

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS
AT&T MOBILITY LLC
Petitioners

v.

SOLOCRON MEDIA, LLC
Patent Owner

Case IPR2015-00342
Patent No. 6,496,692

**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 6,496,692
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *ET SEQ.***

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PETITIONERS' EXHIBIT LIST

<u>Exhibit No.</u>	<u>Description</u>
Exhibit 1001	U.S. Patent No. 6,496,692 (the '692 patent)
Exhibit 1002	Complaint filed in <i>Solocron v. Cellco Partnership et al.</i> (Case No. 2-13-cv-1059) (E.D. Tex.)
Exhibit 1003	Copy of U.S. Provisional Patent App. 60/169,158, as filed Dec. 6, 1999 (downloaded from PAIR)
Exhibit 1004	Copy of Prosecution History for U.S. Patent App. 09/518,712, filed Mar. 3, 2000 (now U.S. Patent No. 6,496,692) (as produced by Solocron)
Exhibit 1005	Exhibit Not Used
Exhibit 1006	Exhibit Not Used
Exhibit 1007	Exhibit Not Used
Exhibit 1008	Exhibit Not Used
Exhibit 1009	Exhibit Not Used
Exhibit 1010	Exhibit Not Used
Exhibit 1011	Excerpts of Documents Showing Mr. Shanahan's Prosecution and Litigation Experience
Exhibit 1012	List of Patents and Patent Applications Issued to Nokia Relating to Ringtones
Exhibit 1013	Exhibit Not Used
Exhibit 1014	International Publication No. WO 98/25397, entitled "Telecommunication Device and a Method for Providing Ringing Information", published June 11, 1998 (" Philips " or " Rizet ")
Exhibit 1015	Exhibit Not Used

Exhibit 1016	“Ring My Bell,” The New Yorker, March 7, 2005. (downloaded from http://www.newyorker.com/magazine/2005/03/07/ring-my-bell)
Exhibit 1017	“The Sweet Sound of Success,” Time Magazine Europe, 2004 (downloaded from http://content.time.com/time/magazine/article/0,9171,901040816-678568,00.html)
Exhibit 1018	“Pioneer of the Mobile Ringtone Business,” Mobile Entertainment Forum MEF Special Recognition Award, 2004
Exhibit 1019	Internet Archive Declarations and Copies of Various Websites
Exhibit 1020	Exhibit Not Used
Exhibit 1021	Local Patent Rule 4-3 Statement filed in <i>Solocron v. Celco Partnership et al.</i> (Case No. 2-13-cv-1059) (E.D. Tex.)
Exhibit 1022	U.S. Patent No. 6,292,668, filed on October 30, 1998, as a continuation of No. 08/804,236 (filed on February 20, 1997), issued on September 18, 2001 (“ Alanara ”)
Exhibit 1023	Certified English translations of JukeBoksi websites (corresponding to 1019-0088 -0098).
Exhibit 1024	<i>Google, Inc. v. Whitserve LLC</i> , IPR2013-00249, Decision dated Sept. 10, 2013 (Paper 11) Granting petition based in part on Exhibit 1003 (also attached)
Exhibit 1025	Wynn W. Coggins, Prior Art in the Field of Business Method Patents – When Is an Electronic Document a Printed Publication for Prior Art Purposes?, AIPLA, Fall 2002, available at http://www.uspto.gov/patents/resources/methods/aiplafall02paper.jsp
Exhibit 1026	Declaration of Jari Valli
Exhibit 1027	The IEEE Standard Dictionary of Electrical and Electronics Terms (6th ed. 1997)
Exhibit 1028	Webster’s II New College Dictionary (2001)
Exhibit 1029	Microsoft Press Computer Dictionary (1999)
Exhibit 1030	The Concise Oxford Dictionary (Judy Pearsall ed., Oxford University Press, 10th ed. 1999)

Exhibit 1031	Nokia 9110 User Manual, published at least as early as February 1, 1999 (“ 9110 UM ”)
Exhibit 1032	Declaration of Erin Flaucher re Nokia 9110 with Exhibits
Exhibit 1033	9110 Nokia.com web page archived May 8, 1999 for “frequently asked questions” (“ 9110 FAQ ”)
Exhibit 1034	9110 CD Listing Printout (“ 9110 CD Listing ”)
Exhibit 1035	9110 PC Suite PC Suite for Nokia 9110 Communicator User’s Guide (“ 9110 PC Suite ”)
Exhibit 1036	Quick Guide for the WAV converter for the Nokia 9110 Communicator, 10/22/1999 http://nds1.nokia.com/phones/files/software/wav_converterzip9110.zip (“ 9110 WAV Converter ”)
Exhibit 1037	Declaration of Internet Archive re Nokia Web Sites
Exhibit 1038	Declaration of Henry Houh, Ph.D., and CV
Exhibit 1039	Merriam-Webster Online Dictionary

I. INTRODUCTION AND BACKGROUND

Cellco Partnership d/b/a Verizon Wireless and AT&T Mobility LLC (“Petitioners”) request *inter partes* review of claims 1 and 4-6 of U.S. Patent No. 6,496,692 (“the ‘692 patent”) (Exhibit 1001). The ‘692 patent is part of a family of nearly twenty patents owned by Solocron Media, LLC (“Solocron”), a small company in Tyler, Texas. The portfolio’s inventor, Michael Shanahan, is a former telecommunications and electronics patent prosecutor and litigator whose clients over the past fifteen years include Nokia, Inc. and other well-known electronics companies. *See, e.g.*, Exhibit 1011 at 0004-5, 0066, 0068-81.

Solocron alleges that the ‘692 patent relates to searching for and downloading a “user-defined” audio file from a database and using that audio file as a ringtone. Mr. Shanahan did not claim to invent ringtones, and conceded during prosecution of the ‘692 patent that ringtones were well-known in the art prior to his filing date. Exhibit 1004 at 0094-95. Indeed, Nokia owns at least 101 patent applications relating to ringtones, including 17 patents and applications predating the ‘692 patent. Exhibit 1012. These include U.S. Patent No. 6,292,668 (“Alanara”) (Exhibit 1022), which predates the ‘692 patent by over two years and discloses the claim elements in much greater detail than the ‘692 patent contemplates. Alanara and the other references discussed herein were not presented to the Patent Office during prosecution of the ‘692 patent.

Recognizing this crowded field, the inventor tried to distinguish his invention during prosecution by (wrongly) asserting that prior art systems were confined to “predefined audio selections.” To address this alleged “problem,” Mr. Shanahan disclosed downloading audio files (without providing any details on how the downloading occurred) and utilizing them as “indicia” of communications.

But by the filing date of the ‘692 patent, many others in the art solved this *same* alleged “problem” using this *same* method. More than two years before the ‘692 filing, Nadege Rizet filed an application for searching, browsing, selecting and downloading ringtones. Exhibit 1014. This application uses strikingly similar language to the ‘692 patent, including the same “user defined” language that was a purported basis for novelty of the ‘692 claims. *See id.* at 2:29-30.

Almost a year prior to Mr. Shanahan’s purported invention, Nokia published a User’s Manual and other documents about a well-known device, the Nokia 9110. These documents explicitly teach users to search, browse and select files from the Internet so that “WAV files can be downloaded from the Internet . . . [and] can also be used as ringtones.” Exhibit 1033 at 0004. Neither the 9110 nor any documentation concerning the 9110 were considered during prosecution.

Similarly, well before the ‘692 filing, a Finnish carrier, Radiolinja, worked with an inventor, Vesa-Matti Paananen, to develop and launch a website called “Jukeboksi” that allowed subscribers to customize their cellular phones with

ringtones of their choice. Mr. Pananen has received recognition from the industry including a special award as “Pioneer of the Mobile Ringtone Business.” Exhibits 1016-1018. As shown below in screen captures from the Wayback Machine, Jukeboksi permits a user to search, browse, and download a wide variety of ringtones. Exhibit 1019 at 0015, 0019, 0021 and 0088-98 and Exhibit 1023.

Also prior to Mr. Shanahan’s earliest filing date, the My Nokia website launched and permitted users with Nokia phones such as the 9110 to customize those phones with selectable ringtones. Exhibit 1019 at 0015, 0019, 0021. Authenticated screen captures of My Nokia confirm that My Nokia discloses the elements of claims 1 and 4-6 in concise detail. Neither Jukeboksi nor My Nokia were considered by the Examiner during prosecution.

The lack of consideration of these references is unsurprising given the limited and inconsistent file history of the ‘692 patent. Significantly, claims 1 and 4-6 only received a single rejection during prosecution for lack of antecedent basis, and do not appear to have ever been substantively examined by the Patent Office. Moreover, the Examiner allowed the claims on a basis that he previously acknowledged was present in the prior art, and changed his reasons for allowance during prosecution without explanation.

For all the reasons below, there is a reasonable likelihood that claims 1 and 4-6 of the ‘692 patent are unpatentable, warranting *inter partes* review.

II. NOTICES, STATEMENTS AND PAYMENT OF FEES

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

The real parties in interest are Celco Partnership d/b/a Verizon Wireless and AT&T Mobility LLC.

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

Solocron sued the entities below (and Petitioners) for infringement of the ‘692 patent in the Eastern District of Texas on December 6, 2013 (Case No. 2:13-cv-01059) (“the Litigation”): Sprint Corporation, Sprint Communications Company L.P., Sprint Solutions Inc., and T-Mobile USA, Inc. *See* Exhibit 1002.

C. Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

Petitioners designate lead and back-up counsel as noted below. Powers of attorney pursuant to 37 C.F.R. § 42.10(b) accompany this Petition.

For Petitioner Celco Partnership d/b/a Verizon Wireless	
Lead Counsel	Backup Counsel
Kevin P. Anderson, Reg. No. 43,471	Floyd B. Chapman, Reg. No. 40,555 Scott A. Felder, Reg. No. 47,558
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MCKOOL SMITH PC, 300 Crescent Court, Suite 1500, Dallas, TX 75201 Phone 214.978.4000 / Fax 214.978.4044	

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

Please address all correspondence to lead counsel at the addresses above.

Petitioners consent to electronic service by email at: kanderson@wileyrein.com, fchapman@wileyrein.com, sfelder@wileyrein.com, shejny@mckoolsmith.com, tstevenson@mckoolsmith.com, and nmathews@mckoolsmith.com.

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

Petitioners certify pursuant to 37 C.F.R. § 42.104(a) that the ‘692 patent is available for *inter partes* review, and that Petitioners are not barred or estopped from requesting *inter partes* review based on the grounds herein. Petitioners certify this petition is filed within one year of the service of the Complaint above.

F. Fees Under 37 C.F.R. § 42.103

Petitioners concurrently submit fees of \$23,000. If more fees are necessary to accord this Petition a filing date, authorization is granted to charge the same to Deposit Account No. 50-1129 with reference to Attorney Docket No. 79244.0187.

III. THE ‘692 PATENT

A. Background

The ‘692 patent was filed on March 3, 2000, and purports to claim priority to a December 1999 provisional application (“the December 1999 application”). Exhibit 1001. The ‘692 patent relates to personalizing telephones with audio files. *Id.* at 1:55-57. The specification acknowledged that there were “many types of electronics devices” with “user-selectable” audio and video that were already available before the invention date. *Id.* at 1:15-26. Similarly, Mr. Shanahan later

acknowledged that basic ringtone technology was already well-known before his earliest invention date. Exhibit 1004 at 0094-95.

According to Mr. Shanahan, a drawback of such technology was that users “ha[d] to choose from a limited selection of pre-programmed information . . . placed there by the manufacturer.” Exhibit 1001 at 1:31-34. To address this purported issue, Mr. Shanahan proposed a method for “allow[ing] a user to program user-defined information into his or her electronic device” to “customize” that device. *Id.* at 1:35; 1:62-64. As shown below, this basic customization technology was well-established long before Mr. Shanahan’s invention date.

B. Prosecution History of the ‘692 Patent

On March 3, 2000, Mr. Shanahan filed the application that eventually became the ‘692 patent. Mr. Shanahan initially presented a different set of claims bearing little resemblance to the issued claims. Exhibit 1004 at 0031-35. The Examiner rejected these claims over many references, many of which were unrelated to ringtones and the inventor cancelled those claims. *Id.* at 0072-78.

Mr. Shanahan made several key concessions about the prior art and his purported invention. First, he conceded that “ring sequences or notes provided by a telephone manufacturer or other source” were already known in the art prior to his earliest priority date. *Id.* at 0094-95. Second, Mr. Shanahan admitted that existing prior art systems allowed users to “compose a ring sequence” using notes

available on the device. *Id.* at 0096. Thus, Mr. Shanahan conceded that he did not invent: (i) the concept of ringtones or (ii) the personalization of ringtones.

Mr. Shanahan tried to distinguish the prior art by asserting that his invention allowed a user to “browse and choose from among a very broad range of audio and/or video information found on a wide variety of mediums.” *Id.* at 0095. Yet Mr. Shanahan’s purported distinction contradicted his own admissions that prior art systems such as Napster®—the well-known music sharing service that permitted users to browse and download music from a wide variety of sources—had been developed well before his earliest priority date. *Id.*

In the same 2001 Office Action response, Mr. Shanahan introduced the claims that eventually became claims 1 and 4-6. Despite the concessions on the substantial body of available art, the Examiner made only a procedural antecedent basis rejection with respect to claims 1 and 4-6, but otherwise allowed those claims pending correction of that antecedent basis issue. *Id.* at 0134.

In his reasons for allowance, the Examiner acknowledged that the steps of claim 1 were well-known in the art. For example, the Examiner conceded that one of the cited references, Krane, taught each of the first three steps of claim 1 of the ‘692 patent. *Id.* The sole basis for patentability was that Krane did not disclose programming that audio file into the device for use as a ringtone. *Id.*

However, the Examiner did not acknowledge: (i) Mr. Shanahan’s repeated

concessions concerning the existence of ringtones; or (ii) the existence of ample ringtone-related prior art, including prior art that the Examiner himself cited on other claims in the *same* Office Action. *Id.* Indeed, the Examiner rejected other claims—ultimately cancelled by Mr. Shanahan in the face of these rejections—over Armanto and Ohayon, noting that Armanto “disclose[s] a programming of a telephone’s ringing tone,” and that Ohayon taught “playing . . . user audio . . . when receiving an incoming telephone call.” *Id.* at 0131. The Examiner did not explain why Armanto and/or Ohayon were not cited or even discussed with respect to eventual claims 1 and 4-6.

Mr. Shanahan corrected the antecedent basis issues and the Examiner issued a Notice of Allowability. The Examiner changed the reasons for allowance, asserting that “none of [the references] teach and fairly suggest that the user to search [sic] a plurality of different locations including the combination and [sic] specifically described as claimed.” *Id.* at 0162-64. In making that assertion, the Examiner did not acknowledge that (i) he had previously conceded that this limitation was taught by at least the Krane reference; or (ii) he previously agreed that programming ringtones into a device was taught by a number of prior art references. Claims 1 and 4-6 subsequently issued.

IV. IDENTIFICATION OF CHALLENGE UNDER 37 C.F.R. § 42.104(b)

Petitioners request *inter partes* review of claims 1 and 4-6 of the ‘692 patent,

in view of the references identified below. None of the references listed below were considered by the Patent Office during prosecution. Except where noted, all references are prior art under 35 U.S.C. §§ 102(a) or (b):

1. **Alanara (Exhibit 1022)**, U.S. Patent No. 6,292,668, was filed on October 30, 1998, as a continuation of Application No. 08/804,236 (filed on February 20, 1997), and issued on September 18, 2001. It is prior art under § 102(e).
2. **Rizet (Exhibit 1014)**, Int’l Pub. No. WO 98/25397, entitled “Telecommunication Device and a Method for Providing Ringing Information,” published on June 11, 1998.
3. **My Nokia (Exhibit 1019)**, the website of a ringtone downloading service with a URL of www.my-nokia.co.uk, was published at least as early as November 29, 1999 via the Internet. *See* Exhibit 1019 ¶¶ 7-11, 13-14 and 0012-21, 0024-28.
4. **JukeBoksi (Exhibit 1023)**, the website of a ringtone downloading service with a URL of www.jukeboksi.radiolinja.fi, was published at least as early as January 25, 1999 via the internet. *See* Exhibit 1019 ¶¶ 39-41 and 0088-98; Exhibit 1023 (certified translations of same).

The My Nokia and JukeBoksi websites are “on-line database[s] or Internet publication[s] that [are] considered to be ‘printed publication[s]’ within the meaning of 35 U.S.C. §§ 102(a) and (b).” MPEP § 2128; *see also Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1379-81 (Fed. Cir. 2012)

(online article that had been available on a public website by the critical date qualified as a “printed publication” under 35 U.S.C. § 102(b)); *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364-65 (Fed. Cir. 2014) (post on an internet newsgroup was a printed publication). Moreover, the PTO has long accepted the Wayback Machine as a proper means for establishing a website as prior art. *See* Exhibit 1024 at 0009-10 and 0015-32 (Sept. 10, 2013 Decision in *Google, Inc. v. Whitserve LLC*, Paper 11, IPR2013-00249, at 9-10 (P.T.A.B. 2013) and Exhibit 1003 thereto (Internet Archive pages)) (granting IPR based on Wayback Machine archive of pages from wells Fargo.com); *see also* Exhibit 1025 at 0003 (“Examiners utilize commercial databases and the Wayback Machine to help establish website posting dates in order to qualify the website as prior art”); *see also EMC Corp. v. Personal Web Techs., LLC*, IPR2013-00086, Paper 66 at 29-31 (P.T.A.B. 2014) (accepting web sites as printed publications and citing cases accepting Wayback Machine materials as sufficient authentication).

5. **9110 UM (Exhibit 1031)**, User’s Manual for Nokia 9110. 9110 UM was available on the Internet no later than February 1, 1999. Exhibit 1026 ¶¶ 5-6. 9110 UM bears a copyright date of 1998 (Exhibit 1031 at 0002), and was distributed to customers on a CD with the 9110 product by no later than February 1, 1999. Exhibit 1026 ¶ 4; Exhibit 1032 ¶¶ 4-13.

6. The following publications referenced as “**9110 Documents**”: (a) **9110 PC**

Suite (Exhibit 1035), “PC Suite For Nokia 9110 Communicator User’s Guide;”
(b) **9110 FAQ (Exhibit 1033)**, “Frequently asked questions” from Nokia 9110 website; (c) **9110 WAV (Exhibit 1036)**, “Quick Guide For The WAV Converter For The Nokia 9110 Communicator,” dated 10/22/1999 and available on Nokia website for downloading no later than December 4, 1999; and (d) **9110 CD List (Exhibit 1034)**, list of files on CD delivered in box with 9110 product.

The following table shows the widespread public availability and distribution of these publications prior to Mr. Shanahan’s earliest priority date.

Publication	Hardcopy	Nokia Website	On CD Distributed With Sales of Product
9110 UM	Exhibit 1026 ¶ 4	Exhibit 1026 ¶¶ 5-6	Exhibit 1032 ¶¶ 4-13.
9110 PC Suite		Exhibit 1037 ¶¶ 24-25 and 0038	Exhibit 1032 ¶¶ 4-12, 15.
9110 FAQ		Exhibit 1037 ¶¶ 38-39 and 0078-81	
9110 WAV		Exhibit 1037 ¶¶ 16-17 and 0028	
9110 CD Listing		Exhibit 1037 ¶¶ 22-23, 38-39, 42-43 and 0036, 0081, 0085	Exhibit 1032 ¶¶ 4-16.

Each of these types of distribution constitutes well-accepted forms of publication. First, the publicly available website distribution, supported by the Butler Declarations and the Wayback Machine screenshots, is routinely accepted as proof of publication as discussed in detail above. Second, hardcopies to

consumers (supported by declaration) is indisputable proof of distribution.

Third, the files and the listing of files on a CD are printed publications under Federal Circuit law. The 9110 CD was distributed in a widespread manner to provide information to consumers and purchasers of the 9110 device. A printed publication can be “printed, handwritten, or on microfilm or magnetic disc or tape, etc.” *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981). “[T]he key to a ‘printed publication’ is the ‘probability of dissemination’ rather than the form.” *Ex Parte Mettke*, Appeal 2008-0610, 2008 WL 4448201, at *6 (B.P.A.I. Sept. 30, 2008) (holding a videotape to be a prior art “printed publication”) (citing *Wyer*, 655 F.2d at 226). Courts interpret the term printed publication “to give effect to ongoing advances in the technologies of data storage, retrieval, and dissemination.” *In re Hall*, 781 F.2d 897, 898 (Fed. Cir. 1986).

“[P]ublic accessibility has been called the touchstone in determining whether a reference constitutes a printed publication.” *In re Klopfenstein*, 380 F.3d 1345, 1349 (Fed. Cir. 2004) (quoting *Hall*, 781 F.2d at 898-99). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (quoting *Wyer*, 655 F.2d at 226). The **9110 CD** was clearly

disseminated and available to any interested purchaser of the device.

A reference need not be indexed or distributed to qualify as a printed publication. *Klopfenstein*, 380 F.3d at 1348. “If accessibility is demonstrated, there is no requirement to show that particular members of the public actually received the information.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988). A reference qualifies as a printed publication when its “entire purpose” is to permit communication with an audience. *Suffolk Techs*, 752 F.3d at 1365 (upholding district court’s finding that newsgroup postings qualified as a printed publication “where dialogue with the intended audience was the entire purpose of the newsgroup postings”).

The 9110 CD was distributed to purchasers of the 9110 product. Exhibit 1032 ¶¶ 4-16. The 9110 UM states that “the sales package ... contains the following . . . CD-ROM” and repeatedly references the “CD-ROM ... in the sales package” (or variants of that phrase). Exhibit 1031 at 0017, 0035, 0040, 0046, 0051, 0095, 0105, 0131, 0135, 0167. Numerous Nokia.com Internet pages archived on May 8, 1999 reference the “CD ROM in the sales package” (or variations). Exhibit 1037 ¶¶ 22-23, 38-39, 42-43 and 0036, 0081, 0085.

The entire purpose of the 9100 CD, as well as all the Internet pages and manuals that reference the 9100 CD, was to disseminate information concerning the 9100 CD. The 9100 CD, the files thereon, and the listing of files thereon are

thus prior art under 35 U.S.C. § 102(a). *See e.g., Stored Value Solutions, Inc. v. Card Activation Techs. Inc.*, 499 F. App'x 5, 14 (Fed. Cir. 2012) (upholding district court's finding that software user manual was printed publication given the evidence that it was copyrighted prior to the critical date and was in fact distributed to customers who purchased the software prior to the critical date).

Petitioners request that claims 1 and 4-6 be cancelled based upon the following grounds, as explained in detail below (including relevant claim constructions): **Ground 1**: claims 1 and 4-6 are invalid under 35 U.S.C. § 102 as anticipated by Alanara; **Ground 2**: claims 1 and 4-6 are invalid under 35 U.S.C. § 102 as anticipated by Rizet; **Ground 3**: claims 1 and 4-6 are invalid under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 as anticipated by and/or rendered obvious over My Nokia; **Ground 4**: claims 1 and 4-6 are invalid under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 as anticipated by and/or rendered obvious over JukeBoksi; **Ground 5**: claims 1 and 4-6 are invalid under 35 U.S.C. § 102 as anticipated by 9110 UM; **Ground 6**: claims 1 and 4-6 are invalid under 35 U.S.C. § 102 as obvious over 9110 UM in combination with 9110 Documents; **Ground 7**: claims 1 and 4-6 are invalid under 35 U.S.C. § 103 as obvious over 9110 UM in combination with My Nokia.

V. **HOW THE CHALLENGED CLAIMS ARE TO BE CONSTRUED UNDER 37 C.F.R. § 42.104 (b) (3)**

In this proceeding, claim terms are given their broadest reasonable interpretation consistent with the specification and prosecution history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012). The broadest reasonable interpretation of the relevant claim terms is as follows:

“Allowing a user to search” should mean **“permitting a user to examine a set of items for those that have the desired property.”** This construction is supported by the plain and ordinary meaning of “search” and with usage of “search” in the specification. *E.g.*, Exhibit 1027 (“search” is “to examine a set of items for those that have a desired property”); Exhibit 1001 at 3:43-46; 7:3-7.

The broadest reasonable interpretation of “search” would at least encompass the ability of a user to manually access and examine different Internet websites, for example. *See id.* at 6:37-65; 7:13-35. Allowing a user to search also includes permitting the user to use well-known functions of Internet browsers (*id.* at 6:25-36) to search the webpages (*id.* at 7:15-17), such as the “control-f” or “find” option usable on many web browsers. In the Litigation, Solocron asserts that “allowing” should be given a “plain meaning” of “permitting.” *See* Exhibit 1021 at 0059.¹

¹ In the Litigation, Defendants assert that these “allowing” terms are indefinite because these terms do not provide any definition or restriction on the scope of the property right such that one may determine when infringement occurs. The phrase

“Plurality of different locations” should be construed to mean, in its broadest reasonable interpretation application for this proceeding, **“more than one distinct place.”** “Plurality” means “more than one.” The “different locations” means “distinct places” as shown in extrinsic evidence. *E.g.*, Exhibit 1039-0001 (“a place or position”). This includes multiple distinct memory addresses in a computer. *E.g.*, Exhibit 1001 at 3:44-46; 10:34. It also includes different places on a single Internet server defined, for example, by separate URLs which can point to, for example, different web pages or different files. *Id.* at 7:15-18. It also encompasses different Internet websites. *Id.* at 6:50-65; 11:41-42.

“Allowing a user to browse audio files” should be construed to mean **“permitting a user to listen to, scan, or observe audio files.”** This is consistent with the contemporaneous discussion of the ordinary meaning of “browse.” *See, e.g.*, Exhibit 1029 (“To scan a database, a list of files, or the Internet, either for a particular item or for anything that seems to be of interest. Generally, browsing implies observing”); Exhibit 1030 (“Survey goods or text in a leisurely and superficial fashion”); Exhibit 1028 (“To inspect leisurely and casually b. To read superficially”). This definition is consistent with usage of “browse” in the patent.

“allowing a user to [perform some action],” when used in a method claim, requires the action of a third party (the “user”) and does not provide any guidance or restriction on when another party (an alleged infringer) “allows” the third party to act independently. Thus, it is indefinite under the approach dictated by *Markman*.

See Exhibit 1001 at 4:46-47; 7:45 (“browsing through a menu”); 8:17-18; 10:49-53; 11:33-35. Such a definition encompasses a user observing files on a website. *Id.* at 10:51-52.

“**User-defined audio file**” should be construed to mean for the purpose of this IPR its broadest reasonable interpretation of a “**user-selected audio file.**” This definition is consistent with Solocron’s proposed definition in the Litigation. Exhibit 1021 at 0032.² Such a definition, under the broadest reasonable interpretation, encompasses at least a file that a user selects for downloading.

“**Audio file**” should mean its broadest reasonable interpretation of “**information or data that can be used to produce sound.**” This definition is consistent with the plain and ordinary meaning.

VI. DETAILED EXPLANATION AND SUPPORTING EVIDENCE UNDER 37 C.F.R. §§ 42.104(b)(4) AND (b)(5)

Pursuant to 37 C.F.R. §§ 42.104(b)(4) and (b)(5), Petitioners explain below why claims 1 and 4-6 are unpatentable under the statutory grounds identified above, including the identification of where each element is found in the prior art patents or printed publications. The claim charts identify the supporting evidence relied upon to support the challenge by exhibit number and set forth the relevance

² In the Litigation, Defendants have proposed that this term mean “an audio file provided by the user.” *See* Exhibit 1021 at 0032 (Defendants’ construction). This construction is narrower than the broadest reasonable construction required here.

of the evidence to the challenge raised, including an identification of those specific portions of the evidence that support the challenge. An Exhibit List (*see* 37 C.F.R. § 42.63(e)) identifying the exhibits is also included, *supra*, at p. v.

A. Mr. Shanahan Is Not Entitled to an Invention Date Prior to March 3, 2000.

Claims 1 and 4-6 are not entitled to the filing date of the December 1999 provisional application. As set forth in the Declaration of Dr. Henry Houh (Exhibit 1038), the provisional application does not come close to providing sufficient written description to establish that Mr. Shanahan possessed the full scope of the subject matter of claims 1 and 4-6 prior to March 2000. 35 U.S.C. §§ 112, 120.

“[A] patent’s claims are not entitled to an earlier priority date merely because the patentee claims priority.” *In re NTP, Inc.*, 654 F.3d 1268, 1276 (Fed. Cir. 2011) (citations omitted). “[T]he specification of the *provisional* must ‘contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,’ to enable an ordinarily skilled artisan to practice the invention *claimed* in the *non-provisional* application.” *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002). “This requires that the written description actually or inherently disclose the claim element.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306-07 (Fed. Cir. 2008).

The 1999 application falls far short of actually or inherently disclosing all features of claims 1 and 4-6 of the ‘692 patent. *See* Exhibit 1038 ¶¶ 50-54. The provisional does not describe “allowing a user to search” and does not describe the “plurality of locations” that is searched, browsed, and selected from as required by claim 1. *Id.* ¶ 51. In fact, the terms “browse,” “browsed audio files,” “search,” “plurality of different locations,” and “indicia of an incoming communication” do not appear in the application, nor does any discussion of any related concepts. *Id.*

There is no *enabling* discussion of the claim step of “enabling the user of the telephone to program at least a portion of the user-defined audio file into the telephone.” *Id.* ¶ 52. The provisional states this as a goal, but does not say how that goal is accomplished. *Id.* Similarly, for claim 4, the provisional provides no description of how “retrieving the user defined audio file from the Internet” is part of the “enabling” step. *Id.* For claim 5, there is no discussion whatsoever of transmitting the user-defined audio file across a *wireless* network. *Id.* Thus, there is no actual disclosure as required under *PowerOasis*.

Similarly, there is no inherent disclosure of these claimed features. “Inherency ... may not be established by probabilities or possibilities.” *Agilent Techs., Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1383 (Fed. Cir. 2009) (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)). Instead, inherency requires that “the missing descriptive subject matter is ‘necessarily present’” *In re Robertson*,

169 F.3d 743, 745 (Fed. Cir. 1999) (internal citation and quotation omitted). The December 1999 application fails to meet this standard because each of the claimed features listed above is not “necessarily present” in the December 1999 application. Exhibit 1038 ¶¶ 50-54.

The lack of support for the vast majority of the claim elements in the December 1999 application confirms that Mr. Shanahan cannot seek to swear behind references pre-dating the December 1999 application date, as he may try to do. Proving an earlier invention date is a two-step process. First, a patentee must provide evidence that it had possession of *every feature recited in the claims* at the time of the alleged conception. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 59, at 22-23 (P.T.A.B. 2013). Second, it must provide independent corroboration of the date and origin of that evidence. *Id.*

As shown above, Mr. Shanahan cannot establish that he had possession of *every claimed feature* in December 1999—much less any earlier date. Additionally, even if Mr. Shanahan attempted to introduce some earlier document, he cannot show diligence throughout the entire critical period. *Monsanto Co. v. Mycogen Plant Sci., Inc.*, 261 F.3d 1356, 1369 (Fed. Cir. 2001) (“The evidence must show that the alleged earlier inventor was diligent throughout the *entire critical period*”) (emphasis added). Indeed, the Federal Circuit has recognized that even miniscule delays are sufficient to preclude a finding of diligence. *In re*

Mulder, 716 F.2d 1542, 1545 (Fed. Cir. 1983) (two-day unexplained gap disproves the continuity required for due diligence).

Thus, Mr. Shanahan is not entitled to a December 1999 priority date, and cannot swear behind any of the references below.

B. Claims 1 and 4-6 Are Anticipated by Alanara

Alanara is one of many Nokia patents that expressly discloses a mobile phone that wirelessly communicates with an Internet server to search, browse, select, download and program “applications” (which include ringtones) into a wireless phone. *See, e.g.*, Exhibit 1022 at 14:39-65; Figure 10; claim 1.

In sharp contrast to the sparse disclosure of the ‘692 patent, Alanara details how a mobile phone and an Internet server would be programmed to download ringtones. For example, Alanara extensively details how to create menus on the phone that link to different websites in order to download ringing tones the phone. *Id.* at 10:26-12:3. The ringtones are shown as “sub-menu Download Ringing Tones” option on the phone and “[e]ntries in the sub-menus can be associated with URL (Uniform Resource Locator) information, which can be used to fetch information from Internet.” *Id.* at 11:13-26. Thus, each ringtone submenu can link to a different location (URL) on the Internet which can be used to search / download ringtones. *See id.* at 14:39-65.

Alanara teaches website programming for ringtone websites as well.

Alanara teaches that “a number of different companies have their own services pages on the Internet through which a user may order information on a service.” *Id.* at 16:48-50. Alanara’s services included ringtones. *See id.* at 10:26-12:3; 14:39-65; Figure 10. Alanara even teaches how these different companies can program their webpages to permit access by a mobile device. *See id.* at 16:24-20:30. These webpages program applications like “menus” (which, as shown above, includes “Download Ringing Tones”). *Id.* at 20:11 (showing “[m]enu” as an application that is provided by an internet server).

Alanara also teaches a “plurality of different locations” in at least two independent ways. First, Alanara teaches that “sub-menus” can be associated with different “Uniform Resource Locators” (or websites) to “fetch information from the internet”; an example of this expressly includes using a “sub-menu” to send a “command” “request” for the “top 10 ringing tones” as described in connection with Fig. 10. Given that each of the sub-commands can be programmed to access different websites, Alanara teaches searching a plurality of websites (identified by the “URLs”) to “fetch information” (including, for example information about “ringing tones” (such as a “top 10 list”). Searching different websites constitutes searching different locations. Alanara discloses that using the menu system, the user can browse (“scroll down”) the list of potential ringtones one at a time and has the option to “select” a ringtone for downloading and for “playback” before

deciding to “save” or reject the ringtone. For example, in connection with Fig. 10, Alanara details how the user can “scroll down” through each of the “Top 10 Ringing Tones” sent by the server. Alanara also teaches the search function generically in connection with “applications” –which include “ringing tone.”

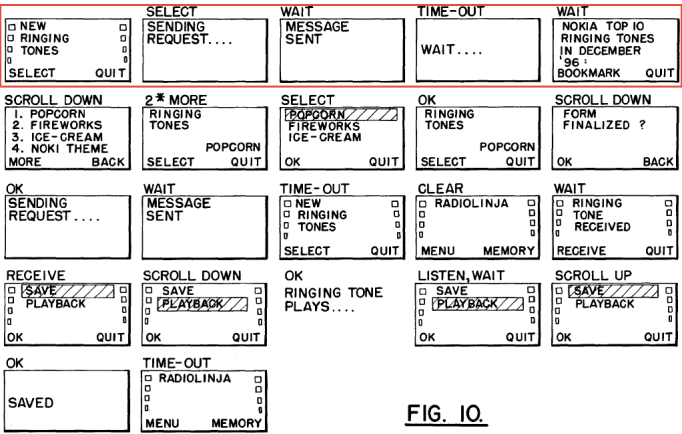
Second, Alanara teaches that more than one “[network] operators” (sometimes referred to as “service providers”) can provide such services on the same network, and that a phone can be programmed (using the “sub-menus”) to send a “command” “request” to a server of a service provider to get a list of the “latest ringing tones” (e.g., Nokia’s current “top 10 ringing tones”). Given that there can be multiple service providers on the same network, Alanara teaches allowing a user to search the multiple service providers for their lists of ringing tones. Searching different providers constitutes searching different locations.

Alanara anticipates claims 1 and 4-6 as indicated below. *See also* Exhibit 1038 ¶¶ 94-139.

Claim Element	Where Each Limitation Is Found in Alanara (Exhibit 1022)
1. A method for programming a user-defined audio file into a telephone comprising:	“[S]ub-menu Download Ringing Tones can be divided into sub-menus according to ring tone melodies (Rock around the clock, Those were the days, Smoke on the water) which can then be chosen as ring tones by selecting the specific sub-menu and activating it as a command. The command is sent to the service provider as a user message according to the invention and as a response to the user message the operator may send the ring tone coded into a user message which can then be stored into a ring

	<p>tone memory of the terminal.” 11:13-22.</p> <p>“The terminal is preferably a mobile phone or communicator, which has circuits and a user interface that enable the processing of different applications.” 20:44-47; <i>see</i> claim 3.</p>
<p>[1a] allowing a user to search a plurality of different locations that include audio files;</p>	<p>“Selections made in sub-menus cause wide variety of actions. Entries in the sub-menus can be associated with URL (Uniform Resource Locator) information, which can be used to fetch information from Internet...In addition, supplementary services can be initiated directly from these entries; ...Actions may cause information to be sent to the terminal by a network entity, e.g. enables selection and then downloading of ringing tones as explained above. Thereby the Operator Services menu can cause information to be fetched from Internet based on URL information, ... The users can browse through these services, and pick those that interest them.” 11:23-42.</p> <p>“An example of creating a menu for ringing tones is disclosed in FIG. 10 as a sequence of displays to illustrate what the user sees on the display. The command ‘NEW RINGING TONES’ is sent in a user message to a server of a ringing tone service provider in order to request [the] latest ringing tones. As a response the server sends a user message containing information relating to the Menu applications for creating a menu, from which the user can select a new ringing tone.” 14:39-47.</p> <p>“A network like the GSM network is maintained by several operators and usually each operator has at least one SMS server of their own. In this case naturally any SMS server or several servers may be used for the invention.” 3:30-35.</p> <p>“Optionally a service provider or operator may have a separate server GTW” 5:41-42.</p> <p>“The example ... shown in FIG. 11 illustrates how user messages according to the invention can be used for providing new services to a terminal, like a mobile phone, by having predetermined signs corresponding to predetermined commands. These signs and commands can be stored in a memory in the terminal device of a user (e.g. a mobile phone) or of a service provider (e.g. a computer) and can be implemented by software</p>

	<p>run by a processor for performing the predetermined commands. Also in this way the terminal can be programmed to function in a specific manner. The Menu application allows [a service provider] to introduce new applications into the terminal. For example the previously mentioned Phone Book application could be introduced to the terminal by a first user message from the service provider creating a first menu (e.g. menu 'Phone Book') after which when sending a request to the service provider the terminal would first receive a menu structure for sending the information needed to get the relevant phone number as was described earlier and after sending the relevant information the terminal would receive a response including the phone number." 16:1-21.</p> <p>Alanara teaches each menu can be associated with a "specific short message service centre or to any SM-SC of a specific list":</p> <p>"When using the Menu application with short messages the number of one or several short message service centres (SM-SC) can be related to a menu so that when activating a user message by a menu item the message would be sent via a specific short message service centre or to any SM-SC of a specific list. The numbers of a specific or different SM-SCs can be sent from the network to the terminal in a user message, e.g. when a menu is created or updated. This would allow more possibilities for services and quicker and more reliable transmission of user messages, when a special service (or the server providing that service) accessible via a specific menu command is connected to a specific service centre." 14:26-38.</p> <p>See Fig. 10 and description relating to sending a request for ringtones that results in a list of ringtones being received:</p>
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	 <p style="text-align: center;">FIG. 10.</p>
<p>[1b] allowing the user to browse audio files in one of the plurality of different locations that include audio files;</p>	<p>See Fig. 10 and description relating to scrolling and playing back ringtones as shown in element [1a].</p> <p>“...The users can browse through these services, and pick those that interest them.” 11:23-42.</p> <p>“An example of creating a menu for ringing tones is disclosed in FIG. 10 as a sequence of displays to illustrate what the user sees on the display. The command “NEW RINGING TONES” is sent in a user message to a server of a ringing tone service provider in order to request for latest ringing tones. As a response the server sends a user message containing information relating to the Menu applications for creating a menu, from which the user can select a new ringing tone. The user selects the desirable ringing tone from the menu (selects ring tone ‘Popcorn’). The selection activates a user message to be sent to the server indicating the desired ring tone. ... The user can accept or reject the ring tone. ...If the user selects the Playback-option the received ringing tone is played to the user and after that the original selection list displays again. If the user gives a rejection of the new ring tone, the received ringing tone is discarded...” 14:39-65.</p>
<p>[1c] allowing the user to choose the user-defined audio file from among the browsed audio</p>	<p>“As a response the server sends a user message containing information relating to the Menu applications for creating a menu, from which the user can select a new ringing tone. The user selects the desirable ringing tone from the menu (selects ring tone ‘Popcorn’). The selection activates a user message to be sent to the server indicating the desired ring tone. After a while the terminal receives the ring tone from the server. A received ringing tone is indicated to the user using the</p>

files; and	<p>“RINGING TONE RECEIVED” notification. The user can accept or reject the ring tone.” 14:44-54.</p> <p>“These sub-menus may further be divided into sub-menus, e.g. sub-menu Download Ringing Tones can be divided into sub-menus according to ring tone melodies (Rock around the clock, Those were the days, Smoke on the water) which can then be chosen as ring tones by selecting the specific sub-menu and activating it as a command. The command is sent to the service provider as a user message according to the invention and as a response to the user message the operator may send the ring tone coded into a user message which can then be stored into a ring tone memory of the terminal.” 11:12-22.</p> <p><i>See also</i> Fig. 10 and discussion relating to selection of “Popcorn” from the list of ringtones as shown in element [1a].</p>
[1d] enabling the user of the telephone to program at least a portion of the user-defined audio file into the telephone for use as an indicia of an incoming communication	<p>“These sub-menus may further be divided into sub-menus, e.g. sub-menu Download Ringing Tones can be divided into sub-menus according to ring tone melodies (Rock around the clock, Those were the days, Smoke on the water) which can then be chosen as ring tones by selecting the specific sub-menu and activating it as a command. The command is sent to the service provider as a user message according to the invention and as a response to the user message the operator may send the ring tone coded into a user message which can then be stored into a ring tone memory of the terminal.” 11:12-22.</p> <p>“The selection activates a user message to be sent to the server indicating the desired ring tone. ... the terminal receives the ring tone from the server. A received ringing tone is indicated to the user using the “RINGING TONE RECEIVED” notification. The user can accept or reject the ring tone. Once the user has given acceptance, the selection menu with the options “Save” and “Playback” displays. If the user selects the Save-option the received ringing tone is saved to the phone and it appears to a ringing tone options menu.” 14:48-57.</p> <p><i>See also</i> Fig. 10 relating to saving the received ringtone above in element [1a] (discussing “save” and “saved”):</p>
4. ... wherein	As discussed above with [1c] and [1d] above Alanara teaches

<p>the enabling further comprises retrieving the user-defined audio file from the Internet.</p>	<p>that the submenus can be linked to “URLs” which can be used to “fetch” ringing tones “from [the] internet”:</p> <p>“Entries in the sub-menus can be associated with URL (Uniform Resource Locator) information, which can be used to fetch information from Internet...Actions may cause information to be sent to the terminal by a network entity, e.g. enables ... downloading of ringing tones Thereby the Operator Services menu can cause information to be fetched from Internet based on URL information.” 11:24-35..</p> <p>Claim 1 (“... the mobile terminal has been arranged to open said communication link to the Internet and to download information from a server in the Internet through transmission over said opened communication link, and ... the mobile terminal has been arranged to send requests to and to receive information from a server in the Internet in said user messages”).</p>
<p>5. ... wherein the enabling further comprises transmitting the user-defined audio file across a wireless network.</p>	<p>2:20-40: transmission over “[t]he mobile phone system” using “GSM” and “USSD” and other wireless standards. <i>See</i> 13:5-8 (“... message type, which can be any user message as has been specified earlier (SMS, USSD, R data, SOC, Packet Radio).”</p> <p>Claims 1, 2 (mobile device communicates “information in user messages over the mobile communication [wireless] network” “wherein said user message is one of a short message, a message according to the standardized SMS message, ..., a message according to the standardized USSD message, ..., and a message according to a wireless packet radio service”).</p> <p><i>See</i> Fig. 2 and 6:6-28 discussing “radio interface” (showing wireless network transmissions).</p>
<p>6. ... wherein the enabling is characterized by the use of a telephone call as the incoming communication</p>	<p>“An example of creating a menu for ringing tones is disclosed in FIG. 10 as a sequence of displays to illustrate what the user sees on the display. The command “NEW RINGING TONES” is sent in a user message to a server of a ringing tone service provider in order to request for latest ringing tones. As a response the server sends a user message containing information relating to the Menu applications for creating a menu, from which the user can select a new ringing tone.” 14:39-47.</p>

	<i>See also</i> 10:26-47 discussing “personaliz[ing].”
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C. Claims 1 and 4-6 Are Anticipated by Rizet.

Rizet was not cited during prosecution of the ‘692 patent. Using strikingly similar language to the ‘692 patent, Rizet discloses searching, selecting and downloading ringtones from a “public database containing a variety of alternative forms of ringing information” and programming those ring tones into phones. The language overlap is remarkable. For example, claim 1 focuses on a “user-defined audio file” (Exhibit 1001 at 12:58) and Rizet taught “user defined forms of ringing information.” Exhibit 1014 at 2:30. Claim 1 recites to “choose the user-defined audio file” (Exhibit 1001 at 12:58) and Rizet discloses “selecting user defined” audio files. Exhibit 1014 at 2:30. The ‘692 patent cites accessing user-defined files in “remote database[s] using the first communications link” (Exhibit 1001 at 2:1-2) whereas Rizet taught accessing “via the communication link 2 to the database” where the database “can comprise one or more remotely situated databases.” Exhibit 1014 at 2:19-26. The “one or more ... databases” (Exhibit 1044 at 2:22 is a “plurality of different locations.”

Given the remarkable extent to which Rizet contains the language of the ‘692 patent two years before it was filed, it is unsurprising that Rizet invalidates claims 1 and 4-6 as indicated below. *See also id.* ¶¶ 140-180.

Claim Element	Where Each Limitation Is Found in Rizet (Exhibit 1014)
1. A method for programming a user-defined audio file into a telephone comprising:	<p>Rizet discloses a method for programming a “user-defined forms of ringing information” (e.g., “melody, song, music,” and “soundtracks”) into a telephone (e.g., a “cellular telephone”).</p> <p>“A telecommunication device is disclosed comprising a ringing information memory means, and a ringing information memory updating means for updating the ringing information content [in] the form of ... melodies.” Abstract.</p> <p>“It is an object to provide a multi selection, high quality ringing information extend/change feature to a telecommunication device such as a telephone [by providing] a public database containing a variety of alternative forms of ringing information ...such as a melody, song, music....” 1:25-2:6.</p> <p>“The database is filled with alternative forms of ringing information such as melodies, songs, sound, soundtracks, speech etcetera.” 3:23-24.</p> <p><i>See also</i> claim 4 (wherein “the ringing information memory updating means is connected to selection means coupled to the database for selecting user defined forms of ringing information”); claim 9 (the “device is ... a cellular telephone.”)</p>
[1a] allowing a user to search a plurality of different locations that include audio files;	<p>Rizet discloses that a user can connect to “one or more remotely situated databases” and use a video display to “select [the user’s] preferred ringing information items... by name [thereby] reduc[ing the time spent] trespassing on ... the communication link.” 2:23-3:1.</p> <p>“In an embodiment the telecommunication device according to the invention is characterised in that the ringing information memory updating means is connected to the data base via a long distance communication link. Such a database can comprise one or more remotely situated databases, which are connectable directly to the telecommunication device and to the ringing information memory, but preferably there is a database which can be consulted ...by means of a generally long distance communication link to each subscriber of the telecommunication device, in order to select and</p>

	<p>at wish download his favourite ringing item.” 2:19-26.</p> <p>“In a further elaboration the telecommunication device according to the invention is characterised in that it comprises video display means. The advantage thereof is that the user can select his preferred ringing information items, such as melodies, songs etcetera by name. This reduces the trespassing on communication time over the communication link.” 2:31-3:1.</p> <p>“In a further embodiment the telecommunication device according to the invention is characterised in that there is provided in selection means, in particular user friendly menu driven, preferably easily software implemented, selection means coupled to the database for selecting user defined forms of ringing information.”</p> <p>“Figure 2 shows a flowchart for elucidating one possible way of implementing the updating of the ringing information present in the ringing information memory 4. Block 9 represents the establishing of a telephone call through a number to make a connection via the telecommunication link 2 to the database 6, usually through a modem (not shown). A suitably programmed and connected microprocessor 10 in telecommunication device 3 provides a guided menu (block 11), wherein choices can be made by pushing appropriate keys on a keyboard 12, to choose (block 13) for example for ringing information in the form of music, tones, speech etcetera to be downloaded by the downloading means 7. ... The selection means 8 provide for a stop, next and selection in blocks 16 of a preferred and in block 17 confirmed choice of ringing information. In block 18 the means 7 download the confirmed choice and block 19 ends the session. In an alternative embodiment the telecommunication device 3 contains a video display means 20 for selecting ringing information items in the database 6 on the basis of the name displayed on the video display means 20 or a reference to a particular ringing item, generally by displaying characters on the means 20.” 3:31- 4:14.</p>
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	<pre> graph TD CALL[CALL 9] --> MENU[MENU 11] MENU --> PUSH[PUSH 13] PUSH --> LISTEN[LISTEN 14] LISTEN --> SELECT[SELECT 14] SELECT --> NEXT[NEXT 16] LISTEN --> CONFIRM[CONFIRM 17] CONFIRM --> DOWN_LOAD[DOWN LOAD 18] DOWN_LOAD --> END[END 19] LISTEN --> STOP[STOP 16] </pre> <p style="text-align: right;">FIG. 2</p> <p>“.... [T]he ringing information updating means comprises a public database containing a variety of alternative forms of ringing information. ...So the personal touch and the diversity of adjustments on this point to the wishes of each individual owning a telecommunication device can be honoured in a recognisable, individualised way, without expanding hardware or hardware requirements beyond the technical means normally available to an average user. This high quality, multi diverse extension can be implemented very simple on for example a personal, mobile, cellular, or cordless telephone.... The public database can be managed by a manufacturer of the telecommunication device, or any other professionally suitable instance.” 2:2-18.</p>
<p>[1b] allowing the user to browse audio files in one of the plurality of different locations that include audio files;</p>	<p>Rizet discloses allowing the user to browse audio files (e.g., browsing “melodies” and “songs” using menu buttons such as “stop, next and selection”) in one of the plurality of different locations that include audio files, including allowing the user to “prelisten” to ringtones. For example, Rizet discloses:</p> <p>“Figure 2 shows ... programmed and connected microprocessor 10 in telecommunication device 3 provides a guided menu (block 11), wherein choices can be made by pushing appropriate keys on a keyboard 12, to choose (block 13) for example for ringing information in the form of music, tones, speech etcetera to be downloaded by the downloading means 7. In block 14 the chosen ringing information can at wish be prelistened by audio producing means 15 to hear the melody, speech etcetera, before being downloaded. The selection means 8 provide for a stop, next and selection in blocks 16 of a preferred and in block 17 confirmed</p>

	<p>choice of ringing information. In block 18 the means 7 download the confirmed choice and block 19 ends the session. In an alternative embodiment the telecommunication device 3 contains a video display means 20 for selecting ringing information items in the database 6 on the basis of the name displayed on the video display means 20 or a reference to a particular ringing item, generally by displaying characters on the means 20.” 3:31-4:14.</p> <p>See Figure 2 (shown above in limitation [1b]) allowing the user to move to the next audio files (browse) and select those files.</p>
<p>[1c] allowing the user to choose the user-defined audio file from among the browsed audio files; and</p>	<p>Rizet discloses allowing the user to choose the user-defined audio file (2:29-30) from among the browsed audio files. For example, Rizet discloses that a “suitably programmed and connected microprocessor 10” / “selection means” provides a “guided menu (block 11)” wherein the user can select one of the audio files using the “display” and “keys on a keyboard” (including a “select” key):</p> <p>“Each telephone 3 is provided ... memory updating means 5 is connected via the communication link 2 to a database 6, which is present somewhere in the network 1. The database is filled with alternative forms of ringing information such as melodies, songs, sound, soundtracks, speech etcetera. The communication link 2 is connected to means 7 for downloading at least one or the alternative forms of ringing information to the ringing information memory 4. There is provided in selection means 8 connected to the memory updating means 5 and via the communication link 2 to the database 6 in order to be capable of selectively providing ringing information items from the database 6 to the memory 4 in a way to be described with reference to the flowchart of figure 2.” 3:18-30.</p> <p>See Figure 1 showing the transmission from a database through a wireless network to a phone with the elements described above.</p> <p>“Figure 2 shows a flowchart for elucidating one possible way of implementing the updating of the ringing information present in the ringing information memory 4. A suitably programmed and connected microprocessor 10 in telecommunication device 3 provides a guided menu (block 11), wherein choices can be made by pushing appropriate keys on a keyboard 12, to choose (block 13) for example for ringing information in the form of music, tones, speech etcetera to be downloaded by the downloading means 7. In</p>

	<p>block 14 the chosen ringing information can at wish be prelistened by audio producing means 15 to hear the melody, speech etcetera, before being downloaded. The selection means 8 provide for a stop, next and selection in blocks 16 of a preferred and in block 17 confirmed choice of ringing information. In block 18 the means 7 download the confirmed choice and block 19 ends the session. In an alternative embodiment the telecommunication device 3 contains a video display means 20 for selecting ringing information items in the database 6 on the basis of the name displayed on the video display means 20 or a reference to a particular ringing item, generally by displaying characters on the means 20. The telecommunication device 3 could contain an connector 21 connected to the ringing information updating means 5 for directly inputting updated ringing information to the updating means 5. The inputted information can then be user recorded in order to be further personalised.” 3:31- 4:17.</p> <p><i>See also</i> Fig. 2 (depicted above in connection with limitation [1b]).</p>
<p>[1d] enabling the user of the telephone to program at least a portion of the user-defined audio file into the telephone for use as an indicia of an incoming communication.</p>	<p>Rizet discloses a phone with “ringing information memory” which stores the “sound a telephone makes when it rings”. The phone has a “ringing information memory updating means” that updates ringtones with “user-defined forms of ringing information”:</p> <p>“Each telephone 3 is provided with a ringing information memory 4, wherein information or data is stored about the sound a telephone makes when it rings. Each telephone 3 is also provided with ringing information memory updating means 5, which means 5 are connected to the memory 4, in order to be able to update the content of the memory 4. The memory updating means 5 is connected via the communication link 2 to a database 6, which is present somewhere in the network 1. The database is filled with alternative forms of ringing information such as melodies, songs, sound, soundtracks, speech etcetera. The communication link 2 is connected to means 7 for downloading ... ringing information to the ringing information memory 4.” 3:18-26.</p> <p><i>See also</i> Figure 2 (depicted above in connection with limitation [1b]) and discussion of 3:31-4:17 in element [1c] on flowchart for updating the “ringing information memory.”</p> <p>“[T]he telecommunication device ... is characterised in that there is</p>

	provided ... selection means coupled to the database for selecting user defined forms of ringing information.” 2:27-30; <i>see also</i> 2:1-18 (updating ringing memory with new information).
5. ... wherein the enabling further comprises transmitting the user-defined audio file across a wireless network.	<p>Rizet notes that “it is an object” that “the wishes of each individual owning a telecommunication device can be honoured in a[n] ... individualised way, without expanding hardware or hardware requirements beyond the technical means normally available to an average user. This ... extension can be implemented very simple on for example a personal, mobile, cellular, or cordless telephone....” 1:25-2:16; <i>see also</i> claim 9 (the “device is embodied as a telephone, such as for example a conventional telephone, a cordless telephone, a mobile telephone, a cellular telephone...”). 3:31-4:17 (describing a “connection via telecommunication link 2 to the database 6, usually through a modem”).</p> <p>Figure 1 shows “link 2” between device 3 and “network 1.” The link enters the telephone at the top of Figure 1 at a point distinct from “connector 21” which the device “could contain.” 4:15.</p>
6. ... wherein the enabling is characterized by the use of a telephone call as the incoming communication.	<p>“A telecommunication device is disclosed comprising ... a ringing information memory updating means for updating the ringing information content [with] melodies.” Abstract.</p> <p>“The present invention relates to a telecommunication device comprising a ringing information memory and a ringing information memory updating means coupled to the ringing information memory.” 1:1-3.</p> <p>“Each telephone 3 is provided with a ringing information memory 4, wherein information or data is stored about the sound a telephone makes when it rings. Each telephone 3 [has] ringing information memory updating means 5, which means 5 are connected to the memory 4, in order to be able to update the content of the memory 4. The memory updating means 5 is connected via the communication link 2 to a database 6,. ... link 2 is connected to means 7 for downloading at least one or the alternative forms of ringing information to the ringing information memory 4.” 3:18-26.</p>

With respect to claim 4, while Rizet does not incant the word “Internet,” one


of skill in the art by 1999 would understand Rizet's disclosure of "public databases" accessible by "network" to include transmissions over the (by then) ubiquitous Internet network. Exhibit 1038 ¶ 168.



D. My Nokia Anticipates Or Renders Obvious Claims 1 and 4-6

My Nokia is an internet website that was launched prior to Mr. Shanahan's December 1999 filing date, and permitted users to search, browse, and select a wide variety of ringtones on different locations on the website.³ The "plurality of locations" are the different website URL's that a user may browse to on the My Nokia website. One of skill in the art understands a user can access web pages using an Internet browser and that each web page (URL) generally constitutes a different file or memory location on a computer. Exhibit 1038 ¶ 226.

My Nokia invalidates claims 1 and 4-6 as indicated below. *See also id.* ¶¶ 219-245.

³ Petitioners submit copies of the website as archived no later than November 29, 1999 by the Internet Wayback Machine (<http://web.archive.org>). *See* Exhibit 1019. Although the different pages show different archived dates for the My Nokia website, the latest of these dates is November 29, 1999, indicating that the captured pages are indicative of the state of the website on that date. While Petitioners contend that the My Nokia website pages are properly characterized as a single reference that would have been published at least as early as November 29, 1999, Petitioners contend in the alternative that the collection of website printouts renders claims 1 and 4-6 obvious. Since all of these websites are related to the same service, and indeed, interconnected by hyperlinks, it would be obvious to one skilled in the art to combine them. Exhibit 1038 ¶ 220. The pages are intended to work together to provide the My Nokia service. *Id.* Collectively, the website printouts yield the inventions of claims 1 and 4-6.

Claim Element	Where Each Limitation Is Found in My Nokia (Exhibit 1019)
1. A method for programming a user-defined audio file into a telephone comprising:	<p>“Customise your mobile phone with cool new ring tones and graphics!” 0013.</p> <p>“We offer a unique service that lets you personalise your Nokia mobile phone with new musical ring tone melodies” 0017.</p>
[1a] allowing a user to search a plurality of different locations that include audio files;	<p>My Nokia has a plurality of related websites where a user can search for ringtones, including “TV&Movies”; “Popular”; “Classical” and “Others.” As indicated by the underlining at the bottom of the screen image below, each of these “four new sections” are links that take the user to different web pages, and thus constitute a plurality of different locations:</p>  <p>0015.</p> <p>Clicking on the link for “TV Movies” takes the user to this web page: “www.my-nokia.co.uk/ringtones1.html” 0019.</p> <p>Clicking on the link for “Popular” takes the user to this web page: “www.my-nokia.co.uk/ringtones2.html” 0021.</p>
[1b] allowing the user to browse audio files in one of the plurality of different locations that include audio	<p>My Nokia allows the user to browse audio files in one of the plurality of different locations, including for example, browsing ringtone files on each of “TV & Movies”; “Popular”; “Classical” and “Others”:</p>

<p>files;</p>	<div data-bbox="451 239 1351 720">  </div> <p>0019.</p> <div data-bbox="451 779 1336 1243">  </div> <p>0021.</p>
<p>[1c] allowing the user to choose the user-defined audio file from among the browsed audio files; and</p>	<p>The user can choose one of the audio files by clicking on the title on any of the website pages as appearing in the images shown in connection with limitation [1b] above.</p>

One of skill in the art would understand that the presentation of the web pages as shown above in [1b] with the selectable links to audio files would allow

the user to choose one of the offered audio files. The underlining in the title indicates that the title is selectable by the user. Exhibit 1038 ¶ 231.

<p>[1d] enabling the user of the telephone to program at least a portion of the user-defined audio file into the telephone for use as an indicia of an incoming communication</p>	<p>“Customise your mobile phone with cool new ring tones and graphics!” 0013.</p> <p>“We offer a unique service that lets you personalise your Nokia mobile phone with new musical ring tone melodies” 0017.</p> <p>“[Y]our phone must be enabled to receive SMS (text messages). ... In the order form we ask three times for you to check your details, and it is solely your responsibility to ensure you are putting the right phone number. ... If you still get it wrong despite all these reminders, we regret that someone else may receive your order and you will have just purchased them a surprise present!” 0025.</p> <p>“It is in your interest that you check your phone will work before paying for the service. Please look up your phone model, ask your mobile phone dealer if unsure, then see what services are available to you. ... [Y]ou are responsible for ensuring your phone will work with the service before ordering. ...[Y]our phone must be enabled to receive SMS (text messages). ... In the order form we ask three times for you to check your details, and it is solely your responsibility to ensure you are putting the right phone number. ... If you still get it wrong despite all these reminders, we regret that someone else may receive your order and you will have just purchased them a surprise present!” <i>Id.</i></p>
<p>4. ... wherein the enabling further comprises retrieving the user-defined audio file from the Internet.</p>	<p>My Nokia is an internet based ringtone service that is available for access using an internet browser as evidenced by its URL: www.my-nokia.co.uk. Moreover, the pages from which the ringtones are selected are also stored in the internet:</p> <p><i>See, e.g.,</i> “www.my-nokia.co.uk/ringtones1.html” (0019); and “www.my-nokia.co.uk/ringtones2.html” (0021).</p>
<p>5. ...wherein the enabling further</p>	<p>“It is in your interest that you check your phone will work before paying for the service. Please look up your phone model, ask your mobile phone dealer if unsure, then see what services</p>

comprises transmitting the user-defined audio file across a wireless network.	are available to you. ... [Y]ou are responsible for ensuring your phone will work with the service before ordering. ...[Y]our phone must be enabled to receive SMS (text messages). ... In the order form we ask three times for you to check your details, and it is solely your responsibility to ensure you are putting the right phone number. ... If you still get it wrong despite all these reminders, we regret that someone else may receive your order and you will have just purchased them a surprise present!” 0025.
6. ... wherein the enabling is characterized by the use of a telephone call as the incoming communication	<p>“Customise your mobile phone with cool new ring tones and graphics!” 0013.</p> <p>“We offer a unique service that lets you personalise your Nokia mobile phone with new musical ring tone melodies” 0017.</p>

E. JukeBoksi Anticipates or Renders Obvious Claims 1 and 4-6.

JukeBoksi is an internet-based ringtone service that was operational at least as early as early 1999—a year before Mr. Shanahan’s March 2000 filing. Jukeboksi similarly permitted users to search, browse, select, and download ringtones from a variety of different sources.⁴ As with My Nokia, the “plurality of

⁴ Petitioners submit copies of the website as archived no later than February 22, 1999 by the Internet Wayback Machine (<http://web.archive.org>). See Exhibit 1023. Although the different pages show different archived dates for the Jukeboksi website, the latest of these dates is February 22, 1999, indicating that the captured pages are indicative of the state of the website on that date. While Petitioners contend that the three JukeBoksi websites are properly characterized as a single reference, Petitioners contend in the alternative that these three websites render claims 1 and 4-6 obvious. Since all three websites are related to the same service, it would be obvious to one skilled in the art to combine them for use as prior art. Exhibit 1038 ¶ 182. The pages are intended to work together to provide the JukeBoksi service. *Id.*

locations” are the different URL’s (web pages) that the user can access. One of skill in the art would understand that a user can access web pages using an Internet browser and that each of these different web pages (URL) generally constitutes a different file or memory location on a computer. Exhibit 1038 ¶ 191.

JukeBoksi invalidates claims 1 and 4-6 as indicated below. *See also id.* ¶¶ 181-218.

Claim Element	Where Each Limitation Is Found in JukeBoksi (Exhibit 1023)
1. A method for programming a user-defined audio file into a telephone comprising:	<p>“On these pages you can browse ringtones made for certain Nokia GSM-telephones.” 0002. “This is how you upload a song to your own GSM telephone[.]” 0009 (followed by steps to download a ringing tone into your phone).</p> <p>“Radiolinja’s JukeBoksi offers you an opportunity to compose, listen to and upload to your GSM telephone your own and others’ creations as well as ringtones protected by authors’ rights laws you should familiarize yourself with the instructions so you can have your own songs playing on your phone.” 0014.</p>
[1a] allowing a user to search a plurality of different locations that include audio files;	<p>JukeBoksi website offers multiple ways to obtain ringtones for browsing. For example, the site lets a user search by “song name, the composer or the style.” In addition, JukeBoksi displays multiple links (“Lists, lists, lists”), each of which links takes the user to a different web page and provides search results for the user to browse, including for example “the song bank (of unpublished songs)”, “TOPTEN”, “Newest Songs”, “Song name lists”, “Performer lists”, “List of ringtone types”.</p> <p>“1. Browsing Published Songs - You can browse published songs according to the song name, the composer or the style. On the TOPTEN page you will always find the currently most popular songs: it will list the ten most uploaded ringtones in the last week. Lists and even TOPTEN are continuously updated in real time.” 0015.</p>

	<p>“2. The song bank -- In the song bank you will see all the unpublished songs you have saved. You can edit a song by clicking on its name. You will no longer be able to edit published ringtones, as they are deleted from your song bank after publication.” 0016.</p> <p>Lists, lists, lists...</p> <p>Check Finland’s hottest ringtones from the <u>TOPTEN list</u> or browse other ringtone lists:</p> <ul style="list-style-type: none">• <u>Newest songs</u>• <u>Song name lists</u>• <u>Performer lists</u>• <u>List of ringtone types</u> <p>0002.</p> <p>“On this page you will find JukeBoksi' s most popular songs from last week. The list is updated every day. Check the new arrivals and all-time favorites every day! JukeBoksi's 30 most popular songs of this week:” 0008</p> <p>JukeBoksi's 30 most popular songs of this week:</p> <table><tr><th>Name of Song</th><th>Performer</th><th>Style</th><th>ID</th></tr><tr><td>1. <u>X-Files Theme</u></td><td>X-Files</td><td>Theme Song - long</td><td>QYNWLY</td></tr><tr><td>2. <u>Last</u></td><td>Jonna & Erin</td><td>Pop</td><td>LDNJJQ</td></tr><tr><td>3. <u>McGyver</u></td><td>McGyver</td><td>Theme Song - long</td><td>EFFIFY</td></tr><tr><td>4. <u>Benny Hill</u></td><td>Benny Hill</td><td>Joik</td><td>BTHIWB</td></tr><tr><td>5. <u>Let's Ride on a Tandem</u></td><td>Radiolinja</td><td>Theme Song - long</td><td>KKYAS</td></tr><tr><td>6. <u>Blue Ovster Club's h</u></td><td>Yes</td><td>Tango</td><td>AWPETZ</td></tr><tr><td>7. <u>Last</u></td><td>Nylon beat</td><td>Blues</td><td>GZGLKU</td></tr><tr><td>8. <u>Forever</u></td><td>Stratovarius</td><td>Heavy</td><td>RRXFAB</td></tr><tr><td>9. <u>Unforgiven</u></td><td>Metallica</td><td>Heavy</td><td>NQVBNQ</td></tr></table> <p>***</p> <p><i>See also</i> 0009.</p>	Name of Song	Performer	Style	ID	1. <u>X-Files Theme</u>	X-Files	Theme Song - long	QYNWLY	2. <u>Last</u>	Jonna & Erin	Pop	LDNJJQ	3. <u>McGyver</u>	McGyver	Theme Song - long	EFFIFY	4. <u>Benny Hill</u>	Benny Hill	Joik	BTHIWB	5. <u>Let's Ride on a Tandem</u>	Radiolinja	Theme Song - long	KKYAS	6. <u>Blue Ovster Club's h</u>	Yes	Tango	AWPETZ	7. <u>Last</u>	Nylon beat	Blues	GZGLKU	8. <u>Forever</u>	Stratovarius	Heavy	RRXFAB	9. <u>Unforgiven</u>	Metallica	Heavy	NQVBNQ
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3. <u>McGyver</u>	McGyver	Theme Song - long	EFFIFY														
[1d] enabling the user of the telephone to program at least a portion of the user-defined audio	<p>See the “Jukeboksi’s 30 most popular songs of this week” figure in element [1c] above.</p> <p style="text-align: center;">***</p> <p>This is how you upload a song to your own GSM telephone:</p> <ol style="list-style-type: none">1. Listen to the song by clicking on the name of the song.2. Send the ID of the song you chose (e.g., YSKLQW) as a text message to number 1559.3. Wait a minute or so, and your phone will display the text “Ringtone received.”4. Play the song and save it, or delete it. Get more information from the user guide for your phone.																

file into the telephone for use as an indicia of an incoming communication	<p>0008-0009.</p> <p>“2. Loading a published song onto your phone -- Should you want to obtain a song you have found, just send the desired song's ID as found in the ringtone's data, for example SGHTVY, as a text message to number 1559. After a little while you will get an answer and you can listen and save the new ringtone. You can find instructions for saving ringtones in the user guide for your GSM telephone.” 0015.</p> <p>“3. Testing an unpublished song with your phone -- You can get your own unpublished songs for your telephone in the same way: just send the ID of your song that is in the song bank as a text to number 15 59. If you have not yet published your song, it will display only to you. Only after publication will the song name and ID be displayed for all users. Also, getting this song will cost the same as getting the songs already on the list.” <i>Id.</i></p>
4. ...wherein the enabling further comprises retrieving the user-defined audio file from the Internet.	<p>JukeBoksi is a ringtone service that is available for accessed using an internet browser as evidenced by its URL: www.jukeboksi.radiolinja.fi</p> <p>“Note! Advance listening will function best with the Internet Explorer 4.0.1 or Netscape 4.0.5 browsers as well as their newer versions.” <i>Id.</i></p>
5. ... wherein the enabling further comprises transmitting the user-defined audio file across a wireless network.	<p>“2. Loading a published song onto your phone -- Should you want to obtain a song you have found, just send the desired song's ID as found in the ringtone's data, for example SGHTVY, as a text message to number 1559. After a little while you will get an answer and you can listen and save the new ringtone. You can find instructions for saving ringtones in the user guide for your GSM telephone.” <i>Id.</i></p> <p>“The desired ringtone or ‘song’ is obtained for the phone by sending the ringtone's ID (e.g., GHJSDF) as a text message to service number 1559.” 0014.</p>
6. ... wherein the enabling is characterized	<p>“Radiolinja's JukeBoksi offers you an opportunity to compose, listen to and upload to your GSM telephone your own and others' creations as well as ringtones protected by authors' rights laws</p>

by the use of a telephone call as the incoming communication	that have been produced by JukeBoksi's music-playing program, or Harmoni. So you should familiarize yourself with the instructions so you can have your own songs playing on your phone.” <i>Id.</i> <i>See also</i> citations and discussion of how to download a ringtone in connection with limitation [1d] above.
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F. 9110 UM Anticipates Claims 1 and 4-6 of the ‘692 Patent

9110 UM (Exhibit 1031) is the user manual that was sold with the Nokia 9110 telephone and made publicly available on Nokia’s website around February 1, 1999. Exhibit 1026 ¶¶ 4-6; Exhibit 1032 ¶¶ 4-14. The manual has nearly 200 pages of detailed instructions teaching users how to set ringtones for individual callers, as well as how to download audio files and copy them to the sounds folder for use as a ringing tone.

9110 UM teaches that the user can browse, search, and select files from any location on the Internet using an integrated browser and then copy those files for use as a ringing tone. 9110 UM also teaches that the user can use a “Notes” application to browse, search, and select the different files in different folders in the memory of the phone itself. These different folders can contain ringing tones.

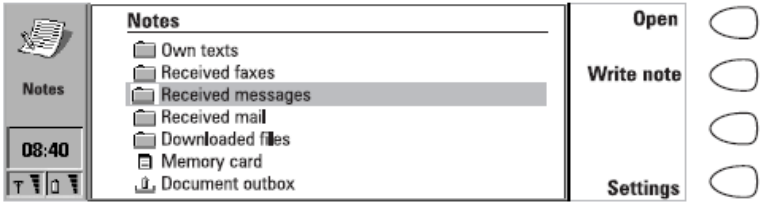
Thus, for 9110 UM, the “plurality of locations” element is met in at least 2 separate ways: (1) multiple locations on the Internet containing audio files; (2) at least one location in the directories (memory) on the phone and at least one location on the Internet. Exhibit 1038 ¶ 261.

9110 UM invalidates claims 1 and 4-6 as indicated below. *See also id.* ¶¶


246-302.

Claim Element	Where Each Limitation Is Found in Nokia 9110 UM (Exhibit 1031)
1. A method for programming a user-defined audio file into a telephone comprising:	<p>UM discloses programming a user-defined audio file (e.g., a “.WAV” file) into a telephone to be used as a “ringing tone”:</p> <p>“The Nokia 9110 is a ... wireless phone, messaging device, access terminal” 0011; Figure 1.</p> <p>UM teaches how additional ringing tones can be stored in a “sounds” folder where the user can select them as a ringing tone.</p> <p>“When you press the Menu button in an opened folder, the following options become available: ... <i>Copy to sounds</i> – You can add the selected tune to the list of ringing tones.” 0110.</p> <p>“<i>Default ringing tone</i> – You can select one of the tones in the pop-up box.” 0123; 0133.</p>
[1a] allowing a user to search a plurality of different locations that include audio files;	<p>UM discloses that the 9110 has an Internet browser called the “WWW application” that allows a user to search a plurality of different websites (e.g., websites operated by Nokia and operated by “selected providers in your country”) to obtain “Internet services” from a plurality of “selected providers in your country.” The UM discloses using this browser to download audio files into a folder called “downloaded files” on the 9110:</p> <p>“Internet applications ... World Wide Web (WWW) -- A hypertext-based system for finding and accessing resources on the Internet.” 0083. “The Nokia 9110 Communicator supports HTML 3.2...” 0095</p> <p>UM provides detailed instructions on how to use the web browser on the 9110 to navigate the world wide web. <i>See, e.g.</i>, 0099-0102 (the section is entitled “To navigate in WWW”).</p> <p>“You can subscribe to the Internet services of selected providers in your country ... When the connection has been made, follow the instructions on the display to select a service provider and to subscribe to their Internet services.” 0084.</p>

	<p>“With Text Web you can fetch information from the Internet, using SMS. ... You can also access services provided by your network operator and Nokia.” 0107.</p> <p>“To fetch a WWW page 1) Select an entry in the Bookmarks list or enter a URL in the address field. 2. Press Go. Tip: To fetch WWW pages stored in the Own texts or Downloaded files folders of the communicator or the memory card, use the prefix Error! Hyperlink reference not valid. (note: three slashes) instead of Error! Hyperlink reference not valid. ” 0096.</p> <p>“A WWW page may contain hotspots, such as selection lists, text entry fields, and reset /submit buttons, which enable you to input information into the World Wide Web.” 0175.</p> <p>“After the WWW page has been fetched, the following commands become available: ... Saves the page contents or the image to the Downloaded files folder.” 0109-0101.</p> <p>Moreover, the web browser allows a user to search the contents of the website using the “Find” function:</p> <p>“When you have a WWW page open and you press the Menu button, the following options become available: ... <i>Find</i> – You can search for various items, such as words in the WWW page” 0100.</p>
[1b] allowing the user to browse audio files in one of the plurality of different locations that include audio files;	<p>UM discloses an internet browser called the “WWW application” which allows the user to browse audio files on a website:</p> <p>“Internet applications ... World Wide Web (WWW) -- A hypertext-based system for finding and accessing resources on the Internet.” 0083. “The Nokia 9110 ... supports HTML 3.2...” 0095.</p> <p>UM provides detailed instructions on how to use the web browser on the 9110 to navigate the WWW. <i>E.g.</i>, 0099-0102 (section entitled “To navigate in WWW”). “When you have a WWW page open and you press the Menu button, the following options become available: ... <i>Find</i> – You can search for various items, such as words in the WWW page” 0100.</p> <p>UM also teaches how to access “Operator services” from “network operators”: “With Text Web you can fetch information</p>

	<p>from the Internet, using SMS. You can also access services provided by your network operator and Nokia... Operator services allows the network operator to provide various services to the subscribers... To use the browser – Press the arrow keys on the keyboard to move from one hotspot to another. To follow a hyperlink, press Fetch.” 0107.</p> <p>See also the display screen and keys that are designed for navigating the web in Figure 5. 0025.</p> <p>Using the Notes application, the user can visually manage folders and store downloaded files first to the “downloaded files” folder and then copy them to the “sounds” folder for use as a ringtone.</p> <p>“Notes is used for ... managing various documents stored in the communicator. Note: When you open a document, the document is opened in the appropriate editor or viewer. The available commands vary according to the editor/viewer.” 0109</p> <p>“Folders in the Notes main view are: ... Downloaded files – Documents downloaded with the Internet applications.” <i>Id.</i> with Figure 1 (below):</p>  <p style="text-align: center;"><i>Figure 1</i></p> <p>“When you press the Menu button in an opened folder, the following options become available: <i>Copy to sounds</i> – You can add the selected tune to the list of ringing tones.” 0110.</p> <p>“A WWW page may contain hotspots, such as selection lists, text entry fields, and reset /submit buttons, which enable you to input information into the World Wide Web.” 0175.</p>
<p>[1c] allowing the user to choose the user-defined audio file from among the</p>	<p>UM teaches a telephone that includes a web browser that allows a user to select audio files (e.g., using the Fetch key, “Save option” or using the Change key to tick off selection boxes) an audio file on a website to download into the “Downloaded files” folder.</p>

<p>browsed audio files; and</p>	<p>“To fetch a WWW page 1) Select an entry in the Bookmarks list or enter a URL in the address field...” 0096.</p> <p>“[U]se the arrow keys to scroll the view and to choose hyperlinks and hotspots. Each arrow key press selects the nearest hyperlink or hotspot, or moves the view one line up or down. See Figure 8[.]” 0099; Figure 8.</p> <p>The web browser allows a user to save the contents using the “Save” function: “When you have a WWW page open and you press the Menu button, the following options become available: ... Save –Saves the page contents or the image to the Downloaded files folder, or adds the address to the page of the Bookmarks list.” 0100.</p> <p>“To use the browser – Press the arrow keys on the keyboard to move from one hotspot to another. To follow a hyperlink, press Fetch.” 0107.</p> <p>As discussed in connection with element [1b], the user can save files off the Internet to the “Downloaded files” folder and then browse those folders and choose items using the Notes applications. 0109-0110.</p> <p>See 0175 for “hotspots, such as selection lists.”</p>
<p>[1d] enabling the user of the telephone to program at least a portion of the user-defined audio file into the telephone for use as an indicia of an incoming communication</p>	<p>UM teaches how a user can program the phone to use a particular ringing tone to indicate an incoming phone call by copying a file to the sounds folder after it has been downloaded into the “downloaded files” folder.</p> <p>As discussed in connection with element [1b], the user can save files off the Internet to the “Downloaded files” folder and then browse those folders and choose items using the Notes applications. 0109-0110.</p> <p>The user may copy the downloaded files to the sounds directory.</p> <p>“When you press the Menu button in an opened folder, the following options become available: ... <i>Copy to sounds</i> – You can add the selected tune to the list of ringing tones.” 0110.</p> <p>UM teaches how an audio file in the sounds folder is assigned and used as a ringing tone to a contact stored as a contact card.</p>

	<p>“Contact card options – When you press Options in an opened contact card, the following options become available: <i>Ringling tone</i> – You can set a specific ringing tone for each contact in the Contracts directory. Select a tone from the list and press Select. The  icon appears at the top of the contract card. See Figure 2.” 0052.</p>
4. ... wherein the enabling further comprises retrieving the user-defined audio file from the Internet.	<p>UM discloses retrieving audio files from the internet.</p> <p>See the discussions in elements [1a – 1d] above regarding “subscrib[ing] to Internet services,” using the “Internet application” (0084) to browse, select, and download files from the “WWW” into the “Downloaded files” directory and then using the “Copy to sounds – You can add the selected tune to the list of ringing tones.” 0109-0110.</p> <p><i>See also</i> 0083-0084; 0095-0099; 0100; 0107; 0109-0110.</p>
5. ... wherein the enabling further comprises transmitting the user-defined audio file across a wireless network.	<p>UM teaches that the 9110 is a wireless communicator can receive an audio file that was transmitted using cellular technology:</p> <p>“Facts about cellular data transmission – The Nokia 9110 Communicator employs the data transmission capabilities of the GSM network to send ... messages ... and to establish connections with remote computers. Cellular data connections can be made from most locations....” 0014.</p> <p>The 9110 displays an icon when there is an active communication link. 0023.</p> <p>“About a minute after the text is sent, your phone will display a message about the received new ringtone....” 0015.</p>
6. ...wherein the enabling is characterized by the use of a telephone call as the incoming communication	<p>As discussed above in connection with limitation [1d], UM teaches how a user of a telephone can copy a downloaded file into the sounds folder (“copy to sounds”) so that the file is available for selection and assignment as a ringing tone, using for example the “contact card options” which allows the user to select a ringing tone for each contact. 0052. <i>See also</i> 0064 (“Ringling tone — Determines the ringing tone.”); 0123 (“Default ringing tone — You can select one of the tones in the pop-up box”); 0140, 0142, 0148.</p>

G. 9110 UM Combined With 9110 Documents Render Obvious Claims 1 and 4-6

The prior section shows that **9110 UM** invalidates claims 1 and 4-6 via multiple locations on the Internet. More Nokia publicly-distributed publications (the “**9110 Documents**”) confirm the invalidity of claims 1 and 4-6.

9110 Documents are not cumulative to **9110 UM** for at least four reasons. First, **9110 Documents** describe another location (file directories on the user’s PC) which a user may search, browse, and select WAV audio files for programming as ringtones. This location provides additional support for meeting the claim 1 term “plurality of locations.” Second, **9110 Documents** expressly state “WAV files can be downloaded from the Internet ... The WAV files can also be used as ringtones.” See Exhibit 1033 at 0004. This relates to all the claim elements in all 4 disputed claims. Third, **9110 Documents** describe another “wireless network” (an IR network) over which the audio files are transmitted which relates to the “wireless network” in claim 5. Exhibit 1035 at 0094. Fourth, the **9110 UM** more explicitly discloses programming audio files as ringtones (claim 1) and transmitting files over the Internet (claim 4).

The **9110 Documents** are: (1) the **9110 FAQ (Exhibit 1033)** webpage from May 8, 1999; (2) the **9110 PC Suite (Exhibit 1035)** manual distributed with the 9110 in 1999; (3) **9110 CD Listing (Exhibit 1034)** showing the two directories on

the CD that included WAV audio files; and (4) **9110 WAV Converter (Exhibit 1036)** teaching that the “converted sound file can be used as a ringing tone” after “[t]ransferring the Wav file to the Nokia 9110 Communicator using the PC Suite Connectivity Software.”

These references cite each other. The **9110 FAQ** recites “a free Windows backup and synchronisation package” (**9110 PC Suite**) (Exhibit 1033 at 0001) and the “set of WAV files can be found on the CDROM in the sales package” (files on the **9110 CD Listing**) (*Id.* at 0004). The **9110 WAV Converter** references WAV files on the PC (Exhibit 1036 at 0001) and the **9110 PC Suite** (“[t]ransfer[ring] the Wav file to the Nokia 9110 Communicator using the PC Suite Connectivity Software”) (*Id.* at 0003). The **9110 CD Listing** shows the directories with WAV files, **9110 UM**, and the **9110 PC Suite**. Exhibit 1034 at 0005, 0010, 0014-18. The **9110 UM** discusses the CD (**9110 CD Listing**) and the **9110 PC Suite**. Exhibit 1031 at 0017 and 0035.

Because **9110 UM** and **9110 Documents** all relate to the same product, were all intended to publicly distribute information about that product, and were all distributed by the same company in the same year (1999), one of skill in the art would combine these references. Exhibit 1038 ¶¶ 306-307. The level of cross-referencing confirms that one would combine the references. *Id.* ¶ 307.

9110 Documents teach the ability of a user to search different locations

(multiple directories on PC including multiple directories of WAV audio files provided by Nokia), browse those locations, select a file, and program that file as ringtone using an IR network to download to the phone. *Id.* ¶ 308.

Thus, the “plurality of locations” element is met in at least 5 separate ways: (1) multiple locations on the Internet containing audio files; (2) multiple locations on the PC containing audio files such as the multiple directories on the CD with WAV files; (3) at least one location on the Internet and one location on the PC; (4) at least one location in the directories (memory) on the phone and one location on the Internet; and (5) at least one location in the directories (memory) on the phone and one location on the PC. *Id.* ¶ 314.

The chart below shows where **9110 Documents** disclose each element in claims 1 and 4-6, and should be combined with the citations for **9110 UM** above. *See also id.* ¶¶ 303-340.

Claim Element	Where Each Limitation Is Found in 9110 Documents
1. A method for programming a user-defined audio file into a telephone comprising:	<p>9110 Documents discloses a method for programming a user-defined audio file (e.g., a “.WAV” file) into a telephone which can be used as a “ringing tone”:</p> <p>9110 FAQ: “Audio files (WAV files as ringtones)” and “WAV files can be downloaded from the Internet ... The WAV files can also be used as ringtones. A set of WAV files can be found on the CDROM in the sales package.” Exhibit 1033 at 0002, 0004.</p>
[1a] allowing a user to search a plurality of	9110 Documents discloses searching a plurality of locations that include audio files (the two directories with WAV files provided

<p>different locations that include audio files;</p>	<p>on the CD with the 9110 and/or other directories on the PC).</p> <p>9110 FAQ: “Audio files (WAV files as ringtones)” and “The WAV files can also be used as ringtones. A set of WAV files can be found on the CDRom in the sales package.” <i>Id.</i></p> <p>9110 CD Listing: Exhibit 1032 ¶¶ 4-12, 16 and Exhibit B thereto (showing listing with two directories containing .WAV files on the CD publicly distributed with the 9110 in 1999).</p> <p>9110 PC Suite teaches “The PC Suite File Transfer functions let you move, copy paste, rename, and delete Nokia 9110 Communicator and PC files and folders in a familiar Windows Explorer-type environment.” Exhibit 1035 at 0094. “Connect your communicator to your PC COM port or establish an infrared connection.” <i>Id.</i></p> <p>9110 WAV Converter: The WAV converter runs on a PC. Exhibit 1036 at 0001. The input and output are files on the PC and the user would “click Open [and] Type or select the name of the Wav file.” <i>Id.</i> at 0002-0003. “The converted sound file can be used as a ringing tone.” <i>Id.</i> at 0001. A six step process ending with “5. Type or select the name for the converted Wav file. 6. Transfer the Wav file to the Nokia 9110 Communicator using the PC Suite Connectivity Software.” <i>Id.</i> at 0003.</p>
<p>[1b] allowing the user to browse audio files in one of the plurality of different locations that include audio files;</p>	<p>9110 Documents discloses the user can browse using either the PC Suite or the WAV Converter.</p> <p>9110 PC Suite allows the user to browse in the different locations discussed in [1a] by providing a list of files (which can include the audio files discussed in [1a]) in the “File Transfer Window Panes” which shows “[d]rives and folders for both the Nokia 9110 Communicator and your PC. . . .” Exhibit 1035 at 0095. See the “File Transfer Window” figure on page 0094.</p> <p>9110 WAV Converter permits browsing audio files by “click Open [and] Type or select the name of the Wav file.” Exhibit 1036 at 0002-0003. “The converted sound file can be used as a ringing tone.” <i>Id.</i> at 0001. A six step process ending with “5. Type or select the name for the converted Wav file. 6. Transfer the Wav file to the Nokia 9110 Communicator using the PC Suite</p>

	Connectivity Software.” <i>Id.</i> at 0003.
[1c] allowing the user to choose the user-defined audio file from among the browsed audio files; and	<p>9110 Documents teaches a user choosing.</p> <p>9110 PC Suite: “Standard Windows file selection methods are used to select files or folders in the File Transfer screen. You can select an item by clicking on it with your mouse ...Files and folders may be copied in the File Transfer window ... select the item(s) you want to copy” Exhibit 1035 at 0095. <i>See also</i> 0096 (“2. In either pane, select the item (or items) you want to cut.”).</p> <p>9110 WAV Converter: a user selects audio files by “click Open [and] Type or select the name of the Wav file.” Exhibit 1036 at 0002-0003. “The converted sound file can be used as a ringing tone.” <i>Id.</i> at 0001. A six step process ending with “5. Type or select the name for the converted Wav file. 6. Transfer the Wav file to the Nokia 9110 Communicator using the PC Suite Connectivity Software.” <i>Id.</i> at 0003.</p>
[1d] enabling the user of the telephone to program at least a portion of the user-defined audio file into the telephone for use as an indicia of an incoming communication	<p><i>See</i> the discussions in elements [1a – 1d] above in 9110 UM.</p> <p>9110 PC Suite: “Ringing tone The individual ringing tone set for the contact in the Nokia 9110 Communicator.” Exhibit 1035 at 0027. <i>See also</i> 0022-0025 and 0036-0039 on syncing contact cards that including ringing tones for the individual contacts.</p> <p>9110 FAQ: “Audio files (WAV files as ringtones)” and “The WAV files can also be used as ringtones. A set of WAV files can be found on the CDROM in the sales package.” Exhibit 1033 at 0002, 0004.</p> <p>9110 WAV Converter “The converted sound file can be used as a ringing tone.” Exhibit 1036 at 0001.</p>

One of skill in the art would understand that the 9110 Documents teach the ability to search, browse and select any file on the PC. This would include the ability to select WAV files on the PC (including WAV files referenced in 9110 WAV Converter) as well as the WAV files that came on the CD (inserted into the

PC) with the 9110. Exhibit 1038 ¶ 315. 9110 WAV Converter teaches that the “converted sound file can be used as a ringing tone” after the user “[t]ransfer[s] the Wav file to the Nokia 9110 Communicator using the PC Suite Connectivity Software” (which is described in PC Suite). Exhibit 1036 at 0001, 0003.

4. ... wherein the enabling further comprises retrieving the user-defined audio file from the Internet.	9110 FAQ: “WAV files can be downloaded from the Internet ... The WAV files can also be used as ringtones. A set of WAV files can be found on the CDROM in the sales package.” Exhibit 1033 at 0004. <i>See</i> elements [1a – 1d] above in 9110 UM .
5. ... wherein the enabling further comprises transmitting the user-defined audio file across a wireless network.	9110 PC Suite teaches “The PC Suite File Transfer functions let you move, copy, paste, ... Nokia 9110 Communicator and PC files and folders” Exhibit 1035 at 0094. “Connect your communicator to your PC COM port or establish an infrared connection.” <i>Id.</i>
6. ... wherein the enabling is characterized by the use of a telephone call as the incoming communication	9110 FAQ: “Audio files (WAV files as ringtones)” and “The WAV files can also be used as ringtones. A set of WAV files can be found on the CDROM in the sales package.” Exhibit 1033 at 0002, 0004.

H. Claims 1 and 4-6 Are Obvious in view of Nokia 9110 UM in Combination with My Nokia.

Nokia 9110 UM teaches a phone that includes a web browser that can allow a user to “subscribe to the Internet services of selected providers in your country directly with your Nokia 9110 Communicator,” (Exhibit 1031 at 0084) as well as “access[ing] services provided by your network operator and Nokia.” *Id.* at 0107.

My Nokia is one such ringtone service provider that was operational at least

as early as November 1999. See Exhibit 1019 ¶¶ 7-11, 13-14 and 0008-9. The My Nokia services were expressly intended for use with Nokia phones. Based on the teachings in 9110 UM, one of skill in the art would have considered accessing the My Nokia website using the web browser on the 9110 in order to download files exactly as taught by 9110 UM. Exhibit 1038 ¶ 341.

The MyNokia website had multiple webpages with ringtones, including, for example: (a) “TV&Movies” (“www.my-nokia.co.uk/ringtones1.html”); (b) “Popular” (“www.my-nokia.co.uk/ringtones2.html”); (c) “Classical” (“www.my-nokia.co.uk/ringtones3.html”) and (d) “Others” (“www.my-nokia.co.uk/ringtones1.html”). Clicking on any of these links would take the user to a different web page, where the user would be presented with a different list of ringtones for downloading. Two examples from Exhibit 1019 are shown below:



Using the Nokia 9110 phone as described in the 9110 UM to access the My

Nokia website to visit each of the “Popular” “TV and Movies” websites would constitute searching two different locations to obtain a list of ringtones, satisfying the search limitation using the broadest reasonable interpretation. Moreover, using the “Find” function described above in connection with limitation [1a], a user could search each of the two lists (i.e., the list of TV & Movie themes *and* the list of Popular songs), would also satisfy “searching” a plurality of locations.

If “search” is construed more narrowly so as to require searching two unrelated locations, then searching the My Nokia website (as described in the preceding paragraph) would constitute searching a first location. *Id.* ¶ 343. While My Nokia teaches at least one such website for downloading ringtones, it would be obvious to one skilled in the art to utilize additional websites offering similar ringtone services, including for example, the websites of operators as described in the 9110 UM, and the Nokia 9110 would be able to access such other websites via the internet and search for ringtones in the same fashion described above. *Id.*

I. The Cited Bases Are Not Cumulative

The Board should not find any of the grounds to be cumulative, as each ground addresses different arguments that Solocron may make. For example, Solocron may seek to swear behind certain references such as the “My Nokia” website. Petitioners should be permitted to respond to such attempts because it seems impossible for the inventor to prove diligence as discussed above.

Similarly, it is unclear what claim constructions Solocron might seek to use and different references have different strengths. For example, on the “search” step, if Solocron seeks to restrict the claims to some (as yet unstated) particular type search (which is not in the ‘692 patent), then the websites explicitly show functionality (via links and different lists) that the other references may not. Alanara and Rizet show guided menus used to search while the 9110 UM includes the “find” feature typically on browsers which allows a user to search a web page.

For “plurality of locations,” if Solocron seeks to impose a limit that these are different websites (as opposed to different URL’s on the same site), then the 9110 UM (which accesses *any* website) discloses this expressly. Similarly, both Alanara (“different operators” websites and different URL’s) and Rizet (“a database can comprise one or more remotely situated database”) show multiple locations but it is not clear how Solocron will construe that term.

9110 UM and 9110 Documents are not cumulative to any of the other references because they describe multiple different methods for browsing, selecting, and downloading ringtones. 9110 UM discloses a wireless phone with a generic Internet browser that can search, browse, select, download and program ringtones from *any* websites. Similarly 9110 UM discloses the use of .WAV files as ringtones—which is one of the identified formats identified in the ‘692 patent.

VII. CONCLUSION

For all of the foregoing reasons, *inter partes* review of claims 1 and 4-6 of the '692 patent is respectfully requested.

Respectfully submitted,
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**CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105(A)**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that, on the 5th day of December, 2014, a complete and entire copy of this Petition for *Inter Partes* Review, together with all supporting exhibits, was provided to the Patent Owner by mailing a copy of the same via FedEx® to the following attorneys of record for the Patent Owner:

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