

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELECTRONIC FRONTIER FOUNDATION
Petitioner,

v.

PERSONAL AUDIO, LLC
Patent Owner.

Case IPR2014-00070
Patent 8,112,504

Before TRENTON A. WARD, SHERIDAN K. SNEDDEN, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

On October 30, 2013, Electronic Frontier Foundation (“Electronic Frontier” or “Petitioner”) filed a revised petition requesting *inter partes* review of claims 31-35 of U.S. Patent No. 8,112,504 (Ex. 1001, “the ’504 patent”). Paper 6 (“Pet.”). On February 7, 2014, Personal Audio, LLC (“Personal Audio” or “Patent Owner”), filed a preliminary response. Paper 20 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD.—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons described below, we determine that the present record shows a reasonable likelihood Petitioner will prevail in showing unpatentability of all the challenged claims. Accordingly, pursuant to 35 U.S.C. § 314, we institute an *inter partes* review for claims 31-35 of the ’504 patent.

A. *Related Proceedings*

Petitioner indicates the ’504 patent is involved in co-pending proceedings, including: (i) *Personal Audio, LLC v. CBS Corp.*, No. 2:13-cv-270 (E.D. Tex. Apr. 11, 2013); (ii) *Personal Audio, LLC v. NBC Universal Media, LLC*, No. 2:13-cv-271 (E.D. Tex. Apr. 11, 2013); (iii) *Personal Audio, LLC v. Ace Broadcasting Network, LLC*, No. 2:13-cv-14 (E.D. Tex. Jan. 7, 2013); (iv) *Personal Audio, LLC v. Howstuffworks.com*, No. 2:13-cv-15 (E.D. Tex. Apr. 10, 2013); (v) *Personal Audio, LLC v. Togi*

Entertainment, Inc., No. 2:13-cv-13 (E.D. Tex. Jan. 7, 2013); (vi) *Fox Networks Group, Inc. v. Personal Audio, LLC*, No. 1:13-cv-11794 (D. Mass. July 26, 2013); and (vii) *Personal Audio, LLC v. Fox Broadcasting Co.*, No. 2:13-cv-577 (E.D. Tex. Aug. 6, 2013). Pet. 1-2.

B. The '504 patent

The '504 patent broadly relates to a player for audio programming, which includes functions that allow the listener to control many aspects of the playback. Ex. 1001, 2:21-56. As relevant to the claims under consideration, the '504 patent relates to how audio program segments are distributed to client subscriber locations. Ex. 1001, Abstract.

Figure 1 of the '504 patent is reproduced below:

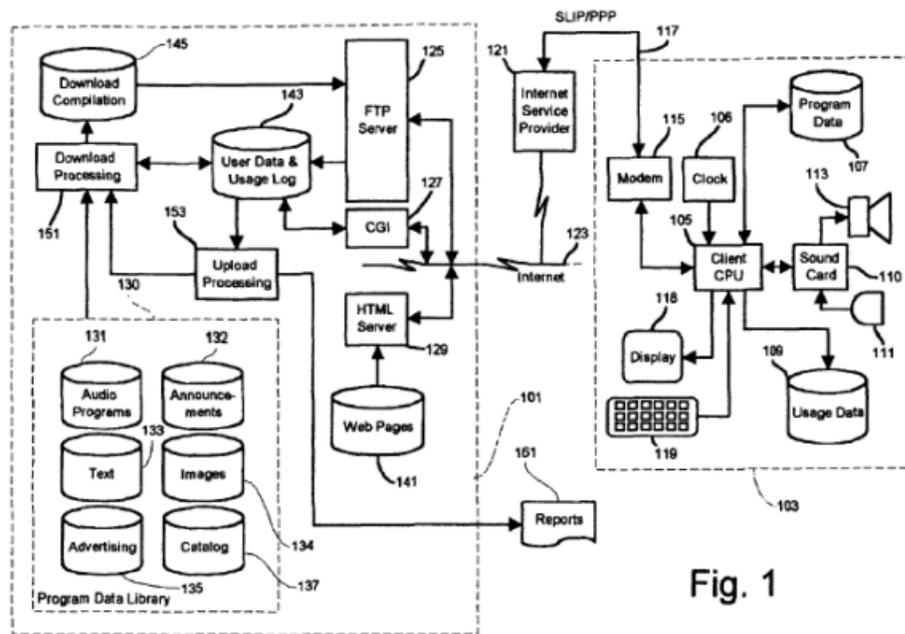


Fig. 1

Figure 1 is a block diagram of the invention illustrating the utilization of the Internet to connect host computer 101 to audio player 103. Ex. 1001, 4:39-42. Host server 101 periodically transmits download compilation file 145 upon receiving a request from player 103. *Id. at* 6:60-62. The compilation file extracts data from library 130 based on the selections of the user as

specified in the subscriber data and usage log database 143. *Id. at 7:3-9.* The file is placed in a predetermined FTP download file directory and assigned a filename known to the player. *Id. at 6:62-64.* Using clock 106, at a time determined by the player, a dial up connection is established via service provider 121 and Internet to FTP server 125, and the download compilation is transferred to program data store 107 in the player. *Id. at 6:64-7:1.* Once downloaded, the user plays program data 107 using the functionality of the player. *Id. at 4:44-60.*

The invention includes the ability for the user to select a program segment, which may represent an episode in a series. Ex. 1001, 19:35-38. When a serialized sequence is requested, the host may download less than all of the episodes, when all are not yet available. *Id. at 19:45-49.* Episodes that have not issued yet may be selected. *Id. at 20:64-21:3.*

C. Exemplary Claims

Claim 31 is the only independent claim challenged and is reproduced below:

31. Apparatus for disseminating a series of episodes represented by media files via the Internet as said episodes become available, said apparatus comprising:

one or more data storage servers,

one or more communication interfaces connected to the Internet for receiving requests received from remotely located client devices, and for responding to each given one of said requests by downloading a data file identified by a URL specified by said given one of said requests to the requesting client device,

one or more processors coupled to said one or more data storage servers and to said one or more communications interfaces for:

storing one or more media files representing each episode as said one or more media files become available, each of said one or more media files being stored at a storage location specified by a unique episode URL;

from time to time, as new episodes represented in said series of episodes become available, storing an updated version of a compilation file in one of said one or more data storage servers at a storage location identified by a predetermined URL, said updated version of said compilation file containing attribute data describing currently available episodes in said series of episodes, said attribute data for each given one of said currently available episodes including displayable text describing said given one of said currently available episodes and one or more episode URLs specifying the storage locations of one or more corresponding media files representing said given one of said episodes; and

employing one of said one or more communication interfaces to:

(a) receive a request from a requesting client device for the updated version of said compilation file located at said predetermined URL;

(b) download said updated version of said compilation file to said requesting client device; and

(c) thereafter receive and respond to a request from said requesting client device for one or more media files identified by one or more corresponding episode URLs included in the attribute data contained in said updated version of said compilation files.

D. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Abbreviation for Reference(s)	Description	Date	Exhibit(s)
NCSA GotW ¹	Browser rendering of the web page located at www.ncsa.uiuc.edu/radio/radio.html ²	Apr. 22, 1993	Ex. 1019 ³
SurfPunk	[surfpunk-0080] BUBBLES: talk radio; <i>_A New Age_</i> ; clipper chip	Apr. 22, 1993	Ex. 1020
Geek of the Week Articles	News articles regarding Geek of the Week.	March 31, 1993 through July 15, 1994 ⁴	Exs. 1008-1011 ⁵
Patrick/CBC	Andrew S. Patrick, et al, <i>CBC Radio on the Internet: An Experiment in Convergence</i> , 21 CANADIAN J. OF COMM'N 1, 125-140 (1996)	Jan. 1, 1996 ⁶	Ex. 1012

¹ “NCSA” is an acronym for National Center for Supercomputing Applications at the University of Illinois Urbana-Champaign. Declaration of Carl Malamud, Ex. 1003 ¶ 10. “GotW” is shorthand for “Geek of the Week,” an Internet talk radio program. *Id.*, ¶ 3.

² One of several locations where the content was available. Ex. 1003 ¶ 9.

³ Ex. 1019 is the “rendered version.” HTML version is Ex. 1021. Pet. 16.

⁴ Ex. 1003 ¶ 11.

⁵ A series of articles on Internet Radio and Mr. Malamud’s involvement. *See* II.D. (regarding Geek of the Week articles).

⁶ Declaration of Chris Schmandt, Ex. 1002 ¶ 59 (citing Ex. 1013).

Compton/CNN	Charles L. Compton, <i>Internet CNN NEWSROOM: The Design of a Digital Video News Magazine</i> , Massachusetts Institute of Technology (Aug. 10, 1995)	Aug. 10, 1995	Ex. 1022
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E. The Alleged Grounds of Unpatentability

Petitioner alleges the following grounds of unpatentability.

Claims	Grounds	Reference[s]
31-35	35 U.S.C. § 102(b)	NCSAGotW
31-35	35 U.S.C. § 102(b)	SurfPunk
31-35	35 U.S.C. § 103	NCSAGotW, SurfPunk, and Geek of the Week Articles
31-35	35 U.S.C. § 102(a)	Patrick/CBC
31-35	35 U.S.C. § 103	Compton/CNN

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). The terms also are given their ordinary and customary meaning as would be understood by one of ordinary

skill in the art in the context of the disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. “episode” (Claims 31-35)

Petitioner proposes “episode” be construed “as a program segment, represented by one or more media files, which is part of a series of related segments, e.g. a radio show or a newscast.” Pet. 11-12. Petitioner notes that the specification describes that an episode is a program segment that is part of a series (i.e. a sequence of related segments). *Id.* at 11, (citing Ex. 1001, 19:35-42). Patent Owner does not propose a construction for the term.

Petitioner’s proposed construction is the broadest reasonable interpretation consistent with the specification, and is therefore adopted for this decision.

2. “compilation file” (Claims 31-35)

Petitioner proposes “compilation file” be construed as “any file that contains information about multiple episodes and satisfies the other claim requirements.” Pet. 12-13. Patent Owner does not propose a construction for the term. Petitioner argues that the specification describes the “compilation file” as simply an ordinary file that contains the information required by the claim. *Id.* (citing Ex. 1001, 6:60-64, 7:10-22).

The specification describes the compilation file as “one or more subscriber and session specific files which contain the identification of separately stored sharable files.” Ex. 1001, 7:10-13. Applying the broadest reasonable construction consistent with the specification, compilation file is construed to mean “a file that contains episode information” for the purposes of this decision.

3. “*media file*” (*Claims 31-35*)

Petitioner proposes that “media file” be construed as “a file with content that can be reproduced as video, audio, and/or text.” Pet. 13. Petitioner points to claims 32 and 33 as reciting that the media file includes “digital compressed audio” and/or “text data.” *Id.* (citing Ex. 1001, claims 32-33). Patent owner does not propose a meaning for the term.

The specification does not disclose the term “media files” beyond the recitation of the term in the claims. Neither is the term medias described in the specification. The plain and ordinary meaning of media is consistent with Petitioner’s proposed construction of “media files.” Petitioner’s construction is the broadest reasonable construction and is consistent with the specification and is therefore adopted for this decision.

B. Anticipation by Patrick/CBC (Claims 31-35)

The ’504 patent claims priority through a series of divisional applications, the earliest filed of which is U.S. Patent Application Ser. No. 08/724,813, filed October 2, 1996, now U.S. Patent No. 6,199,076. Ex. 1001, 1:8-17. Petitioner’s declarant, Mr. Schmandt, uses October 2, 1996, as the effective filing date. Ex. 1002 ¶ 4. Based on Mr. Schmandt’s declaration and metadata for the article showing a January 1, 1996 date of publication, Petitioner alleges Patrick/CBC was published January 1, 1996. For purposes of this decision, we therefore assume Exhibit 1012 is prior art dated January 1, 1996. *See* Ex. 1002, ¶ 59, Ex. 1013.

Petitioner alleges Patrick/CBC is prior art anticipating claims 31-35 of the ’504 patent under 35 U.S.C. § 102(a). Pet. 16, 35-45. Petitioner relies, in part, on the testimony of Mr. Schmandt. Ex. 1002 ¶¶ 58-71.

1. Patrick/CBC Overview

Patrick/CBC discloses an experimental trial to determine, among other things, if there was any demand for regular radio programming distributed as digital audio files over the Internet. Ex. 1012, Abstract. Patrick/CBC alleges that the trial is “the first time that audio programs produced for traditional radio broadcasts have been made available on the Internet on a regular basis.” *Id. at 2.*⁷ CBC Radio programming was stored on a server and the resulting program files were made available using standard Internet server software. *Id. at 2-3.*

2. Claims 31-35 as Anticipated by Patrick/CBC

Independent claim 31 is an apparatus claim. The preamble recites, in pertinent part, that a “series of episodes” is disseminated over the Internet as they become available. Petitioner argues that Patrick/CBC’s disclosure of making traditional radio broadcasts available over the Internet meets the preamble’s language.⁸ Pet. 35 (citing Ex. 1012, 3, 7; Ex. 1002, ¶ 64).

Patrick/CBC discloses “Installing the Server,” and that the disclosed trial was conducted on a server that was used as a source for Canadian government documents. Ex. 1012, 3. Patrick/CBC discloses that the server could be accessed at <ftp://www.radio.cbc.ca> or <http://www.radio.cbc.ca/>. *Id. at 7.* Petitioner relies on this disclosure for the recitation of “data storage servers” in claim 31. Pet. 40, Ex. 1002 ¶ 64.

⁷ Page references are to the actual page numbers of Exhibit 1012, and not Petitioner’s Exhibit pages.

⁸ The preamble forms an antecedent basis for “series of episodes” as used in the claim 31’s “from time to time” limitation and will be given weight for purposes of this decision. *See, Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003). The parties do not address the question.

Claim 31 requires requests for media files to be received from “remotely located client devices.” Patrick/CBC discloses that the program files for CBC Radio programs were made available via FTP, Gopher, and World Wide Web (WWW) using standard Internet server software. Ex. 1012, 2-3. Petitioner asserts that in using FTP, Gopher, and the World Wide Web, one of skill in the art would have understood that URLs were used to identify the data file a user was requesting using a remotely located client device, as required by claim 31. Pet. 40 (citing Ex. 1002 ¶¶ 60, 62-64).

Claim 31 also recites “downloading a data file identified by a URL,” as specified by the client device. As discussed above, Patrick/CBC discloses access to the program files located on a server via FTP, Gopher, and World Wide Web. Ex. 1012, 3. Petitioner argues that this disclosure meets the “downloading a data file identified by a URL” limitation in claim 31. Pet. 40 (citing Ex. 1002 ¶ 66).

Patrick/CBC discloses an FM radio receiver was installed in the laboratory to constantly monitor the CBC broadcasts. Ex. 1012, 3. Using a “cron” program, a Sun computer automatically recorded programs and transferred them to the server. Ex. 1012, 3. For example, Patrick/CBC discloses that the *Quirks & Quarks* science magazine show was recorded each week, broken down into its component parts, and made available on the server. *Id.* Patrick/CBC also discloses that radio programs were made available “on demand” in that users could request them from the server at any time. *Id.* at 3. Petitioner relies, in part, on this disclosure as meeting claim 31’s recitation of storing media files as they become available. Pet. 41 (citing Ex. 1002 ¶¶ 63-64, 67). Further, Petitioner argues that the media files are located at a specific URL. *Id.* Petitioner argues that these

disclosures regarding the radio programs meets the claim 31 requirement that, “from time to time, as new episodes represented in said series of episodes become available.” Pet. 41-42 (citing Ex. 1002 ¶¶ 63-66). Additionally, claim 31 requires “displayable text,” and Petitioner argues that Patrick/CBC discloses accompanying text describing the episodes. *Id.* (citing Ex. 1012, 3).

Claim 31 further requires receiving a “request for an updated version of the compilation file,” downloading the updated compilation file, and then receiving and responding to a request for “one or more corresponding episode URLs.” Petitioner cites to Patrick/CBC’s disclosure of the HTML construct of the URL for downloading the radio programming as meeting the “compilation file” limitation. Pet. 43 (citing Ex. 1012, 3, 7; Ex. 1002 ¶¶ 65-67).

Patent Owner argues the petition does not explain adequately what portions of the quoted materials correspond to precise claimed elements. Prelim. Resp. 29-30. In addition, Patent Owner contends that the petition admits that, at the end, “the trial was not updated during this time.” *Id.* Patent Owner also argues equipment available to users in 1993 did not necessarily support downloading data files. *Id.* at 30. Patent Owner also disputes Petitioner’s contention that a link to an episode of CBC Radio equates to a specific URL for an episode. *Id.* at 31-32.

Patrick/CBC discloses storing media files, in the form of radio programming, on a server for later use. Ex. 1012, Abstract. A series of programs are stored and made available, i.e., the *Quirks & Quarks* science magazine show was recorded each week, broken down into its component parts, and made available on the server. *Id.* at 3. New episodes are added as

they become available. Two newscasts were recorded each day and made available on the server immediately after the broadcast. *Id.* Thus we are persuaded that the key element of claim 31 as asserted by Patent Owner (Prelim. Resp. 3) is shown in Patrick/CBC and explained in the petition. As discussed above, Petitioner has presented sufficient evidence to show the remaining elements of claim 31.

Petitioner relies on Mr. Schmandt's testimony that links may be used, like a URL, to take a user to a specific file location. Ex. 1002 ¶¶ 27-33. Additionally, the '504 patent also uses the term "link" in the context of accessing a program segment, and as an "Internet link," such as shown in Figure 1. Ex. 1001, 3:35-53, 7:53-58. Further, FTP downloads are disclosed as specifying the "URLs of the needed files." *Id.* at 19:6-9. FTP downloads are disclosed in Patrick/CBC. Ex. 1012, 2-3. Petitioner asserts that, in using FTP, it would have been understood to a person of ordinary skill in the art that URLs were used to identify the data file a user was requesting using a remotely located client device. Ex. 1002 ¶¶ 60, 62-64. For purposes of this decision, we are persuaded by Petitioner's argument that Patrick/CBC discloses to the person of ordinary skill in the art the use of URLs to identify specific file locations.

Patent Owner further argues that in December 1993, when the trial of Patrick/CBC was conducted, adequate technology did not exist to download files as claimed. Prelim. Resp. 30-31. Contrary to Patent Owner's argument, however, Patrick/CBC identifies the technology used to prepare, download, and play audio files. Ex. 1012, 2 ("Running the Trial Digitizing Radio Programs"). That it was not as fast or capable as later developed technology does not appear to be relevant to the claims.

We have also reviewed the petition in connection with dependent claims 32-35. In summary, we have reviewed Petitioner's analysis and supporting evidence regarding the proposed ground of anticipation by Patrick/CBC, and determine that Petitioner, on the record before us, has demonstrated a reasonable likelihood that independent claim 31, and claims 32-35 dependent from claim 31, are anticipated by Patrick/CBC.

C. Obvious over Compton/CNN (Claims 31-35)

Petitioner contends that claims of the '504 patent are obvious under 35 U.S.C. § 103 over Compton/CNN (Ex. 1022). Pet. 16, 45-59. To support this position, Petitioner presents the testimony of Mr. Schmandt. Ex. 1002 ¶¶ 72-85.

1. Compton/CNN Overview

Compton/CNN describes the design of a digital video newsroom based on the video program CNN NEWSROOM.⁹ Ex. 1022, Abstract. Compton/CNN describes that the CNN NEWSROOM uses MPEG digital video and is distributed via the World Wide Web on the Internet. *Id.*

CNN NEWSROOM is disclosed as being distributed via cable television systems as well as directly to schools via satellite. Ex. 1022, 11.¹⁰ Compton/CNN describes that an important aspect of the Internet deployment of CNN NEWSROOM is the development of a searchable digital library of CNN NEWSROOM programs and segments. *Id. at 14.* CNN NEWSROOM is disclosed as being archived for six months. *Id. at 15.*

⁹ Exhibit 1022 also uses "CNN Internet NEWSROOM," "Internet CNN NEWSROOM," and "Internet NEWSROOM." We will generally refer to these disclosed video programs as "CNN NEWSROOM."

¹⁰ Page references are to the actual page numbers of Exhibit 1022 and not to Petitioner's Exhibit pages.

Figure 1 of Compton/CNN is reproduced below.

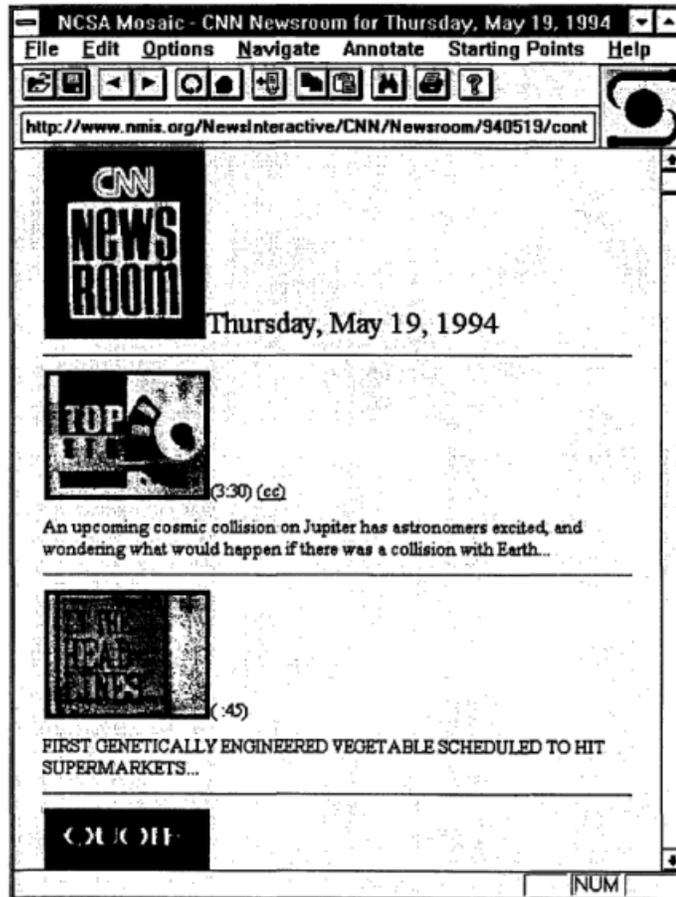


Figure 1: CNN NEWSROOM Video Magazine

Figure 1 shows the Table of Contents for a particular day's program. Ex. 1022, 14. Figure 1 further shows the Table of Contents as an HTML document that consists of a short summary and an icon or title for each segment of the program, where a segment corresponds to a single news story. *Id.*

Figure 6 of Compton/CNN is reproduced below.

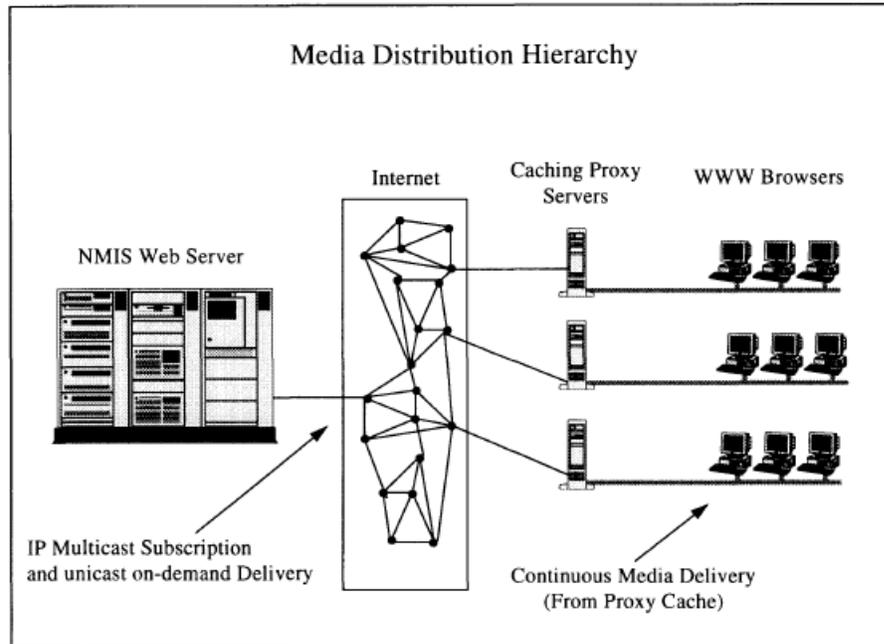


Figure 6: Media Distribution Hierarchy

Figure 6 illustrates a hardware hierarchy for network video distribution. Ex. 1022, 23-24. Caching proxy servers store video content. *Id.* Only one caching server is required for Internet connectivity. *Id.* at 23.

Ultimately, video is delivered over the Internet to the subscribing caching servers for display. Ex. 1022, 25. The programming includes past episodes of other news programs, sitcoms, and soap operas. *Id.* at 29.

2. Claims 31-35 as Obvious over Compton/CNN

Compton/CNN discloses that each day of the CNN NEWSROOM program is distributed over the Internet. Ex. 1022, 10. Petitioner points to this disclosure as meeting the basic environment set out in the preamble. Pet. 46-47, 53-54.

Compton/CNN shows servers in the form of the NMIS Web Server. Ex. 1022, fig. 6. Petitioner argues these servers meet the “data storage

servers” recited in claim 31. Pet. 47-48, 54. Petitioner alleges that a person of ordinary skill would have understood, at the time the invention was made, that “processors” and the claimed “communications interface” are “necessarily contained” in the server once media files are requested over the Internet. Pet. 47-48 (citing Ex. 1002 ¶ 76).

Claim 31 recites storing “one or more media files representing each episode as said one or more media files become available” at a “unique episode URL.” Compton/CNN discloses the automatic generation of a WWW user interface for daily content. Ex. 1022, 7. Further, Compton/CNN captures video using the FTP protocol and delivers the files to the server. *Id.* at 22. The results can be delivered to “any host on the Internet supporting the FTP protocol.” *Id.* Petitioner relies upon these disclosures and the testimony of Mr. Schmandt to argue the limitation is met because links would be understood to be unique episode URLs. Pet. 55 (citing Ex. 1002 ¶ 77).

A “compilation file” updated from “time to time, as new episodes represented in said series of episodes become available” is also recited in claim 31. Compton/CNN discloses a Table of Contents, see Figure 1 above, which Petitioner relies on as a “compilation file.” Pet. 55 (citing Ex. 1002 ¶ 78). Petitioner argues that the displayable text in the Table of Contents describes the episode, i.e., “segment.” Pet. 56. The Table of Contents is an HTML file that “was automatically updated each day and presented attribute data describing each episode (in this case, the episodes were news segments).” Ex. 1022, 13-14, 17-19. Further, the link in the Table of Contents is a URL in that it “specifies the location of one of the media files representing the episode.” Pet. 56 (citing Ex. 1002 ¶¶ 24-33).

As to the recitations of claim 31 regarding a “compilation file,” Petitioner relies upon the disclosure in Compton/CNN regarding updates to the Table of Contents. Pet. 50 (citing Ex. 1022, 13-14). The Table of Contents is an HTML file that includes information about each program or segment, which is updated as new segments are produced. *Id.* (citing Ex. 1022, 14). Compton/CNN discloses that clicking a link downloads a MPEG file to playback. *Id. at 25.* Petitioner points to these features of Compton/CNN as meeting the recited limitations. Pet. 56-57 (citing Ex. 1002 ¶¶ 80, 24-33).

Patent Owner argues Compton/CNN’s segments are not “episodes represented by media files.” Prelim. Resp. 32. Further, Patent Owner argues that the Table of Contents is not a “compilation file.” *Id. at 34.* Given our construction of “episode” and “compilation file,” we are not persuaded by Patent Owner’s arguments. First, the “segments” of Compton/CNN are programming, i.e., media files. Furthermore, the “segments” disclosed in Compton/CNN also fall within our construction of “episodes” as “a program segment, represented by one or more media files, which is part of a series of related segments, e.g. a radio show or a newscast.” Additionally, the Table of Contents is a listing of program materials available for download to a user. As such, we are not persuaded that the Table of Contents of Compton/CNN is not “a file that contains episode information.”

Claim 31 further requires that “from time to time, as new episodes represented in said series of episodes become available,” the compilation file is updated. As noted above, Petitioner has cited to the disclosure in Compton/CNN that the Table of Contents was automatically updated each

day with attribute data describing each episode, i.e., news segments. Pet. 56, Ex. 1022, 13-14, Ex. 1002 ¶ 72. In addition, to the extent an updated compilation file is not shown in Compton/CNN, Petitioner alleges that element would be obvious. Pet. 45.¹¹ Patent Owner alleges the obviousness grounds are conclusory. Prelim. Resp. 3. Patent Owner makes no specific argument as to why Compton/CNN would not render claim 31 obvious. Indeed, the only argument made regarding Compton/CNN is that the compilation file is not updated. Prelim. Resp. 32-33. For reasons already discussed we disagree that Compton/CNN discloses updating a compilation file. Furthermore, given the disclosure of storing multiple episodes of news programming in Compton/CNN in a compilation file, updating the compilation file would have been a predictable step and, therefore, obvious to the person of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

We have also reviewed the petition in connection with dependent claims 32-35. In summary, we have reviewed Petitioner's analysis and supporting evidence regarding the proposed ground of obviousness by Compton/CNN and determine that Petitioner, on the record before us, has demonstrated a reasonable likelihood that independent claim 31, and claims 32-35 dependent from claim 31, are obvious over Compton/CNN.

¹¹ Petitioner alleges the person of ordinary skill in the art at the time the invention was made "had a bachelor's degree in computer science or engineering and at least 3-5 years of experience in the field of electronic information distribution systems, including distribution of media content over the Internet, or who had an equivalent combination of education and experience." Pet. 8 (citing Ex. 1002 ¶¶ 18-19). Patent Owner has no proposal.

D. Anticipation under 35 U.S.C. § 102(b) of Claims 31-35 by NCSA GotW or SurfPunk

Patent Owner alleges both NCSA GotW and SurfPunk are not printed publications available for *inter partes* review. Prelim. Resp. 7-8 (citing 35 U.S.C. § 311 (b), 37 CFR § 42.104 (b)(2) and (b)(4)). More specifically, NCSA GotW and SurfPunk are alleged to be grounds for unpatentability based on public use or knowledge. *Id.* at 7, *see* 35 U.S.C. § 102(a). 35 U.S.C. § 311 (b) limits the scope of *inter partes* review to any “ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.”

Petitioner alleges NCSA GotW is a printed publication because on April 13, 1993, Marc Andreessen, the maker of Mosaic, published the URL [www.ncsa.uiuc.edu /radio/radio.html](http://www.ncsa.uiuc.edu/radio/radio.html) for NCSA GotW. Pet. 19 (citing Ex. 1018). Petitioner acknowledges NCSA GotW no longer exists at the URL, but argues that content was copied in SurfPunk. Pet. 17-18. Petitioner apparently relies on *In re Klopfenstein*, 380 F.3d 1345, 1350-52 (Fed. Cir. 2004) for the proposition that temporary public availability is sufficient to establish that NCSA GotW is a printed publication. *Id.* at 19.

SurfPunk is alleged to be a technical journal that Petitioner argues was capable of being downloaded as a printed publication. *Id.* (citing *Voter Verified, Inc. v. Premier Election Sol’ns*, 698 F.3d 1374, 1380-81 (Fed. Cir. 2012)). Petitioner represents SurfPunk (Ex. 1020) as the *SurfPunk Technical Journal* dated April 22, 1993, which included a copy of NCSA GotW. *Id.* (citing Declaration of Chris Schmandt, Ex. 1002 ¶ 50, *see* Pet. 16, Ex. 1002 ¶ 44.a.).

Patent Owner argues that whether a document constitutes a printed publication under 35 U.S.C. § 102 is a question of law based upon the underlying facts of each particular case. Prelim. Resp. 9 (citing *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1332-33 (Fed. Cir. 2009)). Further, Patent Owner argues dissemination and public accessibility are the keys to the legal determination of whether the prior art reference was “published” in the context of 35 U.S.C. § 102(b). *Id.* (citing *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989)); *see In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986).

Patent Owner argues NCSA GotW was not accessible because even a knowledgeable person of ordinary skill in the art would need precise location information to locate it. Prelim. Resp. 10. As such, it is not publicly accessible. *Id.* Petitioner relies on Exhibit 1018 and Mr. Adreesen as evidence directing a person seeking access to copy and paste the URL, providing the precise direction required. Pet. 10-11. Patent Owner relies on *SRI international, Inc. v. Internet Security Systems, Inc.*, 511 F.3d 186, 1196-97 (Fed. Cir. 2008), where a paper sent via email and posted on a file transfer protocol was not sufficiently publicly accessible to constitute a printed publication because the paper would not have been found without precise direction. *Id.* at 11.

Concerning SurfPunk, Patent Owner alleges it is a private email exchange. Prelim. Resp. 13. As such, SurfPunk is printed, but not a printed publication, because it is not publicly accessible. *Id.*

To determine whether to deny a ground on the basis that a reference is not a “printed publication,” we decide each case on the basis of its own facts. More specifically, the determination of whether a given reference

qualifies as a prior art “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public. *In re Klopfenstein*, 380 F.3d at 1350. “A reference is publicly accessible upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (internal citation and quotation marks omitted).

Petitioner acknowledges GotW was only temporarily available, and no longer exists at the URL location. Pet. 17-18. Petitioner’s evidence shows the earliest existing copy of the GotW, located using the “Wayback Machine,” is dated December 20, 1996. Ex. 1003 ¶ 17. Petitioner fails to provide any evidence that the GotW document, Exhibit 1019, could be found anywhere other than directly through the URL.¹² Additionally, while the URL for GotW is found in Mr. Andreessen’s announcement contained in Exhibit 1018, this fact alone is not dispositive of the sufficiency of the public availability of GotW. For example, there is a question of whether Exhibit 1018, itself, was publicly available such that the URL would likewise be available.

On its face, Exhibit 1018 states that it was “Posted in group: alt.radio.internet.” Petitioner fails to provide any information regarding this posting, the group, who is in the group, or the size of the group. Neither

¹² Carl Malamud, the “inventor” of GotW (Ex. 1003 ¶ 3), states that the NCSA GotW/SurfPunk web page was not captured until April 18, 1999 on the Internet Archive “Wayback Machine” for the “Geek of the Week” episode index. Prelim. Resp. 16-17 (citing Ex. 1003 ¶ 19).

Mr. Schmandt nor Mr. Malamud (Exs. 1002 and 1003) provide any insight about Exhibit 1018 or its availability.

Based on the record before us, we determine that Petitioner fails to provide sufficient factual support that Exhibit 1018 was publicly available. More particularly, Petitioner fails to provide sufficient factual support that the person of ordinary skill, exercising reasonable diligence, would have been able to find the URL based on Exhibit 1018. *Kyocera*, 545 F.3d at 1350 (reference must be “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it”).

Additionally, we determine that Petitioner failed to provide sufficient evidence that SurfPunk remedies the deficiencies in GotW. SurfPunk, as provided in Exhibit 1020, is not in the form of *SurfPunk Technical Journal*, but rather a private email exchange. Petitioner fails to provide any evidence that Exhibit 1020 was ever publicly available. Petitioner points to Exhibit 1030 as listing *SurfPunk Technical Journal* as a publication (Pet. 25), but Exhibit 1030 does not specifically identify the email exchange reflected in Exhibit 1020 as an issue of *SurfPunk Technical Journal*. Similar to Exhibit 1018, only the URL is identified in Exhibit 1020. The URL alone, as already discussed, is not sufficient evidence of public availability. There must be a factual showing that SurfPunk was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence can locate it.” *Kyocera*, 545 F.3d at 1350. Petitioner fails to provide sufficient factual support of the public availability of Ex. 1020. For the reasons discussed above and based on the record before us, we determine that Petitioner fails

to make a threshold showing that either NCSA GotW or SurfPunk was publicly available more than one year prior to the effective filing date. As such, Petitioner failed to establish that either qualifies as a printed publication under section 102(b).

Accordingly, based on the record before us, Petitioner has not demonstrated a reasonable likelihood that claims 31-35 are anticipated by NCSA GotW or anticipated by SurfPunk.

E. Obviousness under 35 U.S.C. § 103 of Claims 1-35 Over the Geek of the Week Articles

Petitioner asserts claims 31-35 are unpatentable as obvious over various Geek of the Week articles, Exhibits 1003, 1007-1011, and 1022-1028. Pet. 16, 26-35. Exhibit 1003 is the Declaration of Carl Malamud.¹³ Mr. Malamud alleges that he is the “sole, original and first inventor of the Internet talk radio show published under the name ‘Geek of the Week.’” Ex. 1003 ¶ 3. We have considered Mr. Malamud’s testimony for purposes of identification and authentication of the other exhibits relied on.

Petitioner’s additionally cites to Exhibits 1007-1011 and 1018-1028 as “Geek of the Week.” Pet. 16. As discussed above, we determine that Petitioner fails to provide sufficient evidence of the public availability of Exhibits 1018-1020 as printed publications; therefore we do not consider them in this requested ground. Additionally, Exhibit 1021 is an HTML version of Exhibit 1019; thus, we do not consider it as a printed publication

¹³ Mr. Malamud’s testimony primarily relates to prior public use and knowledge under section 102(a). As previously discussed, under 35 U.S.C. § 311 (b), such testimony falls outside the scope of *inter partes* review.

for the same reasons discussed above. Exhibits 1007 and 1022-1028¹⁴ include undated materials, archival materials, and are not specifically referred to in the grounds related to Geek of the Week in the petition. Rather, all the exhibits relied on for the obviousness grounds are grouped together and argued as a single prior art reference. Pet. 28-35. For our purposes Exhibits 1008-1011, which are all printed publications with dates, are referred to as the “Geek of the Week articles” for the grounds asserted. *See* I.D above.

Petitioner must show in its petition that there is a reasonable likelihood that it would prevail with respect to at least 1 of the claims challenged in the petition. 35 U.S.C. § 311. To this end, the petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon,” and it “must include . . . a detailed explanation of the significance of the evidence including material facts.” 37 C.F.R. §§ 42.104(b)(4), 42.22(a)(2); *see* 35 U.S.C. § 312(a)(3).

The petition fails to make the required showing with respect to the Geek of the Week articles. Petitioner fails to cite to evidence in the Geek of the Week articles as to where the elements of the claims can be found. Pet. 28-34. Absent “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” the statements made by Mr. Schmandt are mere conclusory statements. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The only rational underpinning articulated by Petitioner is that accessing the URL would download the file. Ex. 1002 ¶ 46. Petitioner fails to cite to the disclosure of a URL in any exhibit other

¹⁴ Exhibit 1022 is Patrick/CNN and does not relate to Geek of the Week.

than those removed from consideration based on insufficient evidence of public availability.

Accordingly, based on the record before us, Petitioner has not demonstrated a reasonable likelihood that claims 31-35 are obvious in view of the Geek of the Week articles.

III. CONCLUSION

For the foregoing reasons, we are persuaded that the information presented in the petition establishes a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 31-35 of the '504 patent.

The Board has not made a final determination of the patentability of any challenged claim.

ORDER

For the reasons given, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to the following claims and grounds:

(1) Claims 31-35 are unpatentable under 35 U.S.C. § 102(a) as anticipated by Patrick/CBC (Ex. 1012); and

(2) Claims 31-35 are unpatentable under 35 U.S.C. § 103 as obvious over Compton/CNN (Ex. 1022).

FURTHER ORDERED that all other grounds raised in the petition are denied;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial on the grounds of unpatentability authorized above; the trial commences on the entry date of this decision.

Case IPR2014-00070
Patent 8,112,504

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