

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**AMAZON.COM, INC.,
AMAZON.COM SERVICES LLC,
AMAZON WEB SERVICES, INC., and
AUDIBLE, INC.,**
Petitioners,

v.

AUDIO POD IP, LLC,
Patent Owner.

Case No. IPR2025-00757
U.S. Patent No. 10,091,266

**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 10,091,266**

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TABLE OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent. No. 10,091,266 (“the ’266 patent”)
1002	Declaration of Professor Ketan Mayer-Patel, Ph.D.
<i>Exhibit Numbers 1003-1019 Not Used</i>	
1020	U.S. Patent Publication No. 2015/0093093 (“Abecassis”)
1021	U.S. Patent Publication No. 2009/0259711 (“Drieu”)
1022	U.S. Patent Publication No. 2002/0034374 (“Barton”)
1023	U.S. Patent Publication No. 2015/0256903 (“Walker”)
1024	U.S. Patent Publication No. 2012/0084455 (“McCue”)
1025	U.S. Patent Publication No. 2014/0280695 (“Sharma”)
<i>Exhibit Numbers 1026-1034 Not Used</i>	
1035	U.S. Patent Publication No. 2004/0148638 (“Weisman”)
<i>Exhibit Numbers 1036-1049 Not Used</i>	
1050	U.S. Patent App. No. 15/054,756, filed February 26, 2016 (“the ’756 application”)
<i>Exhibit Numbers 1051-1094 Not Used</i>	
1095	Excerpts from the File History of U.S. Patent No. 10,091,266
1096	CV of Professor Ketan Mayer-Patel, Ph.D.

Petitioners Amazon.com, Inc., Amazon.com Services LLC, Amazon Web Services, Inc., and Audible, Inc. (“Petitioners” or “Amazon”) respectfully request *inter partes* review of claims 1-13 of U.S. Patent No. 10,091,266 (“the ’266 patent”), which Audio Pod IP, LLC (“Patent Owner” or “PO”) purportedly owns.

I. INTRODUCTION

The ’266 patent claims relate to rendering, simultaneously and in synchronization, first content on a first device and secondary content on a second device. The claims are lengthy, but merely combine three known concepts: (1) exchanging a content “identifier” and a “play position” between two devices; (2) simultaneously and synchronously presenting digital content on two devices; and (3) discarding unneeded content from device memory.

By the time of the patent’s earliest possible priority date in 2016, each of these concepts was well known. For example, in 2015, Abecassis disclosed simultaneously and synchronously displaying content on two devices using an identifier and a play position. Years earlier, in 2009, Drieu disclosed using a server to send an identifier and play position between devices. And, in 2002, Barton disclosed the claimed method of discarding content from memory to reduce storage demand. These references render the claims obvious.

PO’s own prior patents also render the claims unpatentable. U.S. Patent Publication No. 2012/0084455 (“McCue”) published long before the ’266 patent’s 2016

priority date. McCue discloses or renders obvious every limitation of the '266 patent claims except simultaneously and synchronously presenting content on two devices. However, that limitation was known in the art and disclosed by Sharma in 2014.

Thus, the Board should cancel the challenged claims.

II. BACKGROUND AND STATE OF THE ART

A. Exchanging a Content Identifier and a Play Position Between Devices Was Well Known.

By 2016, exchanging content information between devices was well known. For example, Abecassis taught that a second device obtains a “video ID” and a play position for the video playing on a first device to allow the devices to display content simultaneously. (EX-1020 ¶¶[0258], [0261], [0281], Abstract.) The second device used the video ID to obtain a “video map” describing the video content as well as information and content necessary to display supplemental content. (*Id.* ¶[0067].) The second device used the play position to display supplemental content such as images, location information, subtitles, or shopping items related to the video playing on the primary device. (*Id.* ¶¶[0067], [0084], [0108], [0134]-[0136], Abstract.)

Drieu disclosed exchanging content information, including a “media object identifier” and a play position, between devices via a server. (EX-1021 ¶¶[0024], [0030], [0037]-[0038].)

PO’s own prior art, McCue, also disclosed exchanging content information, including a content identifier and a play position, between devices. (EX-1002 ¶36.)

B. Simultaneously and Synchronously Presenting Digital Content Across Two Devices Was Well Known.

By 2016, simultaneously and synchronously presenting digital content on two devices was also well known. Abecassis taught a second device that “display[s] information on the second screen device synchronized with the contemporaneously played video on the primary screen device.” (EX-1020, Abstract.) Sharma likewise taught a multi-screen system where a user “may consume second screen content in synchronization with primary content that the user simultaneously consumes via a first screen device.” (EX-1025 ¶[0059].)

C. Discarding Unneeded Content From Device Memory Was Well Known.

Discarding unneeded content from device memory was also well known. For example, Barton disclosed streaming content using a linear cache (“LC”). (EX-1022 ¶[0031].) Barton’s LC is shown in Figure 3:

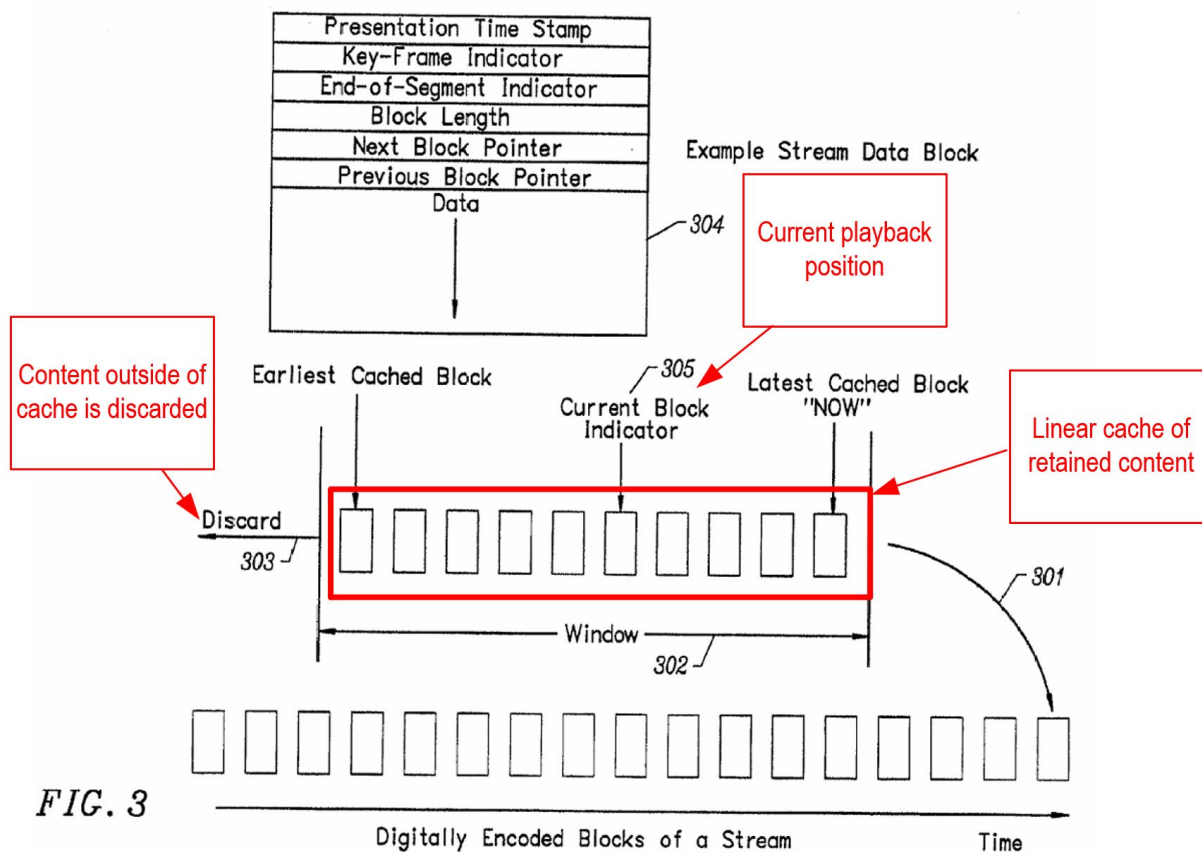


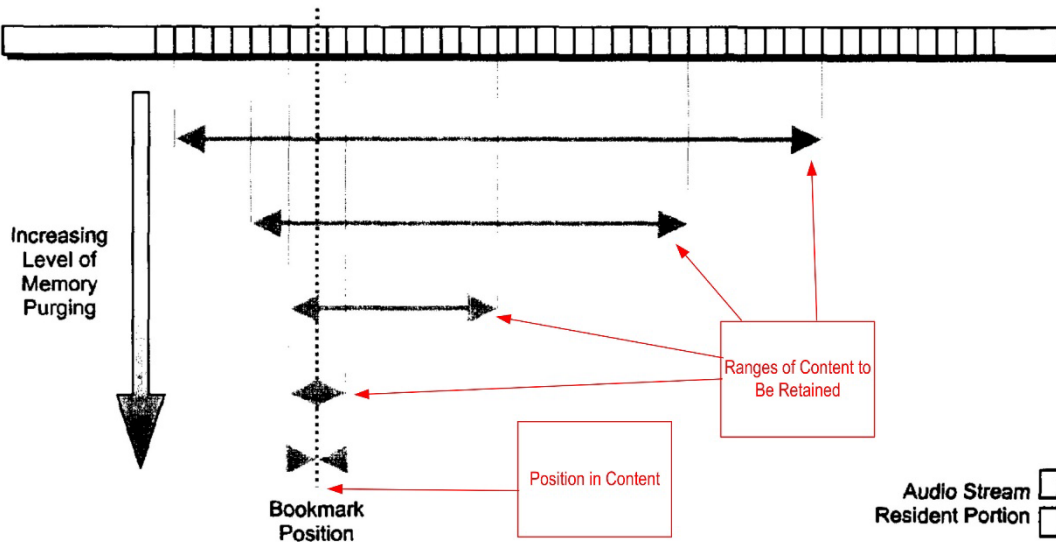
FIG. 3

(*Id.*, Fig. 3¹; EX-1002 ¶39.) Barton disclosed identifying and retaining a “window” of content around the user’s current position. (EX-1022 ¶¶[0048]-[0049].) Content outside the window is discarded to reduce memory demand. (*Id.* ¶[0049].)

McCue disclosed a similar process. (EX-1002 ¶40.) McCue teaches “a memory purge process” that ensures that a “requested level of free memory is made available.” (EX-1024 ¶[0091].) McCue’s purge “focuses on the bookmark position within the audio stream.” (*Id.* ¶[0096].) The process for purging bookmarked audio

¹ Figures may be annotated for clarity.

streams is shown in Figure 13, which shows ranges of content to be purged depending on memory demand:



(EX-1024, Fig. 13.)

III. THE '266 PATENT

A. Overview

The '266 patent's specification is extremely similar to McCue's because McCue is a continuation-in-part of a patent in the priority chain of the '266 patent. Indeed, most of the '266 patent's disclosure is verbatim in McCue, although McCue added more disclosure. Relevant here, the '266 patent, like McCue, discusses transferring a bookmark from a first client to a second client. (EX-1001, 8:24-41, Fig. 9.) The bookmark identifies the particular content and the position in the content. (*Id.*, 8:10-11, Fig. 9.) Like McCue, the '266 patent also discloses discarding unneeded content from memory. (*Id.*, 12:66-13:1, 13:23-49, Fig. 13.)

B. Claims

Claims 1-13 are challenged in this petition. Claim 1 is representative and recites a “method of rendering digital content across multiple client devices.” The method comprises several steps, falling into three categories. A first set of steps relates to rendering content on a first device:

- [a] rendering on a first client device at least a portion of primary digital content;
- [b] determining on the first client device an identifier corresponding to the primary digital content, wherein the identifier identifies a descriptor of the primary content;
- [c] determining on the first client device a first position in the primary digital content;

The second set of steps relates to rendering associated content on a second device:

- [d] transferring the identifier and the first position from the first client device to a second client device via a network accessible library;
- [e] downloading the descriptor from the network accessible library to the second client device by using the identifier;
- [f] rendering on the second client device at least a portion of secondary other digital content associated with the primary digital content by using the descriptor and the first position, wherein the secondary digital content is ancillary to the primary digital content, and wherein the secondary digital content is rendered on the second client device simultaneously and in synchronization with the rendering of the primary digital content on the first client device;

Finally, a third set of steps relates to discarding unneeded content on the first and second devices:

- [g] identifying a range of content surrounding the first position in the primary digital content as content to be retained;
- [h] releasing storage resources allocated to all content of the primary digital content that is not identified as content to be retained on the first client device;
- [i] identifying content in the secondary digital content that is related to the range of content surrounding the first position in the primary digital content as content to be retained; and
- [j] releasing storage resources allocated to all content of the secondary digital content that is not identified as content to be retained on the second client device.

C. Prosecution

The originally filed claims related to rendering digital content across multiple client devices. (EX-1095, 218-20.) Certain original claims also related to rendering ancillary digital content on a second client device “in synchronization” with first digital content on a first client device, but did not recite rendering content “simultaneously” with other content. (*Id.*) The Examiner rejected the original claims as obvious over two prior art references not relied on herein. (*Id.*, 124-28.)

In response, PO amended the independent claims to recite that “the secondary digital content is rendered on the second client device simultaneously and in synchronization with rendering of the primary digital content on the first client device.” (*Id.*, 112.) PO argued that a cited reference (Griffin) did not teach two pieces of content “rendered simultaneously and in synchronization.” (*Id.*, 119 (emphasis in original).) The Examiner had cited Griffin as disclosing playback of a second content file from where playback of a first content file was stopped “so that the playback

can seamlessly continue.” (*Id.*) The Examiner argued this satisfied the original claim’s “synchronization” requirement. (*Id.*) PO overcame Griffin by arguing that Griffin’s second content file was “rendered subsequently to, not simultaneously with” its first content file. (*Id.*) Thus, Griffin did not disclose the amended claim language.

PO also argued that the claims of its prior patent “make no mention of rendering secondary, ancillary digital content simultaneously with primary digital content.” (*Id.*, 117.) This amendment is the first time the term “simultaneously” was introduced into what became the ’266 patent.

The Examiner issued a new obviousness rejection based on different art. (*Id.*, 84-87.) PO then amended each independent claim to recite the final four claim elements relating to discarding unneeded content on the first and second devices. (*Id.*, 75-78.) The Examiner allowed the claims based on this amendment. (*Id.*, 23-24.)

D. The Earliest Possible Priority Date Is November 22, 2016.

1. Legal Standard for Priority

A patent claim is entitled to the benefit of an earlier-filed application only if the earlier application satisfies the written description requirement. *See* 35 U.S.C. §120; *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997). There must also be a continuity of disclosure: “each application in the chain leading

back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Lockwood*, 107 F.3d at 1571.

To comply with the written description requirement, the specification must contain disclosure such that “one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). “Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed.” *Lockwood*, 107 F.3d at 1571-72.

The Board can properly consider whether claims are entitled to earlier priority dates. *See Indivior UK Ltd. v. Dr. Reddy’s Labs. S.A.*, 18 F.4th 1323, 1330 (Fed. Cir. 2021) (affirming finding that claim was not entitled to priority date for lack of written description support in parent); *Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1344-45 (Fed. Cir. 2022) (confirming Board’s authority to decide whether parent application meets written description requirement).

2. The ’266 Patent’s Priority Chain Does Not Disclose Two Clients Rendering Content “Simultaneously and in Synchronization.”

The application for the ’266 patent was filed November 22, 2016, claiming priority to U.S. Patent Application No. 15/054,756 (“the ’756 application”). However, the ’756 application lacks written description support for the claim limitation

that recites rendering content across different devices “simultaneously and in synchronization.” (EX-1002 ¶¶43-47.)

During prosecution of the '266 patent, PO identified paragraphs 45 and 93-97 of the application as filed as supporting the “simultaneously and in synchronization” limitations. (EX-1095, 116.) These paragraphs are identical to the same numbered paragraphs of the parent '756 application. Accordingly, PO might argue that these paragraphs of the '756 application support rendering content “simultaneously and in synchronization” across devices. They do not.

Paragraph 45 of the '756 application discusses a “virtual audio stream descriptor” that “includes descriptive details used to describe the content of [an] audio stream, such as the title and/or ISBN” and, optionally, “internal media marks, illustrations related to the audio stream, and/or internal advertising.” (EX-1050 ¶[0045].) Nothing in that paragraph relates to presenting content on two different devices “simultaneously and in synchronization” as recited in each challenged claim.

Paragraphs 93-97 also lack any description of presenting content across two different devices “simultaneously and in synchronization.” Those paragraphs are part of a table that provides a “summary of various types of information, structures or files” that reside on servers within the system. (EX-1050 ¶[0066].) The paragraphs correspond to rows on the table discussing illustrations, ancillary content, and advertisements. (*Id.* ¶¶[0093]-[0097].) The rows contain no disclosure of how those

types of information would be presented at all, let alone any disclosure of presenting content across two different devices “simultaneously and in synchronization.”

Accordingly, the ’756 application contains no disclosure of rendering primary and secondary content on devices “simultaneously and in synchronization,” as claimed. (EX-1002 ¶47.) Because this is not disclosed in the ’756 application, the priority chain is broken and the earliest possible priority date of the claims is the actual filing date of the application for the ’266 patent, November 22, 2016. *Lockwood*, 107 F.3d at 1571; *The NOCO Co., Inc. v. Pilot, Inc.*, IPR2022-01417, Paper 12 at 11-13 (P.T.A.B. Feb. 6, 2024).

IV. LEVEL OF ORDINARY SKILL IN THE ART

A POSITA is “a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Here, a POSITA would have had at least a bachelor’s degree in electrical engineering, computer engineering, or computer science, and at least three years of industry or academic experience in the design, development, and/or implementation of content rendering and/or distribution systems. (EX-1002 ¶¶29-33); see *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Work experience could substitute for formal education and additional formal education could substitute for work experience. (EX-1002 ¶31.)

V. CLAIM CONSTRUCTION

No claim terms require construction to resolve the obviousness challenges here. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). For this proceeding only, Petitioners assume the claims are not invalid as indefinite under §112.

VI. STATEMENT OF PRECISE RELIEF REQUESTED

A. Grounds

The Board should cancel claims 1-13 as obvious under 35 U.S.C. §103 on the following Grounds:

Ground	Challenged Claims	References
1A	1-9, 12-13	Abecassis, Drieu, and Barton
1B	10-12	Abecassis, Drieu, Barton, and Walker
2A	1-13	McCue and Sharma
2B	10-12	McCue, Sharma, and Walker

Additional support is included in the Declaration of Professor Ketan Mayer-Patel, Ph.D. (EX-1002.)

B. Status of References as Prior Art

Each reference is prior art under post-AIA 35 U.S.C. §102² because it published before the patent’s earliest possible priority date of November 22, 2016: (i) Abecassis published on April 2, 2015; (ii) Drieu published on October 15, 2009; (iii) Barton published on March 21, 2002; (iv) Walker published on September 10, 2015; (v) McCue published on April 5, 2012; and (vi) Sharma published on September 18, 2014.

These references are analogous art because they are from the same field of endeavor as the ’266 patent, e.g., content distribution and/or rendering. (EX-1002 ¶24); *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1000 (Fed. Cir. 2016). They are also pertinent to a particular problem the inventor was focused on, e.g., efficient and effective distribution and/or rendering of content. (*Id.*)

VII. GROUND 1A: CLAIMS 1-9 AND 12-13 WOULD HAVE BEEN OBVIOUS IN VIEW OF ABECASSIS, DRIEU, AND BARTON.

A. Claim 1

1. Preamble

The preamble recites a “method of rendering digital content across multiple client devices.” To the extent the preamble is limiting, Abecassis discloses it. For

² Because the effective filing date of the ’266 patent is November 22, 2016, post-AIA 35 U.S.C. §102 applies. *See Leahy-Smith America Invents Act*, Pub. L. No. 112-29, 125 Stat. 284 (2011) §3(n)(1).

example, Abecassis discloses “displaying information on the second screen device synchronized with the contemporaneously played video on the primary screen device.” (EX-1020, Abstract.) The first and second screen devices are client devices. (*Id.* ¶¶[0057] (primary and secondary devices may be “televisions, personal computers, laptop and portable computers, tablets, smartphones, and mobile devices”), [0075] (primary and second screen devices “acquire[] access to the network 100 and the various services providers 101-103”); EX-1002 ¶50.)

Abecassis further discloses the content is digital. (EX-1020 ¶¶[0073] (video is “available over the internet”), [0292] (video played by devices disclosed in an incorporated patent entitled “Video Entity Recognition In Compressed *Digital* Video Streams” (emphasis added)); EX-1002 ¶51.)

Thus, Abecassis discloses the preamble. (EX-1002 ¶¶49-52.)

2. 1[a]: Rendering Primary Content on a First Client Device

Element 1[a] recites “rendering on a first client device at least a portion of primary digital content.” Abecassis discloses this because it discloses a “primary screen device” (a first client device) that is capable of “playing/displaying content.” (EX-1020 ¶[0057]; *see also id.* ¶¶[0114] (disclosing “playing [a] video on the primary screen device”), [0003]-[0004], [0006]-[0008], [0075] (identifying client devices), [0089]-[0090] (same), [0108], [0114]-[0115], [0122], [0125], [0129], [0141], [0258], Abstract, Figs. 12, 13; EX-1002 ¶¶53-55.)

**3. 1[b][i]: Determining an Identifier of the
Primary Content on a First Client Device**

Element 1[b][i] recites “determining on the first client device an identifier corresponding to the primary digital content.” Abecassis discloses this because it discloses that, upon the playing of a video on the primary screen, the device’s control program “causes the reading of the video’s *identifier* from the video source,” searches memory for a corresponding video map and, if one is not available, downloads the map. (EX-1020 ¶[0086] (emphasis added), Fig. 12.) Following a user’s selection of a video, “the video ID(s) are obtained” to determine whether a video map is available. (*Id.* ¶[0261], Fig. 12.) Thus, Abecassis discloses determining (reading or obtaining) on the first client device (primary screen device) an identifier (video ID) corresponding to the primary digital content (video). (EX-1002 ¶[57].)

Even if Abecassis did not disclose this limitation, Drieu discloses it. (*Id.* ¶[58].) Drieu discloses a “first device” determines “state information” including a “media object identifier” that relates “to a user’s access of content on the first device.” (EX-1021 ¶¶[0030], [0037]; *see also id.* [0004]-[0007], [0019], [0024], [0035]-[0036], [0037]-[0038].) Drieu’s first device may transmit “the determined state information.” (*Id.* ¶¶[0037]-[0038]; EX-1002 ¶[58].) To the extent Abecassis does not already disclose this limitation, a POSITA would have been motivated to modify

Abecassis’s method to incorporate this teaching of Drieu (along with Drieu’s teaching of transferring the identifier to the second device), for the reasons set forth below.

(*Infra* §VII.A.6; EX-1002 ¶¶59-62.)

Thus, Abecassis alone, or in combination with Drieu, discloses this limitation.

(EX-1002 ¶¶56-63.)

4. 1[b][ii]: The Identifier Identifies a Descriptor of the Primary Content

Element 1[b][ii] recites the “identifier identifies a descriptor of the primary content.” Abecassis discloses that its “video ID” (identifier) is used to “determine if a map” (descriptor) is available for a user-selected video. (EX-1020 ¶[0261], Fig. 12.) If not, “then the map is downloaded from a remote source.” (*Id.*; *see also id.* ¶[0086] (device causes “the reading of the video’s identifier from the video source,” uses the identifier to search for a video map, and downloads “the appropriate map” if necessary).)

Abecassis’s “video map” is a descriptor of the primary content, i.e., the video being played. Abecassis’s “‘video map’, ‘map’, and ‘segment map’” refer to “any combination, arrangement, table, database, listing, index, and/or information” that “defines a beginning and ending of one or more segments” of a video and “describes ... content of a video.” (*Id.* ¶¶[0040], [0067], [0082]-[0087], [0103].) The video map comprises a “descriptor” and a “linkage among segments.” (*Id.* ¶[0067].) It

also comprises “information, data, linkages, and content that may be required to enable or support the features and functions detailed” in Abecassis, such as “images and description of a location depicted in a particular scene of a movie,” “video map subtitle data” to identify and display subtitles corresponding to the “desired period of time,” or “[s]hopping items” to provide a shopping feature. (*Id.* ¶¶[0067], [0084], [0108].)

Abecassis’s video map contains the same information as the “descriptor” in the ’266 patent, e.g., subtitle information, advertisements, and information about segments. (EX-1001, Fig. 5c.) Abecassis’s video map similarly includes information about subtitles, shopping items, and video segments. (*See, e.g.*, EX-1020 ¶¶[0067], [0084], [0106]-[0116] (subtitles), [0190]-[0197] (shopping).)

Thus, Abecassis discloses an identifier (video ID) identifies a descriptor (map) of the primary content (video). (EX-1002 ¶¶64-68.)

5. 1[c]: Determining a Position in the Primary Content on the First Device

Element 1[c] recites “determining on the first client device a first position in the primary digital content.”

Abecassis discloses “an identification of [the] current play position may be performed by the primary screen device[.]” (EX-1020 ¶[0115]; *see also id.* ¶¶[0259] (primary device determines “the time code of the current play position”), [0259] (similar “time code retrieval functionality” is available with “most software media

players”), [0262] (when item notification routines have been activated, “the current play location within a video 1222 is identified” by primary device to enable display of notification information), [0114] (“second screen device receiv[es] ... from the primary screen device an identification of a current play position of a video being played on the primary screen device”), Abstract (second screen device “obtain[s] from the primary screen device an identification of a current play position of the video”).) Accordingly, Abecassis discloses the first device (primary screen) determines a first position (e.g., current play position) in the primary digital content (e.g., video). (EX-1002 ¶¶69-71.)

6. 1[d][i]: Transferring the Identifier and Position from the First Device to a Second Device

Element 1[d][i] recites “transferring the identifier and the first position from the first client device to a second client device.”

Abecassis discloses the primary device determines the identifier (video ID) and play position. (*Supra* §§VII.A.3, VII.A.5.)

Abecassis further discloses transferring the current play position from the first device to the second device. Specifically, Abecassis discloses the second screen device obtains “current play position data of a video being played on a primary screen device (e.g., obtaining *from the primary screen device* an identification of a current play position of the video).” (EX-1020, Abstract (emphasis added); *see also id.* ¶¶[0114] (“the second screen device receiving ... from the primary screen device

an identification of a current play position of a video being played on the primary screen device”), [0292] (system may provide “direct current play position identification”), claim 9 (second screen device receives, from a primary screen device, “an identification of a play position in a video playing on the primary screen device”).)

Transferring the video ID from the primary screen device to the secondary screen device would have been obvious to a POSITA in view of Abecassis’s disclosure. Abecassis discloses the second screen device downloads a video map using the video ID after obtaining the video ID. (EX-1020 ¶¶[0260]-[0261], Fig. 12.) An obvious way for the second device to obtain the video ID is for the primary device to send the video ID to the second screen device, either directly or through an intermediate server. (EX-1002 ¶75.)

Even if Abecassis did not disclose or render obvious transferring a video identifier and play position from the first device to the second device, it would have been obvious in view of Drieu. Drieu discloses the first device “determine[s] 802 state information relating to an access state” of content presented on the first device. (EX-1021 ¶[0037].) The state information can include a video identifier (“media object identifier”) and play position (“playhead position”). (*Id.* ¶¶[0030], [0037]-[0038]; *see also id.*, Abstract, ¶[0004], claims 1, 11, 17, 27, 33, 43; *supra* §§VII.A.3 (identifier), VII.A.5 (play position).) Drieu teaches transmitting the identifier (as

included in the state information) and play position to the second device. (*Id.*; *id.* ¶[0024].)

A POSITA would have been motivated to modify Abecassis to incorporate this teaching of Drieu for several reasons. (EX-1002 ¶¶77-80.)

First, the references suggest doing so. Abecassis discloses transferring the play position from the first device to the second device, as discussed. Abecassis also discloses the second device uses the “video ID” to identify and then synchronously display content with the first device. (EX-1020 ¶¶[0258], [0261], Abstract.) Drieu provides additional details as to how the second device acquires the video ID: the first device determines a media object identifier for the content and then transfers that identifier to the second device. (EX-1021 ¶¶[0030], [0037]-[0038].) Drieu uses its method to obtain the same goal as Abecassis. (*Compare* EX-1021, Abstract (Drieu goal of “[m]edia state synchronization”) *with* EX-1020, Abstract (Abecassis goal of “synchronized” playing on two devices).) Drieu further teaches how to transmit the identifier from one device to another. (EX-1020 ¶¶[0258], [0261]; EX-1021 ¶¶[0030], [0037]-[0038].) Thus, a POSITA implementing Abecassis’s method would have looked to other references, such as Drieu, for detailed teachings of how to transfer the identifier and play position. (EX-1002 ¶78.) Drieu’s method of using the first device to determine and transfer the identifier and play position would efficiently allow two devices to synchronize content between each other and ensure the

second device was correctly playing content corresponding to the content on the first device. (*Id.*)

Second, the combination represents nothing more than the simple addition of one known element (Drieu’s transfer mechanism for video identifier and play position) to another known element (Abecassis’s first and second devices) to obtain predictable results (enabling transfer of an identifier and play position from first device to second device). (*Id.* ¶79); *see KSR*, 550 U.S. at 417.

Third, the combination represents the use of a known technique (Drieu’s transfer of identifier and play position) to improve a similar device and method (Abecassis’s use of identifier and play position to display second screen content) in the same way. (*Id.*)

Fourth, the combination applies a known technique (Drieu’s identifier and play position transfer) to a known device and method (Abecassis’s use of identifier and play position at second devices) that is ready for improvement and yields predictable results (second device obtaining identifier and play position via transfer from a first device that determined the identifier and position). (*Id.*)

A POSITA would have had a reasonable expectation of success when making this combination because Abecassis already discloses using an identifier at two devices and Drieu teaches how to transmit this identifier from one device to another. (EX-1002 ¶80.)

Thus, Abecassis alone, or in combination with Drieu, discloses this limitation.

(*Id.* ¶¶72-81.)

7. 1[d][ii]: The Transfer Is Via a Network Accessible Library

Element 1[d][ii] recites that the transfer is “via a network accessible library.” Abecassis discloses, or at least suggests, this limitation because it discloses synchronizing devices through Wi-Fi networks “and/or remote servers.” (EX-1020 ¶¶0102.) A POSITA would have understood this disclosure to teach, or at least render obvious, transmitting the video ID and play position from the first device to the second device via a network accessible library. (EX-1002 ¶83.)

Even if Abecassis alone did not disclose or render obvious transferring the video ID and play position via a network accessible library, doing so would have been obvious in view of Drieu. Drieu teaches transferring an identifier and a play position between two devices. (*Supra* §VII.A.6; EX-1021 ¶¶[0037]-[0038], [0005].)

Drieu further teaches the transfer can occur via a network accessible library. For example, Drieu teaches a system including multiple clients connected to a server via a network. (EX-1021, Fig. 1, ¶¶[0020]-[0022], [0045].) The server provides content, such “as movies, television episodes, music, or presentations,” to clients. (*Id.* ¶¶[0028], [0020], [0029] (content server and state information server can be the same).) Thus, Drieu’s server is a network accessible library. (EX-1002 ¶85.) Drieu teaches the transfer of a position and identifier between clients is via the network

accessible library server. (EX-1021 ¶¶[0024] (transfer of state information between client devices occurs via “server 130”), [0020] (server 130 is content server); *see also id.*, Abstract, ¶¶[0004], [0037]-[0038], claims 1, 11, 17, 27, 33, 43.)

As discussed above, it would have been obvious to incorporate Drieu’s transfer of an identifier and position into Abecassis’s method. (*Supra* §VII.A.6.) Because Drieu’s transfer is via a network accessible server, this combination teaches “transferring the identifier and position from the first client device to a second client device via a network accessible library” as claimed. (EX-1002 ¶87.)

A POSITA would have been motivated to modify Abecassis to transfer the video ID (identifier) and play position (position) from the first device to a second device via a network accessible library, as taught by Drieu, for many reasons. (*Id.* ¶¶88-92.)

First, Abecassis suggests doing so because it explicitly contemplates synchronization of devices via “remote servers.” (EX-1020 ¶[0102]; EX-1002 ¶89.) Using a network accessible library server as taught by Drieu would be advantageous because storing identifiers, play positions, and content on the same location would reduce complexity of the system and require fewer servers. (EX-1002 ¶89.) Similarly, it would increase efficiency because a client would only need to communicate with a single server, as opposed to multiple servers for each of the identifiers, play positions, and content. (*Id.*)

Second, the combination represents nothing more than the simple addition of one known element (Drieu's transfer of identifier and position via a network accessible server) to another known element (Abecassis's method, in which the second device requires the identifier and position) to obtain predictable results (synchronization information transferred between devices via a network accessible server). (EX-1002 ¶90); *KSR*, 550 U.S. at 417.

Third, the combination represents the use of a known technique (transferring synchronization information via a network accessible server) to improve a similar device and method (Abecassis's) in the same way (provide synchronization information to second device). (*Id.*)

Fourth, the combination applies a known technique (Drieu's identifier and position transfer via a network accessible server) to a known device and method (Abecassis's) that is ready for improvement and yields predictable results (second device obtaining identifier and play position from first device via a network accessible server). (*Id.*)

Fifth, transferring the identifier via a server would allow the transfer to occur using a standard internet connection and would not require specialized hardware, such as Wi-Fi or Bluetooth transceivers. (EX-1002 ¶91.) This would advantageously simplify the types of client devices that could use the system. (*Id.*)

A POSITA would have had a reasonable expectation of success when making this combination because Abecassis already discloses synchronizing via servers and Drieu provides details about how that could be accomplished. (*Id.* ¶92.)

Thus, Abecassis and Drieu disclose and render obvious this limitation. (*Id.* ¶¶82-93.)

8. 1[e]: Downloading the Descriptor from the Library to the Second Device

Element 1[e] recites “downloading the descriptor from the network accessible library to the second client device by using the identifier.”

Abecassis’s video map is a descriptor. (*Supra* §VII.A.4.) That video map may be “downloaded ... at a second screen device.” (EX-1020 ¶[0260].) Abecassis further discloses the video ID is used to “determine if a map” is available for a user-selected video. (*Id.* ¶[0261], Fig. 12.) If not, “then the map is downloaded from a remote source.” (*Id.*; *see also id.* ¶[0289] (once video is identified, map may be “downloaded from a remote source”), Fig. 13.) Thus, Abecassis discloses the second device downloads the video map using the identifier. (EX-1002 ¶96.) Further, Abecassis discloses, or at least suggests, downloading this descriptor from the network accessible library because it discloses synchronizing devices through Wi-Fi networks “and/or remote servers.” (EX-1020 ¶[0102], EX-1002 ¶96.)

Even if Abecassis did not disclose this limitation, it would have been obvious to download the video map via the network accessible library in view of Drieu.

(EX-1002 ¶¶97.) Drieu teaches its library server provides content, such as movies, as well as metadata about the content. (EX-1021 ¶¶[0020], [0029].) A POSITA would have understood the video map of Abecassis comprises metadata about the content. (EX-1002 ¶¶97; EX-1020 ¶¶[0067] (video map includes metadata such as “a descriptor” or “video synchronizing information”).)

A POSITA would have been motivated to use the network library of Drieu, and would have reasonably expected success doing so, for the same reasons discussed above. (*Supra* §VII.A.7.) Moreover, Abecassis teaches video maps are stored at a “video provider” that enables the “downloading of ... video content” via a network. (EX-1020 ¶¶[0071]-[0072].) Thus, Abecassis teaches video maps can be obtained at a server with video content, like the server of Drieu. Accordingly, combining Abecassis with Drieu would merely be applying a known technique (Drieu’s video content server) to a known device and method (Abecassis’s video map source) that is ready for improvement and yields predictable results. (EX-1002 ¶¶98); *KSR*, 550 U.S. at 417.

Thus, Abecassis alone, or in combination with Drieu, discloses and renders obvious this limitation. (EX-1002 ¶¶94-99.)

9. 1[f]: Rendering Secondary Content on the Second Device

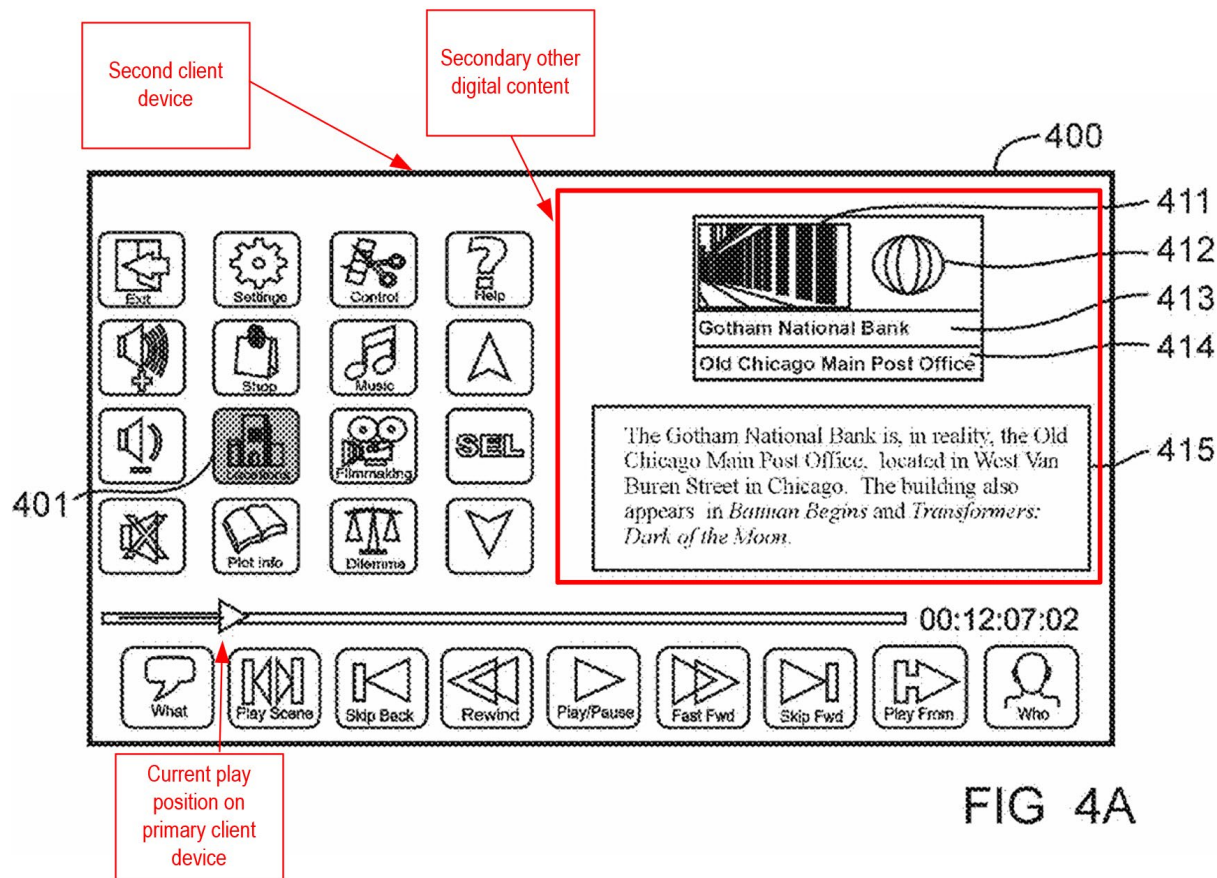
Element 1[f] recites “rendering on the second client device at least a portion of secondary other digital content associated with the primary digital content by using the descriptor and the first position, wherein the secondary digital content is ancillary to the primary digital content, and wherein the secondary digital content is rendered on the second client device simultaneously and in synchronization with the rendering of the primary digital content on the first client device.”

Abecassis discloses “displaying information on the second screen device synchronized with the contemporaneously played video on the primary screen device.” (EX-1020, Abstract; *see also id.* ¶¶[0007] (second display used for “synchronized” display of subtitles), [0080] (use of second screen may be “simultaneous” and used “as part of the viewing of the content on a primary screen”), [0104], [0105] (system is “synchronized” to provide additional information on second screen “during playback of the movie” on primary screen), [0109] (subtitles on second screen synchronized to video on first screen), [0112] (same), [0129] (identification information displayed on second screen “contemporaneously with the playing of the video” on primary screen), [0141] (disclosing second screen “synchronization to the playing of the video” on first screen), [0248] (supplemental information may be “displayed on the second screen as the video continues to be played on the primary screen”), [0257]

(video playback on primary screen synchronized with information on second screen), [0258], [0264], Fig. 12, claims 1-19.)

Abecassis further discloses the secondary content is rendered using the descriptor (video map) and the first position (play position). (*Id.* ¶¶[0105] (secondary video content rendered using video map), [0114] (supplemental content such as subtitles rendered using “current play position”), [0115], [0129] (using the “current play position,” supplemental “Who” information may be displayed on second screen “contemporaneously” and in “strict synchronization” with video playing on primary screen), [0129] (“responsive to the current play position, the depicted noteworthy performers/characters are identified” on the second screen), [0141]-[0142] (locale information synchronized to primary video), [0193]-[0194] (display of item for purchase is based on “current play location”).)

For example, Abecassis teaches a “Locations function” that “identifies the locale being depicted” on a primary device and provides “relevant locale information and geographical maps.” (*Id.* ¶[0134].) Abecassis teaches a second device uses the video map (a descriptor) to determine real-world information, such as images and descriptions, of a location depicted in a particular movie scene playing on a primary device, and then displays that information on the second device. (*Id.* ¶¶[0135]-[0138].) The second screen display of location information is depicted in Figure 4A of Abecassis:



(*Id.*, Fig. 4A; EX-1002 ¶103.)

Abecassis’s second screen content is “associated with” and “ancillary to” the original primary content. (EX-1020 ¶¶[0114]-[0115] (subtitles), [0128]-[0131] (information about performers/characters), [0133]-[0140] (locale information), [0144]-[0149] (plot information), [0150]-[0155] (filmmaking information), [0156]-[0165] (dilemmas), [0166]-[0175] (trivia), [0190]-[0197] (shopping information).) Such information is “ancillary to the primary digital content” (video playing on the first device) at least because it can be selectively displayed (or not) without effecting playback of the video. (*Id.* ¶[0136]; *see also* EX-1001, 11:54-56 (ancillary content

includes “information, structures, and files used in the delivery of content not considered actual content”).) Indeed, Abecassis discloses the same types of ancillary content as the ’266 patent, such as subtitle information or advertisements. (EX-1001, Fig. 5, 11:57-60; EX-1020 ¶¶[0106]-[0116], [0190]-[0197].)

Thus, Abecassis discloses rendering on the second client device (second screen) at least a portion of secondary other digital content (e.g., subtitles, locale information, shopping information) associated with the primary digital content (e.g., video being played on primary screen) by using the descriptor (e.g., video map) and the first position (e.g., play position). (EX-1002 ¶¶100-06.)

10. 1[g]: Identifying Primary Content to Be Retained

The last four limitations of claim 1 relate to known methods of managing storage resources and, specifically, discarding content. (EX-1002 ¶107.) Barton discloses these claim elements. (*Id.* ¶¶107-23.)

Element 1[g] recites “identifying a range of content surrounding the first position in the primary digital content as content to be retained.”

Barton discloses a mechanism for streaming content in which a “window” of content around the current play position is retained. (EX-1022 ¶¶[0048]-[0049], [0059], claims 2, 23, 45, 68, 89, 110, 135; EX-1002 ¶108.) Barton does so using a linear cache (“LC”), as shown in Figure 3:

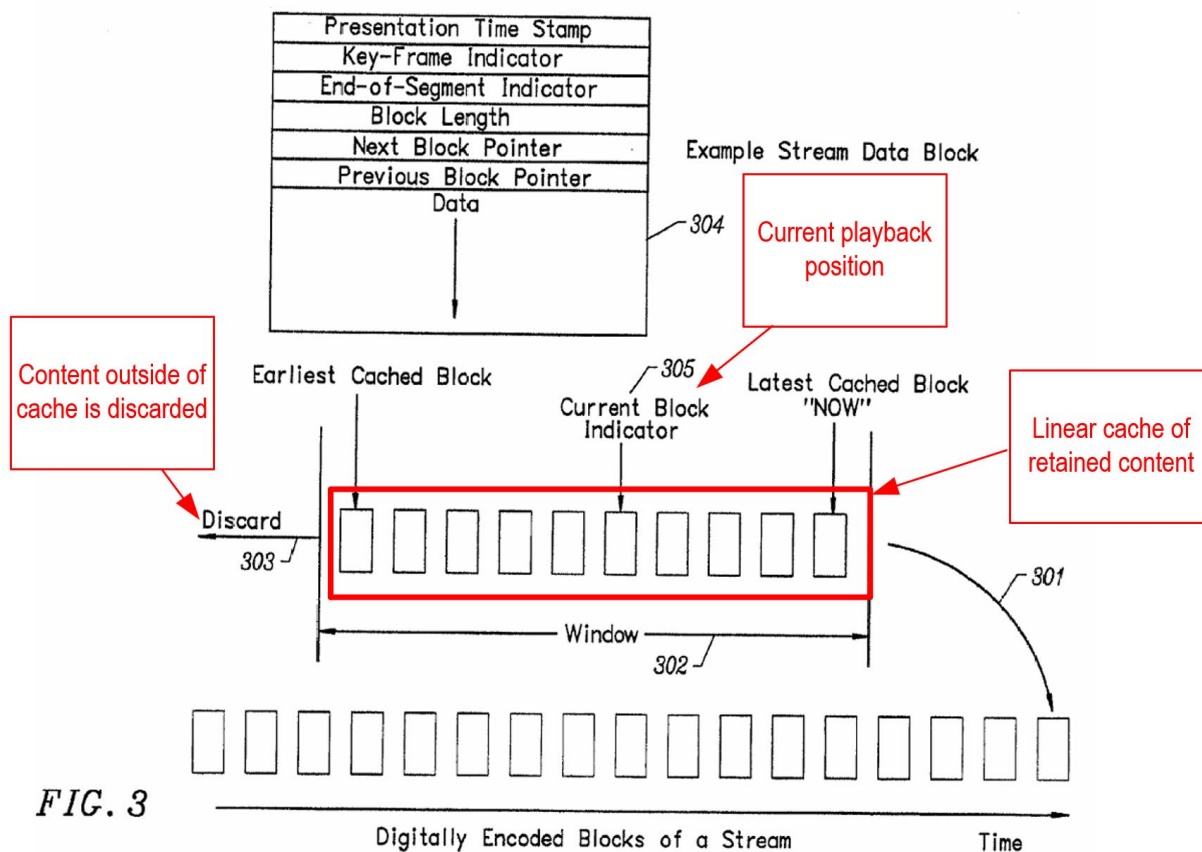


FIG. 3

(EX-1022, Fig. 3, ¶[0031].) The content includes “encoded digital blocks.” (*Id.* ¶[0048].) Thus, Barton’s LC identifies a range of content surrounding a first position in a primary digital content as content to be retained.

It would have been obvious in view of Barton to implement Abecassis (as modified in view of Drieu as discussed above) such that streamed content is stored within a linear cache identifying a range of content surrounding a first position in a primary digital content as content to be retained. A POSITA would have been motivated to modify Abecassis to use the LC as taught in Barton for multiple reasons. (EX-1002 ¶¶109-13.)

First, both Abecassis and Drieu—like Barton—implement streaming video to client devices. (EX-1020 ¶¶0072]; EX-1021 ¶¶0005]; EX-1022 ¶¶0010].) Barton notes that storage of an entire digital video stream undesirably requires extensive storage space. (EX-1022 ¶¶0010].) The LC of Barton provides “the illusion for the consumer that recent portions of the stream are stored locally.” (*Id.* ¶¶0007].) This local storage enables desirable functionalities such as rewinding and fast-forwarding video. (*Id.*; EX-1002 ¶¶111.) Thus, a POSITA would have found it advantageous to use the system of Barton to store content. (EX-1002 ¶¶111.)

Second, the combination represents nothing more than the simple addition of one known element (Barton’s LC for streaming video) to another known element (Abecassis and Drieu’s methods for streaming video to client devices) to obtain predictable results (reducing storage requirements for streaming video). (*Id.* ¶¶112); *KSR*, 550 U.S. at 417.

Third, the combination represents the use of a known technique (Barton’s LC) to improve a similar device and method (Abecassis and Drieu’s streaming client devices) in the same way. (*Id.*)

Fourth, the combination applies a known technique (Barton’s LC) to a known device and method (Abecassis and Drieu’s streaming client devices) that is ready for improvement and yields predictable results (reducing local storage requirements for streaming video). (*Id.*)

A POSITA would have had a reasonable expectation of success when making this combination because both Abecassis teaches a system for streaming media content and Barton teaches a method for storing media content in such a system. (EX-1002 ¶113.)

Thus, Abecassis and Drieu, in combination with Barton, disclose this limitation. (*Id.* ¶¶107-14.)

11. 1[h]: Releasing Storage of All Other Primary Content

Element 1[h] recites “releasing storage resources allocated to all content of the primary digital content that is not identified as content to be retained on the first client device.” Barton teaches discarding the portion of the primary digital content falling outside the LC window. (EX-1022 ¶[0049], claims 3, 24, 46, 69, 90, 111, 136.) Discarding blocks from a cache releases storage resources allocated to those blocks. (EX-1002 ¶116.)

Thus, Abecassis in combination with Barton discloses this limitation. (*Id.* ¶¶115-17.)

12. 1[i]-1[j]: Identifying Secondary Content Related to Primary Content to Be Retained and Releasing All Other Portions of Secondary Content

Elements 1[i] and 1[j] recite “identifying content in the secondary digital content that is related to the range of content surrounding the first position in the primary

digital content as content to be retained” and “releasing storage resources allocated to all content of the secondary digital content that is not identified as content to be retained on the second client device.” These elements are similar to the preceding elements of claim 1, except they relate to “content in the secondary digital content” that is “related to” the retained portion of primary content.

Abecassis teaches supplemental content (secondary content) can be displayed on a second device simultaneously and in synchronization with primary content shown on a first device. (EX-1020 ¶[0142]; *supra* §VII.A.9.) Abecassis teaches supplemental content may be video content, such as a “video presentation” of a locale in a video shown on a first device. (EX-1020 ¶¶[0138], [0152], [0195].) Abecassis further teaches secondary content may be retrieved from “remote locations” (e.g., streamed). (*Id.* ¶[0272].) Thus, it would have been obvious to incorporate the LC of Barton when streaming video on a second device, and a POSITA would have reasonably expected success doing so, for the same reasons discussed above with respect to a first device (e.g., to reduce storage requirements on the second device). (*Supra* §VII.A.10.) Additionally, a POSITA would have been further motivated to incorporate the LC of Barton to store secondary content because Abecassis teaches displaying the primary video content and the supplemental content synchronously. (EX-1002 ¶120.) Thus, a POSITA would have been motivated to use the same system to store both portions of content to ensure that only the supplemental content

intended to be played with the retained primary content was retained. (*Id.* (citing EX-1035 ¶¶[0206] (disclosing removing secondary content (e.g., bookmark and related series information) from memory when associated primary content is removed)).)

Abecassis further teaches the supplemental video content relates to a current playback position on the first device. (EX-1020 ¶¶[0008], [0114], [0129].) Thus, the supplemental video content stored in the LC would constitute “content in the secondary digital content that is related to the range of content surrounding the first position in the primary digital content” as claimed. (EX-1002 ¶121.) Those portions of the supplemental video content stored in the LC would be “identif[ied] as ... content to be retained.” (*Id.*) Accordingly, a second device of Abecassis, when implementing the LC of Barton, would “identify[] content in the secondary digital content that is related to the range of content surrounding the first position in the primary digital content as content to be retained” as claimed. (*Id.*)

Because the LC discards content outside the retained window, a second device of Abecassis implementing the LC of Barton would “release[e] storage resources allocated to all content of the secondary digital content that is not identified as content to be retained on the second client device” as is further claimed. (*Id.* ¶122.)

Thus, Abecassis in combination with Barton discloses and render obvious this limitation. (*Id.* ¶¶118-23.)

Accordingly, Abecassis, Drieu, and Barton render obvious claim 1. (*Id.* ¶¶49-124.)

B. Claim 2

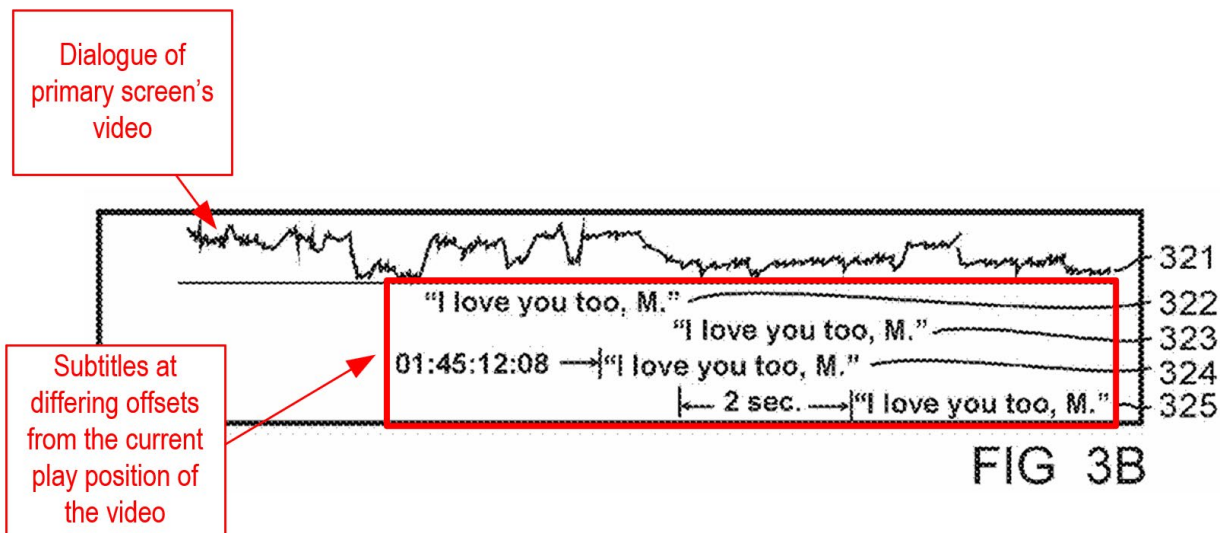
1. 2[a]: Secondary Content Comprises a Series of Items

Claim 2 depends from claim 1. Element 2[a] recites that “the secondary digital content comprises a series of items.” Abecassis teaches that supplemental content can include subtitles. (EX-1020 ¶[0114].) These subtitles are divided into portions, corresponding to a video’s audio dialogue. (*Id.* ¶[0060].) Thus, Abecassis discloses that the secondary content comprises a series (multiple portions) of items (e.g., subtitles). (EX-1002 ¶126.) Abecassis similarly discloses displaying different information, locations, or items for sale (e.g., secondary content) based on the particular scene or frame of the primary content. (EX-1020 ¶¶[0118]-[0119], [0135]-[0140], [0145]-[147], [0176], [0191]-[0203].) Because each of these types of content consists of different items that are displayed as the primary content changes, a POSITA would have understood them to be a series of items. (EX-1002 ¶¶125-27.)

2. 2[b]: Determining on the Second Device an Item Associated with the First Position Using the Descriptor

Element 2[b] recites “determining on the second client device an item in the series of items that is associated with the first position in the primary digital content by using the descriptor.” Abecassis discloses this. For example, it discloses a “What

function” that enables a user to view subtitles for a currently playing video, optionally with an offset (to enable users to determine what was recently said in the video), as shown in Figure 3B:

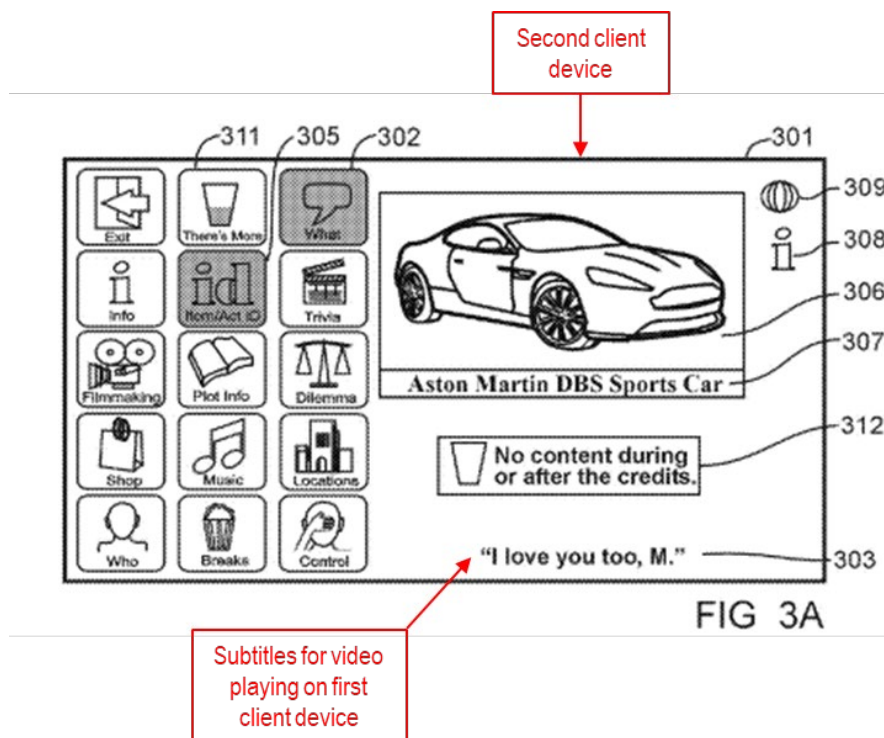


(EX-1020, Fig. 3B; EX-1002 ¶129.) The appropriate subtitles for a current play position are determined using the video map of Abecassis (a descriptor). (EX-1020 ¶[0108] (“video map subtitle data is searched to identify the subtitle information” corresponding to the desired offset calculated based on “the current play position”).) Thus, Abecassis discloses determining on the second client device an item (e.g., subtitle) in the series of items (e.g., series of subtitles) that is associated with (corresponding to, but potentially offset from) the first position (current play position) in the primary digital content by using the descriptor (video map). (EX-1002 ¶¶128-

30.) Abecassis similarly discloses that its video map (descriptor) identifies the information, locations, or items for sale to display for a current play position. (EX-1020 ¶¶[0084], [0103], [0135], [0139], [0145], [0147], [0206].)

3. 2[c]: Item Associated with the First Position Is Rendered on the Second Device

Element 2[c] recites that “the item associated with the first position is rendered on the second client device.” Abecassis discloses that, once appropriate subtitles are determined, the “subtitles are then displayed” on the second device. (EX-1020 ¶¶[0108].) This is shown in Figure 3A:



(*Id.*, Fig. 3A; EX-1002 ¶132.)

Abecassis further discloses that its secondary device can display the information, locations, or items for sale for the particular scene or frame being played on

its primary device in the same manner as it displays subtitles. (EX-1020 ¶¶[0118]-[0119], [0145]-[147], [0176], [0135]-[0140], [0191]-[0203].)

Thus, Abecassis, Drieu, and Barton render obvious claim 2. (EX-1002 ¶¶125-35.)

C. Claim 3

Claim 3 depends from claim 1 and further recites that “the first position is determined by tracking a current position in the primary digital content as the primary digital content is rendered on the first client device.” Abecassis’s second device “obtain[s] synchronizing information (e.g., timing information such a current location time code) from the video as the video is played.” (EX-1020 ¶¶[0258]-[0259].) As part of the method, “the play location” on the primary device “continue[s] to be monitored.” (*Id.* ¶¶[0262], [0193].) Thus, Abecassis discloses that the first position is determined by tracking (e.g., monitoring) a current position (play location) in the primary digital content as the primary digital content is rendered on the first client device. (EX-1002 ¶137.) Accordingly, Abecassis discloses the additional limitation of claim 3 and thus Abecassis, Drieu, and Barton render obvious claim 3. (*Id.* ¶¶136-39.)

D. Claim 4

Claim 4 depends from claim 1 and further recites that “the descriptor contains the secondary digital content, location information for accessing the secondary digital content, or a combination thereof.” Abecassis discloses that the video map (descriptor) can include “information, data, linkages, and content” for performing the functions described in Abecassis. (EX-1020 ¶[0067].) Thus, Abecassis teaches that the descriptor (video map) contains secondary digital content (e.g., maps or information). (EX-1002 ¶141.)

Abecassis also discloses that the video map (descriptor) may link to associated secondary content. (EX-1020 ¶¶[0139] (“a video map, associates, for example, a Google map link with a video location”), [0139] (map link), [0067]; *see also id.* ¶¶[0040], [0084], [0105], [0118], [0134]-[0135], [0139]-[0142] (linkage to location information), [0145], [0149], [0155], [0157], [0165], [0167], [0173], [0176]-[0177], [0191].) Thus, Abecassis also discloses that the descriptor (video map) contains location information (e.g., a link) for accessing the secondary content. Accordingly, Abecassis discloses the additional limitation of claim 4 and thus Abecassis, Drieu, and Barton render obvious claim 4. (EX-1002 ¶¶140-44.)

E. Claim 5

Claim 5 depends from claim 4 and further recites that “the descriptor contains location information for accessing the secondary digital content” and that the method

comprises “accessing the secondary digital content for rendering on the second client device by using the location information in the descriptor.” As discussed above, Abecassis discloses that its video map can provide “linkages to secondary information.” (EX-1020 ¶[0007]; *supra* §VII.D.) This linkage “enables retrieving and/or downloading data from a local/internal and/or a remote/external source.” (EX-1020 ¶[0040]; *see also id.* ¶[0204].)

For example, as discussed for claim 4 above, Abecassis discloses a descriptor that contains location information for accessing secondary digital content (a video map that includes a link to a map of a physical location depicted in primary content). (EX-1020 ¶[0139]; *supra* §VII.D.) Abecassis further teaches accessing the secondary content using that link and rendering it on the second device. For example, Figure 4B shows map data obtained by “parsing the data provided by the above Google map link” in a video map “and utilizing the Google Maps Javascript API” to retrieve and render the map data:

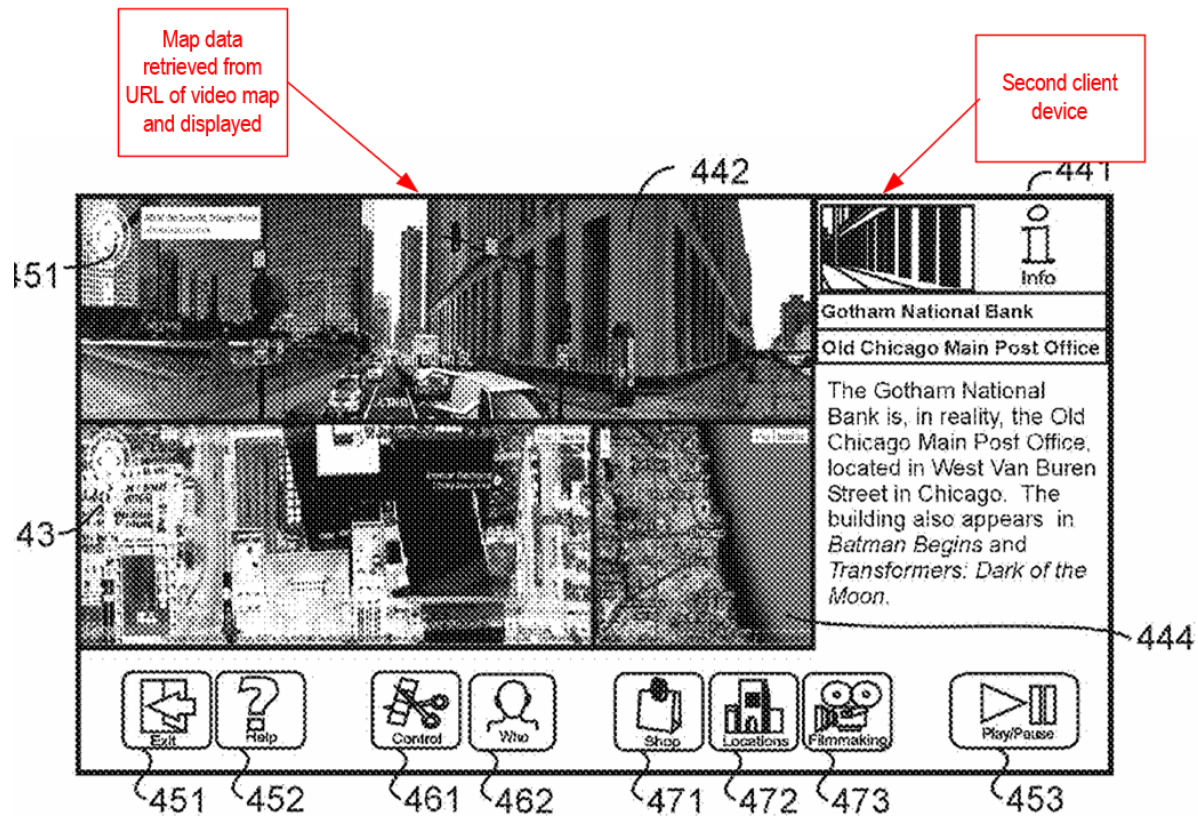


FIG 4B

(EX-1020, Fig. 4B, ¶[0141].)

Accordingly, Abecassis discloses the additional limitation of claim 5 and thus Abecassis, Drieu, and Barton render obvious claim 5. (EX-1002 ¶¶145-49.)

F. Claim 6

Claim 6 depends from claim 1 and further recites that “the secondary digital content is a different type of digital content than the primary digital content.” Abecassis’s primary content may be video, while supplemental content can be “a geographic map, a write-up, and an actual identity of a locale” (EX-1020 ¶[0141]),

which is a different type of content than video. Abecassis’s supplemental content may also be subtitles, performer lists, shopping information, plot points, ratings, or trivia, each of which is also a different type than video. (*Id.*, Abstract.) Thus, Abecassis discloses the additional limitation of claim 6. (EX-1002 ¶¶150-53.)

G. Claim 7

Claim 7 depends from claim 1 and further recites that “the secondary digital content includes audio content, audio/video content, video content, text content, static image content, moving image content, user-entered content, advertising content, or a combination thereof.” Abecassis’s supplemental content can include an image, text, video, or multimedia presentation. (EX-1020 ¶¶[0138] (image), [0195] (“image or video” or “textual identification”), [0152] (video, photo, audio, or multimedia), [0164], [0172] (trivia inputs).) Accordingly, Abecassis discloses the additional limitations of claim 7 and thus Abecassis, Drieu, and Barton render obvious claim 7. (EX-1002 ¶¶154-57.)

H. Claim 8

Claim 8 depends from claim 1 and recites that “the secondary digital content includes a plurality of different types of digital content.” Abecassis’s supplemental content can be “a geographic map, a write-up, and an actual identity of a locale.” (EX-1020 ¶¶[0141].) Abecassis further teaches multiple types of supplemental content, including subtitles, performers lists, shopping information, etc., each of which

is of a different type. (*Id.*, Abstract.) Accordingly, Abecassis discloses the additional limitations of claim 8 and thus Abecassis, Drieu, and Barton render obvious claim 8. (EX-1002 ¶¶158-61.)

I. Claim 9

Claim 9 depends from claim 8 and further recites “selecting one or more of the different types of digital content for rendering on the second client device.” Abecassis in Figure 2 teaches an interface enabling selection of different types of secondary digital content:

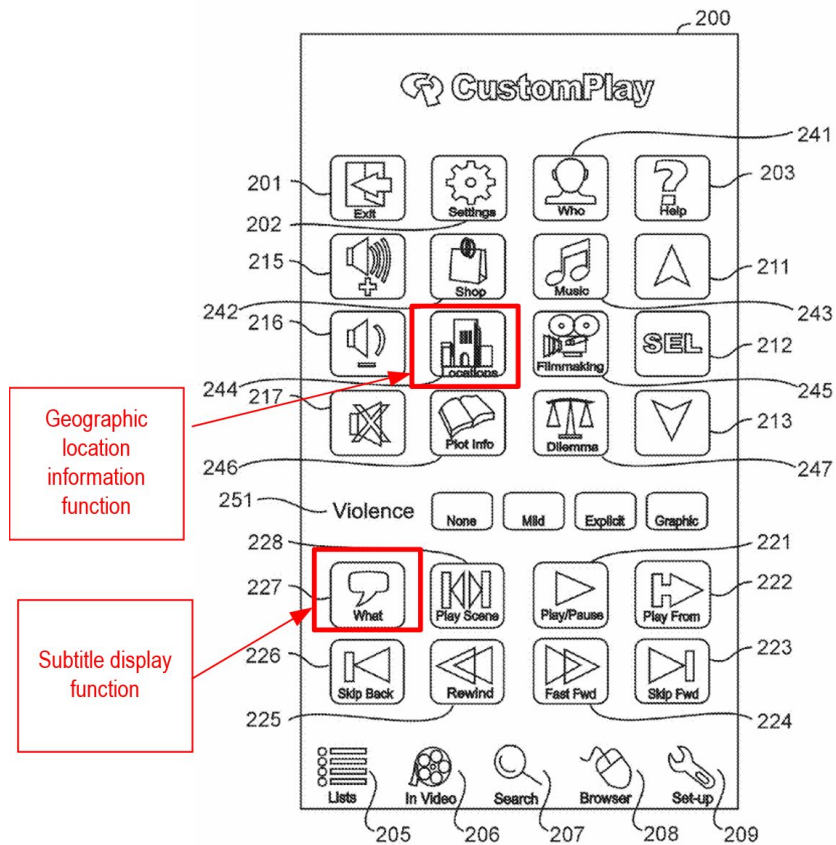


FIG 2

(EX-1020, Fig. 2, ¶¶[0095], [0011], [0098]; EX-1002 ¶163.)

Selecting an input displays the corresponding content, as shown in Figure 4A:

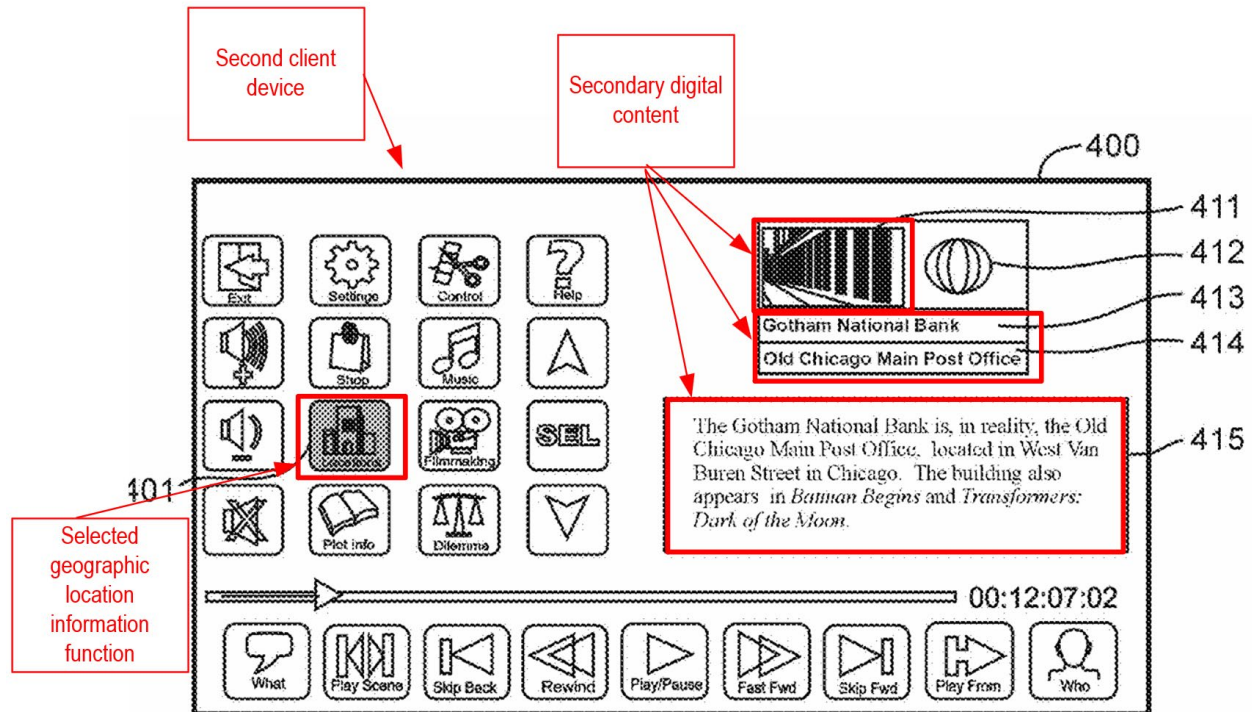


FIG 4A

(EX-1020, Fig. 4A; EX-1002 ¶164.)

Accordingly, Abecassis discloses the additional limitations of claim 9, and thus Abecassis, Drieu, and Barton render obvious claim 9. (EX-1002 ¶¶162-66.)

J. Claim 12

Claim 12 depends from claim 1 and further recites that “the first client device and the second client device have different rendering capabilities.” Abecassis teaches a system including at least two devices. (EX-1020 ¶[0075].) These devices can be “televisions, personal computers, laptop and portable computers, tablets, smartphones, and mobile devices, remote control devices, and computing devices

having a display screen.” (*Id.* ¶[0057]). A POSITA would have understood that these devices each have different rendering capabilities (e.g., screen size, screen resolution, audio output capabilities). (EX-1002 ¶168.) Accordingly, Abecassis discloses the additional limitations of claim 12, and thus Abecassis, Drieu, and Barton render obvious claim 12. (*Id.* ¶¶167-70.)

K. Claim 13

Independent claim 13 recites substantially the same limitations as claim 1, but recites a system rather than a method. (EX-1002 ¶174.) The system comprises “a first client device; a second client device; and a network accessible library accessible by the first and second client devices via a network.” Abecassis, alone or with Drieu, discloses and renders obvious such a system. (*Supra* §§VII.A.2 (first client device), VII.A.6 (second client device), VII.A.7 (network accessible library); EX-1002 ¶171.)

As a further example, Abecassis discloses a system including multiple client devices connected to video, data, and information providers via a network:

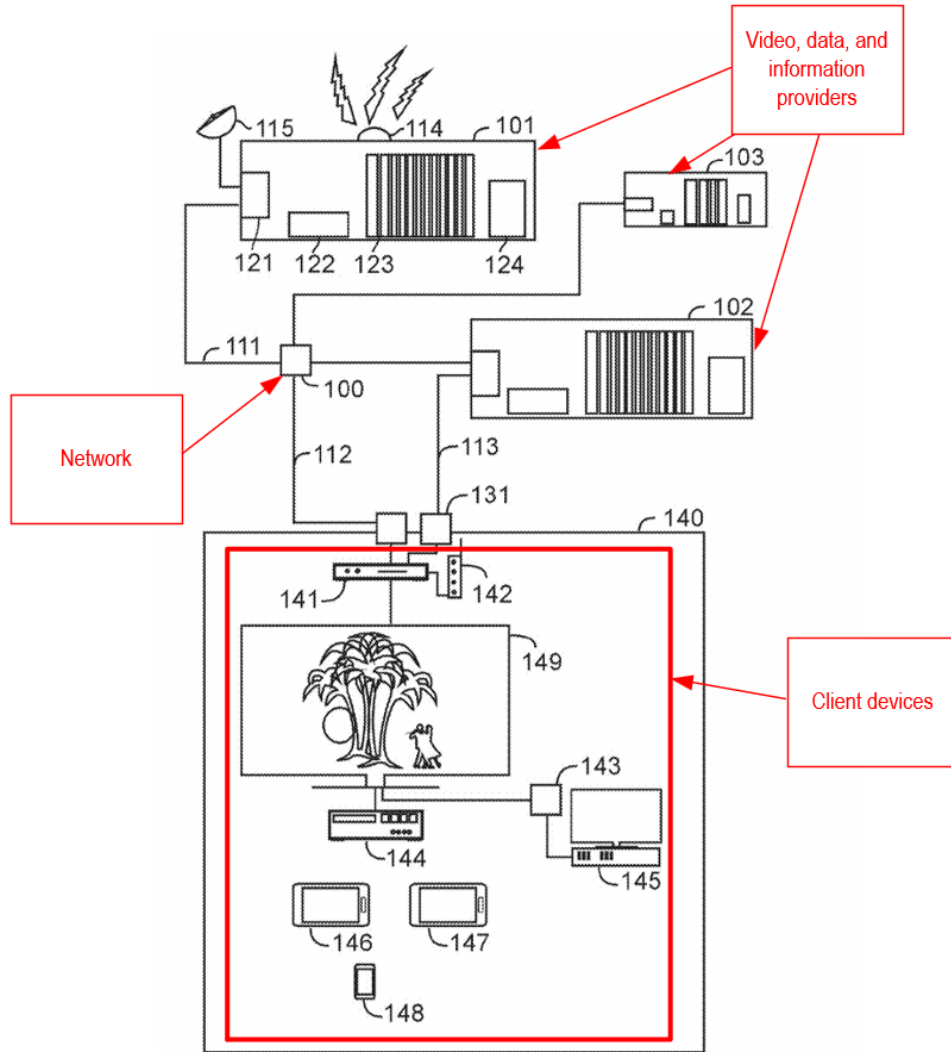


FIG 1

(EX-1020, Fig. 1; EX-1002 ¶172.) Abecassis teaches the video providers enable downloading of video content, thus acting as a network accessible library. (See EX-1020 ¶¶[0071]-[0072], [0010], [0085]-[0086].)

Even if Abecassis did not disclose these limitations, Drieu discloses such a system because it discloses multiple client devices accessing a server acting as a network library. (*Supra* §VII.A.7.) And, it would have been obvious to include

these features in Abecassis. (*Id.*) Thus, Abecassis, in combination with Drieu and Barton, discloses each limitation of claim 13, and Abecassis, Drieu, and Barton render obvious claim 13. (EX-1002 ¶¶171-74.)

VIII. GROUND 1B: CLAIMS 10-12 WOULD HAVE BEEN OBVIOUS IN VIEW OF ABECASSIS, DRIEU, BARTON, AND WALKER.

Each element of claims 10-12 is disclosed by, or would have been obvious in view of, Abecassis, Drieu, Barton, and Walker. Ground 1A shows how Abecassis, Drieu, and Barton disclose and/or render obvious each limitation of the claims from which claims 10-12 depend.

A. Claim 10

Claim 10 depends from claim 9 and further recites “wherein the one or more of the different types of digital content are selected in dependence on rendering capabilities of the second client device.” Abecassis’s second-screen devices can be “televisions, personal computers, laptop and portable computers, tablets, smartphones, and mobile devices, remote control devices, and computing devices having a display screen.” (EX-1020 ¶[0057]). Because such devices have different capabilities (e.g. screen size, audio output capabilities, high/low screen resolution), it would have been obvious to select digital content to be sent to the second screen device based on the capabilities of the particular device. (EX-1002 ¶178.) A POSITA would have been motivated to select content based on the capabilities of the particular device to ensure that the device can play the selected content. (*Id.*)

Alternatively, this would have been obvious over Walker, which also teaches providing supplemental content in connection with a video. (EX-1023 ¶[0027].) The system retrieves “supplemental content identifying data” identifying supplemental content for a video. (*Id.* ¶[0060].) The identifying data can be based on the rendering capabilities of a rendering device, such as “screen size, audio capabilities, video capabilities, 3D television support, [or] 4k television support.” (*Id.* ¶¶[0061], [0065]-[0066], [0027] (supplemental content “may be displayed on a separate device”).)

A POSITA would have been motivated to modify the systems of Abecassis to incorporate Walker’s capability-dependent content selection. (EX-1002 ¶¶180-83.) First, Abecassis expressly discloses multiple different types of platforms on which content can be rendered. (EX-1020 ¶[0090].) A POSITA would have understood in view of Walker that different platforms can have different rendering capabilities, such that some may not be able to render certain types of content. (EX-1002 ¶181; EX-1023 ¶[0061].) Incorporating the capability-dependent content selection of Walker would avoid presenting users with content their devices cannot render. (EX-1002 ¶181.)

Second, the combination represents nothing more than the simple addition of one known element (Walker’s capability-dependent content selection) to another known element (Abecassis’s supplemental content selection) to obtain predictable

results (selecting supplemental content based on device capability). (EX-1002 ¶182;) *KSR*, 550 U.S. at 417.

Third, the combination represents the use of a known technique (Walker’s capability-dependent content selection for supplemental content) to improve a similar device and method (Abecassis’s display of supplemental content) in the same way. (*Id.*)

Fourth, the combination applies a known technique (Walker’s capability-dependent content selection) to a known device and method (Abecassis’s second screen display) that is ready for improvement and yields predictable results (selecting supplemental content based on device capability). (*Id.*)

A POSITA would have had a reasonable expectation of success when making this combination because both Abecassis and Walker disclose similar devices for displaying video content. (EX-1020 ¶[0075]; EX-1023 ¶[0036]; EX-1002 ¶183.)

Accordingly, Abecassis alone, or in combination with Walker, discloses and renders obvious the additional limitation of claim 10, and thus, Abecassis, Drieu, Barton, and Walker render obvious claim 10. (EX-1002 ¶¶177-85.)

B. Claim 11

Claim 11 merely combines limitations recited in claims 7-10, and is therefore obvious for the same reasons as claims 7-10. Thus, Abecassis alone, or in combination with Walker, discloses the additional limitations of claim 11, and Abecassis, Drieu, Barton, and Walker render obvious claim 11. (EX-1002 ¶¶186-87.)

C. Claim 12

Claim 12 depends from claim 1 and further recites that “the first client device and the second client device have different rendering capabilities.” Abecassis’s system has at least two devices. (EX-1020 ¶[0075]; *supra* §VII.A.6.) Walker teaches that different devices have different attributes, such as differing “resolution, screen size, audio capabilities, video capabilities, 3D television support, 4k television support, scanning support ... display settings,” etc. (EX-1023 ¶[0060].) Thus, Abecassis and Walker teach two client devices having different rendering capabilities, thereby disclosing the additional limitation of claim 12. (EX-1002 ¶¶188-91.) Accordingly, Abecassis, Drieu, Barton, and Walker render obvious claim 12. (*Id.*)

**IX. GROUND 2A: CLAIMS 1-13 WOULD HAVE BEEN OBVIOUS
IN VIEW OF MCCUE AND SHARMA.**

Each element of claims 1-13 is disclosed by, or would have been obvious in view of, McCue and Sharma. McCue is a continuation-in-part from a patent in the ’266 patent’s priority chain, and contains nearly all of the disclosure of the ’266

patent,³ as well as additional disclosure. Because McCue contains the same substantive disclosure as the '266 patent, PO cannot dispute that McCue at least renders obvious the claim limitations.

Below Petitioner identifies the portions of McCue that are most similar to the claims of the '266 patent. Petitioner does not concede that the '266 patent contains written description support for its claims.

A. Claim 1

1. Preamble⁴

McCue discloses that a user can listen to “audio streams on more than one client device,” but discloses doing so sequentially rather than simultaneously. (EX-1024 ¶¶[0010]-[0011]; *see also id.* ¶¶[0014], [0079], [0083], [0132] (user may switch from rendering text on a computer to audio on a cell phone), [0169] (bookmark allows user to start listening to an audio stream of an e-book from a bookmark created while reading the e-book).) Sharma discloses rendering digital content across devices simultaneously. (EX-1025, Abstract.) Thus, to the extent that the preamble is limiting, McCue and Sharma disclose it. (EX-1002 ¶¶193-96.)

³ Some small portions of the Abstract, Cross Reference to Related Applications, and Summary of Invention sections from the '266 patent are not in McCue.

⁴ Because the claim language is quoted in Grounds 1A and 1B, it is not repeated here.

2. 1[a]: Rendering Primary Content on a First Client Device

McCue teaches a “client 150” including “a media player 156.” (EX-1024 ¶¶[0063], [0073], *see also id.*, Abstract, ¶¶[0015]-[0016], [0065], claims 1, 24.) “As the media player advances through the audio stream, the small audio files are successively loaded and played until the end of the audio stream is reached.” (*Id.* ¶[0103].) Thus, McCue discloses this limitation. (EX-1002 ¶¶197-99.)

3. 1[b]: Determining an Identifier Corresponding to the Primary Content on a First Client Device, Wherein the Identifier Identifies a Descriptor

McCue discloses that the first client device may create a bookmark. (EX-1024 ¶[0077] (bookmarks typically created by client software); *id.* (user may create a bookmark).) A bookmark “identifies and/or points to the virtual audio stream descriptor of the target audio stream (e.g., in a local directory or at some network address).” (*Id.* ¶[0076].) Thus, McCue discloses that, when a bookmark is created, the first client device determines an identifier (e.g., the pointer to the virtual audio stream descriptor or other item that “identifies ... the virtual audio stream descriptor”). (*Id.*; *see also id.* ¶[0087], Fig. 5c; EX-1002 ¶201.) That identifier corresponds to the primary digital content (e.g., audio stream) and identifies a descriptor (e.g., the virtual audio stream descriptor). (*Id.*) Therefore, McCue discloses this limitation. (EX-1002 ¶¶200-02.)

4. 1[c]: Determining a Position in the Primary Content on the First Device

McCue teaches that the bookmark also identifies “a specific point in time in the audio stream that is offset from the beginning of that audio stream.” (EX-1024 ¶[0076]; *see also id.* ¶¶[0077] (“bookmark identifies ... the time offset of the bookmarked position”), [0103] (as client plays the audio stream, “current position in the actual audio stream is tracked”), [0105] (bookmark identifies “the time offset of the bookmarked position”).) Thus, McCue discloses determining on the client device a first position (e.g., bookmarked position) in the primary digital content (e.g., audio stream). (EX-1002 ¶¶203-05.)

5. 1[d][i]: Transferring the Identifier and Position from the First Device to a Second Device

McCue’s “bookmark can be transferred from client to client.” (EX-1024 ¶[0079].) “For example, a user can bookmark an audio stream at an interesting point and e-mail that bookmark to friends.” (*Id.*; *see also id.* ¶¶[0014], [0079], [0083], [0132] (user may switch from rendering text on a computer to audio on a cell phone), [0169].) Because the bookmark contains the identifier and the first position as discussed above, McCue discloses transferring the identifier and first position from the first client device to a second client device. (EX-1002 ¶¶206-08.)

6. 1[d][ii]: The Transfer Is Via a Network Library

McCue teaches that “the bookmark can be transferred from client to client or from server to client.” (EX-1024 ¶[0079].) McCue further teaches “[i]nformation transfer from client to server.” (*Id.* ¶[0088].) The server and client are connected via a network. (*Id.* ¶[0063].) McCue teaches “information structures and files that reside on one or more servers,” which include bookmarks. (*Id.* ¶¶[0088]-[0089].) McCue teaches that servers may host “a library.” (*Id.* ¶[0067].) Thus, McCue renders this limitation obvious. (EX-1002 ¶¶209-11.)

7. 1[e]: Downloading the Descriptor from the Library to the Second Device

McCue discloses that the bookmark includes a pointer to the “virtual audio stream descriptor” (EX-1024 ¶[0077]) and that the virtual audio stream descriptor may be “addressed from ... the bookmark” (*id.* ¶[0078]). (*See also id.* ¶¶[0087] (virtual audio stream descriptor is acquired from a server), [0067] (virtual audio stream descriptor stored in “library residing on one or more servers on the Internet”), [0100] (virtual audio stream descriptor is “downloaded”).) McCue discloses that a device may use a bookmark “to play the audio stream at the bookmarked position.” (*Id.* ¶[0079].) Thus, it would have been obvious to a POSITA based on McCue’s disclosure that a second client device that had received a transferred bookmark would download the virtual audio stream descriptor from the network accessible li-

brary using the identifier (e.g., the pointer or other item in the bookmark that “identifies ... the virtual audio stream descriptor”) so that it could render content on the second client device. (EX-1002 ¶¶212-14.)

8. 1[f][i]: Rendering Secondary Content on the Second Device

McCue discloses or renders obvious that, after the second client obtains the descriptor, the descriptor “provides the information needed to recreate a continuous media experience for the user from the discontinuous media stream in the plurality of media streams” stored on the server. (EX-1024 ¶[0117]; *id.* ¶¶[0014], [0079], [0083], [0132], [0169].) By recreating the media experience, the client is rendering content (both primary and secondary content). (EX-1002 ¶216.) McCue further explains that the media streams can include an “audio stream” (primary content), as well as “eText, illustrations, graphics, video, figures, tables, and user generated content” (a portion of secondary other digital content). (EX-1024 ¶¶[0115]-[0116].) The media streams can also include “advertising” (a portion of secondary other digital content). (*Id.* ¶[0116].) Thus, McCue discloses that the second device renders both primary and secondary content, and discloses this limitation. (EX-1002 ¶¶215-17.)

9. 1[f][ii]: The Secondary Content Is Ancillary

McCue teaches that the “virtual audio stream descriptor” can include “illustrations related to the audio stream, and/or internal advertising.” (EX-1024 ¶[0066];

see also id. ¶[0112] (virtual audio stream descriptor is also a “Virtual Media Descriptor”).) “Illustrations” are ancillary because they are “intended for use with and in support of the actual audio stream.” (*Id.*, Table 1; EX-1002 ¶219.) “Advertisements” are ancillary because they are “portions of multimedia content intended to be used before, during, and after presentation of any audio stream.” (EX-1024, Table 1; *id.* ¶[0200] (descriptor identifies “ancillary content”); EX-1002 ¶219.) Thus, McCue discloses this limitation. (EX-1002 ¶¶218-20.)

10. 1[f][iii]: The Secondary Content Is Rendered Simultaneously and in Synchronization Across Devices

McCue discloses that, when the user is streaming media based on the virtual media descriptor, the user “can have both the audio stream and the eText rendered simultaneously” *on the same device*. (EX-1024 ¶[0198].) McCue does not disclose rendering secondary content on the second device “simultaneously and in synchronization with the rendering of the primary digital content on the first client device.” (EX-1002 ¶222.)

Sharma teaches that “a user may control a second screen device 302 so that the user may consume second screen content in synchronization with primary content that the user simultaneously consumes via a first screen device.” (EX-1025 ¶[0059]; *id.*, Abstract, ¶¶[0019], [0032].) To synchronize the devices, a synchroni-

zation manager sends a “synchronization signal” to the second screen device identifying “the portion or point in time” of the content on the first screen device. (*Id.* ¶¶[0082], [0067], [0005], [0046]-[0049], [0051]-[0053].) The second screen device then simultaneously displays the relevant second screen content based on this signal. (*Id.*) In view of Sharma, would have been obvious to a POSITA to modify McCue’s system to use a synchronization manager to allow McCue’s client devices to render content simultaneously and in synchronization across the devices, such as by incorporating the synchronization manager into McCue’s library server. (EX-1002 ¶223.) Indeed, McCue’s library server, like the synchronization manager, already communicates with McCue’s client devices. (EX-1025, Fig. 5 (Sharma’s synchronization manager 542 is a server connected to client devices); *Supra* §IX.A.6 (McCue’s library server connects to client devices).)

A POSITA would have been motivated to modify McCue’s system to incorporate Sharma’s simultaneous and synchronous output across devices. (EX-1002 ¶¶224-27.) First, Sharma teaches that a second screen displaying content related to the primary screen content keeps users engaged, and “there is a demand for taking second screen experiences further” by providing “supplemental content (e.g., second screen content) that is synchronized with the primary content.” (EX-1025 ¶[0001].) Incorporating simultaneous display across devices into McCue would thus increase engagement and meet consumer demand. (EX-1002 ¶225.)

Second, the combination represents the addition of one known element (Sharma’s simultaneous and synchronous presentation across devices) to another known element (McCue’s synchronization on one device) to obtain predictable results (simultaneous and synchronous rendering of content across devices). (EX-1002 ¶226); *KSR*, 550 U.S. at 417.

Third, the combination represents the use of a known technique (simultaneous and synchronous presentation across devices) to improve a similar device and method (McCue’s) in the same way. (*Id.*)

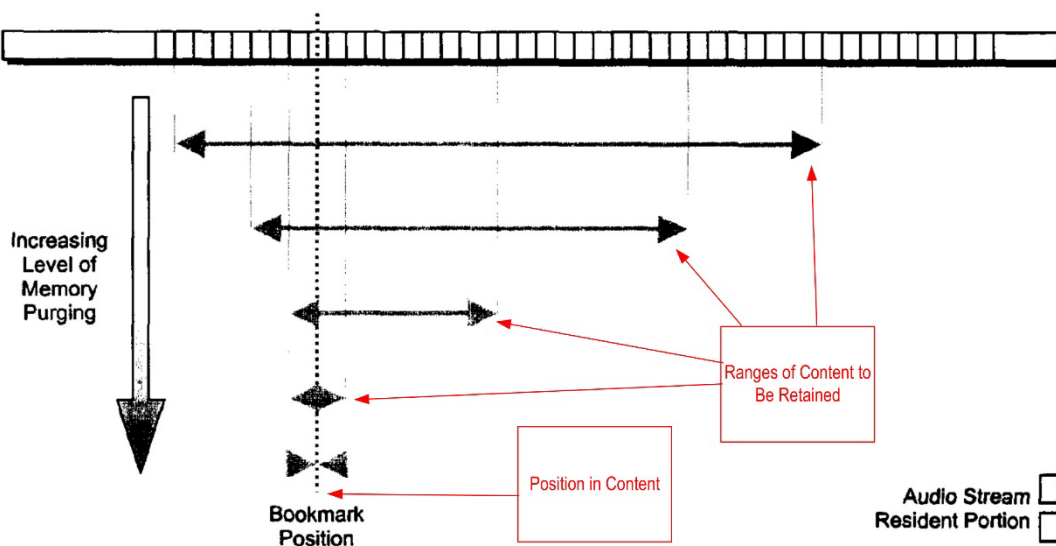
Fourth, the combination applies a known technique (simultaneous and synchronous presentation across devices) to a known method (McCue’s) that is ready for improvement and yields predictable results (simultaneous and synchronous rendering of content across devices). (*Id.*)

A POSITA would have reasonably expected success when combining McCue and Sharma because both systems render content across multiple devices. (EX-1024 ¶0198; EX-1025 ¶0059; EX-1002 ¶227.) Moreover, both systems rely on transferring the same type of information. (*Supra* §§IX.A.3-IX.A.6 (McCue transfers identifier corresponding to content and first position); EX-1025 ¶0046] (Sharma transfers information identifying primary content and timing).) Both do so via a server. (*Supra* §§IX.A.5-IX.A.7; EX-1025 ¶0005].)

Thus, McCue and Sharma render this limitation obvious. (EX-1002 ¶¶221-28.)

11. 1[g]: Identifying Primary Content to Be Retained

McCue discloses the same “memory purge process” described in the ’266 patent. (EX-1024 ¶[0091].) McCue’s “purge process focuses on the bookmark position within the audio stream.” (*Id.* ¶[0096].) Figure 13 shows various ranges of content to be retained:



(EX-1024, Fig. 13; *id.* ¶¶[0102]-[0103].)

Thus, McCue discloses this limitation. (EX-1002 ¶¶229-31.)

12. 1[h]: Releasing Storage of All Other Primary Content

McCue’s memory purge process “is used to remove volatile files to ensure that a requested level of free memory is made available.” (EX-1024 ¶[0091]; *id.*

¶¶[0092], [0102]-[0103].) “Bookmarked audio streams are purged with increasing levels of severity until the memory demands are met.” (*Id.* ¶[0094].) By removing files, McCue’s system releases storage. (EX-1002 ¶233.) Thus, McCue discloses this limitation. (*Id.* ¶¶232-34.)

13. 1[i]-1[j]: Identifying Secondary Content Related to Primary Content to Be Retained and Releasing All Other Portions of Secondary Content

McCue’s purging process can also remove secondary content. (EX-1002 ¶236.) McCue teaches that “a user’s position within a text or audio stream can be determined” and “used to free up memory or resources should the need arise.” (EX-1024 ¶[0196]; *id.* ¶¶[0091]-[0092].) “For example, the first 60 chapters of Moby Dick, both eText, audio, and ancillary content can be purged from a devices memory or storage when the user has advanced sufficiently beyond that content.” (*Id.* ¶[0196].) McCue discloses that this can occur on its client devices generally. (*Id.* ¶¶[0196] (memory manger performs purging), [0074] (memory manager on client).) Thus, it would have been obvious that this process could occur on a second client device. (EX-1002 ¶236.) These limitations would further have been obvious in view of Sharma’s disclosure that secondary content can be stored on a second client device, and thus would need to be purged from the second client device. (EX-1025 ¶[0032] (second screen content on second screen device); EX-1002 ¶237.)

Thus, McCue in view of Sharma renders these limitations obvious. (EX-1002 ¶¶235-39.)

B. Claim 2

McCue teaches “a series of independent images that represent illustrations of the e-Book” of an audio stream. (EX-1024 ¶[0116]; *see also id.* ¶¶[0066], [0115] (“ancillary content” includes illustrations), [0119], [0139], [0176] (describing items of secondary content), [0200], Table 1.) McCue also discloses secondary content such as “graphics” (*id.* ¶¶[0155], [0117], claim 17), advertisements including images or videos (*id.*, Table 1, ¶¶[0066], [0070], claim 17), or notes, videos, and links (*id.* ¶[0117]). These are series of items. (EX-1002 ¶240.)

McCue further teaches a “media stream” including illustrations of a given work, graphics, or advertising. (*Id.* ¶[0116]; *id.* ¶[0119].) McCue teaches that “bookmarks containing a time offset can be used to access any media stream at will” because “the time offset associated with the bookmark is used with the Virtual Media Descriptor to position the media stream to the selected position.” (*Id.* ¶[0170]; *see also id.* ¶¶[0164]-[0165], [0173]-[0174].) McCue’s offsets are used to “access” content including “Illustrations” and “Advertising” in the media stream. (*Id.* ¶¶[0173]-[0174].) The time offset information of a virtual media stream “is used to ... render

the relevant content.” (*Id.* ¶[0200]; *see also id.* ¶¶[0173]-[0174].) McCue also discloses rendering an item (e.g., graphic, note, video, or link) from a series of items using time offsets in the descriptor. (*Id.* ¶[0177].)

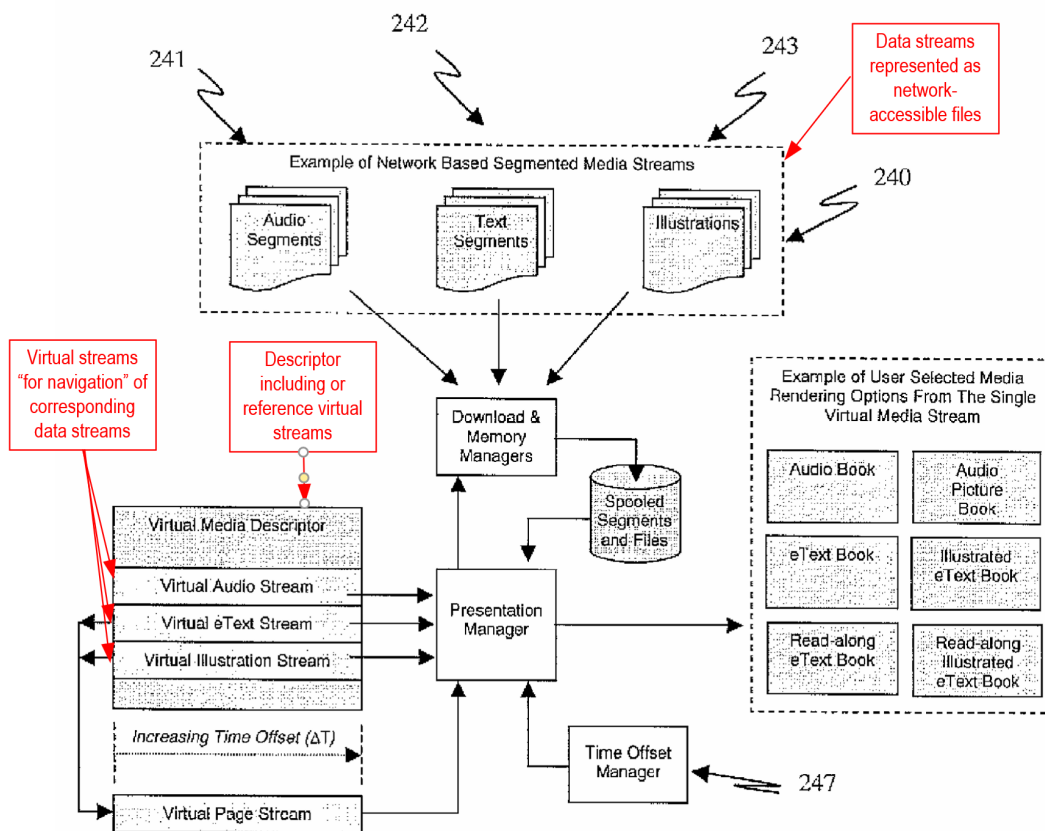
Thus, McCue renders obvious the additional limitations of claim 2, and it would have been obvious to render the items on the second device as taught by Sharma for the reasons discussed above for claim 1. (EX-1002 ¶¶240-44.)

C. Claim 3

McCue teaches: “[a]s the media player advances through the audio stream, ... [t]he current position in the actual audio stream is tracked.” (EX-1024 ¶[0103]; *id.* ¶¶[0112]-[0113].) The device then creates a bookmark at the position. (*Id.* ¶[0105]; *id.* ¶¶[0019], [0077], claims 23, 27.) Thus, McCue discloses the additional limitation of claim 3. (EX-1002 ¶¶245-48.)

D. Claim 4

McCue teaches that a “Virtual Media Descriptor 224 typically includes or references a plurality of Virtual Media Streams 228,” for example, an illustration stream. (EX-1024 ¶[0117].) The illustration stream is stored as one or more network accessible files. (*Id.* ¶[0124].)



(*Id.*, Fig. 24a.) These files are “downloaded” (accessed) to the client and “rendered on a media player via a presentation manager.” (*Id.* ¶[0124].) Because the illustrations are accessed from network accessible files using the illustration stream, the illustration stream is location information for those files. (EX-1002 ¶[250.]) The descriptor can include “links to web addresses or web based content” (EX-1024 ¶[0177]), which is also location information for accessing secondary digital content. (EX-1002 ¶[250.])

Further, the virtual audio stream descriptor can include “internal media marks, illustrations related to the audio stream, and/or internal advertising.” (EX-1024 ¶¶[0066]; *id.* ¶¶[0117].)

Thus, McCue discloses the additional limitation of claim 4. (EX-1002 ¶¶[249-53].)

E. Claim 5

As discussed for claim 4, McCue discloses or renders obvious that the descriptor contains location information for the secondary content and that the secondary content is “rendered on a media player via a presentation manager.” (EX-1024 ¶¶[0124].) McCue’s media player can render content on first and second devices. (EX-1024 ¶¶[0073].) As discussed for claim 1, Sharma discloses rendering secondary content simultaneously on the second device. Thus, McCue and Sharma render the additional limitation of claim 5 obvious. (EX-1002 ¶¶[254-55].)

F. Claim 6

The “primary digital content” of McCue can be an audio stream. (*Supra* §IX.A.2.) The secondary digital content can include “eText, illustrations, graphics, video, figures, tables, and user generated content.” (EX-1024 ¶¶[0116]; *id.* ¶¶[0066], [0117], [0157]-[0158].) Thus, McCue discloses the additional limitation of claim 6. (EX-1002 ¶¶[256-59].)

G. Claim 7

As for claim 6, McCue discloses the additional limitation of claim 7. (*Id.*)

H. Claim 8

McCue teaches that “eText or eText segments is/are rendered” whereby “each page is dynamically created” and “filled with appropriately formatted text and ancillary content” such as “illustrations[] and videos” (a plurality of different types of digital content). (EX-1024 ¶¶[0157]-[0158]; *id.* ¶[0177].) McCue’s secondary content can also comprise “graphic, image, video or audio/video portions of multimedia content[.]” (*Id.*, Table 1.) Thus, McCue discloses the additional limitation of claim 8. (EX-1002 ¶¶260-63.)

I. Claim 9

McCue teaches that a user “can select any media rendering option available” for content, including rendering “as an audio book, as an eText book, a read-along book, an audio picture book, an illustrated eText book, or a read-along illustrated eText book.” (EX-1024 ¶[0124]; *id.* ¶¶[0015]-[0016], claims 1, 24.) McCue’s illustrations are secondary digital content. (*Supra* §§IX.A.8-IX.A.9.) Accordingly, user selection to render “an illustrated eText book” represents selection to render one of the different types of digital content (illustrations). As explained (*supra* §IX.E), McCue discloses that this rendering can occur on a first or second client device. Moreover, Sharma discloses that a user can “select second screen content”

(secondary content) to download and view. (EX-1025 ¶¶[0033], [0063].) It would have been obvious in view of Sharma to render the different types of digital content on the second client device for the reasons discussed for claim 1. (*Supra* §IX.A.10.) Thus, McCue and Sharma render obvious the additional limitation of claim 9. (EX-1002 ¶¶264-68)

J. Claim 10

McCue teaches a “plurality of media streams” including “eText.” (EX-1024 ¶[0116].) The text can be rendered on multiple eReaders that can “use different formats (e.g., PDF and epub).” (*Id.* ¶[0199].) Thus, it would have been obvious to adjust the eText to the format of the eReader it is being sent to. (EX-1002 ¶270.) Accordingly, McCue renders the additional limitation of claim 10 obvious. (*Id.* ¶¶269-72.)

K. Claim 11

Claim 11 merely combines recitations of claims 7-10, and is therefore obvious for the same reasons as claims 7-10. Thus, McCue and Sharma render obvious the additional limitations of claim 11. (EX-1002 ¶273.)

L. Claim 12

McCue teaches that “it is possible for the first and second eReaders to use different formats (e.g., PDF and epub)” and that such formats can change over time. (EX-1024 ¶[0199].) Thus, it would have been obvious that different clients could

be different eReaders and therefore have different rendering capabilities. Accordingly, McCue renders the additional limitation of claim 12 obvious. (EX-1002 ¶¶274-77.)

M. Claim 13

McCue teaches a system including “a server 100, a client 150, and a network.” (EX-1024 ¶¶[0063]; *id.* ¶¶[0017], [0064], [0073], [0079].) The server includes a “library.” (*Id.* ¶¶[0067]; *id.* ¶¶[0075], [0124] (content stored on “network accessible library”), [0141] (same), [0150] (same), [0187] (same).) McCue discloses multiple client devices. (*Id.* ¶¶[0010] (“more than one client device”), [0079] (“transfer[] from client to client”), [0083], [0112], claim 28.) Thus, McCue discloses the system components recited in claim 13, and claim 13 would have been obvious over McCue and Sharma for same reasons as claim 1. (EX-1002 ¶¶278-81.)

X. GROUND 2B: CLAIMS 10-12 WOULD HAVE BEEN OBVIOUS IN VIEW OF MCCUE, SHARMA AND WALKER.

Even if McCue and Sharma had not disclosed or rendered obvious claims 10-12, these claims would have been obvious over McCue, Sharma, and Walker. Walker discloses the additional limitations of claims 10-12. (*Supra* §VIII.) A POSITA would have been motivated to modify McCue to incorporate Walker’s teachings for multiple reasons. First, McCue discloses multiple platforms on which content is rendered. (EX-1024 ¶¶[0132] (computer, cell phone).) Walker teaches that different platforms can have different rendering capabilities and that some may not

be able to render certain content types. (EX-1002 ¶284; EX-1023 ¶[0061].) Thus, sending content only to devices that can display that content as taught by Walker would avoid presenting users with content their devices cannot render. (EX-1002 ¶284.)

Second, the combination represents the addition of one known element (Walker’s capability-dependent content selection) to another known element (McCue’s supplemental content selection) to obtain predictable results (selecting supplemental content based on device capability). (EX-1002 ¶285); *KSR*, 550 U.S. at 417.

Third, the combination represents using a known technique (Walker’s capability-dependent content selection) to improve a similar device and method (McCue’s display of supplemental content) in the same way. (*Id.*)

Fourth, the combination applies a known technique (Walker’s capability-dependent content selection) to a known device and method (McCue’s second device) that is ready for improvement and yields predictable results (selecting supplemental content based on device capability). (*Id.*) A POSITA would have reasonably expected success because McCue and Walker disclose similar devices. (EX-1024 ¶[0132]; EX-1023 ¶[0036]; EX-1002 ¶286.)

Thus, McCue and Walker disclose the additional limitations of claims 10-12. (EX-1002 ¶¶282-88.)

XI. SECONDARY CONSIDERATIONS

Where, as here, a strong *prima facie* obviousness showing exists, secondary considerations may not dislodge the obviousness conclusion. *Leapfrog Enters. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). Petitioners are aware of no evidence supporting a claim for secondary considerations.

XII. DISCRETIONARY DENIAL UNDER §314(A) IS NOT APPROPRIATE.

Efficiency, fairness, and the merits support institution. *Apple v. Fintiv*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”).

A. Factor 1: Potential Stay

On March 20, 2024, PO sued Petitioners for infringement of the ’266 patent in the Eastern District of Virginia (“EDVA”) in *Audio Pod IP, LLC v. Amazon.com, Inc.*, 2:24-cv-00185 (E.D. Va.) (“*Audio Pod I*”). On May 30, 2024 PO again sued Petitioners (except Audible, Inc.) for infringement of the ’266 patent in *Audio Pod IP, LLC v. Amazon.com, Inc.*, 3:24-cv-00407 (E.D. Va.) (“*Audio Pod III*”), which was joined with a related case, *Audio Pod IP, LLC v. Amazon.com, Inc.*, 3:24-cv-00406 (E.D. Va.) (“*Audio Pod II*”) (collectively, “the Litigations”). Petitioners will move to stay the Litigations pending resolution of this and related IPRs challenging the patents asserted in the Litigations. The EDVA routinely grants motions to stay cases pending IPR proceedings, including pre-institution, when asserted patents are challenged. *See, e.g., Sec. First Innovations, LLC v. Google LLC*, No. 2:23-cv-

00097, 2024 WL 234720 (E.D. Va. Jan. 22, 2024); *Sharpe Innovations, Inc. v. T-Mobile USA, Inc.*, No. 2:17-cv-00351, 2018 WL 11198604 (E.D. Va. Jan. 10, 2018).

On March 14, 2025, Petitioner Audible, Inc. (“Audible”) filed a declaratory judgment action, seeking a declaration that Audible does not infringe the ’266 patent, against PO in *Audible, Inc. v. Audio Pod IP, LLC*, 1:25-cv-02158 (S.D.N.Y.) (the “Audible DJ Action”). That action seeks a declaration of noninfringement only; the validity of the ’266 patent is currently not at issue. However, Audible expects validity to become an issue in that case and, once it does, Audible expects to move to stay the Audible DJ Action in view of this IPR.

Thus, this factor weighs against denial.

B. Factor 2: Proximity of Trial to FWD

The EDVA has not set trial dates in the Litigations. The median time to trial in civil cases in the EDVA for 2024 was 14.6 months⁵, but it is clear a longer schedule will be needed here. (*See infra* §XII.C.) The Audible DJ Action was filed recently, has no trial date, validity is not currently at issue, and SDNY’s time-to-trial of 39.3 months is much longer than this proceeding. Thus, this factor weighs against denial. *Amazon.com, Inc. v. Nokia Technologies OY*, IPR2024-01140, Paper 9 at 9

⁵ See U.S. District Courts–Combined Civil and Criminal Federal Court Management Statistics (December 31, 2024), *available at* https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distpro-file1231.2024.pdf.

(P.T.A.B. February 12, 2025) (this factor weighs against denial when there is no trial date); *Aptiv Services US, LLC v. Microchip Technology, Inc.*, IPR2024-00646, Paper 11 at 32 (P.T.A.B. September 25, 2024) (same); see *Ericsson Inc. v. XR Communications LLC*, IPR2024-00613, Paper 9 at 34 n.12 (P.T.A.B. October 9, 2024) (“median-time-to trial information” not useful where circumstances “do[] not reflect the normal course of a litigation”).

C. Factor 3: Investment in Parallel Proceeding

PO filed its complaint in *Audio Pod I* on March 20, 2024 and in *Audio Pod III* on May 30, 2024. Petitioners filed a motion to dismiss or transfer *Audio Pod I* on May 31, 2024 and no hearing date has been set for that motion. Otherwise, the parties have invested very little in *Audio Pod I*.

Fact discovery in *Audio Pod II* remains in its infancy, with only one deposition taken. The parties have not exchanged proposed claim constructions or submitted claim construction briefs. No expert reports have been served. No case schedule has been set in *Audio Pod I*, and in *Audio Pod II*, the court’s scheduling order does not extend beyond the *Markman* hearing on October 8, 2025. Thus, even if the Court denied Petitioners’ pre-institution motion to stay and the parties proceeded with claim construction over the coming months, much work will still remain, including expert reports, expert discovery, dispositive motions, pretrial motions, and trial.

Because the remaining investment in the Litigations and Audible DJ Action significantly outweighs any investment made thus far, this factor weighs against denial. *Samsung Electronics Co. v. Empire Technology Development LLC*, IPR2024-00896, Paper 15 at 13 (P.T.A.B. December 13, 2024) (factor weighs against denial where *Markman* hearing and close of fact and expert discovery were after institution deadline); *Ericsson*, IPR2024-00613, Paper 9 at 34-35 (factor weighs against denial where “most efforts from the parties and court will take place after institution”); *Amazon.com*, IPR2024-01140, Paper 9 at 9-10.

D. Factor 4: Overlapping Issues

If this IPR is instituted and the Litigations and/or Audible DJ Action are stayed, Amazon could not pursue in those proceedings any invalidity ground raised or that could have been reasonably raised in this IPR. *Cal. Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022). If this IPR is instituted and the Litigations and/or Audible DJ Action are not stayed, Petitioners hereby stipulate not to pursue in those proceedings any ground of invalidity, against any claim challenged herein, that was raised or reasonably could have been raised in this Petition. This factor weighs heavily against discretionary denial. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020).

E. Factor 5: The Parties

The parties are the same, but it is unlikely that the Litigations or Audible DJ Action will go to trial before a final written decision is entered in this IPR. Thus, this factor is neutral. *See Google LLC v. Jawbone Innovations, LLC*, IPR2022-00630, Paper 10 at 14 (P.T.A.B. Sept. 13, 2022).

F. Factor 6: Other Circumstances

The merits of this Petition are compelling, as demonstrated above, which favors institution. *Fintiv*, IPR2020-00019, Paper 11 at 18. Further, denying institution would negate Congress’s intent in providing a 1-year period to file petitions and would encourage forum shopping as patent owners look to shield their patents from PTAB scrutiny by seeking judges with aggressive case schedules.

Thus, the Board should not decline institution under §314(a).

XIII. DISCRETIONARY DENIAL UNDER §325(D) IS NOT APPROPRIATE.

The Office has not considered any of the references relied on in the Grounds herein. Nor has the Office considered “substantially the same prior art or arguments.” 35 U.S.C. §325(d). This is sufficient to avoid denial. *Shenzen Chic Elecs. v. Pilot, Inc.*, IPR2023-00810, Paper 12 at 21 n.11 (P.T.A.B. Nov. 8, 2023) (denial inappropriate where challenges based on new art/arguments “address all challenged claims”). The references here clearly disclose each claim element the Examiner thought was missing from the prior art. (*Supra* §III.C.) Accordingly, they are not—

and could not be—cumulative of previously-considered references, absent material error by the Examiner. *See Quasar Sci. LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10 at 14 (P.T.A.B. Oct. 10, 2023). Thus, the Board should not deny institution under §325(d).

XIV. CONCLUSION

Amazon requests that the Board institute trial and cancel all challenged claims.

XV. MANDATORY NOTICES, GROUNDS FOR STANDING, AND FEE PAYMENT

Pursuant to 37 C.F.R. §42.8(a)(1), the mandatory notices identified in 37 C.F.R. §42.8(b) are provided below as part of this Petition.

A. Real Party-In-Interest (37 C.F.R. §42.8(b)(1))

Amazon.com, Inc., Amazon.com Services LLC, Amazon Web Services, Inc., and Audible, Inc. are the real parties-in-interest.

B. Related Matters (37 C.F.R. §42.8(b)(2))

PO asserted the ’266 patent against Petitioners in patent infringement lawsuits captioned *Audio Pod IP, LLC v. Amazon.com, Inc. et al.*, No. 2:24-cv-00185 (E.D. Va., filed March 20, 2024) and *Audio Pod IP, LLC v. Amazon.com, Inc. et al.*, No. 3-24-cv-00407 (E.D. Va., filed May 30, 2024)⁶. Audible also filed a complaint for

⁶ *Audio Pod IP, LLC v. Amazon.com, Inc. et al.*, No. 1-24-cv-00444 (E.D. Va., filed March 20, 2024) was consolidated with this case.

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declaratory judgment of noninfringement of the '266 patent, captioned *Audible, Inc. v. Audio Pod IP, LLC*, No. 1:25-cv-02158 (S.D.N.Y., filed March 14, 2025).

C. Lead and Backup Counsel (37 C.F.R. §42.8(b)(3))

Petitioners provide the following designation of counsel, all of whom are included in Customer No. 20,995 identified in Petitioners' Power of Attorney.

Lead Counsel	Back-up Counsel
<p>Colin B. Heideman (Reg. No. 61,513) 2cbh@knobbe.com BoxSEAZNL2185LP4@knobbe.com</p> <p><u>Postal and Hand-Delivery Address:</u> Knobbe, Martens, Olson, & Bear, LLP 925 4th Ave., Ste. 2500 Seattle, WA 98104 Telephone: (206) 405-2000 Facsimile: (206) 405-2001</p>	<p>Joseph R. Re (Reg. No. 31,291) 2jrr@knobbe.com</p> <p><u>Postal and Hand-Delivery Address:</u> Knobbe, Martens, Olson, & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502</p> <p>Christie R.W. Matthaei (Reg. No. 62,933) 2crw@knobbe.com Nathan D. Reeves (Reg. No. 77,806) 2ndr@knobbe.com</p> <p><u>Postal and Hand-Delivery Address:</u> Knobbe, Martens, Olson & Bear, LLP 925 4th Ave., Ste. 2500 Seattle, WA 98104 Telephone: (206) 405-2000 Facsimile: (206) 405-2001</p> <p>Daniel Hughes (Reg. No. 76,592) 2dph@knobbe.com</p> <p><u>Postal and Hand-Delivery Address:</u> Knobbe, Martens, Olson & Bear, LLP 3579 Valley Centre Dr., Ste. 300 San Diego, CA 92130 Telephone: (858) 707-4000 Facsimile: (858) 707-4001</p>

D. Service Information (37 C.F.R. §42.8(b)(4))

Please direct all correspondence to lead counsel and back-up counsel at the addresses shown above. Petitioners also consent to electronic service by email to BoxSEAZNL2185LP4@knobbe.com.

E. Grounds for Standing (37 C.F.R. §42.104(a))

Petitioners certify that the '266 patent is available for IPR and that Petitioners are not barred or estopped from requesting IPR on the identified grounds. This petition is being filed within one year of service of the original complaint against Petitioners in the district court litigation.

F. Payment of Fees (37 C.F.R. §42.15(a))

The Office may charge the §42.15(a) fee to Deposit Account No. 11-1410. Review of thirteen claims is requested. Payment for any additional fees due may be charged to the above-referenced Deposit Account.

Respectfully submitted,

KNOBBE MARTENS OLSON & BEAR, LLP

Dated: March 19, 2025

/Colin B. Heideman/

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APPENDIX

Listing of Claims from U.S. 10,091,266	
Claim 1	
1[pre]	A method of rendering digital content across multiple client devices comprising:
1[a]	rendering on a first client device at least a portion of primary digital content;
1[b]	determining on the first client device an identifier corresponding to the primary digital content, wherein the identifier identifies a descriptor of the primary content;
1[c]	determining on the first client device a first position in the primary digital content;
1[d]	transferring the identifier and the first position from the first client device to a second client device via a network accessible library;
1[e]	downloading the descriptor from the network accessible library to the second client device by using the identifier;
1[f]	rendering on the second client device at least a portion of secondary other digital content associated with the primary digital content by using the descriptor and the first position, wherein the secondary digital content is ancillary to the primary digital content, and wherein the secondary digital content is rendered on the second client device simultaneously and in synchronization with the rendering of the primary digital content on the first client device;
1[g]	identifying a range of content surrounding the first position in the primary digital content as content to be retained;
1[h]	releasing storage resources allocated to all content of the primary digital content that is not identified as content to be retained on the first client device;

Listing of Claims from U.S. 10,091,266	
1[i]	identifying content in the secondary digital content that is related to the range of content surrounding the first position in the primary digital content as content to be retained; and
1[j]	releasing storage resources allocated to all content of the secondary digital content that is not identified as content to be retained on the second client device.
Claim 2	
2[a]	The method of claim 1, wherein the secondary digital content comprises a series of items,
2[b]	the method further comprising: determining on the second client device an item in the series of items that is associated with the first position in the primary digital content by using the descriptor,
2[c]	wherein the item associated with the first position is rendered on the second client device.
Claim 3	
--	The method of claim 1, wherein the first position is determined by tracking a current position in the primary digital content as the primary digital content is rendered on the first client device.
Claim 4	
--	The method of claim 1, wherein the descriptor contains the secondary digital content, location information for accessing the secondary digital content, or a combination thereof.

Listing of Claims from U.S. 10,091,266	
Claim 5	
--	The method of claim 4, wherein the descriptor contains location information for accessing the secondary digital content, further comprising: accessing the secondary digital content for rendering on the second client device by using the location information in the descriptor.
Claim 6	
--	The method of claim 1, wherein the secondary digital content is a different type of digital content than the primary digital content.
Claim 7	
--	The method of claim 1, wherein the secondary digital content includes audio content, audio/video content, video content, text content, static image content, moving image content, user-entered content, advertising content, or a combination thereof.
Claim 8	
--	The method of claim 1, wherein the secondary digital content includes a plurality of different types of digital content.
Claim 9	
--	The method of claim 8, further comprising: selecting one or more of the different types of digital content for rendering on the second client device.
Claim 10	
--	The method of claim 9, wherein the one or more of the different types of digital content are selected in dependence on rendering capabilities of the second client device.

Listing of Claims from U.S. 10,091,266	
Claim 11	
--	<p>The method of claim 8, wherein the secondary digital content includes at least two different types of digital content selected from among audio content, audio/video content, video content, text content, static image content, moving image content, user-entered content, and advertising content, further comprising:</p> <p style="padding-left: 40px;">selecting one or more of the different types of digital content for rendering on the second client device in dependence on rendering capabilities of the second client device.</p>
Claim 12	
--	<p>The method of claim 1, wherein the first client device and the second client device have different rendering capabilities.</p>
Claim 13	
13[pre]	<p>A system for rendering digital content across multiple client devices comprising:</p>
13[a]	<p>a first client device;</p>
13[b]	<p>a second client device; and</p>
13[c]	<p>a network accessible library accessible by the first and second client devices via a network;</p>

Listing of Claims from U.S. 10,091,266	
13[d]	<p>wherein the first client device is configured to:</p> <ul style="list-style-type: none">render at least a portion of primary digital content;determine an identifier corresponding to the primary digital content, wherein the identifier identifies a descriptor of the primary digital content;determine a first position in the primary digital content;transfer the identifier and the first position to the second client device via the network accessible library;identify a range of content surrounding the first position in the primary digital content as content to be retained; andrelease storage resources allocated to all content of the primary digital content that is not identified as content to be retained on the first client device; and
13[e]	<p>wherein the second client device is configured to:</p> <ul style="list-style-type: none">download the descriptor from the network accessible library by using the identifier;render at least a portion of secondary digital content associated with the primary digital content by using the descriptor and the first position, wherein the secondary digital content is ancillary to the primary digital content, and wherein the secondary digital content is rendered on the second client device simultaneously and in synchronization with the rendering of the primary digital content on the first client device;identify content in the secondary digital content that is related to the range of content surrounding the first position in the primary digital content as content to be retained; andrelease storage resources allocated to all content of the secondary digital content that is not identified as content to be retained on the second client device.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this **PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,091,266** contains 13,956 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 14,000-word type-volume limit specified by 37 C.F.R. § 42.24(a)(1).

Dated: March 19, 2025

/Colin B. Heideman/

Colin B. Heideman (Reg. No. 61,513)
KNOBBE MARTENS OLSON & BEAR, LLP

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of this **PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,091,266** and **ACCOMPANYING EXHIBITS** are being served on March 19, 2025, via Federal Express overnight mail on counsel of record for U.S. Patent No. 10,091,266 at the Correspondence Address of record below:

Neil Teitelbaum
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A courtesy copy is also being served via email on counsel for the patent holder in the pending district court litigations:

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Dated: March 19, 2025

By: /Colin B. Heideman/
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