

## THE GREAT PODCAST PATENT TROLL CONTROVERSY

By Debbie Seeger (2023 Edition)

Generations of Americans have been raised on the now-(almost) primitive medium of radio. Just over 100 years ago, radio broadcasts reached the masses, albeit on large consoles that resided in a home's living room, where today we typically place a large flat-screen television, equipped with devices that allow access to cable television, digital video discs, and internet streaming applications.

In the 1950s, a new version of the radio was introduced: the transistor. Radio broadcasts were now portable. Early models weren't powerful, but the compact size still made them popular among consumers.

The first car radios became standard in vehicles in the 1960s. Soon after, these stereos could play cassette tapes, so the consumer could choose the music they wanted to listen to in the car. Auto stereo systems would also change with the times, accommodating future listening media.

In the 1980s, consumers had affordable radios at home and could even transport a compact stereo system: the boom box. Radio stations and cassette tapes could go with the listener almost anywhere, but there were still some disadvantages: cassettes or the boom box itself could get lost or damaged if the user wasn't careful. Another portable audio device would arrive on the market: a personal AM/FM/cassette player that included headphones for private listening enjoyment. In the mid- to late-1980s, digital audio had become available in the form of compact discs and CD players, some of which were also portable (e.g., the Discman.) The CD would remain a widely used home and car audio format for approximately two decades.

Enter the World Wide Web. In the late 1990s, the Internet would allow users to download music digitally onto their home computers. Apple's iTunes music media library was introduced in 2001. Not only could the user organize their digital music collection, but there would eventually be a plethora of streaming internet radio stations available for the listener. A new medium accompanied this technology: the podcast.

A podcast is a specialty talk radio-style or music audio program which doesn't necessarily need to comply with FCC radio regulations. Podcasts are searchable via the web, iTunes, and podcast catcher apps. They allow hosts without a terrestrial syndicated radio job to be heard, usually at no cost to the listener. Podcasts were added to the iTunes menu in 2005. Now a listener could do away with that bulky Walkman or Discman — where your battery power could die without a moment's notice — and carry an even more compact MP3 player or, eventually, a smartphone that could store music, audio books, and internet broadcasts. These devices could easily be used on the bus, subway, at the gym, almost anywhere. In the 2020s, it's difficult to imagine a world without portable digital audio!

In 2013, Personal Audio LLC attempted to revert listeners to the time where there weren't so many digital listening options. The company, which rents out an empty office in Texas, is what is known as a *patent troll* (also referred to as a *patent mill*.) A patent troll is a person or entity that purchases vague patents, which could sit idle for a time, and may later enforce patent rights by hunting down individuals they feel are infringing on patent laws so they can collect licensing fees. Personal Audio doesn't provide a tangible good or service, as their patents represent an *idea* instead of a specific product. Jim Logan of Personal Audio feels that even though his company didn't create iTunes, his patents function as a "roadmap": directions on how to create MP3 players and podcasts.

Logan imagined a device in the mid-1990s that would be capable of using the internet to download an individual's preferred content. He attempted to create what would now be the MP3 player but was unable to market it at the time. Instead, Personal Audio proposed a service where the user could choose newspaper and magazine articles of interest and receive — wait for it — a cassette tape of the articles being read aloud to the listener.

This technology wasn't exactly cutting edge, even in 1996 when Logan received his patent. In fact, he forgot about the patent until 2007, when his attorney discovered iTunes and believed the ability to create playlists infringed upon the Personal Audio patent.

Personal Audio sued Apple in 2009 over infringement of their 6,199,076 and 7,509,178 patents. The trolls were rewarded \$8.5 million based on the first patent

for an “audio program player including a dynamic program selection controller.” Following appeals by both Apple and Personal Audio, a private settlement was reached.

Logan wasn't finished yet; he filed a second lawsuit against Apple based on Personal Audio's 2009 patent, U.S. 7,509,178 B2, in August 2011. Attempting to be awarded additional damages regarding playback devices such as the iPod, iPhone and iPad, the suit was denied by U.S. District Judge Ron Clark. In September 2011, Personal Audio even filed infringement suits on their U.S. 6,199,076 B1 patent to other tech companies that market electronics with playlist functions. As a result, companies such as Sirius XM Radio, Samsung, Motorola, and Amazon entered licensing agreements with Personal Audio.

In October 2011, Personal Audio went after Apple for a third time, with hopes that the iOS 5's device-to-iTunes computer technology would be considered infringement upon their U.S. 7,509,178 B2 patent. The two companies would reach a private settlement in December 2011 ending the Personal Audio/Apple legal battle for good.

U.S. Patent 8,112,504 B2, the 2012 update of Personal Audio's patents, was the basis for lawsuits filed against individual podcasters in early 2013. This patent was published for “a system for disseminating media content representing episodes in a serialized sequence.”

Leading podcaster Adam Carolla was one of the hosts sued for patent infringement by Personal Audio LLC. Carolla appeared on Episode 476 of Marc Maron's popular WTF podcast on March 6, 2014 to discuss his plight with the patent mill. Maron was also one of the podcasters contacted by Personal Audio regarding the podcast patent issue. The podcast community was not pleased, as a lawsuit could have been very costly and forced podcasters to charge listeners for their broadcasts or close shop. Carolla even set up a successful fundanything.com campaign in 2014 to raise money for legal expenses.

The White House was aware of these patent mills. The Executive branch of the U.S. government stated that patent trolls were attempting to hijack an idea and claim it for themselves. In June 2013, then-President Obama issued five executive orders and seven legislative recommendations to aid in making the patent system more effective and decrease frivolous lawsuits.

It was apparent that podcasters and their listeners were dedicated to fighting the good fight. Personal Audio thought they had a case, but they didn't really have a pulpit to stand on. Beloved podcasters had soapboxes in their broadcasts. Personal Audio hoped the podcast community wouldn't be able to afford litigation, but they were deceived. Podcast listeners remain a loyal bunch, dedicated to keeping free podcasting alive.

As if the patent infringement lawsuits and threats to podcasters weren't enough, Personal Audio even attempted to seek private information on monetary donors to the Electronic Frontier Foundation ([www.eff.org](http://www.eff.org)), an organization dedicated to defending rights in the digital world. Fortunately, on March 31, 2014, United States Magistrate Judge Nathaniel Cousins granted the EFF's motion to quash (void or suppress) Personal Audio's request for EFF donor information.

Even more hope was on the horizon. In April 2015, the Patent Trial and Appeal Board (PTAB) invalidated the podcast patent's claims. The patent expired in 2016, but by that time Personal Audio had filed an appeal to the Eastern Texas Federal Circuit Court. The statute of limitations for patents is six years, so Personal Audio could still sue podcasters broadcasting before the patent's expiration date. However, the Federal Circuit struck down the patent mill's claims on August 7, 2017. On May 14, 2018, the U.S. Supreme Court upheld the PTAB's ruling and the battle against Personal Audio's podcast patent claims was finally over.

No one owns a patent on podcasts. It is a media format that has slowly evolved over a period of about 20 years. Podcasts are the epitome of free speech; broadcasters can say whatever they want, uncensored, to an audience that has abandoned conventional terrestrial radio. Thanks to the actions of dedicated podcasters and their listeners, the fight to access free podcasts was won.

*Update: In September 2023, Personal Audio attempted to sue Google, stating that the Google Play Music application infringes on its U.S. 6,199,076 and 7,509,178 audio playback patents. The jury initially awarded Personal Audio \$15.1 million, but the verdict was reversed due to lack of sufficient evidence.*

Relevant articles at eff.org:

<https://www.eff.org/deeplinks/2013/02/podcasting-community-faces-patent-troll-threat-eff-wants-help>

<https://www.eff.org/deeplinks/2014/01/eff-fights-patent-troll-demand-eff-podcast-donor-information>

<https://www.eff.org/deeplinks/2014/03/patent-reform-we-need-see-senate>

<https://www.eff.org/deeplinks/2018/05/eff-wins-final-victory-over-podcasting-patent>

Source articles:

<http://arstechnica.com/tech-policy/2014/03/eff-goes-to-court-quashes-patent-trolls-attempt-to-grab-donor-names/>

<http://www.economist.com/blogs/babbage/2014/03/intellectual-property>

<http://popwatch.ew.com/2013/06/07/podcasts-patent-controversy/>

<http://9to5mac.com/2013/01/10/patent-troll-personal-audio-llc-sues-itunes-top-podcaster-adam-carollas-ace-broadcasting/>

<http://www.backstage.com/news/podcasters-prepare-war-against-podcast-patent-owner-personal-audio/>

<http://www.current.org/2013/02/company-claiming-patent-infringement-targets-podcasters/>

<http://arstechnica.com/tech-policy/2014/01/podcasting-patent-trolls-ceo-explains-why-it-wants-eff-donor-names/>

<https://law.justia.com/cases/federal/district-courts/delaware/dedce/1:2017cv01751/63885/884/>

<https://news.bloomberglaw.com/ip-law/google-wins-reversal-of-15-million-audio-patents-jury-verdict>