

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPOTIFY USA INC.,
Petitioner,

v.

MANUEL TIJERINO,
Patent Owner.

Patent No. 9,146,925

Inter Partes Review No. IPR2025-01280

PETITIONER'S REPLY TO PATENT OWNER RESPONSE

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Petitioner Spotify USA Inc. (“Spotify” or “Petitioner”) submits this Reply under 37 C.F.R. § 42.23 to the Patent Owner Response filed March 26, 2026 (Paper 14, “POR” or “Response”).

I. INTRODUCTION

The Board should cancel all challenged claims because the Petition establishes their unpatentability, which the POR fails to rebut.

Patent Owner’s response to Ground 1 hinges on reading improper limitations into the claims. Patent Owner proposes construing “processor” as a “server-side processor,” characterizes the claims as limited to “server-side” architectures, and dismisses the prior art based on those hypothetical limitations. But as the Board recognized, the claims are silent regarding any server or server-side processor, and Patent Owner’s unsupported proposal would improperly “read limitations from the ’925 patent specification into the patent claims.” (DI (Paper 10), 26-27.) “Processor” should instead be given its plain and ordinary meaning, consistent with the Petition.

After rejecting these improper limitations, Ground 1 stands un rebutted. Further, the POR addresses only claim 1 and does not separately address claims 2–17, including independent claim 3 and all dependent claims. Nor does the POR address Ground 2, which independently demonstrates that claims 1-17 are unpatentable.

The POR offers no *evidence* to rebut Spotify’s Petition: no documentary evidence, expert declaration, or testimony addressing how a POSITA would understand the claims or prior art. It relies on unsworn argument, which cannot rebut record evidence. *See Wasica Fin. GmbH v. Cont’l Auto. Sys.*, 853 F.3d 1272 (Fed. Cir. 2017). As the sole named inventor of the challenged patent, Patent Owner’s unsupported argument is particularly unreliable. *See Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1347 (Fed. Cir. 2008) (“it is not unusual for there to be a significant difference between what an inventor thinks his patented invention is and what the ultimate scope of the claims is after allowance”).

Additionally, Patent Owner’s asserted 2007 priority date—an issue where he bears the burden—fails under 35 U.S.C. § 120. The ’665 application was filed after the ’228 application went abandoned, defeating co-pendency. Patent Owner then deleted the priority claim during the ’665 prosecution and never reinstated it. The accompanying declaration of Robert L. Stoll, former USPTO Commissioner of Patents, confirms these points. And as Spotify’s supplemental Rosenblatt declaration confirms, the ’228 application does not support the challenged claims. The claims were allowed only after Patent Owner added “on-the-fly mastering” limitations rooted in paragraph 0081 of the ’925 specification—a paragraph not in the ’228 application. (EX1035, ¶41.)

II. CLAIM CONSTRUCTION

The POR proposes construing five claim terms. (POR, 8¹.) The Board should reject Patent Owner’s attempt to narrow “processor” to “server-side processor,” as it did for “server processor” in the Decision on Institution. (DI, 27.) Under *Phillips*, “processor” can only have its plain and ordinary meaning. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

Info-Hold confirms that approach. There, the Federal Circuit reversed a construction that limited “transmit” to transmissions initiated by a server, not by a playback device. *Info-Hold, Inc. v. Applied Media Techs. Corp.*, 783 F.3d 1262, 1266-68 (Fed. Cir. 2015). The court held that the term was neutral as to which device initiated the transmission: nothing in “transmit” suggested an initiation requirement, the claims were indeterminate on that point, and the specification did not clearly restrict the invention to server-initiated transmissions. *Id.* at 1267. Because the intrinsic record showed neither lexicography nor clear disavowal, the court refused to import a server-based limitation into the claim. *Id.* at 1267-68.

The same reasoning applies here. Nothing in “processor” suggests a server-side limitation. The claims do not specify where the processor must be located. And the specification does not restrict the claimed processor to a server-side processor; instead, the disclosed system includes client elements and operations.

¹ Because the POR is unpaginated, page citations are to the native PDF document.

(EX1035, ¶¶66-79.) “Processor” should therefore receive its plain and ordinary meaning, which is neutral as to whether the processor is server-side, client-side, or elsewhere in the claimed system. That is consistent with the Petition, which did not rely on any particular location for any prior art processor and simply mapped “processor” to prior art controllers and CPUs—components that Patent Owner concedes are “generic,” “common,” and “conventional”. (POR, 15-16, 24.) Nor are lexicography or clear disavowal applicable as discussed below.

The Board need not construe the remaining terms (“venue,” “automatically calculating,” “receiving indication of payment,” and “real-time”) to resolve any legitimate dispute. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). As the Petition explained, no express construction of these terms is necessary because the prior art demonstrates unpatentability under any reasonable interpretation. (Pet., 3-4.)

A. Patent Owner’s Proposed Narrowing of “Processor” is Improper Under *Phillips*

Under *Phillips*, as the Board noted, claim terms are given their plain and ordinary meaning as understood by the POSITA, with only two narrow exceptions: “(1) when a patentee sets out a definition and acts as his own lexicographer, or (2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” (DI, 13 (citing *Thorner v. Sony Comput.*

Entm't Am. LLC, 669 F.3d 1362, 1365 (Fed. Cir. 2012)); *Info-Hold* at 1267-68.)

Patent Owner would depart from the plain and ordinary meaning of “processor” by narrowing it to a “server-side processor.” But neither *Phillips* exception applies.

1. No Lexicography for “Processor”

To act as his own lexicographer, an applicant must clearly set forth a definition of a claim term in the specification that differs from its plain and ordinary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Patent Owner did not do so: far from “clearly set[ting] forth a definition” of “processor,” he did not use the term *even once* in the ’925 specification. (EX1001; EX1035, ¶¶67; *Thorner* at 1365-66.) The “exacting” lexicography exception to the plain and ordinary meaning of “processor” thus cannot apply. *Id.*

2. No Disavowal of Claim Scope

Patent Owner also cannot show clear disavowal of non-server-side processors. The intrinsic record shows that the claimed invention encompasses client-side jukebox processors and client-side processing. (EX1035, ¶¶69-79.) Accordingly, as the Board recognized, limiting the claims to “server-side processors”—or, similarly, to server-side ingestion systems, server-side processing, or the POR’s similar characterizations of the claims—would improperly read limitations from embodiments into the claims. (DI, 29, 31-36, 40,

26-27 (citing *In re Am. Acad. of Science Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004)); EX1035, ¶¶77-79.)

a. The Specification Discloses Performing the Claimed Operations With Non-Server-Side Processors

The claims simply recite a “processor.” The processor performs operations that, in the specification, are performed by client devices, such as “client jukebox 3.” (EX1001, 6:59-60; EX1035, ¶69.) This disclosure alone defeats Patent Owner’s “server-side processor” construction.

For example, Limitation [I] recites the processor “automatically analyzing ... audio signals of the new media for determining a root mean square (RMS) value.” (EX1001, 10:26-28.) The specification describes that process as performed by the client jukebox: “the jukebox will master the artist’s track using digital signal processing. First the average volume is checked using the root mean (RMS) formula.” (EX1001, 6:59-60, 7:41-45; EX1035, ¶73.)

The specification notes that “[t]his step can *also* occur on the server,” indicating that the process is not exclusively server-side. (EX1001, 7:47-48 (emphasis added); EX1035, ¶74.) It further explains that the jukebox applies gain based on the RMS value—another operation of the processor in claim 1. (EX1001, 7:44-54, 10:48-51; EX1035, ¶73.) Patent Owner’s construction would thus improperly transform an optional server implementation into a claim requirement.

See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583-84 (Fed. Cir. 1996); *Info-Hold* at 1266-68.

The specification further describes the user interfaces of Limitations [A]-[E] as available when a member “gets on anything with an internet connection, such as a computer, that can upload their media,” noting that “in most digital systems, there are digital user interfaces to interact with the system.” (EX1001, 3:61-64, 4:7-9.) A POSITA would understand those broad disclosures to include client-side devices and processors. (EX1035, ¶¶70, 73.) Patent Owner likewise characterizes user interface functionality as “client-interface functionality.” (POR, 2-3, 62-63; EX1035, ¶¶70-71.)

Additionally, Figure 1 shows “the entire system from start to finish” and includes client devices such as jukeboxes. (EX1001, 3:4-5, 3:57-64, FIG. 1; EX1035, ¶78.) The specification likewise states that the invention “relates particularly” to artists uploading media to a website linked to client devices, and highlights “*draw[ing] together the capabilities of client and server side software.*” (EX1001, 1:32-35, 1:65-67 (emphasis added); EX1035, ¶78.) Moreover, the “client jukebox 3” is “both a client to the system and part of the system”, and its software is “architecture agnostic.” (EX1001, 6:59-60, 8:18-20; EX1035, ¶78.)

These disclosures do not clearly disavow all but server-side processors. Instead, they embrace client-side processors as within the scope of the disclosed

system. *See Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004) (“Absent a clear disavowal ... the patentee is entitled to the full scope of its claim language.”); EX1035, ¶¶78-79. Similarly, Patent Owner’s restriction of the claims to, *e.g.*, a “server-side ingestion architecture,” would improperly limit the claims to selected embodiments. (EX1035, ¶¶77-79.)

b. The Prosecution History Does Not Support Disavowal

The prosecution history confirms there was no disavowal. The POR relies on a Notice identifying two groups of unentered claims: claims 1-3, which Patent Owner calls “client-interface functionality,” and claims 4-20, which Patent Owner calls a “separate, server-side streaming architecture.” (POR, 3-5; EX1002, 201-202, 222-225, 228-229; EX1035, ¶71.) But Patent Owner did not elect a server-only architecture. Instead, he amended independent claims 4 and 20 to include the “particulars of original claim 1,” thereby adding the admitted client-interface recitations to the alleged server-side architecture. (EX1002, 238; EX1035, ¶71.) The Examiner recognized those amendments as “broaden[ing] the scope of the previous invention.” (EX1002, 241-245, 251.) Patent Owner’s prosecution decisions thus show inclusion of admitted client elements, not disavowal. (EX1035, ¶71.)

B. Patent Owner's Other Proposed Constructions Are Immaterial to the Dispute

Patent Owner's other proposed constructions do not require resolution.

Vivid Techs. at 803; *see also Realtime Data* at 1375. Patent Owner does not appear to rely on these proposed constructions for any argument here, and the Petition showed how the claims are unpatentable under any reasonable interpretation. (*See* Pet., 3-4.) To the extent the Board reaches the constructions, it should reject them and apply the terms' plain and ordinary meaning, which is met for Grounds 1 and 2 as shown in the Petition.

Patent Owner's proposed "venue" construction is immaterial because the POR repeatedly characterizes Laut as a "venue-based jukebox system," including one that provides content selection and output at local jukeboxes and calculates venue-based revenue statistics. (POR, 2, 10, 22, 56.)

Patent Owner's proposed constructions of "automatically calculating" and "receiving indication of payment" do not matter because the Petition showed tracking/tallying and system acknowledgement of payment status, and did not rely on cash handling or disbursement execution. Laut tracks downloads for royalty payment (tracking), calculates fees based on plays and delivery mode (tallying), and presents fees paid or owed (system acknowledgement of payment status); and accepts fees, verifies payment, and determines whether the correct fee has been

deposited or verified. (Pet., 33-37; EX1011, [0030], [0032], [0063], [0065], [0080], [0090], [0098], Fig. 16; EX1003, ¶¶74-78.)

Finally, Patent Owner’s “real-time” construction would broaden the claims and add scheduled system-controlled execution, which Laut discloses via scheduled playback on networked jukeboxes. (Pet., 11; EX1011, [0073], [0105]; EX1003, ¶41; POR, 32.)

III. THE CHALLENGED CLAIMS ARE OBVIOUS

All challenged claims are obvious based on Ground 1, and additionally based on Ground 2.

A. Ground 1 Renders the Claims Obvious

1. The References Teach Each Limitation of Claim 1

The POR’s per-limitation rebuttal of Ground 1 suffers from three fundamental defects.

First, as discussed above, the POR repeatedly rewrites the claims to require nonexistent “server-side” limitations. (*See, e.g.*, POR, 5-7, 10, 30.) The Petition showed that Laut in view of Kincaid and Bongiovi meets the elements actually required by the claims.

Second, the POR applies the wrong legal standards for obviousness. For example, the POR faults the Petition for not identifying express disclosures of the claim limitations and for not showing that the cited references can be bodily incorporated into one another. (*See, e.g.*, POR, 6-7.) To establish obviousness,

Ground 1 need not demonstrate that the claim limitations are expressly recited in the references, only that they are met by the references' combined teachings. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). And the test for obviousness is "what the combined teachings of those references" would have suggested to the POSITA—not whether the references are "physically combinable" or whether their features may be "bodily incorporated." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983). Similarly, the POR attacks individual references, which cannot rebut obviousness based on the references' *combined* teachings, as shown in Ground 1. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097-98 (Fed. Cir. 1986).

Third, the POR incorrectly fails to define a POSITA or to evaluate obviousness from a POSITA's perspective. While the Petition presented extensive expert testimony supporting how the POSITA would have understood the claims and the prior art, Patent Owner provides no expert testimony supporting the POR's factual assertions, no contrary POSITA analysis, and no responsive declaration (or any other evidence) addressing how a POSITA would have understood the claims and the references. The Board should afford no weight to the Patent Owner/Inventor's unsupported characterizations of the scope of his own patent. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 985 (Fed. Cir. 1995) (en

banc) (“[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim.”).

a. Preamble

Patent Owner argues that Laut lacks “real-time distribution of newly ingested media under artist control.” (POR, 32-33.) But the preamble instead recites controlling availability of new media for playback in “public venues via a jukebox.” (EX1001, 9:66-10:2.) The Petition showed that Laut teaches artists uploading content and selecting venues for playback, including simultaneous, staggered, or scheduled playback on networked jukeboxes. (Pet., 11; EX1011, [0029]-[0030], [0073], [0105]; EX1003, ¶41.) The POR admits that Laut discloses a “networked jukebox system in which a user may upload content and select venues for playback.” (POR, 32.) Laut’s scheduling satisfies Patent Owner’s proposed construction, which includes scheduled execution and is “not ‘instantaneous playback only.’” (POR, 8, 33.) In any event, Patent Owner’s preamble arguments are moot, because he “does not rely on the preamble for patentability.” (POR, 34.)

b. Limitation [A]

Patent Owner argues that Laut’s interface is a “local endpoint interface” of a “venue-based jukebox appliance,” not an interface provided by a centralized system. (POR, 34-36.) But Limitation [A] requires only “providing, by a

processor, a user interface to interact with a system.” (EX1001, 10:3-4.) The Petition mapped that limitation to Laut’s controller 220, CPU 221, user interface 240, and display 210. (Pet., 11-14; EX1011, [0029]-[0032], Figs. 2A, 4C; EX1003, ¶¶42-44.) For example, users of Laut’s user interface 240 interact with the jukebox system by selecting content choices, selecting venues, and uploading media content (“authorship”). (Pet., 11-18; EX1001, 2:17-35; EX1011, [0032], [0073]; EX1035, ¶70.) Nothing in the claim excludes a jukebox processor or requires a centralized server-side interface. Patent Owner’s contrary argument depends on its improper server-side construction.

c. Limitations [B] and [C]

Patent Owner argues that Laut assumes an existing account and does not expressly disclose adding a user or creating an account. (POR, 37-38.) But obviousness does not require express disclosure. *KSR* at 418. The Petition explained that Laut discloses user accounts, IDs, passwords, and account-based content lists, and that it would have been obvious to create an account through the same user interface used to access and log in to it. (Pet., 14-15; EX1011, [0042]-[0046], [0060]; EX1003, ¶¶45-46.) Patent Owner’s assertion that the account must be created in a centralized ingestion system adds language not found in the claims. (POR, 38.)

d. Limitation [D]

Patent Owner concedes Laut discloses username/password access, but argues that its login merely retrieves user preferences. (POR, 40-41.) Claim 1 requires only a user interface “to log into the system.” (EX1001, 10:9-10.) The Petition showed that Laut’s user ID and password functionality satisfies that requirement. (Pet., 15-16; EX1011, [0042]-[0046]; EX1003, ¶¶47-48.) Patent Owner’s additional “ingestion” and “attribution” requirements are unsupported insertions, not claim limitations. (POR, 40-41.)

e. Limitations [E] and [F]

Patent Owner argues that Laut’s upload functionality is a user-driven distribution workflow involving venue selection, third-party rating, routing, and scheduling, not adding or receiving “new media” into a centralized server-side system. (POR, 9-10, 41-44.) These arguments do not track the claim language, which does not exclude third-party rating, venue selection, or distribution workflows, and does not require any determination of whether media is new—only that it is “not previously stored in the system” as recited in Limitation [E]. (EX1001, 10:11-14.) The Petition showed that Laut permits users to upload content “desired to be played on any or all of the available jukebox systems,” and that Laut’s controller receives and stores content. (Pet., 17-18, 24; EX1011, [0030], [0073]; EX1003, ¶¶49-51, 58.)

f. Limitation [G]

Patent Owner argues that Laut’s metadata is externally generated, not automatically identified; is not for new media; and is not derived from signal analysis. (POR, 44-45.) Limitation [G] requires “automatically identifying ... metadata for the new media and storing the metadata in a database”; it does not require generating the metadata or computing it from signal analysis. (EX1001, 10:14-16.) Metadata derived from a signal is recited in Limitations [I] and [J] (obtaining and storing an RMS value), not Limitation [G]. As the Petition showed, Laut meets Limitation [G] by automatically identifying metadata such as rating, genre, etc. for newly uploaded media, so that it can be presented appropriately in the user interface. (Pet., 18-20; EX1011, [0048]-[0056], [0060]-[0062], [0074]; EX1003, ¶¶52-54.)

g. Limitation [H]

Patent Owner argues that Laut does not disclose a “central storage device,” “automatically enabl[ing]” playback, or an API call. (POR, 46-47.) The Petition explained that Laut’s content server includes a central storage device. (Pet., 20-24; EX1011, [0034], [0073], [0086]-[0087], [0096]-[0100]; EX1003, ¶¶55-59.) Claim 1 does not exclude distributed systems that include central storage. Nor does the claimed “automatically enabl[ing]” require playback without “user-driven and

conditional steps,” such as content selection; to the contrary, Limitation [M] recites playback occurring in response to a jukebox request. (EX1001, 10:19-38.)

Further, whether Laut “disclose[s]” the API call, *see* POR at 46-47, is the wrong inquiry for obviousness, which is shown by the *teachings* of the prior art. *See Merck* at 1097. The Petition showed this, noting the prosecution record: the Examiner treated an API call as equivalent to a general request for a media/song list—such as in Laut—which Patent Owner does not dispute. (Pet., 24; EX1002, 412; EX1003, ¶59.)

h. Limitations [I] and [J]

Patent Owner argues that Kincaid performs playback-stage normalization in a local device, not server-side analysis at ingestion. (POR, 14-15, 48-49.) But Limitations [I] and [J] do not require a server or ingestion-stage processing. The Petition showed that Kincaid teaches automatically analyzing audio to determine RMS-related values, and calculating perceived acoustic power when tracks are “added to the music library.” (Pet., 24-28; EX1012, 4:13-5:32, 6:59-7:56, 11:48-58; EX1003, ¶¶60-66.) That disclosure is consistent with claim 1’s definition of “new media” as media not previously stored in the system. (EX1012, 4:13-15; EX1001, 10:11-13.) Patent Owner’s argument that Kincaid is not itself a networked ingestion system attacks Kincaid in isolation, not the prior art

combination. *See Merck* at 1097-98. In the combination, the Petition relies on Laut, not Kincaid, for the claimed processor. (Pet., 11-14, 26.)

Patent Owner also misreads the RMS limitations. Limitation [I] first recites determining an RMS value, then mathematically manipulating that initial value to *obtain* a *second* RMS value, which is positive and less than 1. Limitation [J] recites storing this *obtained* RMS value, not the initially determined RMS value. The Petition explained how Kincaid meets that sequence: Kincaid first determines an RMS value for the audio signal—then mathematically manipulates that initial value to obtain a scaled normalization gain factor, which is the *obtained* positive RMS value less than 1. (Pet., 24-26.) Kincaid then stores that obtained value as metadata, satisfying Limitation [J]. (Pet., 29.)

Patent Owner’s remaining objections add nonexistent claim requirements. The POR argues that Kincaid stores file-level metadata rather than metadata in a system database, and operates on local, pre-existing tracks. (POR, 49-51.) But Limitation [J] recites only storing the obtained value “as metadata for the new media.” (EX1001, 10:31-32.) It does not require storage in a system database, storage in the same database as Limitation [G], or processing of tracks that were not already in Kincaid’s local library.

i. Limitation [K]

Patent Owner argues that Laut provides only local display information and not metadata over the Internet in response to an API call. (POR, 51-52.) But the Petition showed that Laut provides the claimed metadata for display by the jukebox over an Internet connection, and refers to Limitation [H] for the API-call mapping. (Pet., 29; EX1011, [0074], Fig. 4C; EX1003, ¶¶68.) Patent Owner also argues that Laut's metadata is static rather than RMS-derived. (POR, 51.) But the Petition relies on Kincaid, not Laut, for RMS-related limitations, and claim 1 does not exclude Laut's descriptive metadata such as artist, title, and genre.

j. Limitation [L]

Patent Owner argues that Laut discloses only user-driven selection, not a request from a jukebox to a processor associated with metadata generated by automated processing. (POR, 52-53.) But the claim requires receiving "a request from the jukebox for playback of the new media associated with the displayed metadata." (EX1001, 10:37-39.) The Petition showed that Laut's jukebox requests playback based on displayed metadata such as genre or artist. (Pet., 30-31; EX1011, [0096]-[0100]; EX1003, ¶¶70-71.) The claim neither excludes user-initiated requests nor requires the request to be tied to RMS-derived metadata.

k. Limitation [M]

Patent Owner argues that Laut schedules playback or provides local playback of pre-existing media. (POR, 53-54.) But claim 1 merely requires

streaming requested new media to the jukebox so the jukebox plays audio—as taught by Laut. (EX1001, 10:40-42.) It does not exclude “pre-existing” media. The Petition showed that Laut streams the requested media for playback. (Pet., 32-33; EX1011, [0030]-[0031], [0078], [0087], [0096]-[0101]; EX1003, ¶¶72-73.)

l. Limitation [N]

Patent Owner argues that Laut discloses pre-transaction pricing, user-driven price adjustments, post-hoc royalty accounting, and no venue earnings. (POR, 54-55.) But the claims do not exclude those mechanisms. Claim 1 recites calculating “amounts earned by an artist and a venue playing the new media,” not Patent Owner’s narrower “processor-driven pipeline” for playback-attributed earnings. (EX1001, 10:39-41.) The Petition showed that Laut meets this via fee calculation, additional fees based on number of plays and delivery mode, royalties, venue revenue, and payments to artists and venues. (Pet., 33-35; EX1011, [0063], [0065], [0080], [0090]; EX1003, ¶¶74-76.)

m. Limitation [O]

Patent Owner argues that Laut discloses pay-to-play payment verification or post-hoc summaries, not receiving an indication that an amount earned has been satisfied. (POR, 56-57.) The Petition showed that Laut discloses accepting fees, verifying payment, monitoring money collected, venue-based revenue statistics, and determining whether the correct fee was deposited or verified—disclosures

that teach receipt of an indication of payment. (Pet., 35-37; EX1011, [0030], [0032], [0053]-[0054], [0092], [0098]; EX1003, ¶¶77-78.) The claim does not exclude user-initiated payment, pre-playback payment, or aggregated payment records, although the Petition does not rely on those features.

n. Limitation [P]

Patent Owner argues that Kincaid applies precomputed gain during playback, not active normalization of newly ingested media in a processor-driven system. (POR, 57-58.) Claim 1 recites applying gain based on the obtained positive RMS value less than 1; it does not limit when that gain may be computed, or exclude playback-side application. (EX1001, 10:48-51.) The Petition showed that Kincaid teaches the claimed gain application. (Pet., 24-26, 37; EX1012, 8:2-5, 9:21-33; EX1003, ¶79.)

o. Limitation [Q]

Patent Owner argues that Bongiovi discloses local DSP applied to an existing playback signal, not compression in a server-side ingestion pipeline. (POR, 58-60.) But Limitation [Q] requires only that audio signals are compressed to reduce dynamic range based on preset ratio and threshold values—admitted “standard DSP parameters.” (EX1001, 10:49-55; POR, 59.) The Petition showed that Bongiovi teaches that limitation. (Pet., 39-42; EX1013, [0011], [0014]-[0020], [0051]-[0054], [0080], [0131]-[0138]; EX1003, ¶¶80-85.) The claim does

not require server-side compression, ingestion-stage compression, or a compression step tied to metadata generation. Indeed, the specification describes corresponding compression as jukebox DSP processing. (EX1001, 7:54-67.)

2. The POSITA Would Have Been Motivated to Combine Laut, Kincaid, and Bongiovi

Patent Owner argues that a POSITA would not have combined Laut with Kincaid, or further with Bongiovi, because the references address “playback-stage audio processing”, which is “fundamentally different” from the “server-side” claims. (POR, 9-18, 19-29; EX1035, ¶¶85.) These arguments fail by incorrectly assuming that the claims exclude playback-stage audio processing and require specific server-side processing. (POR, 10-18, 19-29.) The claim language and specification confirm that playback-stage audio processing—including volume adjustment, normalization, and compression at the jukebox—is within the scope of the challenged claims and that the claims are not limited to server-side processing. (EX1035, ¶¶82-90.)

Indeed, the claim language itself contradicts Patent Owner. Claim 10 recites “automatically adjusting ... volume of the media during playback”. (EX1001, 12:11-15.) Claim 17 likewise recites media “played by the jukebox with substantially a same volume” based on adjustment “during playback.” (EX1001, 12:41-44.) These claims confirm that playback-stage volume concerns are *within*

the challenged claims—including their parent claim 1—not “fundamentally different” from them. (EX1035, ¶¶84-85.)

The specification confirms the same. The claims were allowed only after Patent Owner added the “on-the-fly mastering” limitations [I], [J], [P], and [Q], which the applicant and Examiner identified as supported by paragraph 0081 of the ’925 specification. (EX1002, 402-408, 412, 439-443; EX1035, ¶86.) Paragraph 0081 explains that “the jukebox will master the artist’s track using digital signal processing,” including during playback: “the track begins to play” while the system applies digital signal processing filters, gain, and compression. (EX1035, ¶87; EX1001, 7:38-60.) These jukebox processing operations correspond at least to limitations [P] and [Q]. (EX1035, ¶87.)

These operations are performed by the client jukebox, as one of its “main features,” and one step “can also occur on the server,” confirming that server-side performance is optional, not required. (EX1001, 7:41-47, 8:40-44; EX1035, ¶89.) The specification also states that the process is “[a]gnostic to any method mentioned above for obtaining the audio file[.]” (EX1001, 7:38-44; EX1003, ¶89.) These disclosures contradict that the claims are limited to server-side processing or require a particular “server-side ingestion and analysis system.” (POR, 12-13; EX1003, ¶89.)

The '925 specification gives the same rationale the Petition identified: making tracks sound “relatively the same volume” and preventing poorly mixed tracks from sounding harsh or damaging venue speakers. (EX1001, 7:57-60; EX1003, ¶¶88, 90.) The Petition explained that a POSITA would have combined Laut with Kincaid to ensure consistent loudness, and added Bongiovi to improve sound quality in noisy environments. (Pet., 27-28, 39-41; EX1003, ¶¶65-66, 83-85; EX1035, ¶¶88, 90.)

Patent Owner’s “playback-stage” rebuttal thus reinforces the Petition’s motivation-to-combine rationale. Laut’s networked jukebox system plays music tracks that vary in loudness; Kincaid teaches automatic normalization to address that problem; and Bongiovi teaches dynamic range compression to improve sound quality by reducing differences between loud and quiet portions of audio. (Pet., 27-28, 39-41; EX1011, [0048], [0073]; EX1012, 1:35-43; EX1013, [0014]-[0020], [0051], [0116]-[0117]; EX1003, ¶¶65, 80-84.) These benefits directly track the purpose of the “on-the-fly mastering” limitations that led to allowance. (EX1035, ¶90.)

3. The POSITA Would Have Had a Reasonable Expectation of Success

The POR also supports that a POSITA would have had a reasonable expectation of success. Patent Owner does not dispute Petitioner’s level of skill, adopted by the Board, which includes graduate-level technical training and

experience in computer-based digital audio distribution and playback. (DI, 11-12; EX1003, ¶¶28.) Nor does Patent Owner dispute that Laut, Kincaid, and Bongiovi use conventional computing components and common file formats compatible with a wide range of systems. (POR, 24.) The POR admits “compatibility at the level of generic hardware and playback processing,” acknowledges that Kincaid’s signal processing is compatible with a “generic computing environment,” and confirms that Bongiovi’s techniques may be implemented on various playback devices and broadly applied to playback-stage signal processing. (POR, 24-25, 29.) The combination thus uses known components for their ordinary purposes to achieve predictable benefits: networked jukebox distribution, volume normalization, and dynamic range compression.

The Petition explained why a POSITA would have expected success in view of those compatibilities and the advanced level of ordinary skill. (Pet., 28, 41-42.) Patent Owner does not credibly rebut that showing. Its demand for details, such as “how metadata would be generated,” ignores that a POSITA is not an automaton and would not need step-by-step implementation instructions. *See KSR* at 421. Patent Owner also faults Bongiovi for not addressing new media, ingestion, metadata generation, or distribution. (POR, 20, 22-23, 28-29, 58-60.) But in the prior art combination, the Petition relies on Bongiovi for dynamic range compression, not those features. And Patent Owner’s “integration” argument

improperly demands bodily incorporation, which is not the obviousness test.

(POR, 28; *Keller* at 425.)

4. Claim 3 and the Dependent Claims Are Also Obvious

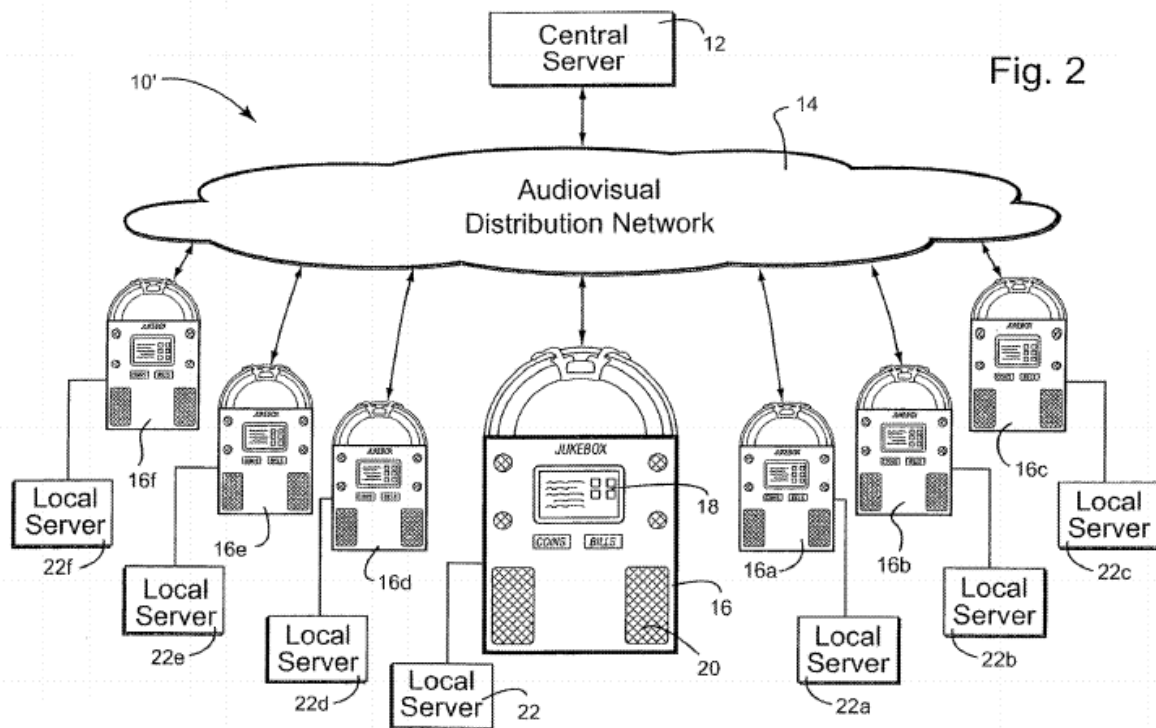
The POR does not separately rebut the arguments against the unpatentability claim 3 or any dependent claim. The limitations of claim 3 are analogous to limitations of claim 1, and claims 2 and 4-17 depend from claim 1. Patent Owner's arguments against claims 2-17 therefore fall with its arguments against claim 1. Because those arguments fail, claims 2-17 are obvious for at least the reasons set forth with respect to independent claim 1.

B. Ground 2 is Unrebutted and Independently Renders the Claims Obvious

Ground 2 independently renders claims 1-17 obvious over Dion in view of Nathan-109 for the reasons set forth in the Petition. (Pet., 56-100; EX1003, ¶¶142-248.) Patent Owner does not address or respond to Ground 2 in the POR. *See* Paper 11, 11 (“any patentability arguments not raised in the response may be deemed waived”); *In re Nuvasive, Inc.*, 842 F.3d 1376, 1380-81 (Fed. Cir. 2016).

Dion's architecture is relevant to Patent Owner's asserted “server-side” theory, although the claims are not limited to that theory. Dion discloses Internet-enabled digital downloading jukeboxes that communicate with a central server over a network, including for content updates, user-tailored music management, royalty accounting, and payment for songs played. (Pet., 56-59; EX1005, Abstract,

2:31-42, 3:1-10, 9:1-17, 9:40-67; EX1003, ¶¶142-146.) Claim 1’s processor is met by a processor of Dion’s jukebox, which can “incorporate[]” a local server, as shown in Fig. 2, depicted in the Petition:



(Pet., 57, 60; EX1005, 55:48-49, Fig. 2, Figs. 29B-29E; EX1003, ¶144.)

As the '925 specification explains, “the terms, *server*, *cloud*, and *service* are interchangeable and mean the same thing.” (EX1001, 2:5-6 (emphasis added).) Consistent with the patent’s explanation of “server,” Dion’s jukebox local servers provide services: “The collective group of local servers may also act as a network of distributed content servers that can be controlled by the central server through each jukebox device to provide services to other devices, such as, for example,

other jukebox devices.” (EX1005, 1:45-50; Pet., 56-59, 68-72.) The services can include, *e.g.*, music downloads. (EX1005, 38:9-35; Pet., 60-61.)

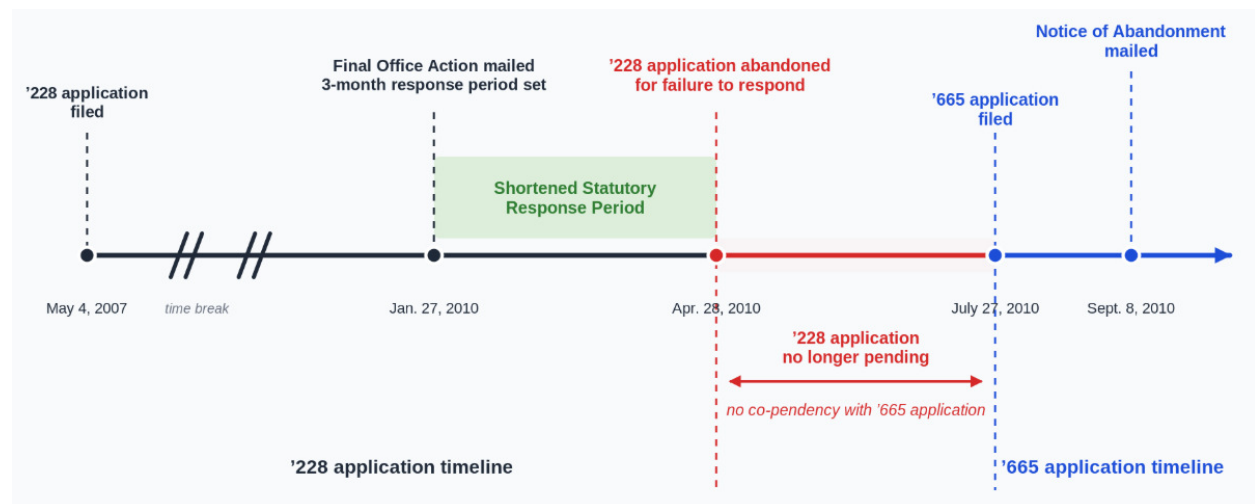
IV. THE '925 PATENT IS NOT ENTITLED TO AN EARLIER FILING DATE

The POR appears to assert that the '925 patent is entitled to the benefit of the filing date of application No. 11/744,228.² (POR, 60-66; Paper 9; EX1027, EX1028). But a patent's claims “are not entitled to an earlier priority merely because the patentee claims priority.” *In re NTP, Inc.*, 654 F.3d 1268, 1276 (Fed. Cir. 2011). Patent Owner bears the burden to show that each challenged claim satisfies § 120, including (a) co-pendency, (b) a specific reference to the earlier application, and (c) support in the earlier application. 35 U.S.C. § 120; *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 906 (Fed. Cir. 2018); DI, 51; EX1033, ¶122. As Commissioner Stoll opines, Patent Owner cannot satisfy at least the co-pendency and specific reference requirements. (EX1033.) And as Mr. Rosenblatt opines, Patent Owner additionally cannot satisfy the support requirement. (EX1035.) Each defect independently defeats the asserted benefit.

² Although Patent Owner argues for an earlier effective filing date, the POR does not identify any reference that Patent Owner seeks to antedate on that basis. *See* DI, 61.

A. No Co-pendency

Section 120's co-pendency requirement requires the later application to be filed before the earlier application is abandoned. The '665 application that became the '925 patent was not co-pending with the '228 application. (EX1033, ¶¶71-86.) The Examiner mailed a Final Office Action for the '228 application on January 27, 2010, setting a three-month shortened statutory period to April 27, 2010. (EX1033, ¶74.) Patent Owner did not respond, appeal, or obtain an extension, so the '228 application became abandoned at midnight on April 28, 2010—months before the '665 application was filed on July 27, 2010 as shown below. (EX1029, 1-7, 106; EX1033, ¶¶75-76; MPEP § 711.04(a).)



(EX1011, (22); EX1033, ¶78.)

In the DI, the Board incorrectly identified the abandonment date as

September 8, 2010—when the Notice of Abandonment was mailed. (DI, 53; EX1033, 83-85.) The Notice of Abandonment merely memorialized abandonment that had already occurred in April 2010; it did not extend pendency. (EX1033, ¶¶81-86; *see TankLogix, LLC v. SitePro, Inc.*, IPR2025-00651, Paper 11 at 28-30 (PTAB Oct. 10, 2025); *see also Urologix, Inc. v. Prostalund AB*, 227 F. Supp. 2d 1033, 1035-40 (E.D. Wis. 2002).

B. No Reference to the Earlier-Filed Application

The '925 patent also lacks the required reference to the '228 application. (EX1033, ¶113.) For this pre-AIA application, the reference had to appear in an application data sheet or in the first sentence(s) of the specification. (EX1033, ¶¶113-128; MPEP § 211.02.) It did not: Patent Owner filed no application data sheet, and he expressly deleted the specification's priority reference on September 2, 2014, after the Examiner stated that the '228 application failed to provide support or enablement. (EX1002, 273, 306, 311, 316; EX1033, ¶¶113-128.)

Patent Owner argues that an Advisory Action dated September 15, 2014, declined to enter the deletion, but the issue is moot: in a subsequent Request for Continued Examination, the applicant expressly requested the USPTO to consider the September 2, 2014, amendments. (POR, 60; EX1002, 306-316, 332-333; EX1033, ¶124.) The Examiner entered the deletion, as confirmed by the issued patent and corrected filing receipt, which indicate that no domestic benefit was

claimed. (EX1001; EX1002, 448-449; EX1033, ¶124.)

Nor do Patent Owner’s USPTO screenshots of publication and bibliographic data change the analysis. (EX1027; EX1028; EX1033, ¶125.) The data shown are from 2010 through 2012, before the applicant’s deletion of the reference in 2014. (EX1033, ¶¶123-128.) The failure of the specification to include the specific reference required by § 120 controls. (EX1001; EX1030; EX1033, ¶113.)

The DI suggested that Patent Owner might be able to “perfect” the claim. (DI, 60.) Not here. Section 120 “places the burden on the patent owner to provide a clear, unbroken chain of priority” and is enforced strictly. *Droplets, Inc. v. E*TRADE Bank*, 887 F.3d 1309, 1317 (Fed. Cir. 2018) (citation omitted). Patent Owner cannot reinstate his deleted priority claim at least because he cannot meet the “unintentional delay” requirement. *See* EX1033, ¶114-121; DI, 58-60; 35 U.S.C. §§ 254-255; MPEP § 211.03; *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1356-57 (Fed. Cir. 2003); *Droplets* at 1317.

C. The ’228 Application Does Not Support the Challenged Claims

The minimal ’228 application does not support the challenged claims. The ’925 application added extensive new disclosure, including paragraph 0081, which the Examiner and applicant identified as support for the “on-the-fly mastering” limitations added to obtain allowance. (EX1002, 408, 412; EX1035, ¶¶32-61.) Those limitations—at least [I], [J], [P], and [Q]—recite RMS analysis and

manipulation, storage of the obtained RMS value as metadata, gain normalization, and dynamic range compression. The '228 application does not disclose those limitations, expressly or otherwise, and thus does not meet § 112's written description requirement for any challenged claim. (EX1035, ¶¶35-61.) Patent Owner's "server-based distribution" argument does not address those limitations and thus cannot satisfy § 112. (POR, 65; EX1035, ¶¶59-61.)

Dated: June 17, 2026

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Certificate of Word Count (37 C.F.R. § 42.24)

I hereby certify that this PETITIONER’S REPLY TO PATENT OWNER RESPONSE has 6,029 words (as counted by the “Word Count” feature of the Microsoft Word™ word-processing system), exclusive of a table of contents, a table of authorities, a listing of facts which are admitted, denied, or cannot be admitted or denied, a certificate of service or word count, or an appendix of exhibits.

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

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

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