

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

PROMPTU SYSTEMS CORP.
Patent Owner.

Case CBM2018-00033
Patent 7,047,196 B2

Before JAMESON LEE, KARL D. EASTHOM, and
ALEX S. YAP, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION
Denying Institution of Covered Business Method Patent Review
35 U.S.C. § 324

I. INTRODUCTION

Petitioner, Comcast Cable Communications, LLC., filed a Petition (Paper 1, “Pet.”) seeking a covered business method (“CBM”) patent review of U.S. Patent No. 7,047,196 B2 (Ex. 1001, the “’196 patent”), pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”).¹ Petitioner challenges claims 14–52 of the ’196 patent. Pet. 1. Patent Owner, Promptu Systems Corp., filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

For the following reasons, we exercise our discretion under 35 U.S.C. § 324(a) to deny the Petition.

A. The ’196 Patent

The ’196 patent, titled “System and Method of Voice Recognition Near a Wireline Node of a Network Supporting Cable Television and/or Video Delivery,” issued on May 16, 2006. Ex. 1001, [45]. The ’196 patent generally relates to a “method and system of speech recognition presented by a back channel from multiple user sites within a network.” *Id.* at Abstract.

B. Related Cases

Petitioner previously filed two *inter partes* petitions challenging the ’196 patent: *Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00344, Paper 1 (PTAB Dec. 19, 2017) (Paper 1, the “’344 Pet.” or “’344 Petition”) and *Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00345 (PTAB Dec. 19, 2017) (Paper 1, the “’345 Pet.” or the “’345 Petition”). The Board instituted an *inter partes* review in each

¹ Pub. L. No. 112-29, 125 Stat. 284 (2011); *see also id.* at 329–31 (providing that the transitional program for covered business method patents will be regarded as a post-grant review under Chapter 32 of Title 35 of the United States Code, and will employ the standards and procedures of a post-grant review, subject to certain exceptions).

proceeding. IPR2018-00344 (the “’344 IPR”), Paper 10 (the “’344 Inst. Dec.”) (instituting on challenged claims 1, 2, 4–6, 12, 13, 27, 28, 30–32, and 38–42); IPR2018-00345 (the “’345 IPR”), Paper 10, (the “’345 Inst. Dec.”) (instituting on challenged claims 14, 15, 17–19, 25, 26, 53–55, 61, 62, and 64–66). The parties identify other matters related to the ’196 patent, including other PTAB proceedings and infringement litigation in Federal District Court. Pet. vii.; Prelim. Resp. 6–7; Paper 4, 2–3. The instant Decision issues concurrently with *Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.*, Case CBM2018-00034 (the “’034 CBM”).

C. Asserted Ground of Unpatentability

Petitioner contends claims 14–52 of the ’196 patent are unpatentable under three different theories. See Pet. 3–4, 30 n.7. Under one theory, Petitioner contends the challenged claims recite a means-plus-function term (“program steps”), and the ’196 patent does not disclose sufficient corresponding structure under 35 U.S.C. § 112, ¶ 6, thereby rendering the challenged claims indefinite under 35 U.S.C. § 112, ¶ 2. Pet. 3. Under a second theory, Petitioner contends each challenged claim recites “both a system and method of using that system in the same claim,” rendering the challenged claims indefinite under 35 U.S.C. § 112, ¶ 2. Pet. 3–4. Under a third theory, Petitioner asserts that even if “program steps” “were not subject to Section 112 ¶ 6, then the claims would be invalid for violating the rule against functional claiming of an apparatus element.” Pet. 30 n.7 (emphasis

omitted) (citing *Halliburton Energy Servs. v. M-I LLC*, 514 F.3d 1244, 1246 (Fed. Cir. 2008)).

D. Challenged Claims

Independent challenged claims 14 and 27, collectively from which all of the remaining challenged claims depend, follow:

14. A program system controlling at least part of a speech recognition system coupled to a wireline node in a network, said program system *comprising the program steps of:*

processing a multiplicity of received identified speech channels to create a multiplicity of identified speech content; and

responding to said identified speech content to create an identified speech content response that is unique to each of said multiplicity of identified speech contents;

wherein said speech recognition system is provided said multiplicity of received identified speech channels based upon a received back channel at said wireline node from a multiplicity of user sites coupled to said network;

wherein said at least one computer communicatively couples through said wireline node to said multiplicity of user sites; and

wherein said network supports at least one of the collection comprising: cable television delivery to said multiplicity of user sites; and video delivery to said multiplicity of user sites.

Ex. 1001, 50:65–53:21 (emphasis added).

27. A system supporting speech recognition in a network, said system comprising:

a speech recognition system coupled to a wireline node in said network for receiving a back channel from a multiplicity of user sites coupled to said network, further comprising

a back channel receiver, for receiving said back channel to create a received back channel;

a speech channel partitioner, for partitioning said received back channel into a multiplicity of received identified speech channels; and

a processor network executing a program system comprised of program steps residing in memory accessibly coupled to at least one computer in said processor network;

wherein said program system is *comprised of the program steps of*:

processing said multiplicity of said received identified speech channels to create a multiplicity of identified speech content;

responding to said identified speech content to create an identified speech content response, for each of said multiplicity of said identified speech contents; and

wherein said network supports at least one of the collection comprising: cable television delivery to said multiplicity of user sites; and video delivery to said multiplicity of user sites; and video delivery to said multiplicity of user sites.

Ex. 1001, 55:9–36 (emphasis added).

II. ANALYSIS

Under 35 U.S.C. § 324(a), the Board possesses discretion on whether to institute. *Cf. Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under the parallel *inter partes* section, 35 U.S.C. § 314(a), which contains language similar to 35 U.S.C. § 324(a), “the PTO is permitted, but never compelled, to institute an [*inter partes* review] proceeding”).

As noted above, Petitioner challenges the claims as indefinite under 35 U.S.C. § 112, ¶ 2. Under one theory, Petitioner’s challenge rests on its assertion that “program steps” as recited in the challenged claims constitutes a “nonce” word that invokes a means-plus-function analysis pursuant to 35 U.S.C. § 112, ¶ 6. *See* Pet. 27–30 (citing *Williamson v. Citrix Online, LLC*,

792 F.3d 1339, 1349–50 (Fed. Cir. 2015) (“Generic terms such as ‘mechanism,’ ‘element,’ ‘device,’ and other nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word ‘means’ . . .”). Under the assumption that “program steps” constitutes a means term falling under 35 U.S.C. 112, ¶ 6, Petitioner contends “[t]he patent specification discloses no more than ‘black boxes’ and fails to disclose any algorithm or other structure for performing the recited functions,” rendering the claims indefinite. *See id.* at 39.

In the ’344 Petition and the ’345 Petition, as Patent Owner correctly notes, Petitioner did not construe the same term (i.e., “program steps”) in claims 14 and 27 as a means-plus-function term. *See* Prelim. Resp. 4 (“[T]he instant CBM petition asserts that the program steps of claims 14 and 24 invoke 35 U.S.C. § 112, ¶ 6. . . . But more than four months before [P]etitioner filed the instant CBM petition, [P]etitioner filed [the ’344 Petition and the ’345 Petition] on those claims without identifying any terms as being governed by § 112, ¶ 6.”); ’344 Pet. 6–9 (construing other claim terms but not “program steps”); ’345 Pet. 8–11 (same); 344 Inst. Dec. 19 (“determin[ing] that no claim terms require express construction”); ’345 Inst. Dec. 19 (same).

Under 37 C.F.R. 42.104 (b) (3), which governs *inter partes* reviews, a petitioner “must identify . . . [h]ow the challenged claim is to be construed” and for a means-plus-function term, “the construction of the claim must identify” corresponding structure of the claimed function in the specification. By not construing “program steps” in the ’344 Petition and ’345 Petition as a means-plus-function term per 37 C.F.R. 42.104 (b) (3), Petitioner indicated there that “program steps” does not constitute a means-plus-function term. The position taken by Petitioner here directly contradicts the positions taken

by Petitioner in the '344 Petition and the '345 Petition, and as of the time of this Decision, Petitioner still maintains those positions in the '344 IPR and the '345 IPR. See '344 Pet. 6–9; '345 Pet. 8–11. In those proceedings, based on arguments in the '344 Petition and the '345 Petition, the Board instituted review of the '196 patent, including independent claims 14 and 27 (and claims dependent therefrom) on a multiplicity of grounds without construing “program steps” as a means-plus-function term.

By raising a new and competing means plus function claim construction issue in this CBM proceeding, Petitioner sets up a potential conflict between the claim construction in this proceeding and the claim construction in both the '344 IPR and the '345 IPR with respect to all the challenged claims in the instant proceeding. Petitioner does not explain why it altered its claim construction position to a diametrically opposing view. The three proceedings would be ongoing concurrently if we instituted this CBM proceeding. In that event, Petitioner would be maintaining diametrically opposing positions on the proper claim construction of the same claim term.

Also, if we agree with Petitioner in this CBM proceeding that the claims recite indefinite subject matter, as Petitioner urges here, *this may imply* the differences between the prior art and each of the challenged claims cannot be ascertained, contrary to the position taken by Petitioner in the '344 and '345 IPRs. See Prelim. Resp. 16 (“The mere fact that [P]etitioner and its prior expert were able to present prior-art-based invalidity defenses in two IPRs undermines the argument [P]etitioner (and its new expert) make here that the claims fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”).

A potential consequence of instituting the instant CBM based on Petitioner’s arguments related to the scope issue raised by Patent Owner involves at least raising the related issue of whether to terminate the ’344 and ’345 IPRs. *See BlackBerry Corp. v. MobileMedia Ideas, LLC*, Case IPR2013-00036, slip op. at 19–20 (PTAB Mar. 7, 2014) (Paper 65) (citing *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) and reasoning that “the prior art grounds of unpatentability must fall, *pro forma*, because they are based on speculative assumption as to the meaning of the claims”). Petitioner does not propose terminating the ’344 and ’345 IPRs in the event that we decide to institute the instant CBM proceeding. Without terminating the ’344 IPR and ’345 IPR, instituting the instant CBM proceeding based on Petitioner’s means plus function arguments would result in different Board panels proceeding under two contradictory claim constructions *on a central issue*—i.e., for the same claim term of the same patent, involving all of the challenged claims in the CBM and a slight majority of the collectively challenged claims in the ’344 and ’345 IPRs.

The Board’s reviewing court disfavors conflicting “reasoning on a point . . . central to [the Board’s] analysis” absent an adequate explanation for the conflict. *See Emerson Electric Co. v. Sipco, LLC*, No. 2017-1866, 2018 WL 4145081, slip op. at *3 (Aug. 29, 2018 Fed. Cir.) (“Because the Board did not adequately explain its reasoning on a point that was central to its analysis and its conclusion on that point was contrary to another Board opinion on nearly identical facts, we vacate the Board’s determination as to the appealed claims and remand for further proceedings.”) (nonprecedential); *Vicor Corp. v. SynQor, Inc.*, 869 F.3d 1309, 1322 (Fed. Cir. 2017) (“[W]here a panel simultaneously issues opinions on the same technical issue between the same

parties on the same record, and reaches opposite results without explanation, we think the best course is to vacate and remand these findings for further consideration.”). As noted above, Petitioner does not present an adequate explanation for the contradictory claim constructions. Whether a recitation constitutes a means-plus-function element does not depend on whether the claim is construed in an *inter partes* review or a covered business method patent review.

As indicated above, Petitioner advances a second theory of indefiniteness, asserting “should Patent Owner assert that Section 112 ¶ 6 does not apply because the ‘program steps’ are appropriately construed as method steps, then claims 14 and 27 (and their dependent claims) are indefinite for claiming both a system and a method of using that system.” Pet. 50 (emphasis added).

In a footnote, as also indicated above, Petitioner advances a third theory of unpatentability, contending that in the event the challenged claims do not recite a means plus function term via the alleged nonce term “program steps,” the challenged claims recite only function, rendering the functional recitations “invalid for violating the rule against functional claiming of an apparatus element.” Pet. 30 n.7 (citing *Halliburton Energy Servs. v. M-I LLC*, 514 F.3d 1244, 1246 (Fed. Cir. 2008) (holding “the term ‘fragile gel’ [i]s indefinite”)); see also *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 2–3, 8 n.1 (1946) (under former 35 U.S.C. § 33 governing written description and

enablement, rejecting claims that “do not describe the invention but use ‘conveniently functional language at the exact point of novelty’”).²

As presented, Petitioner advances the second and third theories of unpatentability as contingent upon not adopting its central argument that “program steps” represents a means plus function term. Because we do not decide the issue of whether “program steps” constitutes a means plus function term, we decline Petitioner’s invitation to investigate further its second and third contingent theories. In addition, given the prominence of the means plus function claim construction issue raised by the parties, in the event we were to decide to institute the instant CBM proceeding, the means plus function issue likely would dominate the CBM trial and may impact the ’344 IPR and ’345 IPR, as discussed above.

Petitioner argues the Board should not exercise its discretion to deny this CBM Petition based on the ’344 and ’345 Petitions, because “the grounds for unpatentability identified in this petition are different than the grounds for unpatentability identified in the IPR petitions—indeed, the grounds for unpatentability raised here are not permitted in an IPR proceeding,” and Patent Owner had “not yet filed a preliminary response to the pending IPR petitions challenging the ’196 Patent.” Pet. 4, n.1 (citing *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (identifying relevant factors)). Nevertheless, as Patent Owner argues, *General Plastic* cites a non-exhaustive list of factors. See Prelim. Resp. 5–6. Petitioner fails to explain why it filed this CBM

² “Congress enacted § 112, ¶ 6, in response to *Halliburton*,” 329 U.S. at 1. *Warner–Jenkinson Co. Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 27 (1997).

Petition (filed April 2, 2018) about three and a half months after it filed the '344 and '345 Petitions (both filed Dec. 19, 2017) with competing claim construction arguments that impact *central aspects* of both trials. Petitioner's implied argument that Congress only authorized certain grounds for *inter partes* reviews and limited other grounds to CBM reviews (e.g., § 112, ¶ 2), fails to explain sufficiently why the Board should entertain Petitioner's new claim construction that potentially would impact central and major aspects of the concurrent '344 and '345 IPRs instituted based on a prior contradictory claim construction advanced by Petitioner.

Accordingly, based on the particular circumstances involved as discussed above, we decline to decide whether to adopt Petitioner's means plus function claim construction position asserted here. On one hand, if we decided to adopt it and institute a CBM review on that basis, concurrent trials would proceed on diametrically opposed claim construction positions—unless the panel in the '344 and '345 IPRs decided to terminate those trials based on our adoption of the diametrically opposed claim construction asserted here. At the least, even without a termination the '344 and '345 IPRs, the diametrically opposed positions would infiltrate the three proceedings and raise collateral issues, undermining the Board's resources and effort “to secure the just, speedy, and inexpensive resolution of every proceeding.” See 37 C.F.R. § 42.1(b). On the other hand, if we decide Petitioner's showing here lacks sufficient support on the merits for purposes of a CBM review, a decision denying institution may serve to advise the parties on this limited record that Petitioner's means plus function claim construction position in the '344 and '345 IPRs appears to be correct even though no final decision has been reached there yet.

For the foregoing reasons, we exercise our discretion and deny institution of covered business patent review.

III. CONCLUSION

After considering the totality of the circumstances, we exercise our discretion to deny the Petition under 35 U.S.C. § 324.

IV. ORDER

In consideration of the foregoing, it is hereby ORDERED that the Petition for covered business method patent review of claims 14–52 of the ’196 patent is denied and no covered business method patent review is instituted.

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