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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER J. ROURK

Appeal 2019-003250
Reexamination Control 90/013,861¹
Patent No. US 9,213,357 B2
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and ERIC B. CHEN,
Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the rejection of claims 9–12 and 19. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We reverse.

The ‘357 patent issued to Millington on December 15, 2015. The ‘700 patent is a system and method for synchronizing operations among a number of digital data processing devices that are regulated by independent clocking devices, particularly a plurality of audio playback devices that receive digital audio information to be played back. A task distribution

¹ Appellant states that the real party in interest is Sonos, Inc. App. Br. 1.

device distributes tasks (e.g., audio information to be played back) to the devices. Each task is associated with a time stamp indicating a time at which the devices are to play back the audio in synchrony. Each respective device obtains the current time from the task distribution device and determines a time differential between that clock and the respective device's clock, so as to determine precisely when to execute the task in synchrony. '357 Patent col. 2:32–66.

Claim 9 is exemplary of the claims on appeal:

9. A first playback device comprising:

one or more processors;

a network interface; and

tangible, non-transitory computer-readable memory comprising program instructions that, when executed by the one or more processors, cause the first playback device to:

receive, via the network interface from a network device configured to control the first playback device and communicatively coupled to the first playback device over a local area network (LAN), control information comprising an address identifying a network location of audio information available at an audio information source, wherein the audio information source is outside of the LAN;

and

after receiving the control information, (i) obtain, via the network interface from the audio information source outside of the LAN, the audio information; (ii) transmit, via the network interface of the first playback device to a second playback device, the audio information, playback timing

information associated with the audio information, and device clock information of the first playback device; and (iii) play back the audio information in synchrony with the second playback device by using the playback timing information associated with the audio information and the device clock information of the first playback device to playback the audio information, wherein the first and second playback devices remain independently clocked during synchronous playback of the audio information.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Millington	US 9,195,258 B2	Nov. 24, 2015
Edens	US 6,611,537 B1	Aug. 26, 2003
Blank	US 2004/0252400	Dec. 16, 2004
Gray, III	US 2002/0150053 A1	Oct. 17, 2002
Fries et al., <i>The MP3 and Internet Audio Handbook</i> , TeamCom Books (2000).		

Throughout this decision, we make reference to Appellant's Brief ("App. Br.," filed Sept. 17, 2018), the Reply Brief ("Reply Br.," filed Jan. 7, 2019) and the Examiner's Answer ("Ans.," filed Nov. 5, 2018) for their respective details.

REJECTIONS

Claims 9-12 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blank, Gray, and APA.

ISSUE

Appellant’s arguments present us with the following issue:

Has Appellant adduced objective evidence that leads to a conclusion that the claims under reexamination would not have been obvious to the person having ordinary skill in the art?

PRINCIPLES OF LAW

“There is a presumption of nexus for objective considerations when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘is the invention disclosed and claimed in the patent.’” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016); *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997). “A patent challenger may respond by presenting evidence that shows the proffered objective evidence was ‘due to extraneous factors other than the patented invention.’” *Id.*; *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1393 (Fed. Cir. 1988). “However, a patent challenger cannot successfully rebut the presumption with argument alone – it must present evidence. *Id.*”

ANALYSIS

Independent claim 9 recites, inter alia, transmitting playback timing information associated with audio information, via a network interface; playing back the audio information in synchrony by using the playback timing information associated with the audio information and the device clock information of the first playback device; wherein the first and second

playback devices remain independently clocked during synchronous playback.

Appellant argues that the Examiner erred in failing to give appropriate weight to its objective evidence of non-obviousness. App. Br. 24–25. Appellant has presented evidence that D&M engineers praised their product, characterizing it as “excellent synchronous playback,” “amazing accuracy over IP network,” and “the best [synchronization] I’ve ever heard.” App. Br. 27. Appellant has presented evidence that D&M set out to copy their product. Appellant’s evidence showed that “D&M was aware of, had access to, and copied Sonos products embodying the claimed synchronous playback.” App. Br. 28. Appellants’ evidence showed that even after allocating “70,240 hours” of employee time and “\$5.33M,” D&M had difficulty implementing Appellant’s synchronous playback functionality. App. Br. 29.

Appellant has presented evidence that D&M set out to achieve the patented synchronous playback product, only to fail for years while expending thousands of man-hours and millions of dollars. App. Br. 29. Appellants’ evidence showed that D&M engineers had no “concrete idea” how Sonos “can synchronize so perfectly.” *Id.*

The Examiner did not rebut Appellant’s evidence. The Examiner’s response was confined to concluding that Appellants’ argument was not persuasive, because Appellant’s evidence failed to establish a nexus between the objective evidence presented and the limitations of the claimed invention. Ans. 12–13.

There is a presumption of nexus for such objective considerations as praise by competitors, copying, and failure of others, when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘is the invention disclosed and claimed in the patent.’” *WBIP*, 829 F.3d at 1329.

We agree with Appellant’s contention that the Examiner erred in holding Appellants’ objective evidence to be unpersuasive. First, the Examiner’s response to arguments, in the Answer, finds that Appellants did not state “what specific claimed feature from the litigation in the D&M case was considered novel enough for praise,” and “what specific feature in the claim that accomplishes the Synchronous playback that sets Sonos above the competition.” Ans. 11. We find that Appellant did, however, argue in the Brief, and again in the Reply Brief, that the D&M litigation concerned the synchronous playback features recited in Millington ‘258, which are substantially identical to the synchronous playback limitations recited in the ‘357 patent under reexamination. D&M was found to have willfully infringed the ‘258 Patent based upon the evidence of copying referenced by Appellant in the Brief. Reply Br. 12, 18. We agree that Appellant has tied their objective evidence to a specific product, which is the invention disclosed and claimed in the ‘258 Patent and the ‘357 Patent, which includes the synchronous playback feature that Appellant’s competitor praised and sought to copy.

Second, in the Answer, the Examiner continues to insist that Appellant has not satisfied the legal requirements for establishing commercial success. Ans. 12. The Examiner’s statements of the law

regarding commercial success are not relevant to the disposition of this appeal, because Appellants *have not presented evidence concerning the commercial success of the invention*. Rather, Appellant has presented unrebutted objective evidence concerning praise by a competitor, copying by a competitor, and failure of others.

The Examiner's finding that the '258 Patent claims multiple other features not found in the claims under reexamination is not persuasive to rebut Appellant's evidence that Appellant's synchronous playback feature was praised, was copied, and was the subject of long-felt need and failure of others. *See* Ans. 13. The Examiner merely suggests that some other feature or features gave rise to this praise, copying, etc. *Id.* The Examiner, however, points to no factual evidence tending to support a theory that any particular other feature or features, rather than the synchronous audio playback asserted by Appellant, motivated Appellant's competitor.

We conclude that Appellant's arguments concerning objective evidence of nonobviousness are persuasive to show Examiner error in asserting the prima facie obviousness of claims 9–12 and 19 over Blank, Gray, and APA. We need not reach Appellant's arguments concerning the prima facie obviousness of the claims over the cited references, because we conclude that the totality of Appellant's evidence of nonobviousness leads to the conclusion that the claims under reexamination would not have been obvious. We do not sustain the Examiner's § 103(a) rejection of claims 9–12 and 19.

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CONCLUSION

Appellant has adduced objective evidence that leads to a conclusion that the claims under reexamination would not have been obvious to the person having ordinary skill in the art.

ORDER

The Examiner's decision to reject claims 9–12 and 19 is reversed.

REVERSED