

UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.
Petitioner

v.

ADVANCED AUDIO DEVICES, LLC
Patent Owner

Case IPR2014-01154

Patent No. 6,587,403

PATENT OWNER'S CONTINGENT MOTION TO AMEND

Patent Owner, ADVANCED AUDIO DEVICES, LLC, respectfully moves that any claim that is found unpatentable be replaced with its corresponding proposed substitute claim as set forth in this Motion.

Respectfully submitted,

ADVANCED AUDIO DEVICES, LLC

By: /James R. Foley/

James R. Foley
Reg. No. 39,979
Timothy M. McCarthy
Reg. No. 42,855
John S. Paniaguas
Reg. No. 31,051
CLARK HILL PLC
150 N. Michigan Ave., 27th Fl.
Chicago, Illinois 60601
Counsel for Patent Owner

Patent Owner respectfully moves that if any of the contested claims, claims 1, 6, 7, 22, 27, 29, 30, 35, 43, and 45 through 47, are found unpatentable on Grounds 1 or 2 of the Petition, that the unpatentable claims be replaced with the proposed substitute claims set forth in the Appendix to this Motion.

I. Proposed substitute claims

Patent Owner proposes that claim 1 be amended to include the following limitations:

said music jukebox configured such that said music library, after being stored, is organizable into a master song list and at least one group of sound tracks wherein each group comprises at least one sound track selected from the master song list, wherein after the sound tracks are stored and organized, the order of the sound tracks in said group of sound tracks is customizable,

Patent Owner proposes that claims 6, 7, 22, 27, 29, 30, 35, 43, and 45 through 47 be amended solely to change dependency.

II. Support for Changes in Originally Filed Application

Pursuant to 37 C.F.R 42.121 (b) and 37 C.F.R 42. 221 (b), the support for the changes to claim 1 as set forth in proposed claim 49 is described below. A copy of United States patent application No. 09/641,069 (the “069 Application”), filed on August 17, 2000, is submitted as Exhibit 2006.

There are two proposed changes to claim 1 as set forth in proposed substitute claim 49. The support for each of these changes is provided below. Each of the citations relates to the 069 Application (Ex. 2006). It is respectfully submitted that neither of these changes enlarges the scope of the claim.

A. Proposed Change 1

The first proposed change relates to adding the words “after being stored.” This change is amply supported in the specification and inherently supported in Claim 1.

The following support is provided in the specification:

1. Page 8, lines 7-10: “The music jukebox includes means for selecting a sound track from the music library **stored** in the data storage structure to play through the audio output structure, and the housing includes a display thereon which identifies sound tracks in the music library.”

2. Page 10, lines 11 and 12: “As will be described, the music jukebox 30 has memory so sound tracks can be **stored** therein and selectively played back.”

3. Page 27, lines 9-13: “Other functions which may be automatically performed by the central processing unit 94 include trimming the lead and/or tail from a take, fading in or out a take, slating a take, setting the equalizing levels for a recording session or even for particular sound tracks within a session, supporting multiple sessions **stored** in the data storage device 106, and permitting the

composing of a session from a library of takes.”

4. Page 29, lines 2-5 : “Either before or after auditioning the digital data and possibly after rearranging the order of the individual digital files, the user may direct or program the compact disc recorder 30 to record, or burn, an image of sound tracks (digital data) **stored** in the data storage structure 106 onto a compact disc.”

5. Page 36, lines 17-21: “However, this does not cause the sound track to be deleted from the data storage device on which the sound track has been **stored**, and the sound track will still remain contained in the master song list which is accessed by pressing push-button 53 while the display is as shown in FIG. 8, after which the display device 46 appears as shown in FIG. 9.”

6. Page 37, lines 1-7: “The display shown in FIG. 9 includes data storage structure indicia 232 which indicates in which data storage structure (e.g. part 106) the list of sound tracks is stored, a master sound track list 234 which lists all the sound tracks stored in the data storage structure indicated by the data storage structure indicia 232, and selection menu 236 which indicates that a user can access the following functions by pressing a corresponding push-button 53, 55, 57, 59, 61, 63 from the set 52 of push-buttons on the front bezel 44: view, up, down, add, exit, more.”

7. Claim 1 supports the change. In particular, claim 1 recites (prior to

the proposed change) “said music jukebox configured such that said music library is organizable into a master song list and at least one group of sound tracks wherein each group comprises at least one sound track selected from the master song list”. It is inherent in the claim language that the “music library” cannot be organized until it is **stored**.

B. Proposed change 2

The second proposed change relates to adding the phrase: “wherein after the sound tracks are stored and organized, the order of the sound tracks in said group of sound tracks is customizable,”

The following support is provided in the specification for this change.

1. Col. 3, lines 31-34: “Still another object of the present invention is to provide a music jukebox that provides that one can easily customize the order in which sound tracks will appear on a compact disc.”

2. Col. 21, lines 2-7: ” Using the compact disc recorder 30, one can easily customize the order in which sound tracks will appear on the compact disc and one can easily write several compact discs having different orders of songs or having slightly different compilations without having to re-enter the sounds into the device 30.“

C. Dependent Claim Changes

The dependency of the balance of the challenged claims 6, 7, 11, 12, 16, 22,

24, 29, 30, 35, 36, 37, 43, 45, 46 and 47 was changed based upon the proposed substitute claim 49.

III. Claim Construction

With respect to proposed change 2, the term "organizable" has already been construed by the Board to include "customizing and rearranging" ("while the specification does disclose the ability to reorder sound tracks within a playlist, it uses the terms 'rearranging' or 'customizing' to describe this ability. Ex. 1001, 13:11-12 ('rearranging the order of the individual files"); *Id* at 13:11-12 ("customize the order in which tracks will appear"). To the extent AAD's proffered construction of "put things into a particular arrangement or order..., it is not in error..." Decision, page 9. It is respectfully submitted that the proposed change 2 simply codifies the Board's claim construction of the term "organizable".

It is respectfully submitted that Proposed Change 2 narrows the scope of Claim 1.

It is further submitted that proposed change 1 simply recites that the sound tracks are stored before being organized. The claim recites that sound tracks are "storable". It is inherent in the claim that the device has the ability to customize sound tracks only after the sound tracks are stored.

It is respectfully submitted that Proposed Change 1 does not change the

scope of the claim.

IV. Level of Skill in the Art

Patent Owner accepts Petitioner's definition of a person of ordinary skill in the art: "[A] person of ordinary skill in the art would have at least a bachelor's degree in electrical engineering, computer science, or equivalent, and 1-3 years of experience in designing and programming consumer electronic devices."

Schmandt Declaration, Exhibit 1007, at ¶ 25.

V. Patentability over the Prior Art

Peter Keller, one of the inventors of the '403 Patent and Manager/President of Patent Owner, is an avid jazz, pop, and classical music enthusiast. Recognizing that analog audio tape and vinyl records could degrade, he investigated methods of preserving a music library. He found that audio tape recorders were unacceptable for various reasons. ('403 Patent at col. 1, ln. 31-40) For example, known prior art audio tape recorders did not provide a way to customize the order in which sound tracks will play. ('403 Patent at col. 1, ln. 42-48) Out of that frustration, the inventors of the '403 Patent invented a music jukebox that could be used for, among other things, storing sound tracks easily and customizing the order of sound tracks. ('403 Patent at col. 3, ln. 23-38.)

The '403 Patent claims a structure that receives external audio signals, records those signals, and allows the user to organize and those signals into a

music library and customize the order of those sound tracks. This functionality was missing from the prior art.

During the prosecution of the '403 patent, Alexander, US Patent No. 5,633,839 (Alexander patent) and Timis US Patent No. 5,792, 971 ("Timis patent") were the most pertinent references. The salient portions of the prosecution history of the '403 patent are discussed on Pages 9 and 10 of HTC's Petition.

Timis '971 discloses a method for editing digital audio information, such as musical material (Timis, Abstract). It does not otherwise disclose a jukebox with the functionality as set forth in Claim 1 including the ability to re-order the sound tracks in a group of sound tracks. Alexander '839 relates to a music vending machine in which music selections purchased by a customer are written to CD that is provided to the customer (Alexander, Abstract). Alexander '839 does not otherwise disclose a jukebox with the functionality as set forth in Claim 1 including the ability to re-order the sound tracks in a group of sound tracks.

With respect to the current proceedings, Nathan 259 is the closest art. As discussed in the Patent Owner's Response, filed herewith, the Nathan 259 jukebox provides no ability to customize the order of the soundtracks that are in the queue. More specifically, in the Nathan 259 jukebox, the songs that are ordered and validated are written to the queue. Nathan 259 ¶ [0074]. Once these songs are in the queue, the songs are automatically played in sequence or randomly. Nathan

259 ¶ [0102].

As set forth in the Patent Owner's Response, filed herewith, neither Nathan 259 nor Nathan 255 disclose a jukebox in which a music library of sound tracks downloaded into memory can be organized into a master song list and at least one group of songs at least one song selected from the music library wherein after the sound tracks are stored and organized, the order of the sound tracks in said group of sound tracks is customizable.

In the Nathan 259 jukebox, the user has no ability to customize the order of the sound tracks. As such feature proposed by the amendment is likewise not disclosed or suggested in Nathan 255, nor does HTC argue that it does. As such, the proposed amendment clearly defines patentable subject matter over Nathan 259, as well as over the other references of record and known prior art. Patent Owner has prosecuted an entire family of patents based on the same disclosure as in the 171 Patent, including but not limited to those undergoing *inter partes* review (see IPR2014-01154, IPR2014-01155, IPR2014-01156, and IPR2014-01157). The most recently issued patent in the family, United States Patent No. 8,400,888, had hundreds of items of prior art cited against it. Patent Owner and its attorneys, nevertheless, believe that the proposed claim contained herein is patentable over the art cited in the Petition, over the art cited in the entire family of patents, and over any other art known to Patent Owner. As far as Patent Owner knows, none of

the features now being claimed were previously known or disclosed in any of the prior art of record, or in any other prior art known to Patent Owner. *See* Declaration of Peter J. Keller at ¶ 18.

With respect to the Lucente, Ozawa, and Sound Blaster references, as set forth in the Patent Owner's Response, based upon the level of skill in the art set forth above, the references are not properly combinable. As such, proposed substitute claim 49 (claim 1, as amended), is patentable over these references.

Based on the above, it is respectfully submitted that the patentability of substitute claim 49, is patentable over all of the art of which the Patent Owner is aware.

Accordingly, for all of the above reasons, Patent Owner respectfully requests that if the Board finds claim 1 of the '403 patent to be unpatentable, that the Amendment herein be entered.

Respectfully submitted,
ADVANCED AUDIO DEVICES, LLC

By: /James R. Foley/

James R. Foley
Reg. No. 39,979
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CLARK HILL PLC
150 N. Michigan Ave., 27th Fl.
Chicago, Illinois 60601
Counsel for Patent Owner

APPENDIX

A. Proposed Replacement of Claim 1

49. A music jukebox configured for storing a music library therein, said music jukebox comprising: a housing; an audio data receiver arranged to receive audio data from outside the housing; audio output structure located at least partially within the housing for outputting audio signals; data storage memory in the housing for storing audio data received from outside the housing through the audio data receiver, said music jukebox including a user interface comprising a display device located at least partially within the housing, said display device providing a display which is viewable from outside the housing, and a plurality of manually operable function controllers on the housing, said music jukebox configured such that a music library of sound tracks is storable in digital form in the data storage memory as a result of audio data being received from outside the housing through the audio data receiver, said music jukebox configured such that said music library, after being stored, is organizable into a master song list and at least one group of sound tracks wherein each group comprises at least one sound track selected from the master song list, wherein after the sound tracks are stored and organized, the order of the sound tracks in said group of sound tracks is customizable, wherein said music jukebox is configured such that indicia of said master song list and indicia of at least one group of sound tracks are displayable on

said display, wherein said music jukebox is configured such that said plurality of manually operable function controllers is useable to select a group of sound tracks stored in the data storage memory and operate the music jukebox such that said music jukebox outputs audio signals through said audio output structure.

B. Proposed Replacement of Claim 6

50. A music jukebox as recited in claim 49 [1], said music jukebox configured such that at least one sound track in the data storage memory is organizable into at least one group of sound tracks.

C. Proposed Replacement of Claim 7

51. A music jukebox as recited in claim 49 [1], further comprising at least one manually operable function controller capable of being operated to facilitate organizing at least one sound track into at least one group of sound tracks.

D. Proposed Replacement of Claim 11

52. A music jukebox as recited in claim 50 [6], said music jukebox configured such that names are assignable to at least one group of sound tracks.

E. Proposed Replacement of Claim 12

53. A music jukebox as recited in claim 52 [11], further comprising at least one manually operable function controller capable of being operated to facilitate naming at least one group of sound tracks.

F. Proposed Replacement of Claim 16

54. A music jukebox as recited in claim 49 [1], further comprising at least

one manually operable function controller capable of being operated to facilitate digitally editing at least one sound track in the data storage memory.

G. Proposed Replacement of Claim 22

55. A music jukebox as recited in claim 49 [1], wherein said audio data receiver comprises at least one external digital interface.

H. Proposed Replacement of Claim 24

56. A music jukebox as recited in claim 55 [22], wherein said external digital interface is communicatively connected to at least one of a Serial Interface Bus and a Digital Signal Processor.

I. Proposed Replacement of Claim 29

57. A music jukebox as recited in claim 49 [1], wherein the music jukebox is configured to sort at least one of the sound tracks and the groups of sound tracks stored in said data storage memory according to indicia of said sound tracks and groups of sound tracks.

J. Proposed Replacement of Claim 30

58. A music jukebox as recited in claim 49 [1], wherein the music jukebox is configured to audition at least one sound track in said data storage memory.

K. Proposed Replacement of Claim 35

59. A music jukebox as recited in claim 49 [1], wherein the display comprises a touch screen such that the music jukebox is capable of being operated

by touching the touch screen display using at least one of a finger, a light pen and a stylus.

L. Proposed Replacement of Claim 36

60. A music jukebox as recited in claim 49 [1], wherein the user interface further comprises a microphone and sound receiving means located at least partially within the housing.

M. Proposed Replacement of Claim 37

61. A music jukebox as recited in claim 60 [36], wherein the music jukebox is configured such that the music jukebox is capable of being operated by a user using voice commands.

N. Proposed Replacement of Claim 43

62. A music jukebox as recited in claim 49 [1], further comprising an amplifier located in the housing.

O. Proposed Replacement of Claim 45

63. A music jukebox as recited in claim 49 [1], wherein the audio output structure comprises at least one of a headphone jack and a phone jack.

P. Proposed Replacement of Claim 46

64. A music jukebox as recited in claim 49 [1], further comprising at least one manually operable function controller, configured such that said manually operable function controller is operable to adjust an output gain of said audio signals output by said music jukebox.

Q. Proposed Replacement of Claim 47

65. A music jukebox as recited in claim 49 [1], wherein said data storage memory comprises random address memory.

Certificate of Service

I served the foregoing Patent Owner's Preliminary Response on the following counsel by email on April 6, 2015:

Bing Ai, ai-ptab@perkinscoie.com

Hwa Lee, Hlee@perkinscoie.com

Thomas Millikan, tmillikan@perkinscoie.com

s/Timothy M. McCarthy/