

UNITED STATES INTERNATIONAL TRADE COMMISSION  
WASHINGTON, D.C. 20436

**In the Matter of**

**CERTAIN PORTABLE ELECTRONIC  
DEVICES AND COMPONENTS THEREOF**

**Inv. No. 337-TA-994**

**FINAL INITIAL DETERMINATION**

**Administrative Law Judge David P. Shaw**

Pursuant to the notice of investigation, 81 Fed. Reg. 29307 (May 11, 2016), this is the initial determination in *Certain Portable Electronic Devices and Components Thereof* (United States International Trade Commission Investigation No. 337-TA-994) regarding whether the asserted claims of U.S. Patent No. 6,928,433 (“the ‘433 patent”) recite patent-eligible subject matter under 35 U.S.C. § 101.

It is held that the asserted claims of the ‘433 patent do not recite patent-eligible subject matter under 35 U.S.C. § 101.

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The following abbreviations may be used in this Initial Determination:

ALJ	-	Administrative Law Judge
CDX	-	Complainants' Demonstrative Exhibit
CPX	-	Complainants' Physical Exhibit
CX	-	Complainants' Exhibit
Dep.	-	Deposition
EDIS	-	Electronic Document Imaging System
JPX	-	Joint Physical Exhibit
JX	-	Joint Exhibit
P.H.	-	Prehearing
RDX	-	Respondents' and Intervenor's Demonstrative Exhibit
RPX	-	Respondents' and Intervenor's Physical Exhibit
RWS	-	Rebuttal Witness Statement
RX	-	Respondents' Exhibit
Tr.	-	Transcript
WS	-	Witness Statement

## I. Background

### A. Institution of the Investigation; Procedural History

By publication of a notice in the *Federal Register* on May 11, 2016, pursuant to subsection (b) of section 337 of the Tariff Act of 1930, as amended, the Commission instituted this investigation to determine:

[W]hether there is a violation of subsection (a)(1)(B) of section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain portable electronic devices and components thereof by reason of infringement of one or more of claims 2, 3, 5, 7, and 17–28 of the ‘433 patent [U.S. Patent No. 6,928,433], and whether an industry in the United States exists as required by subsection (a)(2) of section 337.

81 Fed. Reg. 29307 (May 11, 2016).

Pursuant to Commission Rule 210.50(b)(1), the Commission ordered that:

[T]he presiding administrative law judge shall take evidence or other information and hear arguments from the parties and other interested persons with respect to the public interest in this investigation, as appropriate, and provide the Commission with findings of fact and a recommended determination on this issue, which shall be limited to the statutory public interest factors set forth in 19 U.S.C. 1337(d)(1), (f)(1), (g)(1).

*Id.*

Additionally, the Commission ordered that:

Notwithstanding any Commission Rules that would otherwise apply, the presiding Administrative Law Judge shall hold an early evidentiary hearing, find facts, and issue an early decision, as to whether the asserted claims of the ‘433 patent recite patent-eligible subject matter under 35 U.S.C. 101. Any such decision shall be in the form of an initial determination (ID). Petitions for review of such an ID shall be due five calendar days after service of the ID; any replies shall be due three business days after service of a petition. The ID will become the Commission’s final

determination 30 days after the date of service of the ID unless the Commission determines to review the ID. Any such review will be conducted in accordance with Commission Rules 210.43, 210.44, and 210.45, 19 CFR 210.43, 210.44, and 210.45. The Commission expects the issuance of an early ID relating to Section 101 within 100 days of institution, except that the presiding ALJ may grant a limited extension of the ID for good cause shown. The issuance of an early ID finding that the asserted claims of the '433 patent do not recite patent-eligible subject matter under 35 U.S.C. 101 shall stay the investigation unless the Commission orders otherwise; any other decision shall not stay the investigation or delay the issuance of a final ID covering the other issues of the investigation.

*Id.*

The complainants are Creative Technology Ltd. of Singapore and Creative Labs, Inc. of Milpitas, California. The respondents are ZTE Corporation of Guangdong, China; ZTE (USA) Inc. of Richardson, Texas; Sony Corporation and Sony Mobile Communications, Inc. of Tokyo, Japan; Sony Mobile Communications AB of Lund, Sweden; Sony Mobile Communications (USA), Inc. of Atlanta, Georgia; Samsung Electronics Co., Ltd. of Seoul, Republic of Korea; Samsung Electronics America, Inc. of Ridgefield Park, New Jersey; LG Electronics, Inc. of Seoul, Republic of Korea; LG Electronics U.S.A., Inc. of Englewood Cliffs, New Jersey; LG Electronics Mobilecomm U.S.A., Inc. of San Diego, California; Lenovo Group Ltd. of Beijing, China; Lenovo (United States) Inc. of Morrisville, North Carolina; Motorola Mobility LLC of Chicago, Illinois; HTC Corporation of Taiwan; HTC America, Inc. of Bellevue, Washington; Blackberry Ltd. of Ontario, Canada; and Blackberry Corporation of Irving, Texas. The Office of Unfair Import Investigations is also a party to this investigation. *Id.*

The target date for completion of this investigation was set at fifteen months, *i.e.*, August 11, 2017. *See* Order No. 6 (May 26, 2016). The due date for the initial

determination regarding whether the asserted claims of the '433 patent recite patent-eligible subject matter under 35 U.S.C. § 101 is August 19, 2016. *See* 81 Fed. Reg. 29307 (May 11, 2016); Order No. 3 (May 11, 2016); Order No. 7 (May 26, 2016).

On June 21, 2016, the Commission determined not to review an initial determination granting intervenor status to Google Inc. ("Google"). Order No. 5 (May 19, 2016), *aff'd*, Notice of Commission Determination Not to Review an Initial Determination Granting Intervenor Status to Google Inc. (June 21, 2016).

A preliminary conference concerning 35 U.S.C. § 101 was held on May 19, 2016. *See* Preliminary Conference Tr. 1-46. A prehearing conference concerning 35 U.S.C. § 101 was held on July 6, 2016, with the evidentiary hearing commencing immediately thereafter. The hearing concluded on July 7, 2016. *See* Order No. 3 (May 11, 2016); Order No. 7 (May 26, 2016); P.H. Tr. 1-36; Tr. 1-309. The parties were requested to file post-hearing briefs not to exceed 55 pages in length, and to file reply briefs not to exceed 30 pages in length. P.H. Tr. 15; Tr. 304. On July 15, 2016, the parties filed a joint outline of the issues to be decided in the initial determination concerning 35 U.S.C. § 101. *See* P.H. Tr. 14-15; Joint Outline of the Issues to Be Decided (EDIS Doc. ID No. 585919).

## **B. The Parties**

### **Complainants**

Complainant Creative Technology Ltd. is a Singapore corporation that designs consumer electronic devices and components. Complaint, ¶ 7. Complainant Creative Labs, Inc. is a California corporation and wholly-owned subsidiary of Complainant Creative Technology Ltd. *Id.*, ¶ 8.

## **Respondents**

Respondent ZTE Corporation is Chinese corporation involved in the design, development, manufacture, and sale for importation of portable electronic devices and components thereof, including mobile phones, in the United States. ZTE Answer, ¶ 9. Respondent ZTE (USA), Inc. is a New Jersey corporation involved in the importation, sale after importation, and distribution of ZTE Corporation's portable electronic devices and components thereof, including mobile phones, in the United States. ZTE Answer, ¶ 10.

Respondent Sony Corporation is a Japanese corporation. Sony Answer, ¶ 12. Respondent Sony Mobile Communications, Inc. is a Japanese corporation involved in the design, development, manufacture, and sale of mobile phones outside of the United States. Sony Answer, ¶ 13. Respondent Sony Mobile Communications AB is a Swedish corporation involved in the design, development, manufacture, sale outside the United States, and sale for importation into the United States of mobile phones. Sony Answer, ¶ 14. Respondent Sony Mobile Communications (USA), Inc. is a Delaware corporation involved in the importation, sale after importation, and distribution of Sony Mobile Communications, Inc., and Sony Mobile Communications AB mobile phones in the United States. Sony Answer, ¶ 15. Respondent Sony Mobile Communications, Inc., Respondent Sony Mobile Communications AB, and Respondent Sony Mobile Communications (USA), Inc. are subsidiaries of Respondent Sony Corporation. Sony Answer, ¶ 16.

Respondent Samsung Electronics Co., Ltd. is a Korean corporation. Samsung Answer, ¶ 17. Respondent Samsung Electronics America, Inc. is a New York

corporation and a subsidiary of Respondent Samsung Electronics Co., Ltd. Samsung Answer, ¶¶ 18, 19.

Respondent LG Electronics, Inc. is a South Korean corporation. LG Answer, ¶ 20. Respondent LG Electronics U.S.A., Inc. is a Delaware corporation and subsidiary of Respondent LG Electronics, Inc. LG Answer, ¶¶ 21, 23. Respondent LG Electronics MobileComm U.S.A., Inc. is a California corporation and subsidiary of Respondent LG Electronics U.S.A., Inc. LG Answer, ¶¶ 22, 23.

Respondent Lenovo Group Ltd. has its principal place of business in Beijing, China. Lenovo/Motorola Answer, ¶ 24. Respondent Lenovo (United States) Inc. is a Delaware Corporation and subsidiary of Respondent Lenovo Group Ltd. *Id.*, ¶¶ 25, 27. Respondent Motorola Mobility, LLC is a Delaware corporation and subsidiary of Respondent Lenovo Group Ltd. *Id.* at ¶¶ 26, 27.

Respondent HTC Corporation is Taiwanese corporation. HTC Answer, ¶ 28. Respondent HTC America, Inc. is a Washington corporation that is wholly owned by Respondent HTC Corporation. *Id.*, ¶¶ 29, 30.

Respondent BlackBerry Ltd. is a Canadian corporation. BlackBerry Answer, ¶ 31. Respondent BlackBerry Corporation is a Delaware corporation and subsidiary of Respondent BlackBerry Ltd. *Id.*, ¶¶ 32, 33.

**Intervenor Google Inc.**

As noted above, on June 21, 2016, the Commission determined not to review an initial determination granting intervenor status to Google Inc. (“Google”). Order No. 5 (May 19, 2016), *aff’d*, Notice of Commission Determination Not to Review an Initial Determination Granting Intervenor Status to Google Inc. (June 21, 2016). “All respondents are accused of violating section 337 based upon the alleged use of the



accused portable electronic devices with Google's Play Music app." Order No. 5 at 1.

## **II. Jurisdiction**

Section 337(a)(1)(B) declares unlawful, *inter alia*, "[t]he importation into the United States, the sale for importation, or the sale within the United States after importation by the owner, importer, or consignee, of articles that . . . infringe a valid and enforceable United States patent." 19 U.S.C. § 1337(a)(1)(B). Complainants have filed a complaint alleging a violation of this subsection, and the Commission therefore has subject matter jurisdiction. *See Amgen, Inc. v. United States Int'l Trade Comm'n*, 902 F.2d 1532, 1535-37 (Fed. Cir. 1990).

No respondent or intervenor contested the Commission's personal jurisdiction. *See* Resps. Br. 1-50. Indeed, all respondents and intervenor have appeared and participated in the investigation. The Commission therefore has personal jurisdiction over those respondents and intervenor. *See e.g., Certain Liquid Crystal Display Modules, Products Containing Same, and Methods for Using the Same*, Inv. No. 337-TA-634, Final Initial and Recommended Determinations at 3 (June 12, 2009) (unreviewed).

## **III. Claim Construction**

United States Patent No. 6,928,433 ("the '433 patent"), entitled "Automatic Hierarchical Categorization of Music by Metadata," issued on August 9, 2005, to named inventors Ron Goodman and Howard N. Egan. JX-0001 ('433 Patent). The '433 patent issued from Application No. 09/755,723, filed on January 5, 2001. *Id.* The Summary of the Invention of the '433 patent discloses: "The present invention provides an efficient user interface for a small portable music player. The invention is suitable for use with a limited display area and small number of controls to allow a user to efficiently and

intuitively navigate among, and select, songs to be played. By using the invention, very large numbers of songs can be easily accessed and played.” *Id.* at col. 2, lns. 6-11.

#### **A. Prosecution and Reexamination History**

All claims of the ‘433 patent are method claims. JX-0001 (‘433 Patent). Claim 1 is the sole independent claim of the ‘433 patent. It was cancelled during reexamination as anticipated and obvious in view of prior art U.S. Patent No. 5,739,451 (“Winsky”). CX-0004.0301, 6249. In addition to claim 1, original dependent claims 4, 6, and 8-16 were cancelled during reexamination as anticipated or obvious in view of the prior art. *Id.* at 6263. Claims 17-28 were added by amendment. *Id.* at 6263, 6248. All of the remaining claims of the ‘433 patent depend from cancelled claim 1.

The application that led to the ‘433 patent was filed on January 5, 2001. JX-0001 (‘433 Patent). All original claims related to “filing of media tracks” were cancelled or withdrawn in response to a restriction requirement. *See* RX-0055 at 0126. The application proceeded with new claims, a replaced summary of the invention, and additional content in the detailed description. *Id.* at 0120-154. The new claims were allowed without comment on June 9, 2004. *Id.* at 0117.

On February 26, 2010, the Patent Office granted a request for *inter partes* reexamination of claims 1-16 of the ‘433 patent finding substantial new questions of patentability over a number of prior art references, including Winsky and U.S. Patent No. 6,760,721 (“Chasen”). CX-0004.0239-254. On March 29, 2010, the examiner rejected claims 1-16 of the ‘433 patent as invalid in view of Winsky—characterized by the examiner as teaching “[a] hand held electronic music reference machine” including “a hierarchy of categories”—and in view of Chasen—characterized by the examiner as

describing “a master tree and/or node hierarchy for organizing, selecting and accessing audio metadata and audio data within an audio playing device.” *Id.* at 0310, 0330.

Applicants disputed the rejection of claims 1-16 and simultaneously added new claims 17-33. RX-0011. Applicants submitted declarations in support of its arguments, including one from Dr. Foley. RX-0010. Applicants also submitted an individual inventor declaration of Howard Egan and a group declaration for all three inventors. CX-0004.0511-0563, 1381-1410.

Among the many grounds for rejection over Winsky, the examiner specifically rejected newly added claims 17 and 18 of the ‘433 patent, disclosing an “overlapping hierarchy,” in view of the disclosure wherein “[t]he particular . . . track . . . may be accessed in at least two different ways according to the user selection of filters.” *Id.* at 6147-6148. On September 17, 2012, the Patent Office issued a Notice of Intent to Issue a Reexamination Certificate cancelling original claims 1, 4, 6, and 8-16, and allowing renumbered claims 17-28 of the ‘433 patent. *Id.* at 6248.

## **B. Applicable Law**

Claim construction begins with the plain language of the claim.<sup>1</sup> Claims should be given their ordinary and customary meaning as understood by a person of ordinary skill in the art, viewing the claim terms in the context of the entire patent.<sup>2</sup> *Phillips v.*

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<sup>1</sup> Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vanderlande Indus. Nederland BV v. Int’l Trade Comm.*, 366 F.3d 1311, 1323 (Fed. Cir. 2004); *Vivid Tech., Inc. v. American Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

<sup>2</sup> Factors that may be considered when determining the level of ordinary skill in the art include: “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in

*AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005), *cert. denied*, 546 U.S. 1170 (2006).

In some instances, claim terms do not have particular meaning in a field of art, and claim construction involves little more than the application of the widely accepted meaning of commonly understood words. *Phillips*, 415 F.3d at 1314. “In such circumstances, general purpose dictionaries may be helpful.” *Id.*

In many cases, claim terms have a specialized meaning, and it is necessary to determine what a person of skill in the art would have understood the disputed claim language to mean. “Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms idiosyncratically, the court looks to ‘those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean.’” *Phillips*, 415 F.3d at 1314 (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004)). The public sources identified in *Phillips* include “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Id.* (quoting *Innova*, 381 F.3d at 1116).

In cases in which the meaning of a claim term is uncertain, the specification usually is the best guide to the meaning of the term. *Phillips*, 415 F.3d at 1315. As a general rule, the particular examples or embodiments discussed in the specification are not to be read into the claims as limitations. *Markman v. Westview Instruments, Inc.*, 52

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the field.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). The specification is, however, always highly relevant to the claim construction analysis, and is usually dispositive. *Phillips*, 415 F.3d at 1315 (quoting *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). Moreover, “[t]he construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.” *Id.* at 1316.

Claims are not necessarily, and are not usually, limited in scope to the preferred embodiment. *RF Delaware, Inc. v. Pacific Keystone Techs., Inc.*, 326 F.3d 1255, 1263 (Fed. Cir. 2003); *Decisioning.com, Inc. v. Federated Dep’t Stores, Inc.*, 527 F.3d 1300, 1314 (Fed. Cir. 2008) (“[The] description of a preferred embodiment, in the absence of a clear intention to limit claim scope, is an insufficient basis on which to narrow the claims.”). Nevertheless, claim constructions that exclude the preferred embodiment are “rarely, if ever, correct and require highly persuasive evidentiary support.” *Vitronics*, 90 F.3d at 1583. Such a conclusion can be mandated in rare instances by clear intrinsic evidence, such as unambiguous claim language or a clear disclaimer by the patentees during patent prosecution. *Elekta Instrument S.A. v. O.U.R. Sci. Int’l, Inc.*, 214 F.3d 1302, 1308 (Fed. Cir. 2000); *Rheox, Inc. v. Entact, Inc.*, 276 F.3d 1319 (Fed. Cir. 2002).

If the intrinsic evidence does not establish the meaning of a claim, then extrinsic evidence may be considered. Extrinsic evidence consists of all evidence external to the patent and the prosecution history, and includes inventor testimony, expert testimony, and learned treatises. *Phillips*, 415 F.3d at 1317. Inventor testimony can be useful to shed light on the relevant art. In evaluating expert testimony, a court should discount any expert testimony that is clearly at odds with the claim construction mandated by the

claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent. *Id.* at 1318. Extrinsic evidence may be considered if a court deems it helpful in determining the true meaning of language used in the patent claims. *Id.*

**C. A Person of Ordinary Skill in the Art**

Complainants argue: “A person of ordinary skill in the art for the ‘433 Patent would have had a Bachelor of Science degree in computer science, with two to three years of experience in the design and implementation of user interfaces for hand-held portable electronic devices.” Compls. Br. at 15 (citing CX-0007.2 (Foley WS) at Q15-16).

Respondents’ expert, Dr. Jeffay, testified that a person of ordinary skill in the art in 1999 would “have at least the equivalent of a Bachelor of Science degree in computer science or a similar subject, or two to three years of experience in designing and implementing user interfaces for portable electronic devices.” RX-0058.3.0007 (Jeffay WS) at Q/A 32. Dr. Jeffay testified that experience could substitute for formal training. *Id.*

The Staff argues that a person of ordinary skill “for the ‘433 patent in 1999 would have had a Bachelor of Science in computer science or a related field and at least 1 year of experience in the design and implementation of user interfaces for portable electronic devices. Other training or additional work experience could substitute for formal education in computer science.” Staff Br. at 20. The Staff argues that “the differences between the proposed levels of skill in the art do not significantly affect the claim construction analysis.” *Id.*

There is some disagreement between the private parties' experts on the level of ordinary skill in the art with respect to the '433 patent. It is not clear whether a person with only a formal education and no direct experience at all in the relevant field should qualify as a person of ordinary skill in the art, as Dr. Jeffay suggested. Generally, a person of ordinary skill would be expected to have had sufficient exposure to the field of the invention to have at least an understanding of what is a routine and ordinary practice in that field. It is also not clear whether two to three years of experience in the relevant field would have been necessary to qualify as a person of ordinary skill, as Dr. Foley suggested, in view of the very general nature of the asserted claims and the absence of claim language requiring specialized programming structures or other indications of particularly specialized knowledge of the field.

Dr. Foley opined that the field of the invention is "user interfaces for hand-held portable electronic devices," while Dr. Jeffay opined that the field is "user interfaces for portable electronic devices." CX-0007.2.0010 (Foley WS) at Q/A 12, 15; RX-0058.3.0007 (Jeffay WS) at Q/A 32. Dr. Foley's testimony did not provide a persuasive reason to believe that the field of user interfaces for hand-held portable electronic devices differs demonstrably from the field of user interfaces for all portable electronic devices (especially with regard to the coding skills he has defined for a person of ordinary skill). Thus, the evidence shows that the field of the invention should be defined as user interfaces for portable electronic devices. *Id.*

Accordingly, as proposed by the Staff, the administrative law judge finds that a person of ordinary skill in the art with respect to the '433 patent in 1999 would have had a bachelor of science in computer science or a related field and at least one year of

experience in the design and implementation of user interfaces for portable electronic devices. Other training or additional work experience could substitute for formal education in computer science.

**D. Disputed Claim Term: “portable media player”**

The claim term “portable media player” appears in claim 1 of the ‘433 patent. JX-0001 (‘433 Patent) col. 11, lns. 41-42. As noted above, claim 1 was canceled in the reexamination of the ‘433 patent, but all of the asserted claims (claims 2, 3, 5, 7, 17-28) depend directly or indirectly from claim 1. See JX-0001 at reexamination certificate, original claims 2, 3, 5, 7. Below is a chart showing the parties’ proposed claim constructions.

<b>Claim Term</b>	<b>Complainants’ Construction</b>	<b>Respondents’ Construction</b>	<b>Staff’s Construction</b>
“portable media player”	“a hand-held electronic device that can play audio and/or video content”	“portable media playback device, as distinguished from a general-purpose device such as a handheld computer or a personal digital assistant”	“portable media playback device, as distinguished from a general-purpose device such as a handheld computer or a personal digital assistant”

Compls. Br. at 15; Resps. Br. at 46; Staff Br. at 21.

Complainants argue that the construction of this claim term is necessary to address the question of patent-eligibility under 35 U.S.C. § 101. Compls. Br. at 15-16. Respondents, intervenor and the Staff disagree. Resps. Br. at 45-46; Staff Br. at 5, 13 n.1, 21 n.4, 27. As discussed below, the administrative law judge does not find that construction of the term is necessary. Nevertheless, to provide the Commission with a thorough evaluation of complainants’ argument, the term is construed herein.



For the reasons discussed below, the administrative law judge has determined that the claim term “portable media player” should be construed to mean “portable media playback device, as distinguished from a general-purpose device such as a handheld computer or a personal digital assistant.”

The language of canceled claim 1 of the ‘433 patent, from which asserted claims 2, 3, 5, 7, and 17-28 depend, is as follows:

1. A method of selecting at least one track from a plurality of tracks stored in a computer-readable medium of a portable media player configured to present sequentially a first, second, and third display screen on the display of the media player, the plurality of tracks accessed according to a hierarchy, the hierarchy having a plurality of categories, subcategories, and items respectively in a first, second, and third level of the hierarchy, the method comprising:

selecting a category in the first display screen of the portable media player;

displaying the subcategories belonging to the selected category in a listing presented in the second display screen;

selecting a subcategory in the second display screen;

displaying the items belonging to the selected subcategory in a listing presented in the third display screen; and

accessing at least one track based on a selection made in one of the display screens.

JX-0001 (‘433 Patent) at col. 11, lns. 39-57.

The asserted dependent claims 2, 3, 5, 7, and 17-28 read as follows:

2. The method of selecting a track as recited in claim 1 wherein the accessing at least one track comprises selecting a subcategory in the second display screen and playing a plurality of tracks associated with the selected subcategory.

3. The method of selecting a track as recited in claim 1 wherein the accessing at least one track comprises selecting a subcategory and adding the tracks associated with the selected subcategory to a playlist.

**5.** The method of selecting a track as recited in claim 1 wherein the accessing at least one track comprises selecting an item in the third display screen and adding at least one track associated with the selected item to a playlist.

**7.** The method of selecting a track as recited in claim 1 wherein the accessing at least one track is made after the presentation of the third display screen by reverting back to one of the second and first display screens, the second display screen presented sequentially after the third display screen.

**17.** The method of selecting a track as recited in claim 3 wherein the playlist is an active queue list of songs that is currently being played.

**18.** The method of selecting a track as recited in claim 5 wherein the playlist is an active queue list of songs that is currently being played.

**19.** The method of selecting a track as recited in claim 5 wherein the selected item in the third display screen is associated with a plurality of tracks, and wherein the accessing at least one track comprises adding the plurality of tracks associated with the selected item to a playlist.

**20.** The method of selecting a track as recited in claim 19 wherein the playlist is an active queue list of songs that is currently being played.

**21.** The method of selecting a track as recited in claim 5 wherein the selected item in the third display screen is a selected album name, and wherein the accessing at least one track comprises adding the plurality of tracks associated with the selected album name to a playlist.

**22.** The method of selecting a track as recited in claim 21 wherein the playlist is an active queue list of songs that is currently being played.

**23.** The method of selecting a track as recited in claim 1 wherein:

the category album is selected in the first display screen from available categories that include at least artist and album;

the subcategories listed in the second display screen comprise a listing of album names and one of the album names is selected; and

the accessing at least one track comprises adding a plurality of tracks associated with the selected album name to a playlist.

**24.** The method of selecting a track as recited in claim **23** wherein the playlist is an active queue list of songs that is currently being played.

**25.** The method of selecting a track as recited in claim **1** wherein:

the category genre is selected in the first display screen from available categories that include at least artist, album, and genre;

the subcategories listed in the second display screen comprise a listing of a plurality of genre types, and one of one genre types is selected;

the items displayed in the third display screen comprise a listing of a plurality of album names associated with the selected genre type, and one of the album names is selected; and

the accessing at least one track comprises adding a plurality of tracks associated with the selected album name to a playlist.

**26.** The method of selecting a track as recited in claim **25** wherein the playlist is an active queue list of songs that is currently being played.

**27.** The method of selecting a track as recited in claim **1** wherein:

the category artist is selected in the first display screen from available categories that include at least artist album, and genre;

the subcategories listed in the second display screen comprise a listing of artist names, and one of the listed artist names is selected;

the items displayed in the third display screen comprise a listing of album names associated with the selected artist name, and one of the listed album names is selected; and

the accessing at least one track comprises adding a plurality of tracks associated with the selected album name to a playlist.

28. The method of selecting a track as recited in claim 27 wherein the playlist is an active queue list of songs that is currently being played.

JX-0001 ('433 Patent) at col. 11, lns. 58-65; col. 12, lns. 3-6, lns. 12-17; JX-0001 ('433 Patent Reexamination Certificate) at col. 1, ln. 21 – col. 2, ln. 28.

Complainants argue:

Creative's construction of "portable media player" as "a hand-held electronic device that can play audio and/or video content" is well supported by the teachings of the '433 Patent, relevant dictionary definitions, and the testimony of Creative's expert. For example, the 2006 version of the Oxford English Dictionary defines "portable media player" as "any of various *hand-held electronic devices* for playing digital audio files or other types of digital media." CX-0010 (2006 Oxford English Dictionary excerpt) at CX-0010.0006 (emphasis added). That entry indicates first usage of that term according to that definition in 1998. *Id.* Similarly, the Computer Desktop Encyclopedia defines "portable media player" as "[a]n umbrella term for a variety of *handheld devices* that play back audio, video or both." CX-0011 (Computer Desktop Encyclopedia excerpt) at CX-0011.0001 (emphasis added). Thus, both dictionary definitions confirm that the ordinary meaning of "portable media player" is a hand-held device. Notably, Respondents' expert admitted on cross-examination that he did not dispute the accuracy of either of these dictionary definitions. Jeffay Tr. 294. Nor did Respondents' expert testify that any other dictionary provides a better definition for "portable media player." *Id.*

Compls. Br. at 16-17 (emphasis in original).

Respondents argue:

During reexamination, Creative distinguished a prior art reference, the Chasen patent, arguing that the '433 patent's claimed "portable media player" was distinguishable from the "handheld computer" and "personal digital assistant" ("PDA") disclosed by Chasen based on the differences in functionality that those devices offered. RX-0011 at \*41 (citing RX-0010 (Foley Decl.) at ¶¶ 76-78). Specifically, while Creative did not dispute that Chasen disclosed the key steps of the method of claim 1 and admitted that "Chasen '721 does mention the possibility of an implementation on a 'handheld computer' or a 'personal digital assistant'" Creative

distinguished Chasen on the ground that “such devices are distinguishable from a ‘portable media player.’” *Id.* Dr. Foley submitted a declaration supporting Creative’s position. *See* RX-0010.

Resps. Br. at 48-49.

The Staff argues: “The Staff and Respondents are in agreement as to the correct construction of the claim term “portable media player.”[ ] The Staff does not disagree that “media” is “audio and/or video content” as proposed by Complainants.” Staff Br. at 21.

The parties dispute whether “portable” means “hand-held,” as proposed by complainants. The ‘433 patent describes “portable devices” as having “a small screen” due to “the physical size of the device which is typically carried in the hand.” Thus, the specification discloses that the device need not be hand-held, but is only “typically carried in the hand.” The specification provides measurements only for the preferred embodiment. *See* JX-0001 (‘433 Patent) at col. 1, lns. 36-39; *see also id.* col. 1, lns. 19-20 (“small, portable music playback devices”), col. 2, lns. 2, 7-8 (“small device,” “small portable music player,” “limited display area”), col. 8, lns. 8-17 (preferred embodiment is “5.5” wide by 5.5” tall by 1” thick”); Foley Tr. 182-188.

“‘[C]laims are not necessarily and not usually limited in scope to the preferred embodiment.’” *Akamai Tech., Inc. v. Limelight Networks, Inc.*, 805 F.3d 1368, 1375 (Fed. Cir. 2015) (quoting *RF Del. v. Pac. Keystone Tech., Inc.*, 326 F.3d 1255, 1263 (Fed. Cir. 2003)) (alteration in original). Complainants have not identified any portion of the ‘433 patent specification disclaiming the broader ordinary meaning for the word “portable.” *See* CX-0007.2.0025 (Foley WS) at Q/A 35. Similarly, the dictionary definitions identified by complainants suggest that a typical “portable media player” is handheld size, but the definitions do not specifically exclude players of other sizes. *See*

CX-0007.2.0023 (Foley WS) at Q/A 35 (citing dictionary definitions CX-0010, CX-0011).

Additionally, a difference in the proposed constructions arises from the parties' differing views as to the effect of certain statements made to the U.S. Patent and Trademark Office (USPTO) during the reexamination of the '433 patent. As discussed below, the patentees clearly and unambiguously disclaimed certain claim scope for "portable media player" during the reexamination of the '433 patent. *See Elekta.*, 214 F.3d at 1308; *Rheox*, 276 F.3d at 1319.

Claim 1 of the '433 patent recites "tracks stored in a computer-readable medium of a portable media player" and a "display of the media player," clearly indicating that a "portable media player" is a type of physical "device" as recited in all parties' proposed constructions. JX-0001 ('433 Patent) col. 11, lns. 41-44. The specification of the '433 patent does not use the term "portable media player," but uses a number of similar terms such as "portable music playback devices," "portable music player," "small portable music player," "portable personal player," and "portable player." *Id.* at col. 1, lns. 19-20, 67, col. 2, lns. 7, 65, col. 3, lns. 5, 54, col. 6, lns. 9, 18, 34, 36, col. 7, lns. 18, 60-61. In contrast to the "host system 302" in the '433 patent, for which several alternative embodiments are described, there are no alternative device types described as falling within the category "portable media player." *See id.* at col. 11, lns. 11-24 (host system description).

In a reexamination office action dated March 29, 2010 (CX-0004.0296), the examiner, *inter alia*, rejected all pending claims as anticipated and/or obvious (CX-0004.0330) in view of U.S. Patent 6,760,720 ("Chasen") (CX-0004.0175-93). Much of

Chasen focuses on an interface for the manipulation of metadata for audio files. *See, e.g.*, CX-0004.0183 (col. 1, lns. 11-18), 0184 (col. 3, lns. 43-54). While the preferred embodiment implements the user interface on a “user computer,” Chasen specifically teaches that the user interface “may be implemented on other systems such as, for example, . . . a personal digital assistant [or] a handheld computer.” *Id.* at 0185 (col. 6, lns. 49-62); *see also* Foley Tr. 212-213. Chasen also teaches that “[t]he user may also use the master tree and the node table [in the graphical user interface] to begin playing an audio file and/or a set of audio files” and that the disclosed user interface allows users “to create custom playlists indicating the order in which the user would like to listen to the audio files.” *Id.* at 0184 (col. 3, lns. 45-58), 0185 (col. 5, lns. 39-41).

In a response dated June 1, 2010 (CX-0004.0400), the patentees argued that Chasen was distinguishable over the pending claims (CX-0004.0439-40) by citing to a declaration made by Dr. Foley (CX-0004.0454-80).<sup>3</sup> In paragraph 77 of his declaration, Dr. Foley stated:

The detailed description if [sic] Chasen ‘721 focuses on a method that is implemented on a personal computer. *See, e.g., id.* at col. 6, lines 49-50; and col. 6, line 63 through col. 7, line 7. As noted in the Office Action, Chasen ‘721 does mention the possibility of an implementation on a “handheld computer” or a “personal digital assistant,” *Id.*, col. 6, lines 53-62. A person of ordinary skill in the art at the time would have understood that these are general-purpose devices for handling email, address lists, calendar, and similar office applications; and that such devices are **distinguishable** from a “portable media player.”

CX-0004.0477-78 (Foley Decl. ¶ 77) (emphasis added). In the context of distinguishing over prior art cited by the examiner (Chasen), the statement that a “portable media player” is “distinguishable” from both a “personal digital assistant” (“PDA”) and a

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<sup>3</sup> The portion of Dr. Foley’s declaration addressing the Chasen reference can be found at CX-0004.0477-80 (¶¶ 75-84).

“handheld computer” is a clear and unmistakable disclaimer of those types of devices. Furthermore, the distinction as arises from the fact that a PDA and a handheld computer are “general-purpose devices” as no other grounds for the distinction is provided in paragraph 77 of Dr. Foley’s declaration.

Dr. Foley’s attempts to explain this clear and unmistakable disclaimer in his testimony are unpersuasive. For example, Dr. Foley testified that “it would have made no sense for me to attempt to argue that Chasen does not disclose portable media players.” *See* CX-0007.2.0028 (Foley WS) at Q/A 37. However, that is not the argument in question. Dr. Foley stated that PDAs and handheld computers are distinguishable from (*i.e.*, not the same as) portable media players. *See* CX-0004.0477-78 (Foley Decl. ¶ 77). This statement has nothing to do with whether or not Dr. Foley acknowledged that Chasen disclosed a “portable media player” in some other form.

Dr. Foley’s testimony that one of ordinary skill in the art would understand the argument in paragraph 77 of his reexamination declaration “within the context of the overall argument I was making regarding Chasen—that Chasen’s described technique is not suited for portable media players” is not persuasive. First, Dr. Foley’s “distinguishable” argument in paragraph 77 of his declaration is located in a separate paragraph from his argument (as to the very same devices) in paragraph 76 that “the methods described by Chasen ‘721 are not well suited to use on a ‘handheld computer’ or a ‘personal digital assistant’ because in 1999 such devices used small display screens, and the methods described by Chasen ‘721 are better suited to use on a large display screen.” *Id.* Second, Dr. Foley’s argument that PDA’s and handheld computers have small screens identifies a similarity to his characterization of a “portable media player” and



therefore cannot provide “context” for an argument that PDA’s and handheld computers are distinguishable from portable media players. Third, a person of ordinary skill in the art would understand that Dr. Foley’s argument that the Chasen user interface was not “well suited” to implementation on a PDA or handheld computer would be insufficient to distinguish over Chasen and thus would understand that Dr. Foley needed to identify some other grounds to distinguish over the Chasen reference, at least with regard to those specific devices. *See Verizon Services Corp. v. Cox Fibernet Virginia, Inc.*, 602 F.3d 1325, 1337 (Fed. Cir. 2010) (“It is well-settled that utility or efficacy need not be demonstrated for a reference to serve as anticipatory prior art under section 102.”). In addition, Dr. Jeffay testified that a person of ordinary skill in the art would have understood, consistent with the plain meaning of Dr. Foley’s declaration, that portable media players were distinguishable from handheld computers and personal digital assistants. RX-0058.3 (Jeffay WS) at Q/A 36.

Finally, Dr. Foley presented the following testimony:

[M]y reexamination declaration presented a second preemptive response to the potential counter-argument regarding “handheld computer” and “personal digital assistant.” In particular, my reexamination declaration argued that the terms “handheld computer[s]” and “personal digital assistant[s]” in a technical document in and around 1999, such as the Chasen patent, would not have been understood as necessarily being able to *play* audio or audio/video content and thus would not be understood as being *portable media players*. Thus, my reexamination declaration briefly explained that “handheld computer[s]” and “personal digital assistant[s]” would have been understood as being “general purpose devices *for* handling email, address lists, calendar, and similar office applications” i.e., but *not for* playing audio or video content, and were therefore “distinguishable from a ‘portable media player.’”

CX-0007.2.0028 (Foley WS) at Q/A 37 (emphasis in original).<sup>4</sup> Yet, Dr. Foley made no statement at the time of his declaration as demonstrated by the language in paragraph 77 of Dr. Foley's declaration quoted above. *See* Foley Tr. 222-223. Furthermore, as described above, the Chasen prior art reference explicitly teaches implementation of a user interface that can play audio tracks on a PDA and on a handheld computer. Whether such a device would necessarily have such capability apart from the explicit teaching of Chasen is irrelevant. In addition, as Dr. Jeffay testified, "one of ordinary skill in the art would have been well-aware of the ability of personal digital assistants and handheld computers to play audio and/or video content in the 1999/2000 timeframe." RX-0058.3 (Jeffay WS) at Q/A 38-40 (citing exemplary articles describing same); RX-0045 through RX-0052 (referenced articles); *see also* Foley Tr. 221-222.

Thus, Dr. Foley's testimony does not provide more than one reasonable interpretation of the reexamination prosecution history. Indeed, Dr. Foley's statement in paragraph 77 of his declaration is a clear and unmistakable disclaimer of "portable media player" as including general purposes devices such as personal digital assistants and handheld computers. *See also* RX-0058.3 (Jeffay WS) at Q/A 41.

#### **IV. Patentability Under 35 U.S.C. § 101**

All claims of the '433 patent are method claims. JX-0001 ('433 Patent). Claim 1 is the sole independent claim of the '433 patent. It was cancelled during reexamination as anticipated and obvious in view of prior art U.S. Patent No. 5,739,451 ("Winsky"). CX-0004.0301, 6249. In addition to claim 1, original dependent claims 4, 6, and 8-16

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<sup>4</sup> The emphasis on the quoted "for" in Dr. Foley's testimony does not appear in the original declaration. *See* CX-0004.0478 (first word on page).

were cancelled during reexamination as anticipated or obvious in view of the prior art. *Id.* at 6263. Claims 17-28 were added by amendment. *Id.* at 6263, 6248. All of the remaining claims of the '433 patent depend from cancelled claim 1. Complainants assert dependent claims 2, 3, 5, 7, and 17-28 in this investigation.<sup>5</sup>

For the reasons discussed below, asserted claims 2, 3, 5, 7, and 17-28 of the '433 patent are not directed to patentable subject matter under 35 U.S.C. § 101.

#### **A. Legal Standard**

Whether patent claims are directed to subject matter that is patentable under 35 U.S.C. § 101 is an issue of law. *CLS Bank Int'l v. Alice Corp Pty.*, 717 F.3d 1269, 1276 (2013) (*en banc*) (citing *Bancorp Servs., LLC v. Sun Life Assurance Co. of Can.*, 687 F.3d 1266, 1273 (Fed. Cir. 2012)). “While there may be cases in which the legal question as to patentable subject matter may turn on subsidiary factual issues,” a patentee must clearly identify the fact issues that must be resolved in order to address patentability. *See In re Comiskey*, 554 F.3d 967, 975 (Fed. Cir. 2009).

“[T]he law remains unsettled as to whether the presumption of patent validity under 35 U.S.C. § 282 applies to subject matter eligibility challenges under 35 U.S.C. § 101.” Notice of Commission Determination (1) to Review an Initial Determination

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<sup>5</sup> Complainants argue that “[t]he evidence has shown that the claimed inventions were conceived by December 14, 1999 and reduced to practice by January 4, 2000, with diligence between those dates.” Compls. Br. at 8. Respondents argue that the precise date does not affect the evidence they rely upon to make their arguments concerning patentability under 35 U.S.C. § 101, but state explicitly that “Respondents and Google do not concede that Creative is entitled to the 1999 conception date.” Resps. Br. at 4-5 n.1.

A precise conception date is relevant to consideration of potential prior art under at least 35 U.S.C. § 102(a) and (e), but there is no such language recited in 35 U.S.C. § 101. Further, complainants cite no authority for the proposition that such a determination is necessary or appropriate for evaluating whether claims are directed to patentable subject matter under 35 U.S.C. § 101. *See id.*

Granting Respondents' Motion for Summary Determination that Certain Asserted Claims are Directed to Ineligible Subject Matter Under 35 U.S.C. § 101; and (2) on Review to Affirm the Initial Determination with Modification, Inv. No. 337-TA-963 (Apr. 4, 2016) ("Notice") at 2. In its Notice, the Commission held in that instance that: "Regardless of whether or not such a presumption applies, the record here warrants a finding that the asserted patent claims are directed to ineligible subject matter." *Id.*

Section 101 of the Patent Act sets forth four categories of patentable inventions: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title." 35 U.S.C. §101; *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1366 (Fed. Cir. 2015). The Supreme Court has recognized three exceptions to 35 U.S.C. § 101, holding ineligible for patenting "[l]aws of nature, natural phenomena, and abstract ideas." *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014), *cert denied. sub nom. Ultramercial, LLC v. WildTangent, Inc.*, 135 S. Ct. 2907 (June 29, 2015) (quoting *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014)) ("*Alice*"). "Patents that merely claim well-established, fundamental concepts fall within the category of abstract ideas." *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 Fed. Appx. 988, 991 (Fed. Cir. 2014) (citing *Bilski v. Kappos*, 561 U.S. 593, 611-12 (2010)).

An invention, however, "is not rendered ineligible for patent simply because it involves an abstract concept." *Alice*, 134 S. Ct. at 2354 (citing *Diamond v. Diehr*, 450 U.S. 175, 187 (1981)). The courts have recognized that "[a]t some level,' all

inventions . . . embody, use reflect, rest upon, or apply laws of nature, natural phenomena or abstract ideas.” *Ulramercial*, 772 F.3d at 715 (quoting *Alice*, 134 S. Ct. at 2354).

To identify claims that are ineligible, the Supreme Court has articulated a two-step test. *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1374 (Fed. Cir. 2016). In the first step, the court must decide whether a claim is drawn to an abstract idea. *Id.* (citing *Alice*, 134 S. Ct. at 2355). If the patent claims an abstract idea, the court in the second step seeks to identify an “‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo Collaborative Servs. v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1294, 1298 (2012) (“*Mayo*”). The claim limitations must disclose additional features indicating more than “well-understood, routine, conventional activity.” *Mayo*, 132 S. Ct. at 1292. The limitations must “‘narrow, confine, or otherwise tie down the claim so that, in practical terms, it does not cover the full abstract idea itself.’” *Cyberfone*, 558 Fed. Appx. at 992 (quoting *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1341 (Fed. Cir. 2013), *cert. denied*, 134 S. Ct. 2871 (Jun. 30, 2014)).

Configuring a standard, computerized system to implement an abstract idea does not make the claimed configuration patent-eligible. Manipulation of abstractions on a computer “‘cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.’” *Ulramercial*, 772 F.3d at 717 (quoting *In re Bilski*, 545 F.3d 943, 963 (Fed. Cir. 2008)); *see also Bancorp Servs.*, 687 F.3d at 1278, *cert. denied*, 134 S. Ct. 2870 (2014) (“[A]dding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render the claim patent eligible.”) (quoting *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333

(Fed. Cir. 2012)). The use of sensors does not render such a system patent-eligible. “[M]onitoring, recording, and inputting information represent insignificant ‘data-gathering steps,’ and ‘thus add nothing of practical significance to the underlying abstract idea.’” *Wireless Media Innovations, LLC v. Maher Terminals, LLC*, 100 F. Supp.3d 405, 416 (D.N.J. 2015), *aff’d*, 636 Fed.Appx. 1014, (Fed. Cir. 2016) (quoting *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011)); *see also OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701 (Dec. 14, 2015) (invalidating patent implementing the abstract idea of price optimization on a generic computer); *accord Certain Activity Tracking Devices, Sys., & Components Thereof*, Inv. No. 337-TA-963, Order No. 54 at 13-14 (Apr. 27, 2016) (unreviewed).

Claims that are not merely drawn to abstract ideas implemented by the use of computers, however, may be eligible. Specifically, claims directed to improving computer functioning by the use of unconventional methods may appropriately be patented. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). (“[W]e find it relevant to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea, even at the first step of the *Alice* analysis.”)

Indeed, the use of generic computer technology, however “specific” to the particular environment, will not provide eligibility, if the functionality described constitutes an abstract idea. *See TLI Comm’n’s LLC v. AV Auto., LLC*, 823 F.3d 607, 611 (Fed. Cir. 2016) (“*TLF*”) (holding that 35 U.S.C. § 101 applies where “the specification makes clear that the recited physical components merely provide a generic environment

in which to carry out the abstract idea of classifying and storing digital images in an organized manner”).

In *TLI*, the Federal Circuit considered and held invalid a method for uploading digital photos from a mobile device. *TLI*, 823 F.3d at 609. The Federal Circuit clarified that a relevant inquiry under step one is “whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea.” *Id.* at 612 (quoting *Enfish*, 822 F.3d at 1335). The Circuit contrasted claims “directed to an improvement in the functioning of a computer with claims ‘simply adding conventional computer components to well-known business practices . . . or ‘generalized steps to be performed on a computer using conventional computer activity.’” *Id.* (quoting *Enfish*, 822 F.3d at 1338).

#### **B. Patentability Under 35 U.S.C. § 101**

As noted, claim 1 is the sole independent claim of the ‘433 patent, and it was cancelled during reexamination. All of the remaining claims of the ‘433 patent depend from cancelled claim 1. Complainants assert dependent claims 2, 3, 5, 7, and 17-28 of the ‘433 patent.

Complainants generally argue:

The other parties have failed to show that the asserted claims of the ‘433 Patent are invalid under the *Alice* two-step inquiry for adjudicating patent eligibility. The evidence has shown that the asserted claims of the ‘433 Patent recite patent-eligible subject matter because they are not directed to an abstract idea under the first step of the *Alice* framework. Furthermore, even if it is determined pursuant to *Alice*’s first step that the asserted claims are directed to an abstract idea (which they are not), the evidence has shown that the asserted claims recite elements that either alone or in combination reflect inventive concepts under the second step of the *Alice* framework.

Compls. Br. at 31.

Complainants argue that it is unnecessary to proceed to step two of the *Mayo/Alice* analysis. Compls. Br. at 31-45. Complainants argue:

The other parties have failed to show that the asserted claims of the ‘433 Patent are invalid under the *Alice* two-step inquiry for adjudicating patent eligibility. The evidence has shown that the asserted claims of the ‘433 Patent recite patent-eligible subject matter because they are not directed to an abstract idea under the first step of the *Alice* framework. Furthermore, even if it is determined pursuant to *Alice*’s first step that the asserted claims are directed to an abstract idea (which they are not), the evidence has shown that the asserted claims recite elements that either alone or in combination reflect inventive concepts under the second step of the *Alice* framework.

Compls. Br. at 31.

Concerning the first step of *Alice*, complainants argue:

The first step of the *Alice* framework requires the court to determine whether the claims are directed to an abstract idea. *Alice*, 134 S. Ct. at 2335. The Supreme Court has not articulated a definitive rule to determine what constitutes an “abstract idea” under the first step of the *Alice* inquiry. Nonetheless, the Federal Circuit’s decision in *Enfish, LLC v. Microsoft Corp.* provides helpful guidance for computer software-related inventions.

In *Enfish*, the Federal Circuit explained that the first step in the *Alice* inquiry is to ask “whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish*, 2016 U.S. App. LEXIS 8699, at \*12. In particular, “claims . . . are not directed to an abstract idea” where they “are directed to a specific implementation of a solution to a problem in the” relevant technical field. *Id.* at \*21. Analyzing the claims under that standard, the Federal Circuit held that the claims were directed to an improvement to the operation of computers, embodied in the self-referential table which was designed to improve the way a computer stores and retrieves data, and therefore not abstract. *Id.* at \*13.

Here, the evidence has shown that the asserted claims of the ‘433 Patent are focused on specific technological solutions within the field of computer technology which improve the capabilities of portable media players. In particular, the asserted claims recite a particular user interface method with sequentially presented display screens tied to the levels of a specific hierarchy, as well as a number of additional specific software techniques. Together, the recited user interface method and techniques



improved the user interfaces of portable media players compared to those of prior art portable media players.

Compls. Br. at 31-32.

Concerning the second step of *Alice*, complainants argue:

Even if the claims of the '433 Patent are directed to an abstract concept, the evidence has shown that the claims nonetheless include inventive concepts that render them patent-eligible under the second step of the *Alice* framework. In particular, as Dr. Foley testified, the combination of elements in the claims “transforms” the claimed subject matter into something “significantly more than” a patent on the ineligible concept itself. CX-0007.2 (Foley WS) at Q45-72. The evidence has also shown that the claims of the '433 Patent address a problem necessarily rooted in computer technology and claim a solution that departs from the routine and conventional use of the technology, and are sufficiently specific so as to negate the risk of undue preemption. *Id.* at Q73.

Compls. Br. at 45-46.

Complainants argue:

In the second step of the *Alice* framework, a court must “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355. The Supreme Court describes this step as “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* Here, the evidence has shown that the claims contain inventive concepts sufficient to ensure that the patent amounts to significantly more than a patent on an abstract idea.

For example, the '433 Patent claims the inventive concept of a hierarchically navigated user interface method for a portable media player using a three-level hierarchy to allow a user to navigate through the tracks stored on a portable media player, with categories, subcategories, and items displayed on display screens corresponding to respective levels of the hierarchy. CX-0007.2 (Foley WS) at Q55-56; CX-0005.1 (Egan WS) at Q54. In particular, Mr. Egan testified that, to his knowledge, this was the first time that a hierarchy with three levels including categories, subcategories, and items was used in this way in the interface of a portable media player. CX-0005.1 (Egan WS) at Q54.

Additionally, the evidence has shown that another inventive concept of the '433 Patent is the claimed user interface methods' use of a "sequentially" "present[ed]" series of display screens to navigate through content, allowing the user to make selections that control and limit what is displayed in subsequent screens. CX-0007.2 (Foley WS) at Q55-56; CX-0005.1 (Egan WS) at Q54. Mr. Egan testified that he does not believe that this had previously been incorporated on a portable media player. CX-0005.1 (Egan WS) at Q54.

The evidence has also shown that another new and innovative claimed feature of the '433 Patent, recited in claims 3, 5, 19, 21, 23, 25, and 27 (and dependent claims thereof), are the user interface methods for modifying a playlist directly on a portable media player on-the-fly. CX-0007.2 (Foley WS) at Q55; CX-0005.1 (Egan WS) at Q56. During the 1999 timeframe, conventional portable media players did not have the capability to modify playlists on-the-fly. CX-0005.1 (Egan WS) at Q56. Instead, a user had to create a playlist on a host, such as a personal computer, and then had to upload the playlist to the portable media player. *Id.*; CX-0007.2 (Foley WS) at Q19. Mr. Egan testified that, to his knowledge, this invention was the first time that a user had the ability to modify playlists directly on a portable media player without use of a host computer. CX-0005.1 (Egan WS) at Q56.

Another new and innovative claimed feature of the '433 Patent, recited in claims 17, 18, 20, 22, 24, 26, and 28 (and dependent claims thereof), are the user interface methods for adding songs to an active queue list of songs that is currently being played on a portable media player. CX-0005.1 (Egan WS) at Q57; CX-0007.2 (Foley WS) at Q55. Mr. Egan testified that to his knowledge, not only was this the first time that a user could add songs to an active queue list of songs currently being played on a portable media player, but that this was the first time that a user could add songs to an active queue on any electronic device. CX-0005.1 (Egan WS) at Q57.

Another new and innovative claimed feature of the '433 Patent, recited in claims 2, 3, 19, 21, 23, 25, and 27 (and dependent claims thereof), are the user interface methods for accessing a group of songs together, at once on a portable media player, as opposed to accessing songs one at a time. CX-0005.1 (Egan WS) at Q58-57; CX-0007.2 (Foley WS) at Q55. For example, a user could add an entire album to a playlist at a time. Mr. Egan testified that until the inventions disclosed in the '433 Patent, this feature was not available on a portable media player. CX-0005.1 (Egan WS) at Q58.

The evidence has also shown that another new and innovative claimed feature of the '433 Patent, recited in claim 7, is the user interface for navigating up and down the hierarchy by going back and forth between

display screens. CX-0007.2 (Foley WS) at Q28. That method allowed users to correct errors in navigation, saving significant time compared to the sequential list method of the prior art. *Id.*

Compls. Br. at 46-48.

Respondents argue:

The claims of the ‘433 patent are directed to nothing more than the abstract idea of *using hierarchical categories* to access content. As such, Supreme Court, Federal Circuit, and Commission precedent prescribe only one conclusion—the claims of the ‘433 patent fail to recite patent-eligible subject matter and are invalid pursuant to Section 101.

The Federal Circuit has specifically held that “[u]sing *organizational . . . hierarchies . . .* is an abstract idea that has no particular concrete or tangible form or application;” rather such hierarchies are “a building block, a basic conceptual framework for organizing information.” *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333-34 (Fed. Cir. 2015) (emphasis added). *Versata* is not an outlier case: since the Supreme Court’s seminal decision in *Alice*, the Federal Circuit has assessed patent-eligibility in fifty cases, finding the subject patent claims invalid in forty-six of them. Claims directed to computerized methods of organizing and presenting information are consistently held patent-ineligible.

Resps. Br. at 1 (emphasis in original).

The Staff argues that “the asserted claims of the ‘433 patent are not directed to patentable subject matter as defined by 35 U.S.C. § 101. The asserted claims are directed to the abstract idea of using a three-tiered hierarchy to organize information rather than a specific technological improvement to the electronic hardware or the logical source code model for portable media players. The fact that the claims are limited to the application of that abstract idea in the ‘technological environment’ of functions for portable media players, such as creating playlists, is insufficient to render the claims patentable.” Staff Br. at 9.

For the reasons discussed below, the asserted claims of the ‘433 patent are not directed to patentable subject matter under 35 U.S.C. § 101.

## 1. Canceled Independent Claim 1 and Asserted Dependent Claims

The language of canceled claim 1 of the '433 patent, from which asserted claims 2, 3, 5, 7, and 17-28 depend, is as follows:

1. A method of selecting at least one track from a plurality of tracks stored in a computer-readable medium of a portable media player configured to present sequentially a first, second, and third display screen on the display of the media player, the plurality of tracks accessed according to a hierarchy, the hierarchy having a plurality of categories, subcategories, and items respectively in a first, second, and third level of the hierarchy, the method comprising:

selecting a category in the first display screen of the portable media player;

displaying the subcategories belonging to the selected category in a listing presented in the second display screen;

selecting a subcategory in the second display screen;

displaying the items belonging to the selected subcategory in a listing presented in the third display screen; and

accessing at least one track based on a selection made in one of the display screens.

JX-0001 ('433 Patent) at col. 11, lns. 39-57.

The first question under the *Mayo* test is whether claim 1 of the '433 patent is directed to a natural law, natural phenomena, or abstract idea. The plain language of the claims of the '433 patent are directed to the abstract idea of using hierarchical categories to access content. Claim 1 is a method claim that contains five elements directed only to using hierarchical categories to access content. Indeed, the '433 patent specification includes only a general description of the outside of the preferred embodiment ("NOMAD Jukebox") portable media player and its display. JX-0001 ('433 Patent) col. 8, lns. 14-58, Figs. 9, 10. There is no description in the '433 patent specification of the

internal hardware, electronic schematics, component specifications, or source code for a portable media player. *See* JX-0001.

Consistent with the disclosure of the '433 patent specification, which as noted above lacks any description of electronic hardware, the portable media player, the storage medium, and the display in claim 1 are all generic components for which there are no particularized limitations. *See* Foley Tr. 146-147; Egan Tr. 241; Jeffay Tr. 291; RX-0058.3 (Jeffay WS) at Q/A 108. The recited portable media player of claim 1 of the '433 patent merely provides a generic environment in which to carry out the abstract idea of organizing media tracks. *See TLI*, 823 F.3d at 611; *see also* RX-0058.3 (Jeffay WS) at Q/A 79-80. Nevertheless, “that the improvement is not defined by reference to ‘physical’ [or non-generic] components does not doom the claims.” *See Enfish*, 822 F.3d at 1339.

In considering a claim potentially directed to software, *Enfish* states that “the first step in the Alice inquiry” is “whether the focus of the claims is on specific asserted improvement in computer capabilities.” *See Enfish*, 822 F.3d at 1335-36; *see also CyberFone Sys., LLC v. Lexmark Int’l, Inc.*, 137 F. Supp. 3d 648, 659 (D. Del. 2015) (“In sum, although the problem addressed by the asserted claims is rooted in computer technology, the claimed solution is not disclosed with enough specificity to transform the abstract idea . . . into a patentable application of such, thus risking monopolization of the abstract idea itself.”). There is no specific asserted improvement, such as in the structure or implementation, of the three-leveled hierarchy described in claim 1 of the '433 patent. In fact, there is nothing “specific” at all about the limitations of claim 1. *See Enfish*, 822 F.3d at 1335-38 (distinguishing claims that “recited generalized steps to be performed on

a computer using conventional computer activity”); RX-0058.3 (Jeffay WS) at Q/A 78, 81.

Also, “[a]t step one of the *Alice* framework, it is often useful to determine the breadth of the claims in order to determine whether the claims extend to cover a ‘fundamental . . . practice long prevalent in our system . . . .’” *TLI*, 823 F.3d at 611 (quoting *Intellectual Ventures*, 792 F.3d at 1369 (quoting in turn *Alice*, 134 S. Ct. at 2356)); *see also OIP Tech. Inc.*, 788 F.3d at 1363 (“[T]he claims are exceptionally broad and the computer implementation limitations do little to limit their scope.”). Claim 1 of the ‘433 patent is extremely broad because it claims any sequentially presented organizational hierarchy comprising at least three levels.

As in *Intellectual Ventures*, “[t]he abstract idea here is not meaningfully different from the ideas found to be abstract in other cases . . . involving methods of organizing human activity.” 792 F.3d at 1367. Organizing information into hierarchical categories is a method used to make the selection of individual items simpler in a variety of human activities. *See* RX-0058.3 (Jeffay WS) at Q/A 43-44; RX-0034.0003; Foley Tr. 153-154; *see also* Egan Tr. 243-244. As Dr. Jeffay testified, hierarchical organizational methods have long been employed in libraries and record stores, RX-0058.3.0016 (Jeffay WS) at Q/A 65-66, and have long been applied to logical structures in software and to the organization and presentation of information in computers, *id.* at Q/A 45-51, 98, 101. In *Versata Development Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333-34 (Fed. Cir. 2015) (“*Versata Development*”), the Federal Circuit found that “[u]sing organizational and product group hierarchies to determine a price is an abstract idea that has no particular concrete or tangible form or application. It is a building block, a basic

conceptual framework for organizing information . . . .” Similarly, conforming the presentation of a hierarchy’s content to a display of limited size (*i.e.*, the “technological environment”) via sequential presentation of the hierarchy does not make the idea any less abstract as such a presentation method was a well-known and widespread practice in a variety of computing contexts. *See* RX-0058.3 (Jeffay WS) at Q/A 71-75.

In *Content Extraction*, the Federal Circuit found that the claims of U.S. Patent No. 5,258,855 (“the ‘855 patent”) and other related patents, were directed to the abstract idea of “1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory.” *See Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). Similar to the ‘433 patent claims, these claims are directed to a method of digital content organization and storage. *See id.* Also, like the ‘433 patent claims, claim 1 of the ‘855 patent is implemented using conventional computing components—an “automated digitizing unit” and “memory”—that perform routine computer functions and are defined by those functions, rather than by any particular structure. *See id.* at 1345. Considering the claims, the Federal Circuit concluded that the “concept of data collection, recognition, and storage is undisputedly well-known.” *Id.* at 1347. Inasmuch as the concept of using hierarchical categories to access content is also undisputedly well-known (both in and outside of computing), the ‘433 patent claims are similarly directed to an abstract idea.

In *Certain Activity Tracking Devices*, the Commission affirmed a decision finding that the asserted claims of U.S. Patent No. 8,398,546 (“the ‘546 patent”) were directed to the abstract idea of “the process of collecting data, organizing it in a computer database, and generating reports from the database to be communicated to the product’s user.”

*Certain Activity Tracking Devices*, Inv. No. 337-TA-963, Order No. 40 (Mar. 3, 2016) at 22, Notice of Commission Determination (1) to Review an Initial Determination Granting Respondents’ Motion for Summary Determination that Certain Asserted Claims are Directed to Ineligible Subject Matter Under 35 U.S.C. § 101; and (2) on Review to Affirm the Initial Determination with Modification, Inv. No. 337-TA-963 (Apr. 4, 2016).

Like the claims of the ‘433 patent, the ‘546 patent claims are directed to a method of organizing data and presenting it to a user, based on interactions with the user. *See Certain Activity Tracking Devices*, Inv. No. 337-TA-963, Order No. 40 (Mar. 3, 2016) at 22. Like the claims of the ‘433 patent, claim 1 of the ‘546 patent recites an electronic device (*i.e.*, a “wearable sensor device” that detects physiological data) on which a method is performed, but describes the device itself only in functional terms. *See id.* at 6. The administrative law judge explained that the ‘546 patent is directed to an abstract idea because it does not claim to have invented the device itself, but only an idea for how to use the device. *See id.* at 22-23. The “process of collecting data, organizing it in a computer database, and generating reports from the database to be communicated to the product’s user ‘recites an abstraction.’” *Id.* at 22 (citation omitted).

In another recent ITC decision, the Commission affirmed a decision finding the subject patent-ineligible under 35 U.S.C. § 101. *Certain Automated Teller Machines, ATM Products, Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-972, Order No. 21 (June 28, 2016), *aff’d*, Notice of Commission Decision Not to Review an Initial Determination Granting a Motion for Summary Determination That Claims 20-24 of U.S. Patent No. 7,314,163 Are Invalid under 35 U.S.C. § 101 (July 28, 2016). Relying upon *TLI*, the administrative law judge reasoned that “the use of generic



computer technology, however ‘specific’ to the particular environment, will not rescue a claim from ineligibility, if the functionality described constitutes an abstract idea,” particularly where the electronic functions are described in “vague terms without any meaningful limitations.” *Id.* at 13, 15 (internal quotation marks and citation omitted). While the complainant in that case “argue[d] that the ‘163 patent solves a technical problem that is unique to ATMs,” the administrative law judge concluded that, as with the ‘433 patent, “[t]he purported technological advances are discussed only in terms of abstract ideas.” *Id.* at 19. Accordingly, the patent was directed to an abstract idea rather than an improvement in computer capabilities, even if the “method described may be new to the ATM industry.” *Id.* at 24.

Additionally, a recent district court decision is instructive. In *Versata Software, the court considered claims directed to computerized methods of organizing information. Versata Software Inc. v. NetBrain Techs., Inc.*, Nos. 13-676-LPS-CJB, 13-678-LPS-CJB, 2015 WL 5768938, at \*7 (D. Del. 2015).<sup>6</sup> The court determined that hierarchical categorization is an abstract idea: “The Court easily concludes (indeed, it is not really disputed here) that the concept of representing information in a hierarchy amounts to an abstract idea. Clearly, ‘[a] hierarchy is itself an abstraction’—an organizational structure through which data can be represented.” *Id.* (citation omitted). One claim recited “[a] method for presenting database classifiers organized by hierarchy levels,” which required “displaying a first hierarchy level,” “displaying a second hierarchy level,” “activating one of the second hierarchy database classifier labels,” and “displaying information

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<sup>6</sup> This case is unrelated to the *Versata* Federal Circuit case discussed above.

associated with” such labels. *Id.* at \*15 (concluding that claim “is drawn to the abstract concept of displaying data organized in hierarchical form”).

Finally, it is instructive to contrast the asserted claims of the ‘433 patent with the claims at issue in *Enfish*. *See Enfish*, 822 F.3d at 1335-36. In *Enfish*, the court found that the claims were directed to a particular, unconventional type of data structure, a “self-referential table for a computer database,” which effects an “improvement to computer functionality itself.” *See id.* The Federal Circuit found that this self-referential table was the plain focus of the claims and allowed the computer to search faster, with lower memory requirements. *See id.* at 1337. Inasmuch as the claims improved the functionality of the computer itself, the claims were not directed to an abstract idea. *See id.* at 1339.

Unlike the claims to a specific improvement to the logical model for a relational database in *Enfish*, there are no specific improvements to the hierarchically navigated user interface recited in the asserted claims of the ‘433 patent regardless of whether the portable media player is hand-held.<sup>7</sup> Instead, the asserted claims are directed to application of the abstract and well-known idea of a hierarchically navigated user interface itself to the portable media player computing environment. In *Versata Development*, 793 F.3d at 1333-34, the Federal Circuit found that “[u]sing organizational and product group hierarchies to determine a price is an abstract idea that has no

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<sup>7</sup> As noted in the claim construction section of this initial determination, complainants argue that the construction of the disputed claim term “portable media player” is necessary to address the question of patent-eligibility under 35 U.S.C. § 101. For the reasons discussed above, the administrative law judge does not find that construction of the term is necessary. Indeed, whether a “portable media player” is hand-held is irrelevant in determining whether the asserted claims of the ‘433 patent are patent-eligible under 35 U.S.C. § 101.

particular concrete or tangible form or application. It is a building block, a basic conceptual framework for organizing information . . . .” Indeed, the courts have consistently held that generalized ideas for organizing human activity are abstract. *See Alice*, 134 S. Ct. at 2356; *TLI*, 823 F.3d at 611; *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, \_\_\_ F.3d \_\_\_, 2016 WL 3514158, at \*5 (Fed. Cir. 2016) (“*Bascom*”); *Intellectual Ventures*, 792 F.3d at 1368; *Content Extraction*, 776 F.3d at 1347.

Accordingly, the administrative law judge finds that claim 1 is directed to the abstract idea of a three-leveled organizational hierarchy. *See Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, \_\_\_ F.3d \_\_\_, 2016 WL 3606624 at \*6 (Fed. Cir. 2016) (“At [*Mayo*] step one, therefore, it is not enough to merely identify a patent-ineligible concept underlying the claim; we must determine whether that patent-ineligible concept is what the claim is ‘directed to.’”); RX-0058.3 (Jeffay WS) at Q/A 59, 64. The fact that a claim does not preempt all organizational hierarchies, or may be limited to organizational hierarchies in the portable media player setting, does not make it any less abstract. *See OIP Tech. Inc.*, 788 F.3d at 1362-63 (citing *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014)); *Accenture Global Services*, 728 F.3d at 1346).

Complainants assert dependent claims 2, 3, 5, 7, and 17-28. Those asserted dependent claims depend from canceled claim 1.

The asserted dependent claims 2, 3, 5, 7, and 17-28 read as follows:

2. The method of selecting a track as recited in claim 1 wherein the accessing at least one track comprises selecting a subcategory in the second display screen and playing a plurality of tracks associated with the selected subcategory.
3. The method of selecting a track as recited in claim 1 wherein the accessing at least one track comprises selecting a subcategory and adding the tracks associated with the selected subcategory to a playlist.

**5.** The method of selecting a track as recited in claim **1** wherein the accessing at least one track comprises selecting an item in the third display screen and adding at least one track associated with the selected item to a playlist.

**7.** The method of selecting a track as recited in claim **1** wherein the accessing at least one track is made after the presentation of the third display screen by reverting back to one of the second and first display screens, the second display screen presented sequentially after the third display screen.

**17.** The method of selecting a track as recited in claim **3** wherein the playlist is an active queue list of songs that is currently being played.

**18.** The method of selecting a track as recited in claim **5** wherein the playlist is an active queue list of songs that is currently being played.

**19.** The method of selecting a track as recited in claim **5** wherein the selected item in the third display screen is associated with a plurality of tracks, and wherein the accessing at least one track comprises adding the plurality of tracks associated with the selected item to a playlist.

**20.** The method of selecting a track as recited in claim **19** wherein the playlist is an active queue list of songs that is currently being played.

**21.** The method of selecting a track as recited in claim **5** wherein the selected item in the third display screen is a selected album name, and wherein the accessing at least one track comprises adding the plurality of tracks associated with the selected album name to a playlist.

**22.** The method of selecting a track as recited in claim **21** wherein the playlist is an active queue list of songs that is currently being played.

**23.** The method of selecting a track as recited in claim **1** wherein:

the category album is selected in the first display screen from available categories that include at least artist and album;

the subcategories listed in the second display screen comprise a listing of album names and one of the album names is selected; and

the accessing at least one track comprises adding a plurality of tracks associated with the selected album name to a playlist.

**24.** The method of selecting a track as recited in claim **23** wherein the playlist is an active queue list of songs that is currently being played.

**25.** The method of selecting a track as recited in claim **1** wherein:

the category genre is selected in the first display screen from available categories that include at least artist, album, and genre;

the subcategories listed in the second display screen comprise a listing of a plurality of genre types, and one of one genre types is selected;

the items displayed in the third display screen comprise a listing of a plurality of album names associated with the selected genre type, and one of the album names is selected; and

the accessing at least one track comprises adding a plurality of tracks associated with the selected album name to a playlist.

**26.** The method of selecting a track as recited in claim **25** wherein the playlist is an active queue list of songs that is currently being played.

**27.** The method of selecting a track as recited in claim **1** wherein:

the category artist is selected in the first display screen from available categories that include at least artist album, and genre;

the subcategories listed in the second display screen comprise a listing of artist names, and one of the listed artist names is selected;

the items displayed in the third display screen comprise a listing of album names associated with the selected artist name, and one of the listed album names is selected; and

the accessing at least one track comprises adding a plurality of tracks associated with the selected album name to a playlist.

**28.** The method of selecting a track as recited in claim **27** wherein the playlist is an active queue list of songs that is currently being played.

JX-0001 ('433 Patent) at col. 11, lns. 58-65; col. 12, lns. 3-6, lns. 12-17; JX-0001 ('433 Patent Reexamination Certificate) at col. 1, ln. 21 – col. 2, ln. 28.

The asserted dependent claims contain additional limitations relating to the claimed organizational method, and simply recite functional limitations. *See* Foley Tr. 147 (applying the organization method to steps that constitute “well-understood, routine, conventional activity” in the technological environment of portable media players); RX-0058.3 (Jeffay WS) at Q/A 57.

The dependent claim features fall into five groups; four are generic media player features (*i.e.*, accessing multiple tracks, adding tracks to a playlist, adding tracks to an active queue list of songs that is currently being played, and using labels for “album,” “genre,” and “artist”), and one is a generic feature of a hierarchy (*i.e.*, allowing navigation back to a previous level of the hierarchy). The first media player feature appears in claims 2, 3, 17, and 19-28, and requires adding a plurality of tracks associated with a selected category. JX-0001 ('433 Patent); *see also* CX-0007.2 (Foley WS) at Q/A 27. The next media player feature appears in claims 3, 5, 19, 21, 23, 25, and 27, which recite adding selected tracks to a playlist, *i.e.*, a list of songs. JX-0001 ('433 Patent); *see also* CX-0007.2 (Foley WS) at Q/A 25. The third media player feature appears in claims 17, 18, 20, 22, 24, 26, and 28, which recite that the playlist is an “active queue list of songs,” *i.e.*, a list of songs that is currently being played. JX-0001 ('433 Patent); *see also* CX-0007.2 (Foley WS) at Q/A 26. The final media player feature appears in claims 21-

28, which recite labels for the categories and subcategories, including “album,” “genre,” and “artist.” JX-0001 (‘433 Patent); *see also* CX-0007.2 (Foley WS) at Q/A 24. Claim 7 is related to hierarchical navigation and recites navigating back in the hierarchy from the third to the first or second display screen before a selection is made. JX-0001 (‘433 Patent); *see also* CX-0007.2 (Foley WS) at Q/A 28. Certain claims have multiple dependencies, layering combinations of dependent claim features onto the method of claim 1.

The minor additional functional limitations of the asserted dependent claims flow directly from the application of the abstract organizational idea in claim 1 to the “technological environment” of portable media players. The focus of the dependent claims remains on the abstract three-leveled organizational hierarchy recited in claim 1. *See* RX-0058.3 (Jeffay WS) at Q/A 110; Foley Tr. 151; *Inventor Holdings, LLC v. Gameloft, Inc.*, 135 F. Supp. 3d 239, 248, 252 (D. Del. 2015) (“[T]he various dependent claims do no more than provide variations of the abstract idea applied to a generic mobile device or computer-readable medium.”).

The asserted claims are directed to an abstract idea for the reasons discussed above. Moreover, while the administrative law judge does not find the *Mayo* step one analysis to be a close call, claim 1 of the ‘433 patent and the asserted dependent claims would, at best, fall into the following category described in *Enfish*:

We recognize that, in other cases involving computer-related claims, there may be close calls about how to characterize what the claims are directed to. In such cases, an analysis of whether there are arguably concrete improvements in the recited computer technology could take place under step two [of *Mayo/Alice*].

*Enfish*, 822 F.3d at 1339.

Turning to step two of the analysis, the question is whether the asserted claims of the '433 patent are limited to a patentable application of the abstract idea of organizing information in a three-leveled hierarchy through the addition of an inventive concept. There is no evidence that "accessing a track" through the hierarchy as recited in the final limitation of claim 1 of the '433 or that "playing a plurality of tracks associated with the selected subcategory" (*e.g.*, an album from a list of albums) as recited in claim 2 of the '433 patent is an inventive concept. The '433 patent specifically acknowledges in the "Background of the Invention" that "small, portable music playback devices can store hundreds, even thousands, of compressed songs and can play back the songs at high quality." JX-0001 ('433 Patent) col. 1, lns. 19-22. The conclusion that playing a single track or a group of tracks (*e.g.*, an album) is no more than routine and conventional activity in the art is reinforced by the fact that the '433 patent specification contains no detailed description of the specific methodology (*e.g.*, flowchart or computer code) for accessing and playing a single media track or a grouping or category of media tracks. *See* JX-0001; Foley Tr. 148, 155-156; RX-0058.3 (Jeffay WS) at Q/A 113. Thus, claims 1 and 2 of the '433 patent fail to add an "inventive concept" sufficient to confer patent eligibility.

Similarly, the '433 patent acknowledges in the "Background of the Invention" that "[t]he creation of playlists is one technique to organize the playing of songs. A set of songs can be included in a playlist which is given a name and stored." JX-0001 ('433 Patent) at col. 1, lns. 50-52; *see also* RX-0058.3 (Jeffay WS) at Q/A 118-119; Foley Tr. 157-159. Thus, applying the abstract idea of an organizational hierarchy to a playlist



does not provide an inventive concept for claims 3, 5, 19, 21, 23, and 25. *See* JX-0001 (claims); RX-0058.3 (Jeffay WS) at Q/A 118-119, 125.

In the “Background of the Invention” section, the ‘433 patent references “[m]usic jukeboxes implemented in software executed by a digital computer and portable MP3 and CD players,” and the evidence shows that the concept of an active queue playlist was well known with regard to jukeboxes (record based or otherwise). *See* JX-0001 (‘433 Patent) col.1 ll.25-26; RX-0058.3 (Jeffay WS) at Q/A 121, 124; Foley Tr. 163-164. An active queue list is just a playlist of songs that is currently being played. Foley Tr. 160; RX-0058.3 (Jeffay WS) at Q/A 115. As with other functional limitations, the ‘433 patent includes no description of the way that the computer code or underlying hardware should be designed to implement the claimed active queue playlist and assumes implementation to be within the skill of a person of ordinary skill in the art. JX-0001; *see also* RX-0058.3 (Jeffay WS) at Q/A 120; Foley Tr. 148; Egan Tr. 248. Thus, the inclusion of an active queue playlist in claims 17, 18, 20, 22, 24, 26, and 28 does not represent an inventive concept sufficient to limit those claims to patentable subject matter.

In addition, the evidence shows that using well-known musical categories such as “artist,” “album,” and “genre,” in the organizational hierarchy does not disclose a limiting inventive concept for claims 21, 23, 25, & 27. *See* RX-0058.3 (Jeffay WS) at Q/A 127-129. Also, navigating to the prior level of the hierarchy does not disclose a limiting inventive concept for claim 7. *See id.* at Q/A 130-132; Foley Tr. 156.

In sum, there is no indication that the inventors went beyond anything routine and ordinary in claiming the application of known organizational methods to the standard functions of portable music players and similar devices. The dependent claims do not

recite additional structural elements. The dependent claims simply add further limitations based on known features of the “technological environment” of portable media players, such as the creation of playlists, to the abstract idea. *See* Jeffay Tr. 296-297. Nothing about the asserted dependent claims suggests that they involve steps that are not “well-understood, routine, conventional activity,” and the limitations added by each dependent claim, “when viewed as a whole, add nothing significant beyond the sum of their parts taken separately.” *Mayo*, 132 S. Ct. at 1298; *see also* RX-0058.3 (Jeffay WS) at Q/A 133-135. In contrast to the claims at issue in the recent Federal Circuit decision in *Bascom*, 2016 WL 3514158 at \*6, these claims do not present “an inventive concept [that] can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” Thus, the dependent claims of the ‘433 patent fail to describe an “inventive concept” that is sufficient to confer subject matter patentability.

Relying on the holdings in *DDR*<sup>8</sup> and *Bascom*, complainants argue that the asserted claims of the ‘433 patent provide a technological solution to a problem arising in computers that departs from the routine and conventional use of the technology. *See* Compls. Br. at 49-50. Complainants argue: “As in *BASCOM* and *DDR Holdings*, the asserted claims are necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computers. The evidence has shown that the ‘433 Patent solves problems specifically arising in the realm of computers such as organizing and accessing the large number of tracks that could be stored on a portable media player.” *Id.* at 50.

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<sup>8</sup> *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

Both cases applied the *Alice* test. In *DDR*, the Federal Circuit found that the claimed method “overrides the routine and conventional sequence of events” and contradicts the “routine, conventional functioning of Internet hyperlink protocol,” thus reciting an inventive concept because it is “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and satisfying *Alice* step-two. See *DDR*, 773 F.3d at 1257-58. In *Bascom*, the Federal Circuit found that the claims were directed to the abstract idea of “filtering content,” a longstanding, well-known method of organizing human behavior, but the claims may satisfy *Alice* step two based on the limited record because an “inventive concept can be found in the non-conventional and non-generic arrangement” of known elements. *Bascom*, 2016 WL 3514158 at \*6. The court reasoned that, because of the non-conventional combination, the patent claimed “a technology-based solution (not an abstract-idea-based solution implemented with generic technical components in a conventional way).” *Id.* at \*7. Both cases illustrate the principle that applying a well-known abstract solution in a particular technological setting, as the ‘433 patent claims do, cannot render a claim patent-eligible.

Here too, the asserted claims of the ‘433 patent claim ineligible subject matter regardless of the standard of proof applied, as the fully developed record clearly and convincingly shows that the asserted claims are patent-ineligible.

## **2. Preemption Concerns**

Complainants argue that “the evidence has shown that the asserted claims also do not disproportionately risk tying up or preempting the use of the alleged abstract idea of using hierarchical categories to access content.” Compls. Br. at 53-54.

Complainants argue:

In particular, the asserted claims do not broadly claim all methods of using hierarchical categories to access content. Rather, claim 1, which is the broadest of the claims, is directed at a particular improved method of accessing content that applies only to (a) using a hierarchy with at least three levels; (b) displaying three display screens sequentially where each display screen displays information from a corresponding level of the hierarchy; (c) where the user navigates through the series of display screens by making selections that control what is displayed in the subsequent screen; and (d) utilizing this method on a portable media player. JX-0001 ('433 Pat.) at claim 1. Thus, Dr. Foley identified a number of examples of ways to use hierarchies to access content on a portable media player that would not practice claim 1, including: practicing it on a portable media player without a display (e.g., using a purely audio interface for navigating among content), a portable media player that only uses text searching, a portable media player configured to only have two levels in the hierarchy or two display screens, or a portable media player that selects the top level categories by use of physical buttons rather than being displayed on a screen. CX-0007.2 (Foley WS) at Q73. Respondents have presented no evidence that such alternatives could not be implemented.

Compls. Br. at 54.

Complainants recite a portable media player without a display, using only text searching, using a two-level hierarchy, or with physical buttons to suggest these must be viable options because there is no evidence that the alternatives could not be implemented. *See* Compls. Br. at 54. Whether these impractical designs could be implemented is irrelevant. Complainants do not argue that the proposed alternatives have been implemented nor is there any evidence to support such a claim. *Id.* Indeed, Dr. Foley testified that he was not aware of any devices utilizing his proposed alternatives. Foley Tr. 171-173; RX-0061 (Jeffay Rebuttal WS) at Q/A 21. Complainants do not dispute that such alternatives would be impractical because they yield a cumbersome user experience, omit expected features, or use an organization that is contrary to

conventional, long-used media organization practices. Compls. Br. at 54; RX-0061 (Jeffay Rebuttal WS) at Q/A 21; Egan Tr. 250; RX-0058.3 (Jeffay WS) at Q/A 136-39.

Regarding the proposed alternatives to the dependent claims, complainants do not contend that any have ever been implemented on a portable media player. *See* Compls. Br. at 54-55. Further, each hypothetical alternative is impractical in that it requires the removal of basic media playback functionality that was well-known prior to the time of the '433 patent, *i.e.*, accessing multiple tracks and adding tracks to playlists or active queues. *Id.* Complainants are incorrect in asserting that there is no evidence that devices lacking this conventional media playback functionality are impractical and that Dr. Jeffay's preemption analysis ignores dependent claim limitations. *Id.* at 55. For example, Dr. Jeffay testified that the proposed alternatives "would have to prohibit a user from performing well known operations" and are "not viable or practical alternatives." RX-0058.3 (Jeffay WS) at Q/A 139; *see also* RX-0061 (Jeffay Rebuttal WS) at Q/A 21 (identifying "omissions of conventional features" as one basis for impracticality of proposed alternatives). Portable media players lacking conventional media playback functionality are not shown to be practical alternatives. There is no evidence that any proposed alternatives have ever been implemented. Thus, contrary to complainants' argument, the claims of the '433 patent are impermissibly preemptive in violation of 35 U.S.C. § 101.

\* \* \*

Accordingly, the asserted claims of the '433 patent claim ineligible subject matter under 35 U.S.C. § 101.

**V. Conclusions of Law**

1. The Commission has subject matter and personal jurisdiction in this investigation.
2. The asserted claims of U.S. Patent No. 6,928,433 do not recite patent-eligible subject matter under 35 U.S.C. § 101.

**VI. Initial Determination and Order**

Accordingly, it is the INITIAL DETERMINATION of the undersigned that the asserted claims of U.S. Patent No. 6,928,433 do not recite patent-eligible subject matter under 35 U.S.C. § 101.

Further, this Initial Determination, together with the record of the hearing in this investigation consisting of (1) the transcript of the hearing, with appropriate corrections as may hereafter be ordered, and (2) the exhibits received into evidence in this investigation, is CERTIFIED to the Commission.

The Initial Determination will become the Commission's final determination 30 days after the date of service of the Initial Determination unless the Commission determines to review the Initial Determination.<sup>9</sup> *See* 81 Fed. Reg. 29307 (May 11, 2016).



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David P. Shaw  
Administrative Law Judge

Issued: August 19, 2016

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<sup>9</sup> Pursuant to 19 C.F.R. § 210.42(h), this Initial Determination shall become the determination of the Commission unless a party files a petition for review pursuant to § 210.43(a) or the Commission, pursuant to § 210.44, orders on its own motion a review of the ID or certain issues herein.

**CERTAIN PORTABLE ELECTRONIC DEVICES AND COMPONENTS THEREOF**

INV. NO. 337-TA-994

**PUBLIC CERTIFICATE OF SERVICE**

I, Lisa R. Barton, hereby certify that the attached **Final Initial Determination** has been served by hand upon the Commission Investigative Attorney, **Peter Sawert, Esq.**, and the following parties as indicated, on **AUG 22 2016**



Lisa R. Barton, Secretary  
U.S. International Trade Commission  
500 E Street SW, Room 112A  
Washington, DC 20436

<b>COMPLAINANTS CREATIVE TECHNOLOGY LTD.; AND CREATIVE LABS, INC.:</b>	
Jonathan D. Baker, Esq. <b>FARNEY DANIELS P.C.</b> 800 S. Austin, Suite 200 Georgetown, TX 78626	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____
<b>RESPONDENTS SAMSUNG ELECTRONICS CO., LTD.; AND SAMSUNG ELECTRONICS AMERICA, INC.:</b>	
Sturgis M. Sobin, Esq. <b>COVINGTON &amp; BURLING LLP</b> One City Center 850 Tenth Street, NW Washington, DC 20001	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____

**CERTAIN PORTABLE ELECTRONIC DEVICES AND COMPONENTS THEREOF**

**INV. NO. 337-TA-994**

<p><b>RESPONDENTS SONY CORP., SONY MOBILE COMMUNICATIONS, INC.; SONY MOBILE COMMUNICATIONS AB; AND SONY MOBILE COMMUNICATIONS (USA), INC.:</b></p>	
<p>James B. Altman, Esq.  <b>Foster, Murphy, Altman &amp; Nickel, PC</b>                  899 L Street, NW, Suite 1150                  Washington, DC 20036</p>	<p><input type="checkbox"/> Via Hand Delivery  <input checked="" type="checkbox"/> Express Delivery  <input type="checkbox"/> Via First Class Mail  <input type="checkbox"/> Other: _____</p>
<p><b>RESPONDENTS LG ELECTRONICS, INC.; LG ELECTRONICS U.S.A., INC.; AND LG ELECTRONICS MOBILECOMM U.S.A., INC.:</b></p>	
<p>Scott A. Elengold, Esq.  <b>FISH &amp; RICHARDSON P.C.</b>                  1425 K Street, NW                  11th Floor                  Washington, DC 20005</p>	<p><input type="checkbox"/> Via Hand Delivery  <input checked="" type="checkbox"/> Express Delivery  <input type="checkbox"/> Via First Class Mail  <input type="checkbox"/> Other: _____</p>
<p><b>RESPONDENTS HTC CORPORATION; AND HTC AMERICA, INC.:</b></p>	
<p>Fred I. Williams, Esq.  <b>VINSON &amp; ELKINS LLP</b>                  2801 Via Fortuna, Suite 100                  Austin, TX 78746-7568</p>	<p><input type="checkbox"/> Via Hand Delivery  <input checked="" type="checkbox"/> Express Delivery  <input type="checkbox"/> Via First Class Mail  <input type="checkbox"/> Other: _____</p>
<p><b>RESPONDENTS GOOGLE INC.; MOTOROLA MOBILITY LLC; LENOVO GROUP LTD.; LENOVO (UNITED STATES) INC; BLACKBERRY LTD.; AND BLACKBERRY CORPORATION:</b></p>	
<p>Stefani E. Shanberg, Esq.  <b>WILSON SONSINI GOODRICH &amp; ROSATI</b>                  One Market Plaza                  Spear Tower, Suite 3300                  San Francisco, CA 94105</p>	<p><input type="checkbox"/> Via Hand Delivery  <input checked="" type="checkbox"/> Express Delivery  <input type="checkbox"/> Via First Class Mail  <input type="checkbox"/> Other: _____</p>



CERTAIN PORTABLE ELECTRONIC DEVICES AND COMPONENTS THEREOF

INV. NO. 337-TA-994

**RESPONDENTS ZTE CORP.; AND ZTE (USA) INC.:**

Lyle B. Vander Schaaf, Esq.  
**BRINKS GILSON & LIONE**  
1775 Pennsylvania Avenue, NW, Suite 900  
Washington, DC 20006

- Via Hand Delivery
- Express Delivery
- Via First Class Mail
- Other: \_\_\_\_\_