UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC.,
Petitioner,

v.

PERSONAL AUDIO LLC,
Patent Owner.

Case IPR2015-00846
Patent 7,509,178 B2

Before MITCHELL G. WEATHERLY, DAVID C. McKONE, and
BRIAN P. MURPHY, *Administrative Patent Judges.*

WEATHERLY, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

A. BACKGROUND

Google, Inc. ("Petitioner")[1] filed a petition (Paper 6, "Pet.") to institute an *inter partes* review of claims 1–9, 13–17, 28, and 29 (the "challenged claims") of U.S. Patent No. 7,509,178 B2 (Ex. 1001, "the '178 patent"). Petitioner supported the Petition with the Declaration of Martin G. Walker, PhD (Ex. 1002). Personal Audio LLC ("Patent Owner") timely filed a Preliminary Response. Paper 13 ("Prelim. Resp."). On September 17, 2015, based on the record before us at the time, we instituted an *inter partes* review of claims 1–9, 13–17, 28, and 29. Paper 18 ("Institution Decision" or "Dec."). We instituted the review on the following challenges to the claims:

References	Basis	Claims
U.S. Patent Publication No. 2002/0177914 A1 (Ex. 1007, "Chase") and Shoshana Loeb, *Architecting Personalized Delivery of Multimedia Information*, VOL. 35, NO. 12 COMMUNICATIONS OF THE ACM 39–48 (Dec. 1992) (Ex. 1011, "Loeb")	§ 103	1–4, 9, and 13
Chase, Loeb, and U.S. Patent No. 4,811,315 (Ex. 1009, "Inazawa")	§ 103	5, 6, 14–17, 28, and 29
Chase, Loeb, Inazawa, and U.S. Patent No. 4,609,954 (Ex. 1010, "Bolton")	§ 103	7 and 8

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[1] With our prior authorization, the parties filed joint motions to terminate the proceeding with respect to original petitioner Barnes & Noble, Inc., Paper 20, and original petitioners Lenovo (United States) Inc., Lenovo Holding Company, Inc., and Lenovo Group Ltd., Paper 22. We granted the motions and dismissed Barnes & Noble, Inc., Lenovo (United States) Inc., Lenovo Holding Company, Inc., and Lenovo Group Ltd. from the proceeding, which left Google, Inc. as the sole remaining petitioner. Paper 24.

After we instituted this proceeding, Patent Owner filed a Patent Owner Response in opposition to the Petition (Paper 29, "PO Resp.") that was supported by the Declaration of Kevin C. Almeroth, PhD (Ex. 2016). Petitioner filed a corrected Reply in support of the Petition (Paper 31, "Reply"). Patent Owner did not move to amend any claim of the '178 patent.

We heard oral argument on June 16, 2016. A transcript of the argument has been entered in the record (Paper 38, "Tr.").

We entered our Final Written Decision on September 9, 2016, Paper 39 ("Final Written Decision" or "Final Dec."), in which we concluded that claims 1–4, 9, and 13 were unpatentable but claims 5–8, 14–17, 28, and 29 were not unpatentable. Final Dec. 44. Petitioner filed a timely Request for Rehearing in which it asks that we reconsider the Final Written Decision and find that claims 5–8, 14–17, 28, and 29 are unpatentable as challenged in the Petition. Paper 40 ("Reh'g Req." or "Request for Rehearing"). For the reasons that follow, we deny the Request for Rehearing.

B. STANDARD FOR RECONSIDERATION

The party filing a request for rehearing of a final written decision has the burden of showing that the decision should be modified, and the request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked and the place at which each matter was previously addressed in its papers during the trial. 37 C.F.R. § 42.71(d). Therefore, Petitioner bears the burden of establishing that we misapprehended or overlooked the matters that it requests that we review.

II. ANALYSIS

In our Final Written Decision we concluded that Petitioner failed to establish by a preponderance of evidence that the combination of Chase, Loeb, and Inazawa rendered claims 5, 6, 14–17, 28, and 29 obvious, Final Dec. 35–42, and that the combination of Chase, Loeb, Inazawa, and Bolton rendered claims 7 and 8 obvious, *id.* at 43. Both conclusions were based on Petitioner's failure to establish by a preponderance of evidence that Inazawa taught aspects of claims 5, 6, and 14 to which we referred as the "skip back algorithm." Final Dec. 35–42.

The parties agree that the skip back algorithm is a portion of the algorithm that is recited in means-plus-function form as a "processor for continuously delivering a succession of said audio program files." Pet. 6 (adopting District Court interpretation of "processor for" in related Apple Litigation[2]); PO Resp. 22, 30, 33 (implicitly adopting means-plus-function nature of "processor for"). The algorithm is generally depicted in Figure 3 of the '178 patent.

Petitioner argues that we should overturn our prior decision regarding claims 5, 6, 14–17, 28, and 29 because we "overlooked or misapprehended the claim construction with respect to claims 5, 6, and 14 and the claims that depend from those claims" in two ways. Reh'g Req. 1–13. First, Petitioner contends that we wrongly interpreted the skip back algorithm as one that "precludes multiple button presses." *Id.* at 1. Second, Petitioner contends that we wrongly interpreted the skip back algorithm as referring to a "predetermined time" that is measured "from the beginning of the currently

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[2] *Personal Audio LLC v. Apple, Inc., et al.*, Case No. 9:09-cv-00111 (E.D. Tex.) (the "Apple Litigation")

playing audio program file." *Id.* at 5–6. Based on these allegedly erroneous claim interpretations, Petitioner contends that we wrongly concluded that the prior art, particularly Inazawa, fails to describe the claimed skip back algorithm. *Id.* at 1–11. Petitioner also contends that, even if we were to maintain our interpretation of the skip back algorithm, we wrongly concluded that Inazawa fails to describe that algorithm. *Id.* at 11–13. We disagree with Petitioner on both contentions and maintain our determination that Petitioner failed to establish that Inazawa describes the claimed skip back algorithms of recited in claims 5, 6, and 14 and their respective dependent claims 7, 8, 15–17, 28, and 29.

A. MULTIPLE BUTTON PRESSES

Petitioner contends that we wrongly interpreted claims 5, 6, and 14 as reciting a "skip back algorithm" that "precludes multiple button presses." Reh'g Req. 1. In doing so, Petitioner identifies two statements in the Final Written Decision that it contends reflect the manner in which we "misapprehended" the meaning of these claims. For the reasons expressed below, we disagree.

Petitioner quotes our statement that the "plain terms recited in claims 5, 6, and 14 require that the skip back algorithm is invoked by <u>the same command</u>, a 'skip backward program selection' in claims 5 and 6, and a 'third one of said control commands' in claim 14." *Id.* at 2 (quoting Final Dec. 39–40 with Petitioner's emphasis). Petitioner argues that the use of the indefinite article "a" preceding "skip backward program selection command" in claims 5 and 6 dictates that claims 5 and 6 refer to different "skip backward" commands. *Id.* at 2–3.

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