. 1012, 8:52–61, 9:21–33).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony as relied upon by Petitioner. *See* Ex. 1003 ¶ 68. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [K] of claim 1.

13. Step [L]

Step [L] of claim 1 recites: “receiving, by the processor, a request from the jukebox for playback of the new media associated with the displayed metadata.” Ex. 1001, 10:37–39.

For this step [L], the Petition states: “*See* elements [H] and [K].” Pet. 30 (citing Ex. 1003 ¶ 70). Petitioner further notes “[i]n Fig. 16, content is selected for playback at 1605 based on displayed metadata, and delivery of the content is requested at 1655.” *Id.* Petitioner argues this limitation is taught by Laut. Pet. 31 (citing Ex. 1011 ¶¶ 96–100, Fig. 16 (annotated); Ex. 1003 ¶ 70). Petitioner argues that “[t]he request is received by the processor via user interface 240, as described for element [H].” Pet. 31 (citing Ex. 1003 ¶ 71).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that Laut meets this element as described for elements [H] and [K].” Ex. 1003 ¶ 70. We also credit Mr. Rosenblatt’s testimony that with respect to Laut’s Fig. 16, “content is selected for playback at 1605 based on displayed metadata, and delivery of the content is requested at 1655.” *Id.* (citing Ex. 1011 ¶¶ 96–100, Fig. 16 (annotated)). We further credit Mr. Rosenblatt’s testimony that the “request is received by the processor via user interface 240, as described for element [H].” *Id.* ¶ 71.

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 70–71. Nonetheless, as noted previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [L] of claim 1.

14. Step [M]

Step [M] of claim 1 recites: “in response to the request, streaming by the processor the requested new media to the jukebox for playing audio

corresponding to the streamed portion of the new media.” Ex. 1001, 10:40–42.

For step [M], the Petition states: “*See* element [H].” Pet. 32–33 (citing Ex. 1011 ¶¶ 31, 78, 87, 96–101; Ex. 1003 ¶¶ 72–73). Petitioner argues: “The POSITA would understand the content to be streamed by the processor, which ‘includes processes for . . . playing content,’ such as content in the above streaming formats.” Pet. 33 (citing Ex. 1011 ¶¶ 30, 31; Ex. 1003 ¶ 73).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Laut meets this element as described for element [H]. For example, with respect to Figure 16, requested content is scheduled for playback via the jukebox at stage 1660.” Ex. 1003 ¶ 72 (citing Ex. 1011 ¶¶ 96–100, Fig. 16 (annotated)). We also credit Mr. Rosenblatt’s testimony that “[f]or playback, the content is converted to corresponding audio signals, which are transmitted through an audio output device of the jukebox (*e.g.*, amplifier and speakers).” Ex. 1003 ¶ 73 (citing Ex. 1011 ¶ 101). We further credit Mr. Rosenblatt’s testimony that “Laut discloses that content received by the jukebox can be received as a stream; and that the content is preferably provided in streaming formats including RA (Real Audio Streamed) and ASF (Windows Media File-Advanced Streaming Format).” *Id.* (citing Ex. 1011 ¶¶ 31, 78, 87).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 72–73. Nonetheless, as noted

previously, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [M] of claim 1.

15. Step [N]

Step [N] of claim 1 recites: “automatically calculating, by the processor, amounts earned by an artist and a venue playing the new media.” Ex. 1001, 10:43–44.

Petitioner argues step [N] is taught by Laut. Pet 33 (citing Ex. 1011 ¶¶ 63, 65, 80, 90, Fig. 8 (annotated); Ex. 1003 ¶¶ 74–75).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Laut discloses keeping track of which songs are downloaded ‘in order for the artists to be paid the royalties due to them.’” Ex. 1003 ¶ 74 (citing Ex. 1011 ¶ 80). We also credit Mr. Rosenblatt’s testimony that “Laut further discloses payment of artist royalties by ‘*automatic* money transfer to different accounts,’ which the POSITA would understand to require automatic calculation of amounts earned by the artist.” *Id.* We further credit Mr. Rosenblatt’s testimony that “Laut further discloses a user interface through which the user can select various options to adjust the fee due to the venue, with the jukebox automatically updating the fee in response to options selected.” *Id.* ¶ 75 (citing Ex. 1011 ¶ 65, Fig. 8 (annotated)).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 74–75.

Patent Owner does contend that the term “venue” of claim 1 step [N] means a “territory of use,” the term “processor” means a “server processor,” and the term “automatically calculating” means “requiring tallying play counts, not payments or reporting.” Prelim. Resp. 9. We decline, however, to adopt these constructions, because claim 1 is silent regarding the argued terms. Accordingly, based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [N] of claim 1

16. Step [O]

Step [O] of claim 1 recites: “receiving, by the processor, indication of payment of the amount earned.” Ex. 1001, 10:46–47.

Petitioner argues step [O] is taught by Laut. Pet 35–37 (citing Ex. 1011 ¶¶ 30, 32, 53, 54, 92, 98, Fig. 16 (annotated); Ex. 1003 ¶¶ 77–78).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Laut discloses the jukebox receiving and verifying payment, *e.g.*, via credit card, or as money placed in a money receiver.” Ex. 1003 ¶ 77 (citing Ex. 1011 ¶¶ 30, 32). We also credit Mr. Rosenblatt’s testimony that “Laut further discloses, as part of the playback process 1600 described above, ‘determin[ing] whether the correct fee is deposited/verified.’” *Id.* (citing Fig. 16 (annotated)). We further credit Mr. Rosenblatt’s testimony that Laut

discloses that “the jukebox system monitors ‘money collected,’ and ‘venue[s] that collected the most money, least money, etc.,’ thus indicating payments of amounts earned.” *Id.* ¶ 78 (citing Ex. 1011 ¶¶ 53, 54, 92).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Laut relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 77–78.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

We additionally decline to limit the step [O] language “receiving . . . indication of payment” to mean “the server processor receiving a digital acknowledgment (e.g., record entry, flag) that a tallied royalty obligation has been satisfied,” as argued by Patent Owner because such limitations are not recited in the challenged claim. Prelim. Resp. 6, 9.

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [O] of claim 1.

17. Step [P]

Step [P] of claim 1 recites: “wherein, the audio signals of the new media are normalized by the processor or jukebox by applying gain to the signals based on the obtained positive RMS value less than 1.” Ex. 1001, 10:48–51.

Petitioner argues step [P] is taught by Kincaid. Pet. 37 (citing Ex. 1012, 3:63–66, 8:2–5, 9:21–25:33; Ex. 1003 ¶ 79).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “Kincaid discloses storing a tagged audio file that includes the normalization gain factor metadata, as described above for elements [I] and [J].” Ex. 1003 ¶ 79 (citing Ex. 1012, 9:21–25). We also credit Mr. Rosenblatt’s testimony that “[o]n playback, the audio player (*i.e.*, the processor or jukebox) queries the tagged audio file for the normalization gain factor; and applies that gain factor to ‘normalize the loudness of the associated [audio] file (for either every sample or a selected number of samples).’” *Id.* (citing Ex. 1012, 3:63–66, 8:2–5, 9:25–33).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Kincaid as relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively dispute the portions of Mr. Rosenblatt’s testimony relied upon by Petitioner. *See* Ex. 1003 ¶ 79.

Patent Owner does contend that the term “processor” means a “server processor.” Prelim. Resp. 9. We decline, however, to adopt this construction, because claim 1 is silent regarding the argued term “server.”

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [P] of claim 1.

18. Step [Q]

Step [Q] of claim 1 recites: “wherein, the audio signals of the new media are further compressed for reducing a dynamic range of the signal

based on a preset compression ratio and a preset threshold value.” Ex. 1001, 10:52–55.

Petitioner argues step [Q] is taught by Bongiovi. Pet. 37 (citing Ex. 1013 ¶¶ 11, 14–20, 35, 52, 80, 131–138, Figs. 1, 10; Ex. 1003 ¶¶ 80–82).

Based upon our review of the record, we are persuaded by Petitioner’s position. Additionally, we credit Mr. Rosenblatt’s testimony that “[t]his element is met by Laut in view of Kincaid and Bongiovi. Bongiovi discloses using a processor to apply dynamic range compression to audio signals.” Ex. 1003 ¶ 80 (citing Ex. 1013 ¶¶ 11, 14–20, Fig. 1 (annotated)). We also credit Mr. Rosenblatt’s testimony that “Bongiovi’s compressors 104 and 108 are ‘designed to alter the dynamic range of a signal by reducing the ratio between the signal’s peak level and its average level.’” Ex. 1003 ¶ 81 (citing Ex. 1013 ¶ 80). We further credit Mr. Rosenblatt’s testimony that the “compression is ‘characterized’ by ‘the threshold, KT , and the ratio, r .” *Id.* We also credit Mr. Rosenblatt’s testimony that “once the audio signal’s level surpasses the threshold KT , the compressor decreases the level by the ratio r .” *Id.* (citing Ex. 1013 ¶¶ 80, 131–138, Fig. 10).

At this stage, we also credit Mr. Rosenblatt’s testimony that the “dynamic range of the audio signal is thus reduced by attenuating the signal’s highest levels (*i.e.*, those above the threshold KT) according to the ratio r . The POSITA would understand that these threshold and ratio values are inputs that must be preset in order for a processor to execute the compressor function.” *Id.* ¶ 82 (citing Ex. 1013 ¶¶ 51, 116–117, Fig. 1).

At this stage of the proceeding, Patent Owner does not substantively dispute Petitioner’s arguments regarding the specific paragraphs of Bongiovi as relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent

Owner substantively dispute the portions of Mr. Rosenblatt's testimony relied upon by Petitioner. *See* Ex. 1003 ¶¶ 80–82.

Based on the record at this stage of the proceeding, we preliminarily find Petitioner has shown that Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) collectively teach step [Q] of claim 1.

19. Conclusion for Independent Claim 1

Having considered the arguments and evidence presented by both the Petitioner and Patent Owner, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of independent claim 1 would have been obvious over Laud, Kincaid, and Bongiovi to a person of ordinary skill in the art at the critical time.

B. Challenged Claims 2–17

The Petition demonstrates there is a reasonable likelihood of prevailing in establishing the unpatentability of at least one challenged claim of the '925 patent.” Pet. 28 (citing Ex. 1003 ¶ 66 (quoting Ex. 1012, 1:56–59)); Pet. 41 (citing Ex. 1003 ¶ 85).

Accordingly, it is unnecessary for us to provide an assessment of remaining claims 2–17.

VIII. PRIORITY

Petitioner argues “the '925 patent as allowed and granted does not claim priority to any other application.” Pet. Reply 1 (citing Ex. 1001). As noted by Petitioner, the '925 patent does not include any priority claim on pages 1–2, or in the first page of its Specification. Ex. 1001, 1–2, 51.

Regarding a claim to the benefit of priority, our reviewing court has stated:

a patent's claims are not entitled to an earlier priority date merely because the patentee claims priority. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449 (Fed. Cir. 1986) (explaining that “the art must have existed as of the date of invention, presumed to be the filing date of the application until an earlier date is proved”); *see also In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995) (holding that a reference was properly considered prior art because the earlier filed application did not support the patent's claims, thereby precluding reliance on its earlier priority date). *Rather, for a patent's claims to be entitled to an earlier priority date, the patentee must demonstrate that the claims meet the requirements of 35 U.S.C. § 120.*

NTP, 654 F.3d at 1276 (emphasis added).

As further indicated by the court in *NTP*, the burden shifts to Patent Owner to demonstrate for *each* patent claim that *each* patent or application in the asserted chain of priority claims meet the requirements of 35 U.S.C. § 120.

Here, to assert a claim of priority, the Patent Owner must show that the '925 patent meets *each* of the multiple requirements articulated by the court in *NTP*, as pertaining to *each* of claims 1–17 before us in this IPR proceeding:

Under § 120, a patent is entitled to the priority date of an earlier filed application if:

- (1) the written description of the earlier filed application discloses the invention claimed in the later filed application sufficient to satisfy the requirements of § 112;
- (2) the applications have at least one common inventor;

(3) the later application is filed before the issuance or abandonment of the earlier filed application; and

(4) the later application contains a reference to the earlier filed application. In addition, if the later filed application claims priority through the heredity of a chain of applications, each application in the chain must satisfy § 112.

NTP, Inc., 654 F.3d at 1277 (Fed. Cir. 2011) (emphasis and formatting added) (citing *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997)).

In its Preliminary Response, Patent Owner argues that the “challenged ’925 patent [Ex. 1001] is a continuation of U.S. Application No. 11/744,**731**, which published as US 2008/0275942 A1 [Ex. 2002].” Prelim. Resp. 7 (emphasis added regarding the incorrect last three digits).

We note Patent Owner incorrectly lists the last three digits of the application number for the above-referenced patent application publication US 2008/0275942 A1. *Id.* It appears Patent Owner intended to refer to U.S. Application No. 11/744,**228** (emphasis added regarding the correct last three digits), which published as US 2008/0275942 A1 on Nov. 6, 2008, as reproduced in pertinent part below:

US 20080275942A1

(19) **United States**

(12) **Patent Application Publication**
Tijerino

(10) **Pub. No.: US 2008/0275942 A1**

(43) **Pub. Date: Nov. 6, 2008**

(54) **USER DEFINED INTERNET JUKEBOX
KIOSKS SET TOP BOX**

(76) Inventor: **Manuel Ignacio Tijerino,**
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(21) Appl. No.: **11/744,228**

(22) Filed: **May 4, 2007**

Publication Classification

(51) **Int. Cl.**
G06F 15/16 (2006.01)
H04N 7/16 (2006.01)
(52) **U.S. Cl.** **709/203; 725/2**

(57) **ABSTRACT**

A system such as an Internet Juke Box, Kiosk, or Set Top Box connected to the network which is database driven and tied to an on line internet site where local artist and musicians can create a profile which will allow them to upload their media, being images, music and videos, and later go to an establishment that has this system and play it. The system will have the ability to expose local musicians to the masses and earn them money.

Shown above, Application No. 11/744,228, which published as US Pub. No. 2008/0275942 A1 on Nov. 6, 2008.

Patent Owner seeks the benefit of the May 4, 2007, filing date of Application No. 11/744,228, with respect to the '925 patent. We note the official USPTO electronic file record for Application No. 11/744,228 indicates that this application was abandoned on September 8, 2010, for failure to respond to an office action. The '925 patent was filed on July 27, 2010, before the September 8, 2010, date of the abandonment of parent application No. 11/744,228.

Therefore, at this stage, we preliminarily find Patent Owner has satisfied requirements 2 and 3 under 35 U.S.C. § 120, showing that the applications have at least one common inventor and that the later application was filed before the issuance or abandonment of the earlier filed application. Patent Owner, however, has failed to meet requirements 1 and 4.

Specifically, Patent Owner has not shown: (1) the written description of the earlier filed application discloses the invention claimed in the later

filed application sufficient to satisfy the requirements of § 112, or (4) the later application contains a reference to the earlier filed application.

See NTP, Inc., 654 F.3d at 1277 (Fed. Cir. 2011).

Patent Owner contends: “Under 35 U.S.C. § 120, a continuation ‘shall have the same effect, as to such invention, as though filed on the date of the prior application’ if it contains a specific reference and at least one inventor in common.” Prelim. Resp. 7. Patent Owner further contends that “[t]he ’925 patent properly claims priority to its parent and shares the same disclosure, so all priority rights automatically carry through. No additional showing is required; continuation priority is automatic by statute.” *Id.* (citing *Transco Prods. v. Performance Contracting*, 38 F.3d 551, 556 (Fed. Cir. 1994) (“[T]he disclosure of the parent is effectively incorporated into the continuation as if it were explicitly repeated.”)). Prelim. Resp. 7.

Below, we reproduce Patent Application Publication U.S. No. 2011/0029417 A1, which corresponds to the same application No. 12/804,665 of the ’925 patent:

US 20110029417A1

(19) **United States**

(12) **Patent Application Publication**
Tijerino

(10) **Pub. No.: US 2011/0029417 A1**

(43) **Pub. Date: Feb. 3, 2011**

(54) **USER DEFINED INTERNET JUKEBOX
KIOSKS SET TOP BOX**

Publication Classification

(76) Inventor: **Manuel Ignacio Tijerino, Slidell,
LA (US)**

(51) **Int. Cl.**
G06Q 30/00 (2006.01)

(52) **U.S. Cl. 705/30**

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(57) **ABSTRACT**

A computer readable storage method and system allowing any artist to upload media, including images, video and music, to a server, have that media uploaded in a system of internet jukeboxes placed in establishments for instant playback of media by paying customers. The system of internet jukeboxes programmed to maintain an account for the artist allowing the artist to earn fees and royalties from playback of the media and to provide for automated payment of rent, and other fees due the establishment and the service provider.

(21) Appl. No.: **12/804,665**

(22) Filed: **Jul. 27, 2010**

Related U.S. Application Data

(63) Continuation-in-part of application No. 11/744,228, filed on May 4, 2007, now abandoned.

As shown above, Patent Application Publication US No. 2011/0029417 A1 (corresponding to application No. 12/804,665 of the '925 patent) indicates at code (63) that it is a "Continuation-in-part of application No. 11/744,228, filed on May 4, 2007, now abandoned."

A review of the electronic official record of the '925 patent file indicates that application No. 12/804,665 contains a Filing Receipt (entered on October 25, 2010) that lists the following claim for domestic priority:

Domestic Priority data as claimed by applicant

This application is a CIP of 11/744,228 05/04/2007 ABN

An identical claim for domestic priority to application No. 11/744,228 appears on an earlier Filing Receipt (entered on Augst 16, 2010) in the official electronic record for application No. 12/804,665.

Thus, Patent Owner filed prior application No. 11/744,228 on May 4, 2007 (corresponding to U.S. Pat. Pub. No. 2008/0275942 A1). This application was abandoned on September 8, 2010 (applicant was notified in a Notice of Abandonment that was sent due to failure to respond to an office action), after the July 27, 2010, filing date of the '925 patent.⁷

Thus, upon first inspection it would seem the '925 patent is a Continuation-In-Part (CIP) of prior application 11/744,228 (corresponding to U.S. Pat. Pub. No. 2008/0275942 A1, now abandoned).

It would appear initially that if Patent Owner can show that written description support under pre-AIA 35 U.S.C. 112, first paragraph, is found in prior (parent) application No. 11/744,228, Patent Owner may be able to assert a priority date of May 4, 2007, by showing the subject matter claimed in the '925 patent is supported in the earlier 11/744,228 application on a claim-by-claim basis.

But Petitioner argues that “[i]n correspondence to the Board, Patent Owner asserted that he ‘did not disclaim or revoke the domestic-benefit claim’ to the '228 application.” Pet. Reply 3 (citing Ex. 1027, 1–2). Petitioner asserts that the “record contradicts that assertion: Patent Owner’s deletion of its initial priority claim was clear and deliberate.” *Id.* (citing Ex. 1002, 316 (“Applicant has deleted the claim of priority to Application [N]o. 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-

⁷ We find Petitioner’s assertion that “the original priority claim was improper because the '925 patent was filed *after* Patent Owner abandoned the '228 application” is unsupported by objective evidence in the record. Pet. Reply 2 (emphasis added).

part of application Serial No. 11/744,228, filed May 4, 2007”)). Petitioner argues that “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.” *Id.* (citing Ex. 1002, 448–49).

We reproduce below Exhibit 1002, at page 316, which appears to show intentional waiver by Patent Owner to any claim of domestic priority for the ’925 patent, as argued by Petitioner on page 3 of its Reply:

LETTER TO CORRECT FILING RECEIPT

Office of Initial Patent Examination's
Filing Receipt Corrections
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Post Office Box 29001
Glendale, CA 91209-9001
September 2, 2014

Commissioner:

Under "Domestic Priority data as claimed by applicant", please correct the Filing Receipt as follows:

This application is a CIP of 11/744,228 05/04/2007-None

Applicant is filing concurrently herewith a marked-up Filing Receipt to reflect the above change.

Shown above, Exhibit 1002 at page 316, which appears to show that Patent Owner’s claim to domestic priority was intentionally waived.

Moreover, based upon our review of the official record, the last Filing Receipt (entered on June 15, 2015) in the ’925 official patent application file reveals that no Application Data Sheet was ever entered into the official record of the ’925 patent to perfect the claim for Domestic Priority, and also comply with the provisions of pre-AIA 37 C.F.R. §§ 1.76, 1.78, as follows:

The text from the last Filing Receipt (entered on June 15, 2015) is reproduced below:

Domestic Applications for which benefit is claimed - None.

A proper domestic benefit claim must be provided in an Application Data Sheet in order to constitute a claim for domestic benefit. See 37 CFR 1.76 and 1.78.

Therefore, at this preliminary stage, it appears that Petitioner may be able to show that Patent Owner is not entitled to any claim of priority to his earlier filed prior application No. 11/744,228, which was filed on May 4, 2007 (corresponding to Pat. Pub. US 2008/0275942 A1). The image from the last Filing Receipt (entered on June 15, 2015) is reproduced below:

Inventor(s)

Manuel Ignacio Tijerino, Slidell, LA;

Applicant(s)

Manuel Ignacio Tijerino, Slidell, LA;

Power of Attorney: The patent practitioners associated with Customer Number 23363

Domestic Applications for which benefit is claimed - None.

A proper domestic benefit claim must be provided in an Application Data Sheet in order to constitute a claim for domestic benefit. See 37 CFR 1.76 and 1.78.

Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.) - None.

Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

The image from the last Filing Receipt (entered on June 15, 2015) is reproduced above.

Accordingly, based on the current record, we are persuaded by Patent Owner that official USPTO records control. PO Sur-reply 1. However, a review of the official record indicates that Patent Owner *has not filed a proper domestic benefit claim by filing an Application Data Sheet in order to constitute a claim for domestic benefit. See Pre-AIA 37 C.F.R.*

§§ 1.76(b)(5), 1.78; *see also* MPEP § 601.05 (“Application Data Sheet (ADS)”).

Although Patent Owner asserts that the CIP “notation is generated automatically by the USPTO Publication Branch from the Application Data Sheet (ADS) then on file and accepted” (PO Sur-reply 2), a review of the official record indicates that Patent Owner appears to have never filed such an ADS in application No. 12/804,665, now the ’925 patent.

We note, however, Patent Owner’s counter argument that “[t]he phrase ‘Applicant has deleted the claim of priority . . .’ merely reflects a correction to the ADS label ‘CIP’ for receipt accuracy; it was **never a statutory disclaimer** of domestic benefit.” PO Sur-reply 3.

Petitioner’s understanding of the prosecution history differs from Patent Owner’s account: “When the ’925 patent was filed on July 27, 2010, it initially claimed priority to the ’228 application as a continuation-in-part.” Pet. Reply 2 (citing Ex. 1002, 77). Petitioner explains 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.’” *Id.* (citing Ex. 1002, 273).

Petitioner further asserts that “Patent Owner responded by deleting the priority claim, and by amending the specification to remove its sole reference to the ’228 application.” *Id.* (citing Ex. 1002, 306, 311, 316).

As cited by Petitioner (*id.*), we reproduce Exhibit 1002 at page 316 below (Reply to Office Action of May 2, 2014):

The Examiner notes that the disclosure of the prior-filed application, Application No. 11/744,228 fails to provide adequate support or enablement for the claimed invention in the instant application. Accordingly, Applicant has deleted the claim of priority to Application no. 11/744,228. Entry of the

amendment is respectfully requested.

Petitioner contends the “USPTO accordingly issued a Corrected Filing Receipt, reflecting the deletion, and the patent issued without any priority claim reflected.” *Id.* (citing Ex. 1002, 448; Ex. 1001).

Because substantive changes to an issued patent cannot be made with a Certificate of Correction,⁸ and because the two-year time limit on the filing of a reissue application has passed,⁹ it appears Patent Owner has forfeited the right to file such an ADS due to: (1) lack of a timely response, and (2) the prosecution history discussed above, which indicates an intentional deletion (i.e., waiver) of the claim of domestic priority. *See* Exhibit 1002, 316 (Reply to Office Action of May 2, 2014) (“Accordingly, Applicant has deleted the claim of priority to Application No. 11/744,228. Entry of the amendment is respectfully requested.”).

We leave it to the parties to further develop the waiver or forfeiture issues during trial with respect to the guidance found in MPEP § 211.03 (“Time Period for Making a Claim for Benefit Under 37 CFR 1.78”), and by citing to any case authorities the parties find to be controlling and on point.

In the event Patent Owner still has a path available to perfect its claim of domestic priority, we emphasize that Petitioner correctly points out that “[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. *See* Pet. Reply 5 (citing *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 906 (Fed. Cir. 2018)).

⁸ *See* MPEP § 1481.

⁹ *See* Pre-AIA 35 U.S.C. 251; MPEP § 1410.

We additionally note that it appears Patent Owner may be asserting an earlier domestic priority date for claim construction purposes only, and not to antedate any of the references cited by Petitioner under Ground 1 or Ground 2. If this is not the case, during trial Patent Owner should specify which reference(s) it seeks to antedate with the earlier filing date of May 4, 2007 of patent application publication US 2008/0275942 A1.

Based on the record before us, and at this preliminary stage, we find a preponderance of the evidence supports Petitioner’s assertion that “[t]he challenged claims are thus not entitled to any priority date before the July 27, 2010 filing [date of the ’925 patent].” *Id.*

IX. CONCLUSION

After considering the arguments presented in the Petition, the Preliminary Response, and the current evidence of record, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least claim 1 of the ’925 patent is unpatentable as obvious over the collective teachings of Laut, Kincaid, and Bongiovi.

Accordingly, we institute an *inter partes* review of *all* challenged claims 1–17 on *all grounds* 1 and 2 set forth in the Petition. *See* 37 C.F.R. § 42.108(a).

Our determinations at this stage of the proceeding are based upon the evidentiary record currently before us. This decision to institute trial is not a final decision as to the patentability of any claim for which we have instituted an *inter partes* review. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a [P]etitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of

the evidence at trial”). We will base any final decision on the full record developed during trial.

X. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 1–17 of the ’925 patent on the unpatentability grounds asserted 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, which commences on the entry date of this decision.

IPR2025-01280
Patent 9,146,925 B2

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