

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'S SUR-REPLY

I. INTRODUCTION

Petitioner's Reply does not cure the deficiencies identified in Patent Owner's Response ("POR"). Instead of demonstrating that the asserted prior-art combinations disclose the challenged claims as written, the Reply largely reframes Patent Owner's arguments, expands the expert theories advanced in the Petition, and repeatedly relies upon isolated disclosures from separate references without demonstrating that the asserted combinations teach the claimed relationships recited in the claims.

Although the Petition asserted two grounds of unpatentability, the Board's Institution Decision analyzed Ground 1 in detail and concluded that Petitioner had demonstrated a reasonable likelihood of prevailing based upon the Laut/Kincaid/Bongiovi combination. Paper 10, 27–53. The Board thereafter exercised its statutory authority to institute trial on all asserted grounds. Accordingly, both grounds remain part of this proceeding. Nevertheless, because the Institution Decision's substantive analysis focused on Ground 1, Patent Owner's POR principally addressed the deficiencies identified in the Board's analysis of that asserted combination. Rather than responding to those deficiencies, Petitioner now attempts to rely on Ground 2 and additional expert analysis as an alternative basis for unpatentability instead of demonstrating that the instituted combination satisfies the challenged claims.

The Reply repeatedly asserts that Patent Owner improperly imports limitations from the specification by describing the claimed architecture as involving processor-performed media ingestion and network distribution. That characterization misstates Patent

Owner's position. Patent Owner does not ask the Board to import unclaimed limitations into the claims. Rather, Patent Owner relies on the claim language itself, read in light of the intrinsic record, to demonstrate the chronological relationship expressly recited by the claims. Claim 1 begins with "new media", expressly defined as media "not previously stored in the system," and requires the processor to receive that new media, identify metadata, determine an RMS value, store the resulting RMS value as metadata for the new media, provide access through the claimed Internet/API architecture, and thereafter respond to client requests by providing metadata and streaming media. The later recitation that normalization may be performed by the processor or jukebox does not eliminate or rewrite those earlier processor-performed limitations.

Petitioner further argues that Patent Owner failed to separately address independent Claim 3 and Ground 2. That characterization overlooks both the structure of the Petition and the substance of the POR. The Petition itself largely analyzed Claim 3 by incorporating the corresponding Claim 1 analysis, and the POR directly addressed the underlying claim limitations and architectural relationships upon which those mappings depended. Likewise, although the Board instituted trial on both asserted grounds, the Institution Decision's substantive analysis centered on Ground 1, and the POR responded to the deficiencies identified by the Board. Petitioner's Reply cannot avoid those deficiencies simply by recasting the same limitations under a different asserted combination.

Finally, Petitioner's Reply repeatedly relies upon new declarations from Dr. Rosenblatt

and former Commissioner Stoll to expand the theories presented in the Petition. Those declarations do not alter the intrinsic record. The prosecution history demonstrates that the Examiner specifically considered the claimed RMS and metadata limitations, the written-description support relied upon by Patent Owner, and the amendments that ultimately resulted in allowance. The Reply therefore does not establish that the asserted combinations disclose the challenged claims as written, nor does it demonstrate that the prosecution history or priority record compel a different result.

Accordingly, as discussed below, Petitioner's Reply fails to remedy the deficiencies identified in the POR, and the challenged claims have not been shown to be unpatentable by a preponderance of the evidence.

II. Spotify Cannot Avoid Its Burden by Recasting Ground 2 as a Substitute Theory

A. The Institution Decision's Substantive Analysis Focused on Ground 1

Although the Petition asserted two grounds of unpatentability, the Board's Institution Decision did not analyze the asserted grounds equally. Rather, the Decision conducted its substantive analysis using Ground 1—the combination of Laut, Kincaid, and Bongiovi—to determine whether Petitioner had demonstrated a reasonable likelihood of prevailing under 35 U.S.C. § 314(a). The Decision analyzed the asserted rationale to combine, reasonable expectation of success, and the limitation-by-limitation mapping for the challenged claims with respect to the Ground 1 combination before concluding that Petitioner had satisfied the institution standard.

By contrast, although Ground 2 remained part of the proceeding and was ultimately included within the Board's institution order, the Decision did not undertake the same detailed preliminary merits analysis of the Dion/Nathan combination. Instead, the Institution Decision summarized the asserted references and instituted trial on all grounds after determining that Petitioner had demonstrated a reasonable likelihood of prevailing based upon the first asserted ground.

That characterization misstates both the procedural posture of this proceeding and the substance of the POR. Patent Owner addressed the underlying claim limitations and the asserted combinations upon which the Petition relied. Because the Institution Decision's substantive analysis focused on Ground 1, the POR necessarily focused on the arguments the Board itself identified as supporting institution.

Petitioner cannot now avoid responding to those deficiencies by simply shifting its emphasis to Ground 2 or by relying on expanded expert declarations submitted after institution.

Nor does the Reply cure the deficiencies identified in the POR. Rather than demonstrating where the asserted combinations disclose the claimed sequence of operations, Petitioner increasingly relies on isolated teachings drawn from different references and asks the Board to reconstruct the challenged claims through hindsight. As discussed below, the Reply repeatedly combines Laut's jukebox architecture, Kincaid's normalization techniques, Bongiovi's general digital signal processing, and Ground 2 references such as Nathan and Dion without demonstrating that the asserted

combinations teach the claimed integrated workflow beginning with new media not previously stored in the system, processor-performed media ingestion, metadata generation, RMS metadata storage, Internet/API distribution, and subsequent playback processing. Accordingly, while Ground 2 is properly before the Board as part of the instituted trial, Petitioner's Reply should not be permitted to transform Ground 2 into a substitute theory that avoids addressing the specific deficiencies identified in Patent Owner's Response to the Board's substantive Ground 1 analysis.

III. Spotify Mischaracterizes the Claimed Architecture and the Intrinsic Record

A. Petitioner Improperly Collapses Distinct Stages of the Claimed Workflow

Throughout the Reply, Petitioner attempts to reduce the challenged claims to isolated concepts such as processors, RMS calculations, normalization, compression, and digital signal processing. That approach does not address the invention actually claimed. Rather, the issue is whether the asserted prior-art combinations disclose the specific sequence of operations and relationships expressly recited by the claims. Petitioner repeatedly argues that Patent Owner improperly imports a "server-side processor" limitation from the specification. That is not Patent Owner's position. Patent Owner relies on the claim language itself, read in the context of the intrinsic record, which assigns different operations to different stages of the claimed workflow.

Claim 1 begins by defining "new media" as media "not previously stored in the system."

EX1001, Claim 1, Element E. The claims therefore do not begin with an existing media library or an existing audio track selected for playback. Instead, the claimed invention begins when previously unavailable media enters the system for the first time.

The processor is then required to perform the upstream media-ingestion operations. Specifically, the processor receives the new media (Element F), automatically identifies metadata for the new media and stores that metadata in a database (Element G), stores the new media in a central storage device while providing client software installed in the jukebox access through an API call over the Internet (Element H), automatically analyzes the audio signals of the new media to determine a root mean square ("RMS") value (Element I), and stores the obtained RMS value as metadata for the new media (Element J). The processor thereafter provides metadata over the Internet in response to the API call (Element K), receives the playback request (Element L), and streams the requested media (Element M).

Only after those processor-performed ingestion and distribution operations does Claim 1 recite the later playback-stage digital signal processing. Element P provides that the audio signals of the new media are normalized by "the processor or jukebox" by applying gain based upon the previously obtained RMS value, and Element Q further recites compression using preset compression parameters.

Thus, the claims expressly distinguish between the earlier generation and storage of RMS-derived metadata and the later use of that information during playback processing.

Petitioner's Reply effectively treats the later "processor or jukebox" language as though it rewrites the earlier claim limitations governing receipt of new media, metadata generation, RMS determination, and metadata storage. The claims do not say that. The phrase "processor or jukebox" appears only in the later playback limitations after the processor has already completed the claimed upstream media-processing functions. Reading the claims as Petitioner proposes collapses distinct claim limitations into a single generalized processor analysis and ignores the chronology expressly recited by the claims.

The prosecution history reinforces this distinction. During prosecution, the Examiner did not dispute that RMS calculations or digital signal processing were known techniques. Instead, the prosecution focused on the claimed relationship between analyzing newly received media, determining an RMS value, storing the resulting value as metadata associated with that new media, and subsequently using that information within the claimed distribution architecture. Those amendments were considered by the Examiner before allowance and became part of the issued claims. Petitioner therefore cannot reduce those claim limitations to generalized audio-processing concepts divorced from the claimed workflow.

The asserted references likewise address different portions of the media lifecycle. Laut is directed to networked jukebox operation and content distribution. Kincaid addresses audio normalization of existing audio tracks. Bongiovi teaches general digital signal processing and mastering techniques. Nathan is directed to managing jukebox systems

having local memory storing audiovisual items. Petitioner identifies individual teachings from each reference but never demonstrates where the asserted combinations disclose the complete claimed sequence beginning with new media not previously stored in the system, followed by processor-performed media ingestion, metadata generation, RMS metadata storage, centralized storage, Internet/API distribution, and only thereafter later playback normalization and compression.

Accordingly, the dispute is not whether processors, RMS calculations, normalization, or compression were individually known. The question is whether Petitioner has shown that a person of ordinary skill would have combined those separate teachings to produce the particular architecture and chronological workflow expressly required by the challenged claims. The Reply does not make that showing.

B. Petitioner Improperly Treats the Later “Processor or Jukebox” Language as Rewriting the Earlier Claim Limitations

Petitioner's Reply repeatedly argues that Patent Owner improperly limits the claimed "processor" to a server-side processor and relies on the specification's discussion of jukebox-based digital signal processing to conclude that the earlier processor limitations are not limited to processor-performed operations. That argument misreads both the claims and the specification.

Rather, Patent Owner relies on the express sequence of operations recited by Claim 1. The claim itself assigns specific functions to the processor before it later provides that

normalization may be performed by the processor or jukebox. Those are different claim limitations performing different functions at different stages of the claimed workflow.

The earlier limitations are unequivocal. After the new media is added to the system and received by the processor, the processor automatically identifies metadata for the new media and stores that metadata in a database. EX1001, Claim 1, Elements F-G. The processor then stores the new media in central storage while enabling client software installed in the jukebox to access the metadata through an Internet API. Id., Element H. Before any playback request is received, the processor automatically analyzes the audio signals of the new media to determine a root mean square ("RMS") value, mathematically manipulates that value to obtain a positive RMS value less than one, and stores the obtained RMS value as metadata for the new media. Id., Elements I-J. The processor then provides that metadata over the Internet in response to the API call. Id., Element K. Only after those operations have occurred does the processor receive a request from the jukebox for playback and stream the requested media. Id., Elements L-M.

Only after this sequence does Claim 1 recite that the audio signals of the new media are normalized by "the processor or jukebox" using the previously obtained RMS value. EX1001, Claim 1, Element P.

Thus, the alternative "processor or jukebox" language first appears in Element P, after the processor has already completed the claimed receipt of new media, metadata generation, RMS analysis, RMS metadata storage, Internet/API response, playback

request, and streaming operations.

Petitioner's analysis effectively rewrites the claim by allowing the later "processor or jukebox" language to redefine the earlier processor limitations. Nothing in the claim authorizes that reading. The alternative recited in Element P applies only to the normalization step. It does not modify the earlier limitations requiring that the processor receive the new media, identify metadata, determine the RMS value, store the RMS value as metadata, provide the metadata over the Internet, receive the playback request, and stream the requested media.

The specification likewise does not support Petitioner's interpretation. Paragraph 0081 explains that the jukebox may perform digital signal processing during playback and further states that "[t]his step can also occur on the server." Petitioner relies heavily on that disclosure. However, that discussion concerns the later playback-stage processing corresponding to the claimed normalization and compression limitations. It does not alter the earlier claim language requiring processor-performed analysis of newly received media and storage of the resulting RMS value as metadata before the jukebox requests playback. Reading the later embodiment as rewriting the earlier claim limitations improperly collapses distinct stages of the claimed workflow into a single generalized processing operation.

This distinction is particularly significant because Petitioner's obviousness theory depends upon Kincaid. As Petitioner acknowledges, Kincaid calculates perceived acoustic power when tracks are added to a music library and applies normalization gain

during playback. But even accepting that disclosure, Petitioner's argument still does not identify where the asserted combination teaches the claimed relationship requiring the processor to analyze newly received media, store the obtained RMS value as metadata for that new media, provide that metadata over the Internet, and only thereafter respond to a jukebox playback request using the previously generated metadata. Instead, the Reply isolates individual DSP concepts while overlooking the chronology and relationships expressly recited by the claims.

Accordingly, Patent Owner's position does not depend upon importing a "server-side processor" limitation into the claims. It depends upon applying the claim language as written. Petitioner's Reply does not demonstrate that the asserted combinations disclose the complete sequence recited by Claim 1, nor does it explain why the later "processor or jukebox" language should be treated as rewriting the earlier processor limitations.

C. Petitioner Conflates Distinct Metadata Disclosures Without Establishing the Claimed Relationship

The Reply treats the word "metadata" as though any information associated with an audio file satisfies the claims. It does not. The asserted references disclose different information, generated by different actors, for different purposes, at different stages of operation. For Limitation [G], Petitioner relies on Laut's descriptive information,

including ratings, genre, artist, and title. Reply 15; Pet. 18–20. That information is used to categorize, search, display, or select content. For Limitations [I] and [J], however, Petitioner turns to Kincaid and relies on a calculated normalization parameter associated with an audio track. Reply 16–18; Pet. 24–29. Bongiovi supplies neither category. Bongiovi describes a signal-processing chain using gain adjustments, filters, compressors, and equalization to alter an input audio signal and produce improved sound at an output device. EX1013 ¶¶ 4, 11, 14–21. Its disclosure concerns processing an audio signal, not identifying or storing metadata for new media.

Claim 1 recites a particular relationship among these limitations. The claimed processor receives media that is “new if not previously stored in the system,” automatically identifies metadata for that new media, stores the metadata in a database, stores the media centrally, analyzes the audio signals to obtain the recited RMS-derived value, and stores that obtained value “as metadata for the new media.” EX1001, claim 1, Limitations [E]–[J]. The claim then requires the processor to provide metadata over the Internet in response to an API call before receiving a playback request and streaming the requested media. Id., Limitations [K]–[M].

The Reply does not identify where the proposed combination establishes that relationship. Laut’s title, artist, genre, and rating information is not the RMS-derived value required by Limitations [I] and [J].

Kincaid’s normalization information does not supply Laut’s Internet/API database arrangement or establish that Laut’s processor performs the claimed analysis and stores

the resulting value as metadata for the same newly received media. Bongiovi supplies only a downstream audio-processing technique; it does not generate the claimed metadata, store that metadata, or provide it through the claimed request-and-response architecture.

Petitioner may rely on separate references for separate limitations, but it must still explain how the asserted combination teaches the claim as a whole. Merely placing Laut's descriptive catalog information, Kincaid's normalization parameter, and Bongiovi's compression process beside one another does not establish the claimed processor-mediated relationship among receipt of new media, analysis, metadata creation and storage, API access, request, and streaming.

D. Kincaid Does Not Teach the Claimed RMS-Derived Metadata Workflow

The Reply argues that Kincaid satisfies Limitations [I] and [J] because Kincaid analyzes audio when tracks are added to a music library, calculates a normalization gain factor, and associates that factor with the track. Reply 16–18. That argument does not answer the limitation actually disputed. Kincaid is directed to normalizing the perceived loudness of a digitally encoded audio track, including applying a normalization gain factor during playback. Its abstract and claims describe selecting or processing an encoded track, calculating perceived acoustic power, calculating a normalization gain factor, associating that gain factor with the track, and applying it during playback. EX1012, Abstract, claim 1. Its Figure 2 likewise ends with associating a scaled

normalization gain factor with the selected track, while Figure 3 applies that factor when the track is played. Id., Figs. 2–3.

Claim 1 requires more than the existence of a stored playback parameter. Limitation [I] requires the processor to determine an RMS value from the audio signals of the new media and further mathematically manipulate that RMS value to obtain a positive RMS value less than one. Limitation [J] then requires the processor to store that obtained RMS value less than one as metadata for the new media. EX1001, claim 1, Limitations [I]–[J].

Petitioner equates Kincaid’s scaled normalization gain factor with the claim’s “obtained positive RMS value less than 1.” Reply 17. But a gain factor calculated from perceived acoustic power is not automatically the RMS value identified by the claim. The Reply must establish that Kincaid’s stored quantity is the claimed mathematically manipulated RMS value, not merely another parameter calculated from audio-analysis results. Labeling both quantities “normalization information” does not make them the same limitation.

Nor does Kincaid supply the surrounding claimed relationship. In Claim 1, the processor’s RMS analysis and metadata storage occur after receipt and central storage of new media, but before the processor provides metadata over the Internet, receives the jukebox request, and streams the requested media. EX1001, claim 1, Limitations [E]–[M]. Kincaid does not disclose that Internet/API workflow, central metadata access by jukebox client software, or a processor providing the stored RMS-derived metadata

before responding to a playback request.

The point is that Petitioner still must explain how Kincaid's local track-normalization process is incorporated into Laut so that Laut's claimed processor performs the analysis, stores the particular obtained value as metadata for the newly received media, and then uses that metadata within the claim's Internet/API request-and-streaming sequence. The Reply repeats that Kincaid can run on conventional computing hardware, but common hardware does not supply the missing functional relationship.

E. Petitioner Mischaracterizes Paragraph [0081] and the Prosecution History

Petitioner repeatedly relies on paragraph [0081] of the specification to argue that the challenged claims encompass playback-stage digital signal processing and that a person of ordinary skill in the art would therefore have been motivated to combine Laut, Kincaid, and Bongiovi. Reply 21–23. That argument mischaracterizes both the prosecution history and the purpose for which paragraph [0081] was cited during examination.

The prosecution record demonstrates that paragraph [0081] was not relied upon as evidence that the prior art taught the claimed invention. Rather, it was cited to answer a written-description rejection under 35 U.S.C. § 112(a). In the Final Office Action dated May 2, 2014, the Examiner rejected then-pending claims 9 and 10 because, although the specification disclosed determining an average volume using an RMS calculation, the Examiner concluded that the specification did not adequately describe storing that value

as metadata or the claimed user-interface functionality. The Examiner specifically discussed paragraphs [0067] and [0081], observing that they described calculating average volume, but concluded that they did not expressly disclose metadata including the average volume as then claimed.

Applicant responded by amending the claims and explaining that the amended limitations were fully supported by the original disclosure. The September 2, 2014 Amendment expressly states that the amendments to claims 9 and 10 "find support in paragraphs 0067-0068 and 0081" and requests withdrawal of the § 112 rejection. The response did not argue that Laut, Kincaid, Bongiovi, or any other prior-art reference disclosed the amended limitations. Nor did it contend that paragraph [0081] demonstrated that those references should be combined. Instead, the amendment addressed only whether the original specification reasonably conveyed possession of the claimed invention. That is a fundamentally different inquiry from obviousness.

The amended claims themselves further illustrate this point. Claim 8 requires the processor to automatically analyze uploaded media for determining an average volume. Claim 9 was amended to require storing that average volume in the central storage device. Claim 10 was amended to require adjusting the volume during playback by either the processor or the jukebox based on the previously determined average volume. These amendments correspond directly to the Examiner's written-description concerns and explain why Applicant cited paragraphs [0067]-[0068] and [0081] as intrinsic

support.

Petitioner now attempts to transform that successful § 112 response into evidence supporting its obviousness theory. But the prosecution history does not support that inference. The Examiner's obviousness analysis proceeded under an entirely different set of references, including Davis and Gunaseelan, while separately evaluating whether the amended claims were adequately supported by the specification. The fact that Applicant demonstrated written-description support for the amended claims does not establish that Laut, Kincaid, and Bongiovi teach or suggest the claimed combination. Nor does paragraph [0081] provide the bridge missing from Petitioner's combination. Paragraph [0081] explains that digital signal processing may be performed during playback and that one step "can also occur on the server." It does not state that Laut performs the claimed RMS analysis, that Kincaid supplies the claimed metadata architecture, or that Bongiovi's compression process should be integrated into Laut's networked jukebox system. Petitioner's motivation-to-combine analysis therefore depends upon using Patent Owner's own disclosure as a roadmap for reconstructing the asserted prior-art combination.

That is precisely the type of hindsight reconstruction that § 103 forbids. The relevant question is not whether the specification describes the claimed invention. It plainly does, as confirmed during prosecution. The question is whether Petitioner has shown that the asserted prior-art references, viewed from the perspective of a person of ordinary skill before the invention, would have taught or suggested the claimed combination. Paper 15

does not make that showing.

F. Paragraph [0081] Confirms the Claimed Chronology Rather Than Petitioner's Theory

Petitioner's reliance on paragraph [0081] also overlooks the chronology recited by the claims. Paragraph [0081] explains how previously determined audio characteristics are used during playback to normalize and compress an artist's track. Those later playback operations correspond to the later claim limitations concerning normalization and compression. They do not rewrite the earlier limitations requiring the processor to receive new media, identify metadata, analyze the audio signals, determine the RMS-derived value, store that value as metadata, and make that metadata available through the claimed Internet/API architecture before the jukebox requests playback.

This distinction is reflected in the prosecution history itself. Applicant amended the claims to clarify that the processor first determines the average volume, stores that information, and later adjusts playback using the previously determined value. The Examiner evaluated those amendments as questions of written-description support—not as admissions regarding the scope or teachings of the prior art. Petitioner's attempt to use paragraph [0081] to collapse these distinct stages into a single playback-processing limitation ignores both the claim language and the context in which paragraph [0081] entered the prosecution record.

G. Petitioner Has Not Established a Reasonable Expectation of Success

Petitioner likewise fails to establish that a person of ordinary skill in the art ("POSITA") would have had a reasonable expectation of successfully combining Laut, Kincaid, and Bongiovi to arrive at the claimed invention. Reply 23–24.

The Reply principally argues that the asserted references employ conventional processors, digital signal processing, normalization, compression, and other well-known computing techniques. Reply 23–24.

Patent Owner does not dispute that those individual technologies were known. The relevant inquiry under 35 U.S.C. § 103, however, is not whether individual components were familiar, but whether Petitioner has demonstrated that a POSITA would have reasonably expected the proposed combination to perform the integrated sequence of operations expressly recited by the challenged claims.

As explained in the POR, the challenged claims do not merely recite isolated digital signal processing techniques. Rather, they recite an ordered workflow beginning with media "not previously stored in the system," followed by processor-performed receipt of the new media, automatic identification of metadata, automatic analysis of the media to determine an RMS value, mathematical manipulation of that value, storage of the obtained RMS value as metadata for the new media, centralized storage,

Internet/API access to that metadata, receipt of a playback request, streaming of the requested media, and only thereafter normalization and compression using the previously generated metadata. POR 34–47.

The Reply does not identify where the proposed combination teaches or suggests that integrated processor-mediated workflow. Instead, Petitioner continues to rely on Laut for the networked media architecture, Kincaid for playback normalization, and Bongiovi for downstream digital signalprocessing, while asserting that these teachings could simply be combined because they utilize conventional computing technology. Reply 21–24. That is not the required analysis.

Nor does Patent Owner contend that the references must be physically merged or "bodily incorporated" into one another. Rather, the issue is whether Petitioner has demonstrated that a POSITA would have modified Laut's architecture to perform the claimed sequence of processor operations before playback, while preserving the functional relationships expressly recited by Claim 1. The Reply does not explain why a POSITA would have expected Laut's networked distribution system to incorporate Kincaid's playback-normalization techniques and Bongiovi's mastering processes in the particular chronological relationship required by the claims.

This omission is significant because each reference addresses a different technical objective. Laut is directed to networked media distribution and jukebox management. Kincaid addresses loudness normalization of audio tracks. Bongiovi concerns digital signal processing for improving playback quality. Although each reference concerns audio in some respect, Petitioner does not identify any teaching or reasoning demonstrating why a POSITA would have expected these separate teachings to operate together as the claimed processor-mediated ingestion, metadata-generation, Internet-

distribution, and playback workflow.

Accordingly, the Reply demonstrates only that the individual technologies were known. It does not demonstrate that a POSITA would have had a reasonable expectation of successfully combining those disparate teachings to arrive at the claimed invention as an ordered whole. Petitioner therefore has not remedied the deficiencies identified in the POR regarding either motivation to combine or reasonable expectation of success.

H. Claim 3 and the Dependent Claims Rely on the Same Integrated System Addressed in the Patent Owner Response

Petitioner argues that the Patent Owner Response ("POR") did not separately rebut independent Claim

3 or the dependent claims. Reply 25. That characterization overlooks both the manner in which Petitioner presented its case and the issues actually addressed in the POR. The Board recognized that Claims 1 and 3 are the two independent claims, but further identified Claim 1 as illustrative of the challenged claims. Paper 10 at 5. Petitioner likewise structured its obviousness analysis around Claim 1. Rather than presenting a materially different analysis for Claim 3, the Petition repeatedly incorporates the corresponding Claim 1 limitations by reference, directing the Board for each limitation from the preamble through Limitation [Q] to "See claim 1." Pet. 42-44. Petitioner therefore elected to rely upon the same underlying architecture for both independent claims. Consistent with Petitioner's presentation and the Board's institution analysis, the

POR addressed the architectural limitations common to the challenged claims. As explained throughout the POR, the challenged claims require an integrated processor-controlled workflow in which the processor receives new media, automatically identifies and stores metadata, analyzes the media to determine and store the claimed RMS-derived value, provides metadata through the Internet/API architecture, receives requests originating from client software installed on a jukebox, and streams the requested media in response to those requests. Paper 14, §§ II-III. Those arguments directly address the same processor-controlled architecture incorporated by Petitioner into its Claim 3 analysis. Claim 3 does not describe a separate or disconnected jukebox invention. Rather, Claims 1 and 3 recite complementary aspects of the same distributed system. Claim 1 describes the processor-side operations performed by the central system, while Claim 3 recites the computer-readable instructions implementing communications with the network-connected jukebox. Petitioner's own claim mapping confirms that relationship. Instead of developing a distinct obviousness theory for Claim 3, Petitioner simply incorporates its Claim 1 analysis for each corresponding limitation. Pet. 42-44.

As explained in Paper 14, the Examiner recognized two independently functioning subcombinations—a graphical user-interface invention and a central server-streaming invention—and applied restriction practice accordingly. EX1002 at 228-229. The Patent Owner Response explained that, following the Examiner's guidance, prosecution proceeded on the server-mediated architecture that ultimately matured into the challenged claims. Paper 14 at 3-5. Petitioner does not address that prosecution history

in its Reply and instead continues to rely on the same incorporated Claim 1 analysis for Claim 3. Thus, nothing in the Reply undermines the architectural analysis already presented in the POR. Nor do the dependent claims alter that conclusion. The dependent claims build upon the same integrated processor-and-jukebox architecture addressed throughout the POR. Petitioner cannot establish patentability of those claims merely by asserting that they were not discussed separately when its own Petition analyzes them through the same representative Claim 1 framework. Because the deficiencies identified in the POR apply equally to the common architectural limitations upon which Petitioner's analyses depend, Petitioner's Reply does not cure the failure to establish unpatentability of Claim 3 or the dependent claims.

Nothing in the Reply alters Petitioner's burden to prove every limitation of every asserted ground by a preponderance of the evidence. The Reply suggests that Ground 2 should prevail because Patent Owner did not separately address every aspect of Petitioner's alternative theory. That is not the applicable standard. Petitioner bears the burden throughout trial to prove every limitation of every asserted ground by a preponderance of the evidence. As discussed above, the POR addressed the common architectural and claim limitations underlying both asserted grounds, and the Reply does not cure the deficiencies previously identified.

IV. Petitioner's New Procedural Priority Theory Does Not Defeat Entitlement Under § 120

Petitioner's Reply introduces a new procedural challenge to Patent Owner's entitlement to the benefit of the earlier application through the declaration of former Commissioner Robert L. Stoll. EX1033. Rather than disputing the technical disclosure of the challenged claims, Stoll separately attacks the statutory requirements of 35 U.S.C. § 120 by asserting that co-pendency was lost because Patent Owner did not obtain an extension of time in the parent application before filing the continuation-in-part.

That argument mischaracterizes what occurred during prosecution. Patent Owner did not seek additional time to continue prosecution of the parent application by filing a reply under 37 C.F.R. § 1.136(a). Instead, Patent Owner exercised the continuation practice authorized by 35 U.S.C. § 120 by filing a new non-provisional continuation-in-part application on July 27, 2010, while the parent application remained within the statutory response period identified in the January 27, 2010 Final Office Action.

The USPTO accepted that filing, issued a Filing Receipt recognizing the domestic-benefit claim, examined the continuation-in-part application on that basis, repeatedly relied upon the parent application throughout prosecution, and ultimately issued the challenged patent without requiring revival of the parent application or rejecting the continuation chain on procedural grounds. The prosecution history therefore reflects that the Office recognized continuity of the continuation practice throughout examination.

Moreover, the Board's Institution Decision already determined that the second and third statutory requirements of § 120 were satisfied for purposes of institution. Petitioner's

new evidence does not identify any newly discovered prosecution fact. Instead, it offers a different legal interpretation of the same prosecution history previously before the Office and the Board.

Accordingly, Petitioner's new procedural priority theory does not establish that Patent Owner is not entitled to the benefit of the earlier filing date.

V. CONCLUSION

Petitioner's Reply does not cure the deficiencies identified in the Patent Owner Response. Rather than addressing the claimed invention as an integrated processor-mediated architecture, the Reply continues to rely upon isolated disclosures, expanded expert theories, and new procedural arguments that do not alter either the intrinsic record or the prosecution history. For the foregoing reasons, Patent Owner respectfully requests that the Board determine that Petitioner has failed to establish the unpatentability of claims 1–17 by a preponderance of the evidence and confirm the patentability of the challenged claims.

Dated: July 15, 2026

/s/ Manuel Tijerino

Lead Counsel (Pro Se)

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24)

I hereby certify that this PATENT OWNERS SUR-REPLY has 5,586 words (as counted by the “Word Count” feature of the LibreOffice word-processing system).

Dated: July 15, 2026

/s/ Manuel Tijerino

Lead Counsel (Pro Se)

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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's Sur-Reply in IPR2025-01280** was served on Petitioner's counsel of record by electronic mail on July 15, 2026, at the following addresses:

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