

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPOTIFY USA INC.,
Petitioner,

v.

MANUEL TIJERINO,
Patent Owner.

U.S. Patent No. 9,146,925

Inter Partes Review No. IPR2025-01280

PETITIONER'S MOTION TO STRIKE

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I. INTRODUCTION

Pursuant to Board authorization on July 22, 2026, Petitioner moves to strike arguments raised for the first time in Patent Owner's Sur-reply (Paper 16).

Specifically, Petitioner moves to strike: (1) the third paragraph of Section I, and the portions of Sections III.A, III.B, III.D, III.F, and III.G relating to the Sur-reply's new "ordered workflow" argument; (2) the passage of Section III.A (pages 8-9) that "Nathan is directed to managing jukebox systems having local memory storing audiovisual items"; and (3) the reference to "Ground 2 references such as Nathan and Dion" in Section II.A (page 5).

The Trial Practice Guide ("TPG")¹ provides that a sur-reply "may only respond to arguments raised in the preceding brief," and a sur-reply "that raises a new issue or belatedly presents evidence may not be considered." (TPG, § II.I.)

The Sur-reply violates that rule by presenting new and non-responsive theories of patentability. These new arguments deprive Petitioner of a fair opportunity to respond, and expand, rather than "crystalize," the issues for the Board. (TPG, § II.I.) The Board should grant the motion accordingly.

¹ References herein to the Trial Practice Guide are references to the Trial Practice Guide available at <https://www.uspto.gov/patents/ptab/trial-practice-guide> as of the date of this filing.

II. BACKGROUND

The Petition (Paper 2) challenged claims 1-17 of U.S. Patent No. 9,146,925. Ground 1 demonstrated that claims 1-17 are obvious over Laut, Kincaid, and Bongiovi. Claim 1 recites method steps [A] through [Q]. For claim 1, the Petition mapped limitations [I], [J], and [P] (normalization) to Kincaid; limitation [Q] (compression) to Bongiovi; and the remaining limitations to Laut. Ground 2 separately demonstrated that claims 1-17 are obvious over Dion and Nathan. The Board instituted review on all claims and both grounds. (Paper 10.)

In the POR (Paper 14), Patent Owner argued that the claims are narrowly directed to “server-side processing” and exclude playback-stage operations. (POR, 8, 10-23.) For example, he argued that Ground 1 fails because the claimed steps occur “at the server and at ingestion—not during playback”; Kincaid is “directed entirely to playback-stage concerns”; and Bongiovi’s playback-stage compression takes place at “the wrong stage of operation.” (POR, 10, 19, 21.) The POR was silent as to Ground 2.

III. PATENT OWNER’S SUR-REPLY PRESENTS NEW ARGUMENTS

Petitioner’s Reply (Paper 15) responded that the POR improperly imported unclaimed server-side limitations and improperly excluded playback-stage processing, including for limitations [P] and [Q]. (Reply, 21-24; EX1035, ¶¶82-90.) It also noted that Patent Owner had not addressed Ground 2. (Reply, 24-25.)

Patent Owner does not meaningfully defend the POR's server-side or playback-stage arguments. Instead, he advances in the Sur-reply a new "ordered workflow" theory: that the claims require a "particular chronological relationship" in which the processor performs steps including media ingestion, playback request receipt, and streaming—and normalization and compression (steps [P] and [Q]) occur "only thereafter". (Sur-reply, 2–3, 6–12, 19–22.) The POR never argued that limitations [P] and [Q] occur only after playback request and streaming, or that the claims require the Sur-reply's "particular chronological relationship." And while the POR position excluded playback-stage processing from the claims, the new Sur-reply position *requires* it—at a particular point in an ordered sequence. (See, e.g., Sur-reply, 7 ("Only after those processor-performed ingestion and distribution operations does Claim 1 recite the later playback-stage digital signal processing"), 11 (Paragraph [0081] "concerns the later playback-stage processing corresponding to the claimed normalization and compression limitations").)

The Sur-reply also raises new Ground 2 arguments. It asserts that "Ground 2 references such as Nathan and Dion" fail to disclose the alleged "complete claimed sequence," and newly characterizes Nathan as "directed to managing jukebox systems having local memory storing audiovisual items." (Sur-reply, 5, 8–9.) But the POR did not even mention Ground 2, Nathan, or Dion.

IV. PATENT OWNER’S NEW ARGUMENTS ARE NOT RESPONSIVE TO THE REPLY AND SHOULD BE STRICKEN

A sur-reply “may only respond to arguments raised in the preceding brief”; it may not “proceed in a new direction with a new approach as compared to the positions taken in a prior filing.” (TPG, § II.I; 37 C.F.R. §42.23(b).) The Federal Circuit has affirmed exclusion of patent owner sur-reply arguments that offer “a new theory of patentability” that should have been presented in the POR.

ParkerVision, Inc. v. Vidal, 88 F.4th 969, 981 (Fed. Cir. 2023).

A. The “Ordered Workflow” Argument Should be Stricken

The Sur-reply’s “ordered workflow” argument changes and contradicts the theory advanced in the POR. The POR argued that the claims are directed to server-side ingestion and exclude playback-stage processing, and it was silent on any “particular chronological relationship” now raised in the Sur-reply. (POR, 8, 10-23.) Patent Owner may contend the ordered workflow theory merely responds to the Reply. It does not. The Reply addressed the POR’s position that playback-stage operations are outside the claims. Rather than defend that position, Patent Owner transforms it: playback-stage operations allegedly are now not only within the claim scope, but are required at a specific point in an ordered sequence. (Sur-reply, 9.) That is a new claim interpretation theory that should have been raised, if at all, in the POR.

The Board should strike the portions of the Sur-reply advancing this

improper new theory, including the third paragraph of Section I and the portions of Sections III.A, III.B, III.D, III.F, and III.G arguing that the claims require an “ordered workflow,” “complete claimed sequence,” “particular chronological relationship,” or normalization/compression “only thereafter.”

B. The New Nathan/Ground 2 Arguments Should Be Stricken

The Board should also strike the Sur-reply’s new Ground 2 arguments. The POR does not mention Ground 2—let alone Dion, Nathan, or the Dion/Nathan combination. Any substantive rebuttal to Ground 2 was therefore waived.

The Reply did not open the door to new Nathan arguments. It noted that Patent Owner failed to address Ground 2, and compared Dion to the POR’s “server-side processor” construction. (Reply, 24-26.) But it did not raise any new Nathan-specific merits issue. If Patent Owner believed Ground 2 to be deficient, including based on Dion or Nathan, those arguments belonged in the POR.

The Sur-reply nevertheless introduces new Ground 2 merits argument, asserting that “Ground 2 references such as Nathan and Dion” fail to teach the alleged integrated workflow and newly characterizing Nathan as “directed to managing jukebox systems having local memory storing audiovisual items.” (Sur-reply, 5, 8-9.) The Nathan-specific argument is especially improper because Nathan was not discussed in either the POR or the Reply.

Dated: July 29, 2026

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

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

Manuel Tijerino
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Dated: July 29, 2026

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