

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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STINGRAY DIGITAL GROUP, INC.,  
Petitioner,

v.

MUSIC CHOICE,  
Patent Owner.

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Case IPR2018-00114  
Patent 9,357,245 B1

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Before MITCHELL G. WEATHERLY, GREGG I. ANDERSON, and  
JOHN F. HORVATH, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* HORVATH.

Opinion Concurring filed by *Administrative Patent Judge* WEATHERLY.

HORVATH, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review  
and  
Denying Motion for Joinder  
*37 C.F.R. §§ 42.108, 42.122(b)*

## I. INTRODUCTION

### A. Background

Stingray Digital Group, Inc., (“Petitioner”) filed a Petition to institute *inter partes* review of claims 1–10 and 12–17 (“the challenged claims”) of U.S. Patent No. 9,357,245 B1 (Ex. 1001, “the ’245 patent”). Paper 1 (“Pet.”), 1, 4. Because the Petition would otherwise be time-barred pursuant to 35 U.S.C. § 315(b), Petitioner also filed a Motion for Joinder under 35 U.S.C. § 315(c) to join this Petition to *Stingray Digital Group, Inc. v. Music Choice*, Case No. IPR2017-01193 (PTAB Oct. 10, 2017) (“*Stingray-193*”). *Id.* at 1; *see also* Paper 3, 1. Subsequent to the filing of the present Petition and Motion for Joinder, Music Choice (“Patent Owner”) disclaimed claims 1–9, 12–14, 16, and 17 of the ’245 patent. *See Stingray-193*, Ex. 2002. Patent Owner also filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

Upon consideration of the Petition and Preliminary Response, we are not persuaded, under 35 U.S.C. § 314(a), that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the remaining challenged claims (i.e., claims 10 and 15) of the ’245 patent. Accordingly, we decline to institute an *inter partes* review of the challenged claims, and deny Petitioner’s Motion for Joinder.

### B. Related Matters

Petitioner identifies the following as matters that could affect, or be affected by, a decision in this proceeding: *Music Choice v. Stingray Digital Group, Inc.*, Case No. 2:16-cv-00586-JRG-RSP (E.D. Tex.); *Stingray Digital Group, Inc. v. Music Choice*, Case No. IPR2017-01193 (PTAB Oct.

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10, 2017) (challenging the patentability of claims 1–9, 12–14, 16, and 17 of the '245 patent); and *Stingray Digital Group, Inc. v. Music Choice*, Case No. IPR2017-01192 (PTAB Oct. 19, 2017) (challenging the patentability of U.S. Patent No. 8,769,602 B1 (“the '602 patent”), from which the '245 patent descends) (“*Stingray-192*”). Pet. 1–2. Patent Owner identifies the same matters, as well as U.S. Patent Nos. 7,275,256, 7,926,085, 8,769,602, and 9,451,300, from which the '245 patent also descends. Paper 5, 2–3.

*C. Evidence Relied Upon*

Reference		Publication Date	Exhibit
Mackintosh	WO 00/19662	Apr. 6, 2000	Ex. 1004

Petitioner also relies upon the Declaration of Michael Shamos, Ph.D. (Ex. 1003).

*D. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability:

Reference	Basis	Claims Challenged
Mackintosh	§ 102(b)	1–9, 12–14, 16, and 17
Mackintosh	§ 103(a)	10 and 15

II. ANALYSIS

*A. The '245 Patent*

The '245 patent is directed toward a system and method for providing an interactive, visual complement to one or more audio programs. Ex. 1001, Abstract. Figure 1 of the '245 patent is reproduced below.

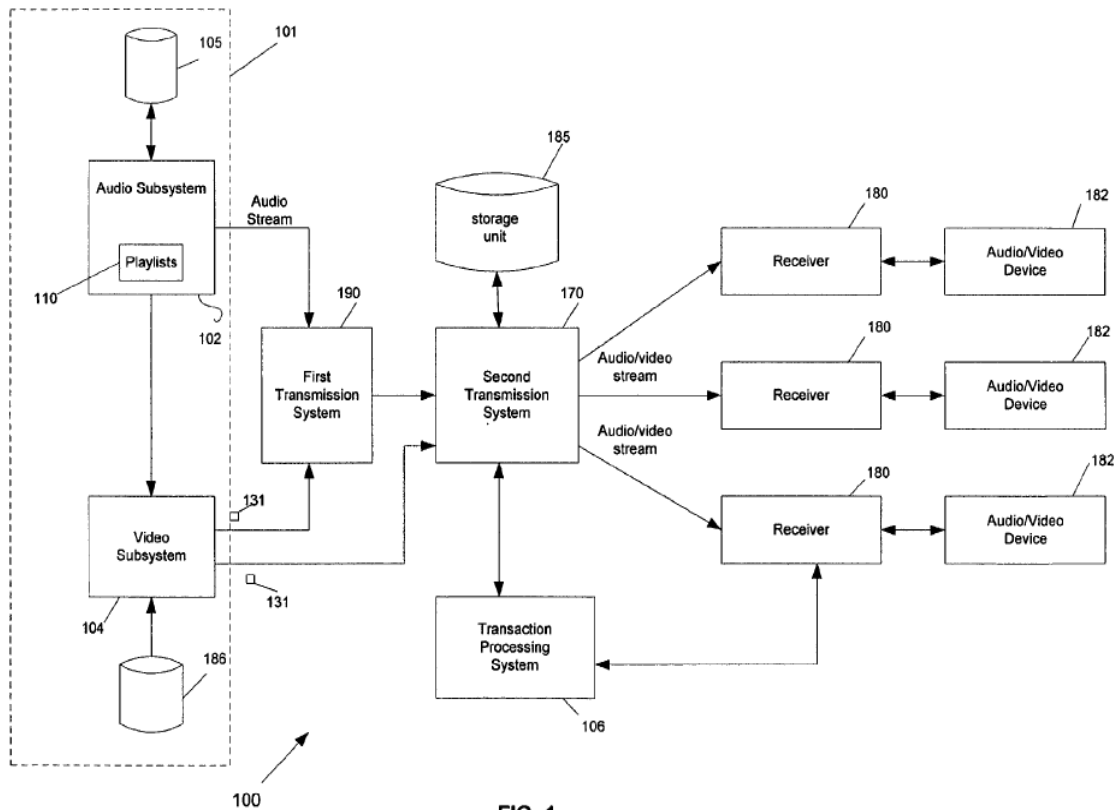


FIG. 1

Figure 1 is a block diagram of audio/video system 100 for providing audio/video programming to consumers. *Id.* at 2:63–65. System 100 includes audio subsystem 102 having playlist 110, video subsystem 104, first transmission system 190, second transmission system 170, receivers 180, and audio/video devices 182. *Id.* at 4:10–36. Playlist 110 contains programmed sound recordings for transmission to listeners of system 100 over a broadcast channel, and is typically generated on a periodic basis (e.g., daily or weekly). *Id.* at 4:11–16. Audio subsystem 102 transmits the programmed sound recordings to first transmission system 190, which further transmits the recordings to second transmission system 170, which transmits the recordings to audio/video receivers 180. The latter are coupled to audio/video devices 182 that reproduce the sound recordings for system

subscribers. *Id.* at 4:22–34. Audio/video receivers 180 may be, e.g., set-top boxes, and audio/video devices 182 may be, e.g., televisions. *Id.* at 4:34–36.

Video subsystem 104 generates a data packet upon receiving a trigger from audio subsystem 102. Ex. 1001, 4:37–39, 6:30–35. The trigger identifies the sound recording, information about the sound recording, and the channel broadcasting the sound recording. *Id.* at 6:30–35. The generated data packet contains a video image specification that specifies a visual complement to the audio broadcast. *Id.* at 4:39–44. The video image specification includes one or more visual media asset identifiers, where visual media assets can be graphic images, videos, text messages, and other media assets. *Id.* at 4:45–52. For example, the video image specification may include the name of a song, artist, and album associated with the song currently broadcast by transmission system 170. *Id.* at 4:54–67. The video image specification “may also specify the screen position where each identified asset is to be displayed” on a subscriber’s screen. *Id.* at 4:47–49. The data packet containing the video image specification can be an XML or HTML file. *Id.* at 5:31–39. Once generated, the data packet is transmitted from video subsystem 104 to first transmission system 170. *Id.* at 5:40–47.

Transmission system 170 parses the data packet received from video subsystem 104, and uses the information contained in the video image specification to generate and transmit a video image to audio/video receivers 180. Ex. 1001, 5:63–6:2. The video image may be encoded according to a Moving Pictures Expert Group (MPEG) standard, a National Television Standards Committee (NTSC) standard, or another video signal standard. *Id.* at 6:10–13. The video image is then displayed by audio/video devices 182. *Id.* at 6:2–3. To generate the video image from the video image

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