

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORPORATION and BLACKBERRY LIMITED¹
Petitioners

v.

MOBILEMEDIA IDEAS LLC
Patent Owner

Case IPR2013-00016
Patent 6,441,828

Before KEVIN F. TURNER, JONI Y. CHANG, and
KALYAN K. DESHPANDE, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

¹ The Board terminated Petitioners' involvement without terminating the proceeding under 35 U.S.C. § 317(a). Paper 31.

INTRODUCTION

On October 12, 2012, BlackBerry Corporation and BlackBerry Limited² (collectively “BlackBerry”) filed a petition, requesting an *inter partes* review of claims 6, 7, 15, 17, and 18 of U.S. Patent No. 6,441,828 (“the ’828 patent”). Paper 1 (“Pet.”). The patent owner, MobileMedia Ideas LLC (“MobileMedia”), waived the patent owner preliminary response. Paper 15. Upon review of the petition, the Board determined that the information presented in the petition demonstrated that there was a reasonable likelihood that BlackBerry would prevail with respect to at least one challenged claim. Pursuant to 35 U.S.C. § 314, the Board issued a Decision on Institution on March 18, 2013. Paper 16 (“Dec.”).

After institution, MobileMedia did not file a patent owner response pertaining to the patentability of claims 6, 7, 15, 17, and 18. Rather, MobileMedia filed a motion to amend claims, which included cancelling claims 6, 7, 15, 17, and 18, and proposing substitute claims 19-23. Paper 21 (“Mot.”). During a conference call on October 16, 2013, MobileMedia conceded that it had cancelled original challenged claims 6, 7, 15, 17, and 18 of the ’828 patent. Paper 28. Therefore, claims 6, 7, 15, 17, and 18 of the ’828 patent are *cancelled*.

As to proposed substitute claims 19-23, BlackBerry filed an opposition to MobileMedia’s motion to amend claims, and MobileMedia

² Real parties-in-interest Research In Motion Corporation and Research In Motion Limited have changed their names to “BlackBerry Corporation” and “BlackBerry Limited,” respectively (collectively, “BlackBerry”). Paper 22.

filed a reply to BlackBerry's opposition. Paper 23 ("Opp."); Paper 24 ("PO Reply"). No oral hearing was held. Paper 28. After the parties filed all of their substantive papers, the parties filed a joint motion to terminate the instant proceeding. Papers 28, 30; Ex. 2013. In light of the advanced stage of the instant proceeding, the Board *granted-in-part* the motion to terminate. Paper 31. Consequently, the proceeding has been *terminated with respect to Blackberry*, but it is *not terminated with respect to MobileMedia*. *Id.*

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is entered pursuant to 35 U.S.C. § 318(a).

Claims 6, 7, 15, 17, and 18 of the '828 patent are *cancelled*.

MobileMedia's motion to amend is *denied*.

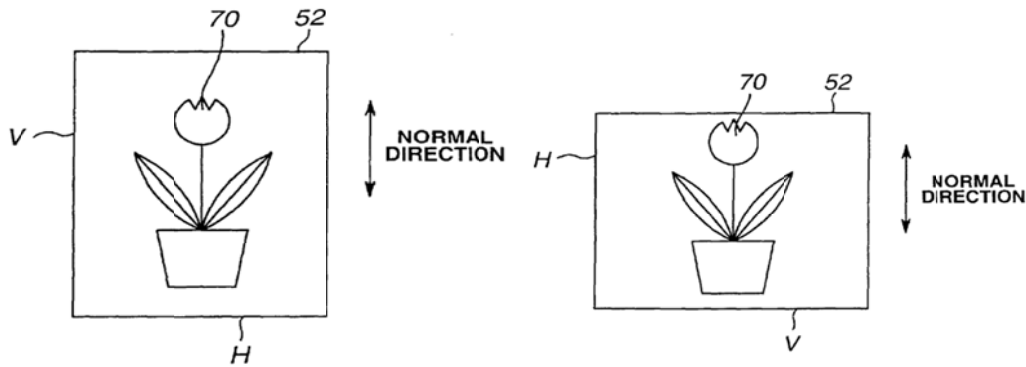
A. Related Proceedings

Blackberry identifies the following related proceedings: *MobileMedia Ideas LLC v. Apple, Inc.*, 10-cv-00258 (D. Del.); *MobileMedia Ideas LLC v. Research In Motion Ltd.*, 11-cv-02353 (N.D. Tex); and *Sandisk Corp. v. MobileMedia Ideas LLC*, 11-cv-00597 (N.D. Cal.). Pet. 1.

B. The '828 Patent

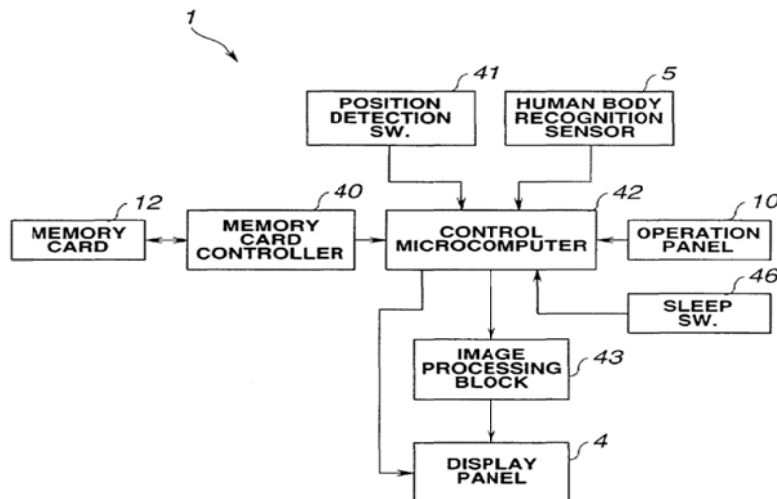
The '828 patent relates to an apparatus (e.g., an electronic picture frame) for displaying a digital image in a normal direction regardless of whether the apparatus is placed with the shorter or longer side down. Ex. 1001, 1:6-8, 1:65-67.

Figures 16A and 16B of the '828 patent are reproduced below:



Figures 16A and 16B show the direction of the displayed image.

Figure 6 of the '828 patent, reproduced below, depicts a schematic block diagram of an image display apparatus:



As shown in Figure 6 of the '828 patent, image display apparatus 1 has memory card 12, memory card controller 40, control microcomputer 42, image processing block 43, and display panel 4 (e.g., a liquid crystal display (LCD)). *Id.* at 3:38-41; 5:48-59. To display an image recorded in memory card 12, control microcomputer 42 reads the compressed image data from

memory card 12 via memory card controller 40 and stores them into a built-in dynamic random-access memory (DRAM). *Id.* at 5:51-59. The compressed image data are decompressed in image processing block 43, and then the decompressed image data are stored back into the DRAM. *Id.* The image data in the DRAM are processed by image processing block 43 for display on the display panel 4. *Id.*

DISCUSSION

An *inter partes* review is more adjudicatory than examinational in nature. *See Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013). A motion to amend claims in an *inter partes* review is not, itself, an amendment. As the moving party, MobileMedia bears the burden of proof to establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). In sum, MobileMedia's proposed substitute claims are not entered automatically, but only upon MobileMedia having demonstrated the patentability of the substitute claims.

In support of its motion, MobileMedia proffers a declaration of Dr. Vijay K. Madiseti. Ex. 2001. We have reviewed MobileMedia's motion and supporting evidence. For the reasons stated below, MobileMedia's motion to amend claims is *denied*. The substitute claims will not be incorporated into the '828 patent.

In its motion to amend claims, MobileMedia proposes substitute claims 19-23. Mot. 3. Substitute claim 19 is an independent claim, and substitute claims 20-23 depend from substitute claim 19. Mot. 4-7.

Substitute claim 19 is reproduced below with markings to show the changes made relative to claim 6:

19. (new claim, proposed substitute for claim 6) An image displaying apparatus for displaying image data read from a recording medium, comprising:

image signal generating means for generating an image signal for display based on image information read from the recording medium;

image displaying means for displaying the image signal produced by the image signal generating means; and

means for determining a direction in which an image of the image signal is to be displayed on the image displaying means according to a posture in which the apparatus is placed and information on a direction in which an image of the image signal is to be displayed read from the recording medium,

said means for determining a direction comprising (a) a position sensor having a moving element that is movable in all directions to automatically detect which position the image display apparatus is placed, (b) an image processing block which displays said image signal in a correct direction regardless of the posture of the apparatus in response to a signal from said position sensor, and (c) a microcomputer,

the apparatus further comprising a recognition sensor that provides a detection signal to said microcomputer based on which a displaying status of the image displaying means is changed.

A. Claim Construction

Claim construction is an important step in a patentability determination. *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1339 (Fed. Cir. 2003); *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper

construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” (Internal citations omitted.)).

To construe means-plus-function language in a claim, one “must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). That is, a means-plus-function limitation shall be construed to cover the corresponding structure described in the specification and equivalents thereof. *See* 35 U.S.C. § 112, ¶ 6.³

For the purposes of the Decision on Institution, we construed seven means-plus-function limitations that invoke 35 U.S.C. § 112, ¶ 6, by identifying the recited functions and the corresponding structures disclosed in the specification for performing the recited functions. Dec. 7-16. For example, we construed the following three limitations recited in claim 6, which also are recited in substitute claim 19.

1. “*Image signal generating means for generating an image signal for display*”

We first identified the recited function for this limitation to be “generating an image signal for display.” Dec. 8. The specification of the ’828 patent contains the following description related to the

³ Section 4(c) of the AIA re-designated 35 U.S.C. § 112, ¶ 6, as 35 U.S.C. § 112(f). Because the ’828 patent has a filing date before September 16, 2012 (effective date), we will refer to the pre-AIA version of § 112.

Based on those portions of the specification, we determined the corresponding structures for performing the recited function (“generating an image signal for display”) to be the control microcomputer and image processing block for the purposes of the Decision on Institution. Dec. 9.

2. “Image displaying means for displaying the image signal”

For this limitation, we determined the recited function to be “displaying the image signal.” Dec. 10. The specification of the ’828 patent provides:

The display panel 4 is a thin, lightweight structure such as an LCD display or plasma display to display an image based on a to-be-displayed image signal supplied from an image processing block which will further be described later.

Ex. 1001, 3:38-39 (emphasis added).

Figure 3 of the ’828 patent is reproduced as follows:

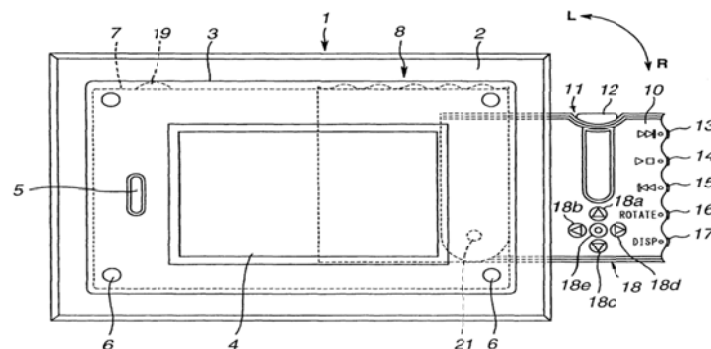


Figure 3 shows a front view of the image display apparatus.

Based on those portions of the specification, we identified the corresponding structure for performing the recited function (“displaying the image signal”) to be a display panel such as an LCD display or plasma display panel. Dec. 11.

3. “*Means for determining a direction in which an image of the image signal is to be displayed on the image displaying means according to a posture in which the apparatus is placed and information on a direction in which an image of the image signal is to be displayed read from the recording medium*”

We determined that the recited function for this limitation is “determining a direction in which an image of the image signal is to be displayed on the image displaying means according to a posture in which the apparatus is placed and information on a direction in which an image of the image signal is to be displayed read from the recording medium.” Dec. 11.

The specification of the ’828 patent provides the following description for determining a display direction:

[A] *position detection switch 41* is provided to detect whether the image display apparatus 1 is placed with the longer or shorter side down, and send a detection signal to the *control microcomputer 42* which will read the displaying-direction information from the memory card 12 via the memory card controller 40. Thus the image can be displayed in the same normal direction. The position detection switch 41 may be either a type of which a moving element is moved in two directions or a type of which a pendulum type element is moved in all directions.

Ex. 1001, 6:26-35 (emphasis added).

There is also provided a *position detection switch 66* to determine a direction in which an image is to be displayed the display panel 52 according to the posture of the enclosure 51 of the image display apparatus 50. In particular, the position detection switch 66 is a *direction select switch* to allow the user to selectively set a direction in which an image is to be displayed, an *automatic position detector* provided with a gravity sensor or the like to automatically detect in which

position the image display apparatus 50 is placed and set a position in which an image is to be displayed, or the like. Note that to save the user's labor to select such a displaying direction, the *automatic position detector* should desirably be adopted in the position detection switch 66. A position detection signal from the position detection switch 66 is sent to the image processing block 65.

Therefore, *the image processing block 65* determines a direction in which an image is to be displayed on the display panel 52 according to the position detection signal, and allows to display the image on the display panel 52 in the determined direction.

Id. at 9:27-46 (emphasis added). For the purposes of the Decision on Institution, we considered the corresponding structures for performing the recited function to be the control microcomputer, the position detection switch, and the image processing block. Dec. 12.

However, because in a means-plus-function limitation, the corresponding structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm, *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999), and because we could not identify an algorithm associated with the microcomputer and the image processing block in the specification that performs the recited functions, we provided MobileMedia the opportunity to inform the Board as to its claim constructions of the means-plus-function limitations including the specific *algorithm* that performs the recited functions. Dec. 8.

4. *MobileMedia's Claim Construction*

In its motion to amend claims, MobileMedia states that the “image signal generating means,” as recited in substitute claim 19, should construed as a means-plus-function limitation invoking 35 U.S.C. § 112, ¶ 6, as the Board construed it with respect to claim 6 in the Decision on Institution. Mot. 8 (citing Dec. 8-10). MobileMedia further indicates that the corresponding structure for the recited function (“generating an image signal for display”) is “the control microcomputer 42 and image processing blocks 43 and 65.” *Id.* (citing Ex. 1001, 5:51-59, 9:17-22; figs. 6, 15). However, MobileMedia fails to identify the specific *algorithm* associated with the microcomputer or image processing blocks for performing the functions recited in substitute claim 19, or explain why an algorithm is not necessary for performing the recited functions. *See Aristocrat Technologies Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (ruling that the claims were indefinite because of lack of disclosure of any specific algorithm used by the disclosed computer to perform the function recited in a means-plus-function element.).

In its motion to amend claims, MobileMedia also takes the position that the following limitation set forth in substitute claim 19 does not invoke 35 U.S.C. § 112, ¶ 6:

means for determining a direction in which an image of the image signal is to be displayed on the image displaying means according to a posture in which the apparatus is placed and information on a direction in which an image of the image signal is to be displayed read from the recording medium,
said means for determining a direction comprising (a) a

position sensor having a moving element that is movable in all directions to automatically detect which position the image display apparatus is placed, (b) *an image processing block* which displays said image signal in a correct direction regardless of the posture of the apparatus in response to a signal from said position sensor, and (c) *a microcomputer*.

Mot. 5, 9-10 (citing to Ex. 2001 ¶¶ 55-57) (emphases added).

It is well settled that a limitation that uses the term “means for” creates a rebuttable presumption that the drafter intended to invoke § 112, ¶ 6. *Personalized Media Commc’ns, LLC v. ITC*, 161 F.3d 696, 703-04 (Fed. Cir. 1998). “This presumption can be rebutted where the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety.” *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375-76 (Fed. Cir. 2003). Therefore, in order to take the “means for determining a direction” limitation outside the bounds of § 112, ¶ 6, the claim must recite *sufficient structure* for performing the recited function. *See Personalized Media*, 161 F.3d at 704 (“In deciding whether [the] presumption has been rebutted, the focus remains on whether the claim as properly construed recites sufficiently definite structure to avoid the ambit of § 112, ¶ 6.”).

MobileMedia, however, does not explain adequately why the features added in substitute claim 19 would provide sufficient structures for performing the recited function—“determining a direction in which an image of the image signal is to be displayed on the image displaying means according to a posture in which the apparatus is placed and information on a direction in which an image of the image signal is to be displayed read from

the recording medium.” Mot. 7-10.

Dr. Madisetti attempts to substantiate MobileMedia’s position by referring to the Board’s claim construction set forth in the Decision on Institution (Ex. 2001 ¶¶ 56-57), which stated:

For the purposes of this decision [on institution], we therefore consider the corresponding structure for this limitation to be the control microcomputer, the position detection switch, and the image processing block.

Dec. 12 (citing Ex. 1001, 6:26-35; 9:27-46). However, merely referencing that claim construction without further explanation as to how the features added in substitute claim 19 provide sufficient structures to perform the recited function is insufficient to establish that the limitation is not a means-plus-function limitation under § 112, ¶ 6. Notably, Dr. Madisetti does not articulate adequately how the features added in substitute claim 19—“a position sensor,” “an image processing block,” and “a microcomputer”—should be construed. Stating that the limitation should be construed “according to its plain, ordinary meaning in light of the specification” (Mot. 9) is not sufficient for a proper construction of claim limitations under § 112, ¶ 6. For example, Dr. Madisetti’s testimony does not indicate whether the claim term “position sensor” should be construed as the “position detection switch” disclosed in the specification. In fact, the claim term “position sensor” is not recited in the specification. And we note that different claim terms are presumed to have different meanings. *See CAE Screen plates, Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000). More importantly, MobileMedia’s motion and expert

testimony fail to identify the specific *algorithm* associated with the microcomputer for performing the functions recited in the substitute claims, or explain why an algorithm is not necessary for performing the recited functions. *See Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009); *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008).

For the foregoing reasons, MobileMedia fails to set forth a reasonable claim construction for each claim feature added in the substitute claims. Without reasonable claim constructions of the claim features, MobileMedia’s motion to amend claims fails to demonstrate the patentability of its substitute claims.

B. Amendment Must be Responsive to a Ground of Unpatentability

Pursuant to 35 U.S.C. § 316(a)(9), and taking into account the statutory considerations under 35 U.S.C. § 316(b)—“the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted”—the Office promulgated 37 C.F.R. § 42.121 to set forth the standards and procedures for allowing a patent owner, in an *inter partes* review, to move to amend the patent “to cancel a challenged claim or propose a reasonable number of substitute claims.” As set forth in 37 C.F.R. § 42.121(a)(2), a motion to amend may be denied where the amendment does not respond to a ground of unpatentability involved in the trial.

Here, MobileMedia eliminates all of the features of original challenged claims 7, 15, 17, and 18. Mot. 6-7. MobileMedia does not

explain adequately why the removal of all those features is responsive to a ground of unpatentability. For example, substitute claim 20 (the proposed substitute for claim 7) eliminates the only element in claim 7—“means whereby the recording medium is set into the apparatus from outside.” Substitute 20 is reproduced below with markings showing the changes made relative to claim 7:

20. (new claim, proposed substitute for claim 7) The apparatus as set forth in claim ~~6~~19 ~~further comprising means whereby the recording medium is set into the apparatus from outside,~~ wherein said recognition sensor (a) emits light and (b) detects the light returned from a human body or object.

Mot. 6.

MobileMedia asserts that the feature recited in substitute claim 20 is “written in non-means plus function format.” Mot. 11. However, we indicated, in the Decision on Institution, that the corresponding structure for the means-plus-function limitation recited in claim 7 is “the socket 53” shown in Figure 13 of the ’828 patent. Dec. 14. MobileMedia does not dispute that claim construction, nor indicate that the feature added in substitute claim 20, a recognition sensor, is the corresponding structure for performing the function recited in claim 7. Therefore, contrary to its assertion, MobileMedia did not rewrite claim 7 simply in a non-means plus function format. In fact, the feature recited in substitute claim 20 has little to do with the corresponding structure for performing the function recited in claim 7.

As another example, substitute claim 21 (the proposed substitute for claim 15) eliminates all of the elements recited in claim 15—“means for detecting an amount of light around the apparatus; and means for adjusting an operation of the image displaying means based on a decision signal from the light detecting means.” Substitute claim 21 is reproduced below with markings to show the changes made relative to claim 15:

21. (new claim, proposed substitute for claim 15) The apparatus as set forth in claim 620 ~~further comprising:~~
~~means for detecting an amount of light around the apparatus; and~~
~~means for adjusting an operation of the image displaying means based on a decision signal from the light detecting means,~~ wherein the displaying status remains changed for at least an expiration time unless the microcomputer receives said detection signal again.

Mot. 6.

Again, MobileMedia asserts that the feature recited in substitute claim 21 is “written in non-means plus function format.” Mot. 11. However, we indicated, in the Decision on Institution, that the corresponding structures for the means-plus-function limitations recited in claim 15 are “the light sensor 55” and “the display brightness controller 69” shown in Figure 15 of the ’828 patent. Dec. 14. MobileMedia does not dispute that claim construction. Contrary to its assertion, MobileMedia did not rewrite claim 15 merely in a non-means plus function format. In fact, the feature recited in substitute claim 21 has little to do with the corresponding structures for performing the functions recited in claim 15.

MobileMedia further asserts that each substitute dependent claim “more specifically” defines the invention of the previous claim to which it refers, without any explanation. *See, e.g.*, Mot. 11. At best, that assertion is merely an explanation as to why the features are added in the substitute claims. Without a reasonable explanation as to why the features recited in the original patent claims are eliminated, MobileMedia has not demonstrated that such amendments are responsive to a ground of unpatentability involved in the trial. Therefore, MobileMedia’s motion to amend claims does not comply with 37 C.F.R. § 42.121(a)(2).

C. Reasonable Number of Substitute Claims

In a motion to amend, a patent owner may, “[f]or each challenged claim, propose a reasonable number of substitute claims.” 35 U.S.C. § 316(d)(1)(B). The presumption is that only one substitute claim would be needed to replace each challenged claim, although the presumption may be rebutted by a demonstration of need. 37 C.F.R. § 42.121(a)(3). A desire to obtain a new set of claims having a hierarchy of different scope typically would not constitute a sufficient special circumstance. Absent special circumstances, a challenged claim can be replaced by only one claim. Each proposed claim should be traceable to an original challenged claim as a proposed substitute claim for that challenged claim.

In its motion to amend claims, MobileMedia asserts that claim 19 is the proposed substitute for claim 6; claim 20 is the proposed substitute for claim 7; claim 21 is the proposed substitute for claim 15; claim 22 is the proposed substitute for claim 17; and claim 23 is the proposed substitute for

claim 18. Mot. 4-7. However, that assertion is not adequate to establish that proposed claims 20-23 are substitute claims for challenged claims 7, 15, 17, and 18. As discussed above, all of the features recited in these challenged claims are being eliminated. For instance, substitute claim 21 purportedly replaces claim 15, but it eliminates all of the features recited in claim 15. Mot. 6. MobileMedia does not explain sufficiently how the feature added in substitute claim 21 would be pertinent to the removed features. Mot. 11-12. Although MobileMedia states that substitute claim 21 defines the invention of substitute claim 20 “more specifically” (*id.* at 11), MobileMedia does not explain why it is necessary to eliminate all of the limitations recited in claim 15. In sum, substitute claim 21 is not traceable to claim 15. Each of the other substitute dependent claims, likewise, is not traceable to the challenged claim it allegedly replaces. Therefore, substitute claims 20-23 are not proper substitute claims for challenged claims 7, 15, 17, and 18.

Moreover, contrary to MobileMedia’s assertion that its motion presents a reasonable number of substitute claims (Mot. 1), we observe that proposed claims 20-23 each are instead substitute claims for challenged claim 6. Claim 6 is the only challenged claim for which each proposed claim includes all of the features. Consequently, claims 20-23, as well as claim 19, are substitute claims for challenged claim 6. However, MobileMedia does not provide any explanation as to why it needs five substitute claims for one challenged claim. Thus, MobileMedia fails to rebut the presumption that only one substitute claim would be needed to replace each challenged claim.

For the foregoing reasons, MobileMedia has proposed more than a reasonable number of substitute claims in violation of 37 C.F.R. § 42.121(a)(3).

D. Patentability Over Prior Art

An *inter partes* review is neither a patent examination proceeding nor a patent reexamination proceeding. The proposed substitute claims, in a motion to amend, are not entered automatically and then subjected to examination. Rather, the substitute claims will be added directly to the patent, without examination, if the patent owner's motion to amend claims is granted. The patent owner is not rebutting a rejection in an Office Action, as though this proceeding is a patent examination or a patent reexamination. Instead, the patent owner bears the burden of proof in demonstrating patentability of the proposed substitute claims over the prior art in general, and thus entitlement to add these proposed substitute claims to its patent.

There is no presumption of validity as to the challenged claims or substitute claims in an *inter partes* review. In fact, upon consideration of the information presented in the petition, we determined that there is a reasonable likelihood that claims 6, 7, 15, 17, and 18 are unpatentable under 35 U.S.C. §§ 102 and 103. Dec. 17-26. MobileMedia did not file a patent owner preliminary response or a patent owner response, arguing the patentability of claims 6, 7, 15, 17, and 18, but instead it has cancelled those claims. Therefore, there is no inference of patentability of substitute claims 19-23 by virtue of that they purportedly are replacing claims 6, 7, 15, 17, and 18.

In its motion to amend claims, MobileMedia only presents the following statements concerning the patentability of the substitute claims:

As explained in greater detail in the Madisetti Declaration, new claims 19-23 are patentably distinct from the Petition Prior Art (Ex. 2001 at ¶¶ 68 - 132.) The proposed new claims recite an apparatus with the automatic display features described above that incorporate additional combinations of features that would not have been obvious to a person of ordinary skill at the time of the invention based on the Petition Prior Art. (*Id.*)

Mot. 14.

At the outset, MobileMedia's arguments attempt to incorporate by reference Dr. Madisetti's testimony (Ex. 2001 ¶¶ 68-132), but incorporation of arguments from one document into another is prohibited by 37 C.F.R. § 42.6(a)(3). MobileMedia's attempt to incorporate Dr. Madisetti's testimony also violates the page limit set forth in 37 C.F.R. § 42.24(a)(1)(v). *Cf. Globespanvirata, Inc. v. Tex. Instruments, Inc.*, 2005 WL 3077915, *1 (D. N.J. 2005) (Defendants provided cursory statements in its motion and sought to make its case through incorporation of an expert declaration and a claim chart. Incorporation by reference of argument not in motion was held to be a violation of local rules governing page limitations and was not permitted by the court).

In any event, MobileMedia's arguments and Dr. Madisetti's testimony are insufficient to demonstrate the patentability of substitute claims 19-23. MobileMedia merely provides the aforementioned conclusory statements without any explanation or other arguments, and essentially relies upon Dr. Madisetti's declaration. However, Dr. Madisetti's testimony is limited

to the prior art cited in the petition. Ex. 2001 ¶¶ 68-132. Dr. Madisetti does not identify the closest prior art known to him with respect to the substitute claims. Nor does he indicate that the prior art cited in the petition is the closest prior art known to him with respect to the substitute claims. Without indicating that his patentability analysis is based on the closest prior art known to him, Dr. Madisetti's testimony provides insufficient information to establish that his patentability analysis as to the substitute claims is complete or reliable. Therefore, Dr. Madisetti's conclusion that "the proposed new claims are novel" is entitled little weight. *See Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) ("Nothing in the rules or in our jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness.").

Further, Dr. Madisetti's testimony also is limited to anticipation issues, and fails to demonstrate sufficiently that the substitute claims are nonobvious. *See, e.g., Minkin v. Gibbons*, 680 F.3d 1341, 1349-1351 (Fed. Cir. 2012) (A movant who was required to demonstrate patentability must prove, by a preponderance of the evidence, that the claims would have been *novel and nonobvious*.). It is well settled that "anticipation and obviousness are separate conditions of patentability, requiring different tests and different elements of proof." *Id.* at 1351; *see also KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-07 (2007). Although Dr. Madisetti concludes that the substitute claims would not have been obvious to one of ordinary skill in the art (Ex. 2001 ¶ 132), Dr. Madisetti's analysis merely discusses how each cited prior art reference individually does not disclose the features added in

the substitute claim. Ex. 2001 ¶¶ 68-132. Such a patentability analysis is insufficient to demonstrate nonobviousness, because an analysis of whether the subject matter of a claim would have been obvious “need not seek out precise teachings direct to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” See *KSR*, 550 U.S. at 418.

Additionally, Dr. Madisetti does not proffer any evidence as to the level of ordinary skill in the art at the time of the invention, which is a necessary factual inquiry for determining obviousness. See *Graham v. John Deere Co.*, 383 U.S. 1, 17-18. In fact, Dr. Madisetti’s testimony does not address the level of ordinary skill in the art at the time of the invention and what was known previously regarding a recognition sensor that provides a detection signal or other claim features added in the substitute claims. At least some explanations should have been provided as to why a person with ordinary skill in the art, applying his own knowledge and creativity, would not have found the substitute claims obvious.

In sum, limiting the discussion to the references cited in the petition is insufficient to demonstrate patentability of the substitute claims over the prior art in general. Without having discussed the level of ordinary skill in the art, and what was known previously regarding the features added in the substitute claims, MobileMedia’s motion fails to demonstrate the patentability of the substitute claims.

CONCLUSION

For the foregoing reasons, MobileMedia has not, in its motion, set forth a prima facie case for the relief requested or satisfied its burden of proof. Consequently, consideration of Blackberry's opposition and MobileMedia's reply is unnecessary.

MobileMedia has not met its burden to show that its proposed substitute claims are patentable.

ORDER

In consideration of the foregoing, it is
ORDERED that claims 6, 7, 15, 17, and 18 of the '828 patent are
cancelled; and

FURTHER ORDERED that MobileMedia's motion to amend claims
is *denied*.

Case IPR2013-00016
Patent 6,441,828

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