

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 No. 9,146,925

PATENT OWNER RESPONSE

I. INTRODUCTION

Petitioner's obviousness theory does not rest on any single prior art reference disclosing the claimed invention. Instead, it depends on assembling disparate teachings from Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013)—each of which addresses a different system, operates at a different stage, and fails to disclose critical limitations of the claims.

Laut is directed to a venue-based, jukebox-style system centered on user interaction and playback selection, not a server-side ingestion architecture. Kincaid is cited only through fragmented excerpts drawn from unrelated portions of its specification, rather than any coherent embodiment. Bongiovi, in turn, is limited to audio signal processing techniques applied during playback and does not disclose a system architecture for ingesting, analyzing, and managing new media. None of these references—individually or collectively—describe a system that receives new media at a server, performs automated analysis at ingestion, generates and stores metadata, and uses that metadata in subsequent network-based distribution.

The Petition attempts to bridge these gaps by extracting isolated features from each reference and recombining them into a unified system that no reference discloses. That approach is not a proper obviousness analysis; it is a hindsight-driven reconstruction of the claimed invention, requiring fundamental modifications to each reference and supplying missing elements through post hoc reasoning rather than prior art teachings.

The Board’s institution decision was expressly made on a threshold record and did not resolve claim scope, architectural location, or priority. (Paper 10 at 2, 14, 56–57.) Those issues are now fully developed and confirm that Petitioner’s theory rests on improper architectural assumptions and mischaracterization of the claimed server-side system.

Because Petitioner fails to identify a single reference—or a permissible combination of references—that discloses the claimed automated, server-side ingestion and metadata pipeline, the asserted grounds of unpatentability cannot be sustained.

II. THE INTRINSIC RECORD CONFIRMS THE SERVER-SIDE INVENTION

The intrinsic record consistently describes a Web-based, server-mediated media distribution architecture in which media is uploaded to a central system that manages storage, metadata, availability, and playback across network-connected clients. Ex. 1001 ¶¶[0007]–[0008], [0068]–[0070].

During prosecution, the Examiner expressly recognized that the application disclosed two distinct inventions:

- (1) **Invention I** — graphical user-interface functionality allowing artists to control and promote media; and
- (2) **Invention II** — a central server system that streams media to client devices in response to requests.

Ex. 1002 at 228–229 (Notice of Non-Responsive Amendment).

The Examiner further determined that these were “separate, independently functioning sub-combinations,” each requiring distinct prior-art searches under restriction practice.

Id. This determination confirms that the Office understood the disclosure to include both client-interface functionality and a separate, server-side streaming architecture.

Consistent with that framework, the claims were prosecuted along the server-side architecture identified as **Invention II**. That invention does not require a venue-based system, nor does it require a user-interface implementation of the type described in Invention I. Rather, the claims are directed to a system in which a processor receives media, performs analysis, stores associated data, and responds to client requests over a network.

The prosecution history further confirms this scope. During amendment, claim language associated with venue-based and jukebox-specific implementations was expressly removed. See Ex. 1002 at 260–261 (amendments striking references to “jukeboxes in establishments,” “jukeboxes in venues,” and “customers on jukeboxes in establishments,” among other terms). These amendments reflect a narrowing away from venue-based embodiments and toward a system-level, network-based architecture.

The intrinsic record also reflects that the claimed system operates on **new media**—that is, media not previously stored in the system—and requires processing at the time of ingestion. See Ex. 1002 at 392. This includes automated analysis and storage of associated data at the server, which is then used in subsequent distribution and playback.

The Examiner's search and rejection history further reinforces this understanding.

Throughout multiple Office Actions, the Examiner evaluated prior art directed to network-based media systems, including server-side storage, metadata handling, and distribution over wide-area networks. See, e.g., Ex. 1002 at 272–289. The prior art applied during prosecution reflects systems involving server-based ingestion, storage, and transmission—not venue-bound playback devices as such.

Taken together, the specification, restriction requirement, claim amendments, and prosecution history consistently establish that the claimed invention is directed to a **server-side system** that (i) receives media, (ii) performs automated analysis at ingestion, (iii) stores associated data, and (iv) responds to network-based requests using that data.

III. THE ASSERTED COMBINATION FAILS TO DISCLOSE THE CLAIMED SERVER-SIDE SYSTEM

Petitioner bears the burden to prove unpatentability with particularity, and that burden never shifts to Patent Owner. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); Paper 10 at 15. To meet this burden, Petitioner must identify where each claim limitation is disclosed, provide an articulated motivation to combine, and demonstrate a reasonable expectation of success. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The Board must also guard against hindsight reconstruction and require a rational underpinning grounded in the prior art. *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016); Paper 10 at 16–17. Where, as here, the claims recite a

cohesive, system-level architecture, Petitioner must show that the prior art teaches that architecture as a whole—not merely isolated features drawn from unrelated systems.

Petitioner fails to meet that burden.

Petitioner’s proposed combination of Laut (Ex. 1011), Kincaid (Ex. 1012), and Bongiovi (Ex. 1013) does not disclose the claimed system—either individually or in any permissible combination—because the references are directed to materially different architectures, operate at different loci and stages, and do not teach a server-side ingestion and metadata pipeline.

Laut is directed to a venue-based, user-facing jukebox system centered on client-side interaction and playback selection. Kincaid is cited through isolated excerpts and figures drawn from disparate portions of its specification, rather than any single coherent embodiment. Bongiovi is limited to audio signal processing applied during playback and does not disclose a system architecture for ingesting, analyzing, or managing media at a server. As reflected in the citation record, Petitioner relies on fragmented citations (e.g., Ex. 1013 ¶¶ 11, 14–20, 52, 80, 131–138, Fig. 1, Fig. 10) drawn from non-unified portions of Bongiovi, rather than any disclosure of a structured ingestion pipeline.

Critically, none of the cited references describes a system that (i) receives new media at a server, (ii) performs automated analysis at ingestion, (iii) generates and stores metadata, and (iv) uses that metadata in subsequent network-based distribution.

Petitioner instead reconstructs the claimed invention by extracting isolated features from

each reference and recombining them across incompatible architectures—client-side jukebox control (Laut), fragmented disclosures (Kincaid), and playback-stage processing (Bongiovi).

That reconstruction is inconsistent with the intrinsic record. As reflected in the October 28, 2013 Notice of Non-Responsive Amendment (Ex. 1002 at 228–229), the Examiner distinguished between two separate inventions: (Invention I) graphical user-interface functionality, and (Invention II) a central server streaming system. The Examiner determined that these were “separate, independently functioning sub-combinations” requiring distinct prior-art searches under restriction practice. This contemporaneous classification confirms that the claimed invention is directed to a server-centric system, not a venue-based jukebox implementation.

Petitioner’s theory disregards that framework. It treats Laut’s venue-based system as interchangeable with a server-side streaming architecture and relies on Bongiovi’s playback-stage processing to supply limitations tied to ingestion-stage functionality.

Nothing in the cited references suggests such a combination, nor does Petitioner identify any teaching or rationale that would have led a person of ordinary skill to modify these systems in the manner required.

Accordingly, the asserted combination is not a permissible synthesis of prior art, but an impermissible hindsight reconstruction of the claimed invention, assembled with knowledge of the claims and unsupported by the disclosures of the references themselves.

IV. CLAIM CONSTRUCTION (PHILLIPS STANDARD)

A. Applicable Standard

The Board applies the same claim construction standard as a district court, i.e., **Phillips** (Paper 10 at 13–14).

B. Proposed Constructions (Phillips-framed; same substance)

Patent Owner proposes the following constructions under Phillips, based on the intrinsic record and ordinary meaning as understood by a POSITA:

- **Processor** = server-side processor
- **Venue** = territory of use
- **Automatically calculating** = tracking/tallying (accrual), not payment execution
- **Receiving indication of payment** = system acknowledgment/record of payment status, not cash handling or disbursement execution
- **Real-time** = system-controlled execution (immediate or scheduled within system control), not “instantaneous playback only”

Key clarification: The Board declined to consider Patent Owner’s proposed constructions **solely because they were presented under BRI**, not because of any substantive defect under Phillips. (Paper 10 at 14.) Patent Owner reasserts the same constructions here under the correct standard.

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

A. Rationale to Combine Laut with Kincaid

At the time of institution, the Board summarized Petitioner's position that a person of ordinary skill would have been motivated to combine Laut and Kincaid based on perceived differences in loudness across audio tracks and the desire to improve listener experience. That preliminary assessment, however, was made on a limited record and does not withstand scrutiny in view of the full record and the requirements of the challenged claims.

Petitioner at Pet 27 Summarizes the prosecution history, stating that the '925 prosecution history was rejected multiple times over prior art related to digital jukeboxes and media distribution and was eventually allowed after amendments adding limitations related to RMS-based audio normalization and compression parameters.

Petitioner at Pet. 27 (citing Ex. 1011 ¶ 48, Fig. 4C; Ex. 1003 ¶ 65) asserting 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 relies on Laut ¶73 to satisfy limitation [E]. That reliance is misplaced. Laut ¶73 describes a user logging into a website to upload content for playback at networked

jukeboxes. However, it does not disclose “providing, by the processor, a user interface to add the new media to the system” as claimed. The cited passage does not identify a processor that provides the interface as part of the claimed system, nor does it describe adding media to the system itself. Instead, Laut describes transmitting uploaded content to a third party for rating, followed by distribution to jukebox systems.

Laut ¶73 also fails to disclose that the media is “new if not previously stored in the system.” The passage contains no discussion of determining whether uploaded content is already stored, nor any mechanism for identifying or handling “new media” as required by the claims. Accordingly, Laut ¶73 does not disclose limitation [E].

Petitioner’s asserted rationale to combine Laut with Kincaid likewise fails. Petitioner contends that differences in perceived loudness across tracks would motivate a person of ordinary skill to normalize audio to improve listener experience. Pet. 27–28 (citing Ex. 1012, 1:35–43; Ex. 1003 ¶ 65). That rationale, however, is directed entirely to **playback-stage concerns**—i.e., how audio is perceived during playback at a jukebox. Kincaid itself addresses manual volume adjustment during playback and the desire for consistent perceived loudness. Ex. 1012, 1:35–43.

The challenged claims require something fundamentally different: **server-side processing at the time of ingestion of new media**, including automated analysis and storage of derived metadata for subsequent use in network-based distribution. As established in Section II, the claimed operations occur at the server and at ingestion—not during playback.

Petitioner's rationale does not address that requirement. It does not identify any reason to modify Laut to perform **automated ingestion-time processing at a server**, nor to generate and store metadata as required by the claims. Instead, it relies on general statements about improving playback experience in a venue environment.

Accordingly, Petitioner's asserted rationale—focused on playback-stage loudness consistency—does not provide a basis to combine Laut and Kincaid to arrive at the claimed server-side ingestion and metadata system.

B. Patent Owners Reply

Patent Owner addresses Petitioner's asserted rationale above in Section V.A. To the extent the Board noted that Patent Owner did not substantively address this issue at the preliminary stage, the institution decision was made on a preliminary record at the time of institution. The issue is now addressed on a fully developed record.

C. The Board's Preliminary Analysis Does Not Establish a Proper Rationale to Combine

At the time of institution, the Board found Petitioner's asserted rationale sufficient based on the disclosures of Laut and Kincaid and the testimony of Mr. Rosenblatt. That finding, however, was made on a preliminary record and does not withstand scrutiny in view of the full record and the requirements of the challenged claims.

The asserted rationale is directed to a **playback-stage problem**—namely, differences in perceived loudness between audio tracks and the desire to provide a consistent listening

experience. Pet. 27 (citing Ex. 1012, 1:35–43; Ex. 1003 ¶ 65). Kincaid likewise addresses normalization of perceived loudness during playback. Ex. 1012, 1:35–43. Mr. Rosenblatt’s testimony similarly relies on improving listener experience and increasing jukebox usage. Ex. 1003 ¶ 65.

That rationale, however, does not address the claimed invention.

As established in Section II, the challenged claims are directed to a **server-side system that processes new media at the time of ingestion**, including automated analysis and storage of derived metadata for subsequent use in network-based distribution. The claimed functionality occurs at the server and at ingestion—not during playback at a jukebox.

Petitioner’s rationale—and the testimony on which the Board relied—does not identify any reason why a person of ordinary skill would modify Laut to perform **automated ingestion-time processing at a server**, nor does it explain how playback-stage loudness concerns would lead to the claimed ingestion and metadata pipeline. Instead, it assumes that a problem arising during playback can be addressed by modifying a fundamentally different stage of the system.

Moreover, the cited portions of Laut confirm that it is directed to a **venue-based jukebox system**, where music is selected and played locally, and where system objectives include playback, payment, and usage tracking. Ex. 1011 ¶¶4, 6. These disclosures reinforce that Laut operates at the playback stage and at the venue—not at

the server-side ingestion stage required by the claims.

Accordingly, even accepting the existence of a loudness-related problem in jukebox playback, Petitioner's asserted rationale does not provide a reason to arrive at the claimed server-side ingestion and analysis system. The Board's preliminary conclusion, based on that rationale, therefore does not support a finding of obviousness on the full record.

D. Reasonable Expectation of Success in Modifying Laut with Kincaid

At the time of institution, the Board summarized Petitioner's position that a person of ordinary skill would have had a reasonable expectation of success based on the alleged similarity of components between Laut and Kincaid, including processors, memory, network interfaces, and audio formats, as well as Kincaid's detailed description of its normalization techniques. That preliminary assessment, however, was made on a limited record and does not withstand scrutiny in view of the full record and the requirements of the challenged claims. The Board Mentioned That:

Petitioner asserts that a person of ordinary skill would have had a reasonable expectation of success in combining Laut and Kincaid because Kincaid's techniques can be implemented on general-purpose computing devices, and Laut includes a processor. Pet. 28 (citing Ex. 1012, 1:56–59; Ex. 1003 ¶ 66). Petitioner further contends that Kincaid's CPU 410 corresponds to Laut's CPU 221, and that the analysis could be implemented accordingly. Ex. 1003 ¶ 64.

That showing is insufficient.

Kincaid's Figure 4 describes a **generic computer system**, including CPU, memory, storage, and input/output devices. Ex. 1012, 8:6–51, Fig. 4. Such disclosures merely demonstrate that audio processing may be performed on a computing device. They do not describe the claimed system architecture, nor do they address how the claimed ingestion, analysis, storage, and distribution pipeline would be implemented.

Petitioner's reasoning therefore reduces to the assertion that because Laut includes a processor, it could perform Kincaid's analysis. That is not sufficient to establish a reasonable expectation of success. Petitioner does not identify where the claimed ingestion-time processing would occur, how new media would be analyzed upon receipt, how metadata would be generated and stored, or how such data would be used in subsequent network-based distribution.

Moreover, Kincaid's analysis is directed to **playback-stage normalization**, whereas the claims require **server-side processing at the time of ingestion of new media**.

Petitioner does not explain how or why a person of ordinary skill would modify Laut to shift processing from playback to ingestion, nor how such a modification would be implemented within Laut's system.

Accordingly, Petitioner has not demonstrated a reasonable expectation of success in combining Laut and Kincaid to achieve the claimed invention.

Petitioner asserts that a person of ordinary skill would have had a reasonable expectation

of success in combining Laut and Kincaid because both systems include processors, memory, storage, network interfaces, and support common audio formats such as MP3. Pet. 28 (citing Ex. 1011 ¶¶29–31, 87; Ex. 1012, 1:25–47, 8:52–64; Ex. 1003 ¶ 66). Petitioner further contends that Kincaid’s CPU 410 is analogous to Laut’s CPU 221 and could implement Kincaid’s analysis. Id. (citing Ex. 1012, 9:6–51, Fig. 4; Ex. 1011 ¶¶29–30).

That showing is insufficient.

Kincaid’s Figure 4 describes a **generic computer system**, including a CPU, memory, storage, and input/output devices. Ex. 1012, 8:6–51, Fig. 4. Such disclosures merely demonstrate that audio processing can be performed on a computing device. They do not describe the claimed system architecture, nor do they address how the claimed ingestion, analysis, storage, and distribution pipeline would be implemented.

Petitioner’s reasoning reduces to the assertion that because Laut includes a processor and conventional computing components, it could perform Kincaid’s analysis. That is not sufficient to establish a reasonable expectation of success. The presence of generic computing elements—such as CPUs, memory, network interfaces, and support for MP3 files—does not demonstrate that a person of ordinary skill would expect to successfully implement the claimed system.

Petitioner does not identify where the claimed **ingestion-time processing** would occur, how new media would be analyzed upon receipt, how metadata would be generated and

stored, or how such data would be used in subsequent network-based distribution. Nor does Petitioner explain how or why Kincaid's **playback-stage normalization process** would be integrated into Laut's system at the time of ingestion.

Accordingly, Petitioner has not demonstrated a reasonable expectation of success in combining Laut and Kincaid to achieve the claimed server-side ingestion and analysis system.

Petitioner further asserts that Laut and Kincaid are "easily combined based on familiar components," and that Kincaid's detailed description of its normalization techniques minimizes any guesswork required of a person of ordinary skill. Pet. 28 (citing Ex. 1003 ¶ 66; Ex. 1012, 4:24–5:32).

That reasoning is insufficient.

The assertion that two systems are "easily combined" based on familiar components is conclusory and does not establish a reasonable expectation of success. The presence of common computing elements—such as processors, memory, and network interfaces—does not demonstrate that a person of ordinary skill would expect to successfully implement the claimed system architecture.

Nor does Kincaid's detailed description of its normalization algorithm cure this deficiency. While Kincaid describes how perceptual loudness may be calculated using frequency-domain analysis and weighting functions, those disclosures relate only to the **method of normalization itself**. They do not address where such processing would

occur within a system, when it would be performed, or how it would be integrated into a broader architecture.

Petitioner does not explain how Kincaid's playback-oriented normalization process would be incorporated into Laut's system to perform **automated analysis at the time of ingestion of new media**, nor how the resulting data would be generated, stored, and used as required by the claims. The existence of a detailed algorithm does not establish a reasonable expectation of successfully implementing a different system architecture.

Accordingly, Petitioner's reliance on "familiar components" and algorithmic detail does not demonstrate a reasonable expectation of success.

E. Patent Owner's Response

Patent Owner did not address Petitioner's reasonable-expectation-of-success arguments at the preliminary stage. However, the Board's institution decision was made on a preliminary record at the time of institution, and the issue is now addressed on a fully developed record. As set forth in Section D, Petitioner has not demonstrated a reasonable expectation of success in combining Laut and Kincaid to achieve the claimed invention.

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

At the time of institution, the Board found Petitioner's showing sufficient to support a reasonable expectation of success based on the asserted similarity of components and the

alleged general applicability of Kincaid’s techniques to computing devices, including multimedia asset players. That preliminary assessment, however, was made on a limited record and does not withstand scrutiny in view of the full record and the requirements of the challenged claims.

The cited statement—that Kincaid’s techniques may be implemented in “any number and type of devices where computational resources are limited such as multimedia asset players” (Ex. 1012, 1:56–59)—addresses only the **generality of computing environments** in which audio normalization may be performed. It does not address the claimed system architecture, nor does it demonstrate that a person of ordinary skill would expect to successfully implement the claimed functionality within Laut.

As explained in Section D, Petitioner’s reliance on “familiar components” and generalized applicability does not establish a reasonable expectation of success. The cited disclosures show only that audio processing can be executed on a computing device—not that the claimed **server-side ingestion, analysis, storage, and distribution pipeline** would be successfully implemented. Petitioner does not identify where the claimed ingestion-time processing would occur, how new media would be analyzed upon receipt, or how metadata would be generated and used in subsequent network-based distribution.

Accordingly, the Board’s preliminary conclusion—based on generalized device compatibility and component similarity—does not support a finding that Petitioner has demonstrated a reasonable expectation of success on the full record.

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

A. Rationale to Combine Laut and Kincaid with Bongiovi

At the time of institution, the Board summarized Petitioner's position that a person of ordinary skill would have been motivated to combine Laut and Kincaid with Bongiovi to improve audio quality in high-noise environments using dynamic range compression and related signal processing techniques. That preliminary assessment, however, was made on a limited record and does not withstand scrutiny in view of the full record and the requirements of the challenged claims.

Petitioner's asserted rationale fails for the same reason as the Laut–Kincaid combination: it is directed entirely to **playback-stage audio processing**, not the claimed invention.

Petitioner relies on Bongiovi's disclosure of dynamic range compression and related signal processing techniques to improve perceived audio quality in high-noise environments such as bars and clubs. Pet. 40 (citing Ex. 1013 ¶¶ 14–20, 17). Those disclosures describe **manipulation of an audio signal during playback**, including gain adjustment, filtering, compression, and equalization to produce a “constant output level of rich, full sound.” Ex. 1013 ¶¶ 14–20, Fig. 1.

That is the wrong stage of operation.

The challenged claims require **server-side processing at the time of ingestion of new media**, including automated analysis, generation of metadata, and storage of that metadata for use in subsequent network-based distribution. As established in Section II, the claimed system operates at ingestion—not during playback at a venue.

Petitioner’s rationale does not address that requirement. It does not identify any reason why a person of ordinary skill would modify Laut to perform **automated ingestion-time analysis at a server**, nor does it explain how Bongiovi’s playback-stage compression pipeline would be integrated into a system that analyzes media upon receipt and stores derived metadata for later use.

Instead, Petitioner relies on general statements about improving sound quality in noisy environments and combines those with Kincaid’s playback-stage normalization. This results in a system directed to **playback enhancement**, not the claimed **ingestion and metadata pipeline**.

Moreover, Petitioner’s reliance on Kincaid’s reference to “peak limiting” does not bridge that gap. Ex. 1012, 4:15–19. That disclosure concerns additional signal processing during playback and does not suggest modifying a system to perform analysis at the time of ingestion or to generate and store metadata as required by the claims.

Accordingly, Petitioner’s asserted rationale—focused on playback-stage compression and loudness enhancement—does not provide a basis to combine Laut, Kincaid, and

Bongiovi to arrive at the claimed server-side ingestion and distribution system.

B. Patent Owner's Response

Patent Owner did not address Petitioner's rationale to combine Laut, Kincaid, and Bongiovi at the preliminary stage. However, the Board's institution decision was made on a preliminary record at the time of institution, and the issue is now addressed on a fully developed record. As set forth in Section VI.A, Petitioner has not demonstrated a sufficient rationale to combine Laut, Kincaid, and Bongiovi to arrive at the claimed invention.

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

At the time of institution, the Board found Petitioner's rationale sufficient to show that a person of ordinary skill would have been motivated to combine Laut, Kincaid, and Bongiovi to improve audio quality in high-noise environments. That preliminary assessment, however, was made on a limited record and does not withstand scrutiny in view of the full record and the requirements of the challenged claims.

The Board's analysis relies on disclosures directed to **venue-based playback conditions** and **audio signal processing during playback**, including Laut's placement of jukebox systems in bars and restaurants (Ex. 1011 ¶¶ 17, 29, 101) and Bongiovi's dynamic range compression techniques for improving perceived sound quality in noisy environments

(Ex. 1013 ¶¶ 14–20). Those disclosures, however, are directed to **playback-stage audio enhancement**, not the claimed invention.

Laut’s cited disclosures concern **venue operation and playback prioritization**, including content selection and output through speakers at a local jukebox. See, e.g., Ex. 1011 ¶ 17 (priority ordering of playback modes), ¶ 29 (jukebox system components), ¶ 101 (conversion and output of audio signals at the venue). These disclosures do not describe server-side ingestion, automated analysis of new media, or generation and storage of metadata.

Similarly, Bongiovi’s disclosures describe a **digital signal processing chain**—including gain adjustment, filtering, compression, and equalization—applied to an audio signal to improve perceived sound quality across playback environments. Ex. 1013 ¶¶ 14–20, Fig. 1. These operations are performed on an existing audio signal and result in a modified output signal. They do not involve receiving new media at a server, analyzing that media upon ingestion, or generating and storing metadata for later use in network-based distribution.

The Board also credits testimony that Bongiovi is broadly applicable across a wide range of audio devices, including MP3 players, computers, and home theater systems. Ex. 1003 ¶ 85 (citing Ex. 1013 ¶¶ 11, 20, 143). That general applicability, however, relates only to the types of devices on which audio processing may be performed. It does not demonstrate that a person of ordinary skill would have been motivated to modify Laut’s system to perform **server-side ingestion and metadata generation**, nor does it

show how Bongiovi's playback-stage processing would be integrated into such a system.

As explained in Section VI.A, Petitioner's rationale is directed to improving playback quality in noisy environments by combining multiple playback-stage techniques. It does not address the claimed system architecture, which requires automated processing at the time of ingestion of new media and the use of derived metadata in subsequent distribution.

Accordingly, the Board's preliminary conclusion—based on playback conditions, audio enhancement techniques, and generalized device applicability—does not support a finding that Petitioner has articulated a sufficient rationale to combine Laut, Kincaid, and Bongiovi to arrive at the claimed server-side ingestion and metadata system.

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

At the time of institution, the Board accepted Petitioner's position that a person of ordinary skill would have had a reasonable expectation of success in combining Laut, Kincaid, and Bongiovi based on shared computer components, common MP3 file formats, and Bongiovi's disclosure of implementation using processors such as those found in Laut and Kincaid. That preliminary conclusion, however, does not withstand scrutiny under the full record and the requirements of the challenged claims.

Petitioner's mapping relies on three categories of alleged compatibility: (1) generic processor-based implementation (e.g., CPUs and DSPs), (2) shared use of MP3 audio

formats, and (3) Bongiovi's purported broad applicability across audio devices. Ex. 1003 ¶ 85. None of these establish a reasonable expectation of success in modifying Laut to arrive at the claimed system.

First, the cited processor disclosures (Ex. 1013 ¶¶ 19, 52, 70; Ex. 1012, 8:6–51; Ex. 1011 ¶ 71) merely reflect that each reference uses conventional computing components. Kincaid's CPU 410 is part of a generic computing environment used to perform signal processing operations, and Laut's controller CPU 221 operates within a venue-based jukebox to control playback, routing, and user interaction. Bongiovi likewise describes implementing audio processing on a processor or DSP embedded within an audio device. These disclosures establish only that each system uses standard computing hardware—not that their fundamentally different processing architectures are compatible or interchangeable. The claimed invention requires server-side ingestion, automated analysis, and metadata generation, none of which are addressed by these processor disclosures.

Second, Petitioner's reliance on shared MP3 file formats (Ex. 1013 ¶¶ 20–23, 52; Ex. 1011 ¶¶ 31, 87; Ex. 1012, 1:25–47, 8:52–64) is misplaced. The fact that multiple systems operate on MP3 files does not provide a basis for combining their respective processing techniques. MP3 is a common input/output format across a wide range of unrelated systems. In Laut, MP3 files are selected and played at a jukebox; in Kincaid, MP3 files are analyzed to compute normalization parameters; and in Bongiovi, MP3 or other audio signals are processed through a compression pipeline to produce a modified

output signal. These uses occur at different stages (selection, analysis, playback processing) and do not establish compatibility with the claimed ingestion-time processing and metadata generation.

Third, Petitioner’s assertion that Bongiovi is broadly applicable to a wide range of audio devices (Ex. 1013 ¶¶ 11, 20, 143; Ex. 1003 ¶ 85) does not demonstrate a reasonable expectation of success. Bongiovi’s disclosures confirm that its techniques may be implemented on various playback devices—including radios, MP3 players, and home theater systems—and are applied to an audio signal prior to output. Ex. 1013 ¶¶ 20–23. This broad applicability relates only to **playback-stage signal processing**, not to the claimed system’s server-side ingestion architecture. General applicability across devices does not provide a reasoned basis to integrate Bongiovi’s compression pipeline into Laut in a manner that would produce the claimed automated ingestion, analysis, and metadata storage functionality.

Finally, Petitioner’s reliance on Bongiovi’s “detailed implementation guidance,” including code examples (Ex. 1013 ¶¶ 131–143), does not cure these deficiencies. Those disclosures describe how to implement compression and equalization within an audio processing chain operating on an input signal and producing an output signal. They do not describe how to modify a networked system such as Laut to perform ingestion-time analysis of new media, nor how to generate and store metadata as required by the claims. The existence of implementation detail within a fundamentally different processing context does not establish that a person of ordinary skill would have expected

success in combining the references to achieve the claimed system.

Accordingly, Petitioner's showing—based on generic hardware similarity, shared file formats, and generalized device applicability—fails to demonstrate a reasonable expectation of success in modifying Laut and Kincaid with Bongiovi to arrive at the claimed server-side ingestion and metadata system.

E. Patent Owner's Response

The Board notes that Patent Owner did not previously advance substantive arguments regarding Petitioner's asserted reasonable expectation of success. Nonetheless, as the Board correctly recognizes, the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378. On the present record, Petitioner has not carried that burden.

Petitioner's showing of reasonable expectation of success rests on generalized assertions that Laut, Kincaid, and Bongiovi employ similar computing components, process MP3-format audio, and operate within the field of audio playback systems. See Ex. 1003 ¶¶ 66, 85. As explained above, those assertions do not address the actual requirements of the challenged claims. The claims are directed to a system that performs **server-side ingestion of new media, automated analysis, and storage of derived metadata for subsequent network-based distribution**. Petitioner does not identify where any of the cited references disclose or suggest modifying Laut to perform those ingestion-time operations, nor does it explain how the cited playback-stage signal processing

techniques of Kincaid and Bongiovi would be integrated into such a system.

Moreover, Petitioner’s reliance on “familiar components” and “broad applicability” is legally insufficient to establish a reasonable expectation of success. The Federal Circuit has made clear that obviousness requires more than identifying shared high-level characteristics; it requires a showing that the proposed combination would have been expected to work for its intended purpose. Here, Petitioner does not demonstrate that applying Kincaid’s normalization or Bongiovi’s compression techniques—both directed to processing audio signals in a playback or device-level context—would result in a system capable of performing the claimed server-side ingestion, analysis, and metadata generation.

Accordingly, even if Patent Owner did not previously address this issue in detail, Petitioner’s evidence fails to establish that a person of ordinary skill would have had a reasonable expectation of success in combining Laut, Kincaid, and Bongiovi in the manner required by the claims. The burden identified by the Board remains unmet.

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

The Board’s preliminary conclusion relies on Petitioner’s assertion that Bongiovi is “broadly applicable to the entire spectrum of audio devices,” which would allegedly include Internet jukeboxes. Pet. 41–42 (citing Ex. 1013 ¶¶ 11, 20, 143; Ex. 1003 ¶ 85). That rationale, however, does not establish a reasonable expectation of success under the

requirements of the challenged claims.

First, the cited portions of Bongiovi (Ex. 1013 ¶¶ 11, 20, 143) disclose that its digital signal processing techniques may be implemented across a wide variety of **audio playback devices**—including radios, MP3 players, televisions, and computers—and that such implementations take an input audio signal and output a modified signal. These disclosures are directed to **device-level signal processing applied to an audio stream prior to output**, not to system-level architecture or network-based media ingestion. The Board’s reliance on this “broad applicability” therefore reflects only that Bongiovi’s processing can be used in many playback environments, not that it can be integrated into a fundamentally different system architecture such as Laut.

Second, the asserted analogy to “Internet jukeboxes” does not bridge that gap. Laut’s system, as disclosed, is a **venue-based jukebox system** in which controller 220 manages playback, routing, and user interaction at a local endpoint. Ex. 1011 ¶¶ 29–30. Bongiovi’s disclosures do not address network-based ingestion, do not describe adding new media to a system, and do not disclose generating or storing metadata associated with newly ingested media. Instead, Bongiovi processes an audio signal already selected for playback. Thus, even if Bongiovi’s techniques are broadly usable across devices, they remain confined to **post-selection, playback-stage signal processing**, which is materially different from the claimed server-side ingestion and analysis.

Third, Petitioner’s and the Board’s reliance on general-purpose computing compatibility (e.g., processors, MP3 formats, and device categories) is insufficient to establish a

reasonable expectation of success. As reflected in Ex. 1003 ¶ 85, Petitioner points to shared hardware components and file formats, but does not explain how Bongiovi’s compression pipeline—designed to operate on an input signal within an audio device—would be modified to perform the claimed operations of ingesting new media, analyzing that media, and storing derived metadata for later use in a distributed system. The cited evidence does not identify any mechanism, pathway, or modification that would enable such a transformation.

Finally, Bongiovi’s disclosure itself confirms the limitation of its teachings. Paragraph 143 expressly describes a software embodiment that processes an input audio signal and outputs a modified signal, implemented on a chip within an audio device. Ex. 1013 ¶ 143. This reinforces that Bongiovi operates within a **signal-processing pipeline at the device level**, not within a system that performs ingestion, metadata generation, or network-based content management.

Accordingly, the Board’s preliminary reliance on Bongiovi’s “broad applicability” does not demonstrate that a person of ordinary skill would have had a reasonable expectation of success in combining Laut, Kincaid, and Bongiovi to arrive at the claimed invention. The cited disclosures establish, at most, compatibility at the level of generic hardware and playback processing—not the feasibility of achieving the claimed server-side ingestion and metadata architecture.

VII. ALLEGED OBVIOUSNESS OVER LAUT, KINCAID, AND BONGIOVI

The Board summarizes Petitioner's position that claims 1–17 would have been obvious over Laut, Kincaid, and Bongiovi, and notes that it has considered the Rosenblatt Declaration (Ex. 1003) in support of institution. On the full record, however, Petitioner has not met its burden to establish unpatentability under 35 U.S.C. § 103.

Petitioner's theory of obviousness depends on combining three references that operate at materially different loci and perform fundamentally different functions. Laut is directed to a **venue-based jukebox system** that manages playback, routing, and user interaction at a local endpoint. Kincaid is directed to **audio normalization techniques** that analyze audio signals and compute gain adjustments to address perceived loudness differences. Bongiovi is directed to **dynamic range compression and signal processing pipelines** applied to audio signals at the device level to improve playback quality in various environments. Petitioner does not demonstrate how these disparate teachings can be combined to produce the claimed system.

The challenged claims require a **server-side architecture that performs ingestion of new media, automated analysis of that media, and storage of derived metadata for subsequent network-based distribution and use**. As established throughout the record, none of the cited references discloses or suggests these operations in the claimed context. Laut does not perform ingestion-time analysis or metadata generation; Kincaid performs analysis but in the context of signal normalization, not system-level ingestion and storage; and Bongiovi performs compression and equalization within a playback

signal chain. Petitioner's combination therefore relies on reconstructing the claimed invention using hindsight rather than identifying teachings in the prior art that would lead a person of ordinary skill to the claimed system.

Moreover, Petitioner's reliance on generalized similarities—such as shared use of processors, MP3 file formats, or network connectivity—does not establish obviousness. These features are ubiquitous in the relevant field and do not provide a reasoned basis for combining the references in a manner that would achieve the claimed functionality. The Federal Circuit has repeatedly held that such high-level commonalities are insufficient to support a conclusion of obviousness absent a specific showing that the combination would yield the claimed invention.

The Rosenblatt Declaration (Ex. 1003) does not cure these deficiencies. The Declaration largely repeats Petitioner's conclusory assertions regarding motivation to combine and reasonable expectation of success, relying on the same generalized characteristics and without identifying how the proposed combination would implement the claimed server-side ingestion, analysis, and metadata pipeline. As such, it does not provide the necessary evidentiary support to bridge the gap between the cited references and the claimed invention.

Accordingly, when the teachings of Laut, Kincaid, and Bongiovi are properly considered, Petitioner has not demonstrated that the claimed invention would have been obvious to a person of ordinary skill in the art. The asserted combination fails to disclose or suggest the claimed system, and the required showing under § 103 is not met.

Response to the Board's Preliminary Finding

The Board's preliminary finding that Laut teaches the preamble rests on Petitioner's reliance on Laut ¶¶ 29–30, 73, and 105, as well as Mr. Rosenblatt's testimony (Ex. 1003 ¶ 41). That mapping is incomplete and legally insufficient.

First, while Laut describes a networked jukebox system in which a user may upload content and select venues for playback (Ex. 1011 ¶¶ 30, 73), those disclosures are directed to **distribution and playback control within a venue-based jukebox network**, not to the claimed **computer-implemented method for real-time music distribution of new media allowing an artist to control availability** as recited in the preamble. Laut's system is centered on **selection and scheduling of existing or uploaded content for playback**, including staggered or simultaneous play, subject to scheduling constraints. Id. ¶ 73. It does not disclose a system in which an artist controls availability of *new media* within a system that performs the claimed ingestion, processing, and distribution pipeline.

Second, the Board credits testimony that Laut allows an artist to “upload content” and select jukeboxes at venues. Ex. 1003 ¶ 41. However, that characterization omits critical context: Laut's upload functionality transmits content to a **third-party rating system** before distribution. Ex. 1011 ¶ 73. This intermediary step demonstrates that Laut does not provide the claimed system-level control over availability of new media, but instead relies on **external processing and approval mechanisms** prior to distribution. The claimed invention, by contrast, is directed to a system in which new media is ingested,

processed, and made available through a unified server-side architecture.

Third, Laut’s disclosure of venues (e.g., bars, restaurants) and networked playback (Ex. 1011 ¶¶ 29, 105) does not satisfy the preamble’s requirement of real-time music distribution of new media. Laut’s scheduling features—including delayed, staggered, or quota-limited playback—demonstrate that playback is not necessarily real-time and is subject to system-imposed constraints. *Id.* ¶ 73. This is inconsistent with the claimed system, which operates through server-side control of media ingestion, availability, and distribution as part of an integrated process.

Finally, the Board’s rejection of Patent Owner’s constructions of “public venues” and “real time” does not cure these deficiencies. Even under a broader reading, Petitioner must still show that Laut discloses a system that performs real-time distribution of newly ingested media under artist control, as required by the preamble. The cited portions of Laut do not disclose such functionality.

Accordingly, Petitioner’s reliance on Laut ¶¶ 29–30, 73, and 105—and the corresponding testimony in Ex. 1003 ¶ 41—fails to demonstrate that Laut teaches the preamble as properly understood in view of the claimed system. The asserted mapping addresses only venue-based playback selection, not the claimed real-time, system-level distribution and control of new media, and therefore does not satisfy the preamble.

Petitioner relies on Laut ¶¶ 29, 30, 73, and 105 to contend that Laut discloses “real-time music distribution” allowing artists to control playback across multiple jukeboxes. *Pet.*

11; Pet. 27; Ex. 1003 ¶ 41.

Patent Owner does not rely on the preamble for patentability. Even assuming, *arguendo*, that the cited disclosures satisfy the preamble, Petitioner’s analysis fails for the reasons set forth below.

The cited passages describe a venue-based jukebox system that allows users to select and schedule playback of existing media across networked devices. They do not disclose the claimed system architecture, which requires server-side ingestion of new media, automated analysis at ingestion, and storage of derived metadata for subsequent network-based distribution.

Accordingly, even if Laut is assumed to satisfy the preamble, it does not cure the deficiencies in Petitioner’s failure to demonstrate the claimed ingestion-triggered, server-side system recited in the body of claim 1.

2. [A]

Step [A] recites: “providing, by a processor, a user interface to interact with a system.”

Ex. 1001, 10:3–4.

The Board’s preliminary analysis accepts Petitioner’s position that Laut’s user interface 240, in combination with controller 220, satisfies this limitation. Respectfully, that conclusion rests on an overbroad characterization of Laut’s disclosure and fails to address the required system context, processor locus, and functional role of the claimed interface.

Petitioner relies on Laut ¶¶ 29–32, 48, 49 and Figures 2A and 4C to identify a “user interface.” These disclosures describe a physical jukebox system 200 deployed at a venue, including a display 210 and user interface 240 through which a user manually selects content, enters credentials, and chooses a venue for playback. Ex. 1011 ¶¶ 29, 32.

However, these disclosures do not satisfy step [A] as claimed.

First, Laut’s interface is tied to a venue-based jukebox appliance, not to the claimed system. Paragraph 0029 explicitly places the system “at a particular venue,” with integrated hardware including display, memory, network interfaces, and a payment verification unit. The interface is therefore a local endpoint interface for a physical device, not an interface provided by a processor of a centralized system.

Second, the processor identified by Petitioner—controller 220—is likewise a device-level processor embedded within the jukebox. Paragraph 0030 confirms that controller 220 performs routing, scheduling, playback control, and fee verification within the jukebox system itself. These are local control and playback functions, not system-level operations of a server-side architecture.

Third, the claimed “system” is not merely any device with a user interface. As reflected in the claim as a whole, the system is a network-based platform that performs ingestion of new media, automated analysis, metadata generation, storage, and distribution. The interface recited in step [A] must therefore be understood in the context of that system.

Laut’s interface does not interact with such a system. Instead, paragraph 0032 confirms

that the interface is used for manual selection of content, authentication, and selection of venue endpoints for playback. Even where a remote server is referenced (§ 0048), the server performs only conventional database search and retrieval of pre-existing media. There is no disclosure of interaction with a system that ingests new media, performs automated analysis, or generates and stores metadata.

Fourth, the function of Laut's interface is fundamentally different from the claimed interaction. Laut's interface enables user-driven selection of existing content for playback at a venue. It does not provide interaction with a system for adding new media, managing ingestion, or controlling server-side processing.

Accordingly, Petitioner's mapping conflates a device-level jukebox interface with a system-level interface required by the claims. The cited disclosures do not show "providing, by a processor, a user interface to interact with a system" as properly construed in the context of claim 1, but instead describe a local, user-driven interface for playback selection at a venue-based appliance.

For these reasons, Laut does not disclose step [A].

3. [B]

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

The Board's preliminary analysis accepts Petitioner's position that Laut discloses this limitation based on user accounts, login functionality, and associated identification and

password features. Respectfully, the cited disclosures do not teach the claimed limitation, and Petitioner's position relies on impermissible inference rather than an actual disclosure.

Petitioner relies on Laut ¶¶ 42–46 and ¶ 60 to argue that a user has an account associated with an identification and password. These paragraphs describe that a user may store personal content selections (e.g., playlists) on a remote server and later retrieve those selections by logging in through the jukebox interface. Ex. 1011 ¶¶ 43–45.

However, these disclosures do not teach “providing ... a user interface to add the user to the system.”

First, Laut does not disclose any step in which a user is added to a system via a user interface. The cited paragraphs describe only authentication and retrieval of pre-existing user data. The system assumes the existence of a user account but does not disclose how such an account is created, provisioned, or added to the system.

Petitioner implicitly acknowledges this gap, stating that “to the extent not expressly disclosed ... it would have been obvious” for the interface to add a user. Ex. 1003 ¶ 45.

This admission confirms that the claimed limitation is not actually disclosed in Laut.

Second, the cited functionality is limited to login and access, not system-level user creation. Paragraphs 0043–0046 describe retrieving and modifying pre-existing personal content lists stored on a remote server. These operations occur after a user already exists in the system and do not involve adding the user to the system.

Third, as with step [A], the cited disclosures are tied to a venue-based jukebox

appliance, not to the claimed system. The “account” described in Laut is a convenience feature for retrieving playlists associated with a user at different jukebox locations. It does not correspond to adding a user into a centralized system that performs ingestion, processing, and distribution of new media as required by claim 1.

Fourth, the function of Laut’s interface is limited to user-driven interaction with pre-existing content. It does not provide an interface for onboarding users into a system that manages new media ingestion, metadata generation, or playback-based attribution.

Accordingly, Petitioner’s mapping relies on an unsupported assumption that account existence implies account creation via the claimed interface. This is not a disclosure but a reconstruction based on hindsight. The cited references therefore fail to teach

“providing ... a user interface to add the user to the system” as required by step [B].

For these reasons, Laut does not disclose step [B].

4. [C]

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

Petitioner does not provide any independent analysis or evidence for this limitation and instead maps step [C] identically to step [B], stating only “See element [B].” Pet. 15 (citing Ex. 1003 ¶ 46). This is insufficient to meet Petitioner’s burden.

First, step [C] requires a distinct function—creation of an account—separate from step [B], which concerns adding a user to the system. Petitioner’s reliance on the same

disclosures for both limitations improperly collapses two separate claim elements into one. Obviousness cannot be established by treating distinct claim limitations as interchangeable.

Second, the cited portions of Laut (¶¶ 42–46, 60) do not disclose account creation. These paragraphs describe only that a user may have an existing account associated with an identification and password, which permits retrieval of stored personal content selections. Ex. 1011 ¶¶ 43–45. The disclosures presuppose that the account already exists and describe only authentication and access.

Third, Petitioner provides no evidence that Laut discloses any user interface through which an account is created. There is no description of registration, user onboarding, account provisioning, or any process by which a user is added to the system. The absence of such disclosure is confirmed by Petitioner’s reliance on the same reasoning used for step [B], which itself depends on inference rather than express teaching.

Fourth, the cited functionality remains limited to a venue-based jukebox interface used for selecting and playing pre-existing content. It does not provide an interface for creating user accounts within a centralized system that performs ingestion, processing, and distribution of new media as required by claim 1.

Accordingly, Petitioner fails to identify any disclosure in Laut that teaches “providing ... a user interface to create an account.” The mapping relies entirely on hindsight and unsupported assumption rather than evidence.

For these reasons, Laut does not disclose step [C].

5. [D]

Step [D] recites: “providing, by the processor, a user interface to log into the system.”

Ex. 1001, 10:9–10.

Petitioner relies on Laut’s disclosure that a user may enter a username and password through user interface 240 to access stored personal content selections. Pet. 15–16 (citing Ex. 1011 ¶¶ 32, 42–46, 73, 89; Ex. 1003 ¶ 47). While Laut describes user authentication, the cited disclosures do not teach logging into “the system” as claimed. First, the functionality disclosed in Laut is limited to accessing user-specific preference data, such as stored playlists or personal content selections. Ex. 1011 ¶¶ 43–46. The login mechanism is used to retrieve and display previously selected content for manual playback selection. It does not provide access to a system that performs ingestion, processing, or management of media as required by claim 1.

Second, the locus of Laut’s login functionality remains tied to a venue-based jukebox interface or a remote interface that merely retrieves stored user preferences. Even when a remote server is referenced, it functions only as a storage location for playlists, not as a system providing centralized processing or automated functionality. The user interface remains a control interface for selecting and playing pre-existing content at specific venue endpoints.

Third, Laut’s login process is entirely user-driven and limited to authentication and

retrieval of stored data. It does not enable interaction with any automated system performing analysis, metadata generation, normalization, or usage-based attribution. The disclosed functionality is confined to manual selection and playback of existing media.

Accordingly, although Laut discloses entering a username and password, it does not disclose “logging into the system” as required by the claims. The cited functionality is limited to accessing stored user preferences within a jukebox environment and does not correspond to accessing a system that performs the claimed operations.

Therefore, Laut does not teach step [D].

6. [E]

Step [E] 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 relies on Laut ¶73 to assert that a user may “upload content” via user interface 240, and contends that such content constitutes “new media” added to the system. Pet. 15–16 (citing Ex. 1011 ¶73; Ex. 1003 ¶¶49–50). This mapping is incorrect.

First, Laut ¶73 does not disclose adding media “to the system” as claimed. Rather, Laut describes a process in which a user uploads content for distribution to networked jukebox systems at selected venues. Ex. 1011 ¶73. The uploaded content is transmitted for third-party rating and then routed for playback at selected jukebox endpoints. *Id.*

This is a distribution and scheduling workflow, not an ingestion of media into a system

that processes, manages, or maintains the media as part of a centralized system.

Second, Laut fails to disclose that the media is “new if not previously stored in the system.” The cited paragraph does not describe any determination of whether media is previously stored, nor any system-level storage logic that distinguishes new media from existing media. Petitioner’s assertion that the uploaded content would have been “not previously stored” relies on speculation (“POSITA would have found it obvious”), rather than any actual disclosure in Laut. Ex. 1003 ¶49. This is insufficient to satisfy the claim limitation.

Third, the locus and function of Laut’s system are fundamentally different from the claimed invention. Laut’s system operates as a venue-based jukebox network that routes and schedules playback of content across endpoint devices. Even when content is uploaded, it is handled as part of a user-driven distribution process and is subject to external rating before playback. Ex. 1011 ¶73. Laut does not disclose any server-side ingestion, automated analysis, metadata generation, normalization, or storage pipeline as required by the claims.

Accordingly, Laut does not teach “providing ... a user interface to add the new media to the system” as claimed. At most, Laut discloses uploading content for distribution to selected venue-based jukebox systems, which is materially different from adding new media to a system that performs the claimed operations.

Therefore, Petitioner has not shown that Laut teaches step [E].

7. [F]

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

Petitioner relies on Laut ¶30 to assert that the processor “receives content,” and equates this with receiving the claimed “new media added to the system.” Pet. 18 (citing Ex. 1011 ¶30; Ex. 1003 ¶51). This mapping is incorrect.

First, Petitioner’s argument is circular and improperly depends on its deficient showing for step [E]. As discussed above, Laut does not disclose adding “new media to the system” as claimed. Because step [F] expressly requires “the new media added to the system,” the failure of step [E] necessarily precludes satisfaction of step [F].

Second, Laut ¶30 does not disclose receiving “new media added to the system.” Instead, ¶30 lists generic functions of a device-level controller, including “receiving content,” alongside routing, transmitting, playing content, and verifying payment. Ex. 1011 ¶30. This disclosure reflects conventional input/output and control operations of a jukebox device, not receipt of newly ingested media within a system.

Third, the locus and function of Laut’s “receiving content” differ materially from the claimed invention. Controller 220 is embedded within a venue-based jukebox system and manages playback, routing, and transactional operations at the device level. *Id.*

There is no disclosure that the controller receives newly added media into a centralized system for processing, storage, or further automated operations. Instead, Laut’s system

routes and handles content as part of a user-driven playback network.

Finally, Laut does not disclose any connection between the alleged “received content” and the claimed “new media added to the system.” There is no indication that the received content is newly ingested media, nor that it is processed as part of the claimed server-side pipeline.

Accordingly, Laut does not teach “receiving ... the new media added to the system” as required by step [F], and Petitioner has not met its burden.

8. [G]

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

Petitioner relies on Laut to assert that metadata such as rating, genre, and other descriptive information is identified and stored in a database. Pet. 18–20 (citing Ex. 1011 ¶¶ 48–52, 56, 60–62, 73, 94; Ex. 1003 ¶¶ 52–53). This mapping is legally and technically deficient.

First, Laut does not disclose “automatically identifying” metadata as required by the claim. Instead, Laut describes content being rated by a third-party rating service, which assigns rating classifications that are then attached to the content. Ex. 1011 ¶¶ 73, 94. These classifications are externally generated and merely associated with the content, not automatically identified by the processor. The cited disclosures reflect receipt or assignment of preexisting labels, not automated identification.

Second, Laut does not identify metadata “for the new media” as claimed. As discussed above for steps [E] and [F], Laut does not disclose adding or receiving “new media” within the claimed system. Because Laut fails to disclose the claimed ingestion of new media, it necessarily fails to disclose identifying metadata for such new media.

Third, the type of metadata in Laut is materially different from that required by the claim. Laut’s metadata consists of descriptive or categorical labels such as rating, genre, artist, and title, which are used for filtering and selection. Ex. 1011 ¶¶ 48–52. In contrast, the claimed invention requires automated identification of metadata derived from the media itself as part of a processing pipeline. Laut contains no disclosure of analyzing media content to generate derived parameters, nor any automated computation of metadata based on signal characteristics.

Fourth, Laut’s database functionality is limited to storing playback statistics and organizing existing content information. Ex. 1011 ¶ 56. This is a post hoc reporting and indexing system, not a pipeline in which metadata is automatically identified from newly ingested media and stored for further processing.

Accordingly, Laut does not disclose “automatically identifying ... metadata for the new media and storing the metadata in a database,” and Petitioner has not met its burden for step [G].

9. [H]

Step [H] 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’s mapping to Laut is deficient for multiple independent reasons.

First, Laut does not disclose a “central storage device.” Instead, Laut describes a distributed network architecture comprising multiple content servers, jukebox systems, routers, and management systems. Ex. 1011 ¶¶ 86–87, Fig. 14. Content may reside on jukebox devices or on various servers across the network, and is retrieved based on location and availability. This is a distributed system, not a centralized storage architecture as required by the claim.

Second, Laut does not disclose that storing media “automatically enables” playback. Rather, playback in Laut is contingent upon multiple user-driven and conditional steps, including content selection, venue determination, fee calculation, fee verification, and scheduling. Ex. 1011 ¶¶ 96–100, Fig. 16. Content is only requested and delivered after these steps are satisfied. Thus, storage does not automatically enable playback; instead, playback is explicitly gated by user interaction and transactional conditions.

Third, Laut does not disclose access to a database “via an API call over the Internet.” Petitioner relies on an equivalence statement from the prosecution record asserting that an API call is “equivalent to making a general request for a media/song list.” Ex. 1002,

412. However, this is not a disclosure of an API call in Laut, but rather an unsupported generalization. Laut itself describes only conventional user interface interactions and database queries, not programmatic API-based access as required by the claim.

Fourth, Laut does not disclose the claimed architecture in which client software installed on the jukebox accesses a database storing metadata for newly ingested media. As discussed above for steps [E]–[G], Laut does not disclose ingestion of new media, nor automatic identification and storage of metadata derived from such media. The cited disclosures instead relate to selecting and retrieving pre-existing content based on descriptive attributes.

Finally, Petitioner’s reliance on controller 220 and user interface 240 reflects a device-level, venue-based implementation, not the claimed server-side architecture enabling centralized storage and API-driven access over the Internet. Laut’s system operates as a distributed jukebox network with user-driven selection and routing, not as a centralized ingestion and distribution platform.

Accordingly, Laut does not disclose “storing ... the new media in a central storage device” that “automatically enables” playback via client software accessing a metadata database through an API call, and Petitioner has not met its burden for step [H].

10. [I]

Step [I] 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 relies on Kincaid to supply this limitation. However, this mapping fails for multiple independent reasons.

First, Kincaid performs audio normalization within a standalone media player architecture. As shown in Kincaid’s system (CPU 410, RAM, storage devices), the RMS calculation and normalization operations occur locally within a device processing pre-existing audio tracks. Ex. 1012, 8:6–51, Fig. 4. Kincaid does not disclose or suggest performing such analysis within a server-side ingestion and distribution system as required by the claims.

Second, Kincaid’s analysis is applied to tracks within a local music library, not to “new media” as required by the claim. The cited disclosures describe normalization occurring as part of background processing when tracks are added to a library. Ex. 1012, 4:13–15. This reflects post-import processing of existing content, not automatic analysis of newly ingested media within a networked system.

Third, Petitioner improperly attempts to substitute Kincaid’s processor (CPU 410) for Laut’s controller 220 without demonstrating how such functionality would be integrated into Laut’s system. Laut’s controller is a device-level component responsible for routing, playback control, and user interaction within a jukebox system, not for performing automated signal analysis. The proposed combination lacks any explanation

of how Kincaid's DSP operations would be incorporated into Laut's architecture.

Fourth, Kincaid does not disclose the claimed integrated processing pipeline in which analysis of audio signals produces derived values used within a broader metadata and distribution framework. Instead, Kincaid performs standalone signal processing for volume normalization without generating or storing metadata tied to a network-based media system.

Finally, Petitioner's argument regarding the "positive RMS value less than 1" is based on speculative scaling behavior rather than a clear disclosure. Kincaid describes computing power values and applying gain factors, but does not disclose generating a bounded RMS value less than 1 as required by the claim.

Accordingly, Kincaid does not teach or suggest "automatically analyzing ... audio signals of the new media" within the claimed system architecture, and Petitioner has not met its burden for step [I].

11. [J]

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

Petitioner relies on Kincaid to satisfy this limitation, asserting that a normalization gain factor is stored as metadata associated with an audio track. This mapping fails for several reasons.

First, Kincaid does not disclose storing metadata within a system-level database as

required by the claims. Instead, Kincaid describes incorporating normalization information into a tag embedded within an audio file (e.g., an MP3 file). Ex. 1012, 7:41–47, 9:21–25. This is file-level metadata stored within the media file itself, not metadata stored in a database as part of a networked system architecture.

Second, Kincaid’s tagging occurs in the context of processing tracks within a local music library, not newly ingested media within a distributed system. The claimed invention requires storing metadata for “new media” generated through the ingestion pipeline, whereas Kincaid operates on pre-existing tracks.

Third, Kincaid’s disclosure is limited to local storage and playback within a multimedia player environment. There is no teaching of storing metadata in a centralized database accessible to networked jukebox clients or enabling playback through such a system.

Fourth, Petitioner improperly equates Kincaid’s normalization gain factor with the claimed RMS value. The gain factor is derived from the RMS value and is a distinct quantity. Kincaid does not disclose storing the RMS value itself as metadata as required by the claim.

Finally, Petitioner’s mapping relies on step [G] for the alleged storage of metadata.

However, as explained above, the cited references do not disclose the claimed metadata generation and storage pipeline. Accordingly, this deficiency carries forward and precludes satisfaction of step [J].

For these reasons, Kincaid does not teach or suggest “storing ... the obtained RMS value

less than 1 as metadata for the new media,” and Petitioner has not met its burden for step [J].

12. [K]

Step [K] 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 relies on Laut and refers back to its mapping for step [H], asserting that metadata is provided because artist and song information is displayed on the jukebox interface. This mapping fails.

First, Laut does not disclose providing metadata over the Internet in response to an API call. The cited portions describe local display of content information (e.g., artist name, song title) on a jukebox interface. Ex. 1011 ¶74, Fig. 4C. This is a user interface function, not a network-based response to an API request.

Second, the alleged “metadata” in Laut consists of static descriptive information such as artist name and song title. The claims, however, require metadata derived from automated analysis of new media, including an RMS value less than 1 as generated and stored in steps [I] and [J]. Laut does not disclose or suggest providing such derived metadata.

Third, Petitioner relies entirely on its deficient mapping for step [H] and identifies no independent disclosure of an API call in Laut. The mere reference to wireless communication (e.g., WiFi) does not establish the existence of an API-based request-

response mechanism.

Fourth, Laut describes a user-driven system in which content is selected through a user interface and displayed locally. It does not disclose a processor providing metadata over a network in response to a request.

Accordingly, Petitioner has not shown that Laut teaches or suggests “providing ... the metadata for the new media over the Internet in response to the API call,” and step [K] is not satisfied.

13. [L]

Step [L] 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.

Petitioner relies on Laut’s Figure 16 and refers back to its mappings for steps [H] and [K], asserting that a request for content delivery at block 1655 satisfies this limitation. This mapping fails.

First, Laut does not disclose a request from a jukebox to a processor. Instead, the cited portions describe a user-initiated workflow in which a user selects content through a local user interface, completes a payment process, and thereby triggers content delivery. Ex. 1011 ¶¶ 96–100, Fig. 16. A user-driven selection through a local interface is not a request generated by a jukebox system as required by the claims.

Second, the alleged “request” is merely a consequence of user interaction within a transactional flow involving fee determination and verification. It is not a system-level

request associated with metadata generated through automated processing of new media.

Third, Laut does not disclose that the request is associated with the claimed metadata. The claims require metadata derived from automated analysis of new media (including RMS-based values), whereas Laut relies on static descriptive information such as genre or artist for menu-based selection.

Fourth, Petitioner’s mapping for this limitation depends entirely on its deficient showings for steps [H] and [K], including the absence of any disclosure of an API call or a processor providing metadata over a network. For the same reasons, step [L] is not satisfied.

Accordingly, Petitioner has not shown that Laut teaches or suggests “receiving ... a request from the jukebox for playback of the new media associated with the displayed metadata.”

14. [M]

Step [M] requires that the processor provide the requested new media to the jukebox for playback.

Petitioner relies on Laut’s Figure 16 (block 1660) and general disclosures regarding streaming and playback formats. This mapping fails.

First, Laut’s block 1660 merely schedules content for playback at the jukebox. Ex. 1011 ¶¶ 96–100. Scheduling playback is not equivalent to providing media from a processor to a jukebox as required by the claims.

Second, Laut discloses that playback occurs locally at the jukebox device, where content is converted into audio signals and transmitted through speakers. Ex. 1011 ¶ 101. This confirms that Laut’s system performs playback at the endpoint device, not via processor-driven provision of media.

Third, Petitioner’s reliance on streaming disclosures (Ex. 1011 ¶¶ 31, 78, 87) is misplaced. These disclosures describe generic transmission of pre-existing media files and are not tied to the claimed sequence of automated analysis, metadata generation, request, and delivery of new media.

Fourth, Laut operates on pre-existing media selected by a user and does not disclose providing “new media” as required by the claims.

Finally, Petitioner’s mapping depends on its deficient showings for steps [H] and [L]. Because Petitioner fails to establish a valid request from the jukebox, it necessarily fails to establish provision of media by the processor.

Accordingly, Petitioner has not shown that Laut teaches or suggests step [M].

15. [N]

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

Petitioner relies on Laut’s pricing disclosures (Ex. 1011 ¶¶ 63, 65), royalty payment discussion (¶ 80), and management reporting (¶ 90). This mapping fails.

First, Laut’s controller determines a “cost to play” prior to playback based on user-

selected parameters such as number of venues and delivery mode. Ex. 1011 ¶ 63. This is a pre-transaction pricing model, not a calculation of amounts earned based on playback of media.

Second, Laut's interface allows users to adjust selections to modify pricing. Ex. 1011 ¶ 65, Fig. 8. These disclosures describe user-driven pricing adjustments, not automatic calculation of earned amounts based on playback.

Third, Laut's discussion of royalty payments reflects post-hoc accounting and distribution mechanisms. Ex. 1011 ¶ 80. The reference discloses tracking downloads and later distributing payments, but does not disclose any processor performing an automatic calculation of earnings tied to playback events.

Fourth, Laut does not disclose calculating amounts earned by a venue based on playback of media, as required by the claims.

Finally, Petitioner's mapping is not tied to "new media" and does not arise from the same processor-driven pipeline that performs analysis, metadata generation, and delivery in the claimed invention. Instead, Laut operates as a selection, pricing, and playback system for pre-existing content.

Accordingly, Petitioner has not shown that Laut teaches or suggests step [N].

16. [O]

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

Petitioner relies on Laut’s disclosures of fee acceptance and verification (Ex. 1011 ¶¶ 30, 32), playback transaction flow (¶ 98, Fig. 16), and reporting of money collected (¶¶ 53–54, 92). This mapping fails.

First, Laut discloses a pay-to-play transaction model in which a user must provide payment prior to playback, and the system verifies whether the required fee has been deposited. Ex. 1011 ¶ 98, Fig. 16. This is a precondition to playback, not the claimed step of receiving an indication that an amount earned has been satisfied.

Second, Laut’s controller “accept[s] fees” and “verif[ies] payment” through mechanisms such as credit cards or money receivers. Ex. 1011 ¶ 30. These disclosures reflect the receipt of actual payment, not the receipt of an indication of payment corresponding to a calculated earned amount.

Third, Laut’s references to “money collected” and venue-based revenue statistics describe aggregated transactional data used for reporting and display. These disclosures are post hoc summaries of payments made, not processor receipt of an indication tied to a computed amount earned from playback.

Fourth, Laut’s system requires payment as a condition precedent to playback and is driven by user-initiated transactions. It does not disclose receiving an indication of payment in response to a processor-calculated amount earned from playback activity, as required by the claims.

Finally, Petitioner’s mapping is not tied to “amounts earned” derived from playback of

new media within a processor-driven pipeline. Instead, Laut operates as a transactional jukebox system that conditions playback on payment and tracks revenue, rather than a system that logs or receives indications of satisfaction of playback-attributed earnings.

Accordingly, Petitioner has not shown that Laut teaches or suggests step [O].

17. [P]

Step [P] requires that 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.

Petitioner relies on Kincaid's disclosures of normalization using a gain factor (Ex. 1012, 3:63–66, 8:2–5, 9:21–33). This mapping fails.

First, Kincaid discloses playback-side normalization, in which an audio player retrieves a stored normalization gain factor from a tagged audio file and applies that gain during playback. Ex. 1012, 3:63–66, 8:2–5. This reflects post-processing of an already stored and selected audio file, not normalization performed on the audio signals of newly ingested media within a processor-driven system.

Second, Kincaid's normalization gain factor is precomputed and stored as metadata within the audio file. Ex. 1012, 9:21–25. The player merely reads and applies this value during playback. This does not disclose a processor that obtains a positive RMS value less than 1 and applies gain as part of an active processing pipeline, as required by the claims.

Third, Kincaid's normalization operates on existing audio content at the time of playback, and is directed to achieving perceptual loudness consistency across tracks. It does not disclose normalization of "audio signals of the new media" within a system that ingests, processes, and manages new media as recited in the claims.

Fourth, Petitioner's mapping improperly equates metadata-based playback adjustment with processor-driven normalization of audio signals. The cited disclosures show that the gain factor is retrieved and applied, not computed and applied as part of a unified processing system handling new media.

Finally, Petitioner does not identify any disclosure in Kincaid tying the alleged normalization to the same processor-driven pipeline recited in the claims. Instead, Kincaid operates as a playback enhancement technique, separate from any system that performs ingestion, analysis, or attribution of new media.

Accordingly, Petitioner has not shown that Kincaid teaches or suggests step [P].

18. [Q]

Step [Q] requires that 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.

Petitioner relies on Bongiovi's disclosures of dynamic range compression (Ex. 1013 ¶¶ 11, 14–20, 80, 131–138; Figs. 1, 10). This mapping fails.

First, Bongiovi discloses generic digital signal processing applied to an input audio

signal within a local processing chain, including filters, compressors, and equalizers. Ex. 1013 ¶¶ 14–20, Fig. 1. These operations are applied to an existing audio signal at playback or output, not to “new media” as required by the claims.

Second, Bongiovi’s compressors (104, 108) operate as part of a device-level DSP pipeline, implemented on a chip or processor embedded within an audio device. Ex. 1013 ¶¶ 19–20; This reflects local signal conditioning, not processing performed within a server-side system handling ingestion and distribution of new media.

Third, although Bongiovi describes compression using a threshold (KT) and ratio (r), these are standard DSP parameters used to modify signal amplitude characteristics, not part of a processor-driven pipeline that analyzes, stores, and processes newly uploaded media. Ex. 1013 ¶ 80, Fig. 10. The reference discloses how compression operates mathematically, but does not tie that operation to any system that processes new media within a networked architecture.

Fourth, Bongiovi’s processing occurs on an input signal already selected for playback, and is directed to improving sound quality (e.g., loudness normalization and clarity across devices), not to transforming newly ingested media within a system that tracks and attributes playback.

Finally, Petitioner’s mapping improperly isolates a standalone DSP technique and attempts to graft it onto Laut’s jukebox system without identifying any disclosure of integrating such compression into a processor-driven pipeline that handles new media as

claimed. There is no teaching or suggestion that Bongiovi's compression is applied in the context of ingestion, metadata generation, or playback attribution.

Accordingly, Petitioner has not shown that Bongiovi, alone or in combination with Laut and Kincaid, teaches or suggests step [Q].

VIII. PRIORITY AND CONTINUITY OF THE CIP CHAIN

In the Institution Decision, the Board discussed Petitioner's contention that Patent Owner intentionally waived any claim to domestic priority to Application No. 11/744,228 during prosecution of Application No. 12/804,665 (the application that issued as the '925 patent), citing Ex 1002 at page 316. Paper 10 at 57. The intrinsic prosecution record demonstrates, however, that the cited language appears only in an after-final submission that the examiner expressly refused to enter into the prosecution record.

The cited language appears in an after-final response filed September 2, 2014 under 37 C.F.R. § 1.116. Ex. 1002 at 306–316. The examiner stamped that submission “DO NOT ENTER,” confirming that the proposed amendments were not entered into the prosecution record. Ex. 1002 at 333. The Advisory Action issued September 15, 2014 likewise states that the proposed amendments filed after final “will not be entered because they raise new issues that would require further consideration and/or search.” Ex. 1002 at 332.

Because those after-final amendments were not entered, they cannot constitute a

prosecution disclaimer, waiver, or abandonment of domestic priority. The intrinsic record reflects only an examiner-refused after-final submission, not an operative amendment to the application. See MPEP § 714.13.

The official USPTO file history independently confirms the continuation-in-part relationship between Application No. 12/804,665 and Application No. 11/744,228. The application publication corresponding to the '925 patent identifies Application No. 12/804,665 as a continuation-in-part of Application No. 11/744,228 filed May 4, 2007. Ex. 1001, code (63). The Board itself recognized at institution that “upon first inspection it would seem the '925 patent is a Continuation-In-Part (CIP) of prior application 11/744,228.” Paper 10 at 56. Examiner search notes also confirm that the parent application was reviewed during examination. Ex. 1002. The USPTO filing receipt and bibliographic data sheet likewise identify Application No. 12/804,665 as a continuation-in-part of Application No. 11/744,228. Ex. 1002 at 133, 140.

Accordingly, the prosecution record shows that the continuation-in-part relationship was never severed by any entered amendment, and Petitioner’s waiver theory relies solely on a refused after-final submission that cannot constitute a disclaimer or abandonment of domestic priority under 35 U.S.C. § 120.

After the examiner refused entry of the September 2, 2014 submission, prosecution proceeded to allowance. The USPTO issued a Notice of Allowance on May 18, 2015 stating that “PROSECUTION ON THE MERITS IS CLOSED.” Ex. 1002 at 439. The later-entered June 15, 2015 filing receipt referenced by the Board did not reopen

prosecution or effect any substantive amendment to the application record. A filing receipt is administrative in nature and does not alter the intrinsic prosecution history or continuity of a CIP relationship established earlier in the official record.

IX. WRITTEN DESCRIPTION / §120 SUPPORT

THE CHALLENGED CLAIMS ARE ENTITLED TO PRIORITY UNDER 35 U.S.C. §120

Even if continuity of the continuation-in-part (“CIP”) chain were disputed, the challenged claims remain entitled to priority because the parent application specification reasonably conveys possession of the claimed server-based distribution of newly uploaded media.

The parent application discloses a network-based system in which artists upload media through a user interface to a central system composed of servers, databases, and web programs that store the media and make it available for playback through connected client interfaces. Ex. 2001 ¶[0007]. The disclosure explains that once media is added to the system, it becomes available for playback across the networked system. Id. These disclosures correspond to the claimed server-mediated ingestion, storage, and distribution of newly uploaded media that formed the basis for allowance during prosecution.

During prosecution, the Examiner expressly recognized that the application disclosure

contained two distinct inventions described in the specification:

(1) graphical user-interface functionality allowing artists to control and promote their media, and

(2) a central server system streaming media to clients in response to requests.

Ex. 1002 at 228–229 (Notice of Non-Responsive Amendment). The Examiner explained that these were “separate, independently functioning” sub-combinations requiring different searches. *Id.* This restriction analysis confirms that both the client-interface functionality and the server-streaming architecture were already disclosed in the application specification.

Patent Owner ultimately proceeded with claims directed to the server-side streaming architecture (the Examiner’s “Invention II”), which is consistent with the Web-based, server-mediated media-distribution system described in both the continuation-in-part specification and the parent disclosure. The continuation-in-part application therefore provided additional descriptive detail regarding implementation and processing operations but did not introduce a different invention.

Accordingly, the parent specification reasonably conveys possession of the server-based distribution of newly uploaded media later claimed in the ’925 patent, satisfying the written-description requirement for priority entitlement under 35 U.S.C. §120. See *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). Patent Owner stands on the intrinsic prosecution record before the USPTO.

X. PARENT APPLICATION PROSECUTION HISTORY (APPLICATION NO. 11/744,228)

The prosecution history of parent Application No. 11/744,228 confirms that the USPTO evaluated the server-side media-distribution architecture reflected in the challenged claims and applied a single anticipation reference directed to network-based jukebox distribution systems.

Following a June 4, 2009 non-final Office Action rejecting original claims 1–20, the applicant submitted a response on November 3, 2009 cancelling claims 1–20 and replacing them with new claims 21–23. These replacement claims recited a computer-implemented method in which a musician uploads media to a server, the system transfers the media to Internet jukeboxes in establishments, and the uploaded media becomes available for playback after ingestion by the server system. The administrative claim index confirms that claims 1–20 were cancelled and claims 21–23 became the operative claim set during prosecution.

The USPTO subsequently issued a Final Office Action on January 27, 2010 rejecting claims 21–23 under 35 U.S.C. §102(b) as anticipated by Davis et al., U.S. Pub. No. 2003/0135424. The examiner mapped Davis to the claimed server upload interface, network transfer to connected jukeboxes, and playback availability following upload. The Notice of References Cited issued with the Final Office Action confirms that Davis was the only prior-art reference applied to the replacement claim set.

No further substantive examination occurred. The application was later abandoned on September 8, 2010 for failure to timely respond to the Final Office Action. The abandonment was procedural and did not involve any additional patentability determination beyond the Davis anticipation rejection.

This prosecution sequence establishes three points relevant to the Board's priority analysis.

First, the intrinsic record shows that the parent application disclosure included the server-mediated distribution architecture later claimed in the '925 patent, which the examiner had already recognized as a distinct invention during restriction practice.

Second, the only anticipation theory applied by the USPTO to the server-distribution claim set in the parent application relied on Davis, not audio-processing or playback-normalization references.

Third, the procedural abandonment of the parent application does not alter the content of the written disclosure or the examiner's recognition of the server-side invention described in the specification.

Accordingly, the parent prosecution history confirms continuity between the originally disclosed server-distribution architecture and the challenged claims, and it reinforces that the continuation-in-part application did not introduce a different invention but rather added implementation detail to the same server-mediated media-distribution system described in the parent disclosure.

The examiner's reliance on Davis as the sole anticipation reference in the parent application provides useful context for the Board's evaluation of Petitioner's obviousness theory, which relies on different categories of prior art not applied during examination of the parent disclosure.

Timeline (for clarity)

PARENT APPLICATION (11/744,228)

- May 4, 2007 — Parent application filed
- Jun. 4, 2009 — Non-Final OA (claims 1–20 rejected)
- Nov. 3, 2009 — Claims 1–20 cancelled → claims 21–23 added
- Jan. 27, 2010 — Final OA (Davis anticipation)
- Sept. 8, 2010 — Procedural abandonment

CIP APPLICATION (12/804,665 → '925)

- CIP filed referencing parent (11/744,228)
- Restriction confirms server-side invention (Invention II)
- Server-ingestion / distribution claims allowed
- June 15, 2015 filing receipt (administrative)
- '925 patent issues

XI. THE INSTITUTION DECISION DOES NOT RESOLVE MERITS

The Board's institution decision is preliminary and does not constitute a final determination on the merits. The Institution Decision does not adopt claim constructions, does not validate Petitioner's mappings, and does not resolve priority or architectural disputes. (Paper 10 at 2, 14, 56–57.)

XII. CONCLUSION

Petitioner has failed to demonstrate, by a preponderance of the evidence, that any challenged claim is unpatentable. Patent Owner respectfully requests that the Board deny Petitioner's requested relief and confirm patentability of claims 1–17.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that a true and correct copy of the foregoing **Patent Owner Response in IPR2025-01280** was served on Petitioner's counsel of record by electronic mail

on March **25, 2025**, at the following addresses:

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Dated: March 25, 2025

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