

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON WEB SERVICES, LLC,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner.

Case IPR2014-01527
Patent 5,887,243

Before KARL D. EASTHOM, TRENTON A. WARD, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner filed a Petition requesting an *inter partes* review of claim 13 of U.S. Patent No. 5,887,243 (Ex. 1003, “the ’243 patent”). Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). The panel instituted an *inter partes* review of claim 13. Paper 7 (“Dec. on Inst.” or “Institution Decision”), 36.

Patent Owner filed a Response (Paper 20, “PO Resp.”), to which Petitioner filed a Reply (Paper 29, “Pet. Reply”). Patent Owner filed Observations on Cross Examination (Paper 38), and Petitioner filed Responses to Patent Owner’s Observations (Paper 40). The parties presented arguments at an oral hearing before the panel, which was transcribed by a court reporter. *See* Paper 41 (“Tr.”).

In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine Petitioner has shown by a preponderance of the evidence that challenged claim 13 is unpatentable.

A. Related Proceedings

According to the Petition, the ’243 patent, including claim 13, is involved in *Personalized Media Commc’ns, LLC v. Amazon.com, Inc.*, No. 1:13-cv-1608-RGA (D. Del., filed Sept. 23, 2013) and *Personalized Media Commc’ns, LLC v. Motorola Inc.*, No. 2:08-cv-70-RSP (E.D. Tex., filed 2008). Pet. 1–2. Granting a motion for judgment on the pleadings, the U.S. District Court for the District of Delaware found claim 13 of the ’243 patent invalid as not directed to patentable subject matter. *See Personalized Media Commc’ns, LLC v. Amazon.com, Inc.*, No. 1:13-cv-1608-RGA,

Memorandum Opinion, slip op. at 5–6 (D. Del. Aug. 10, 2015) (cited in IPR 2014-01528 as Ex. 1040). According to Petitioner, Patent Owner appealed that judgment in the Court of Appeals for the Federal Circuit as Appeal No. 15-2008. Paper 31, 1.

The '243 patent also was involved in an *ex parte* reexamination, which culminated in an appeal to the Board: *Personalized Media Commc'ns, LLC*, Appeal 2008-004816 (BPAI Mar. 5, 2009) (Reexam. Control. No. 90/006,688) (“the '243 Reexam. Appeal,” Ex. 1005, 56). Petitioner filed petitions seeking *inter partes* review of related U.S. Patent Nos. 7,783,252 B1 (IPR2014-01528); 7,864,956 B1 (IPR2014-01530); 8,046,791 B1 (IPR2014-01531); 7,801,304 B1 (IPR2014-01532); 7,805,749 B1 (IPR2014-01533); and 7,827,587 B1 (IPR2014-01534).

B. The '243 Patent

The '243 patent discloses a system for viewing a conventional broadcast program simultaneously with relevant user specific information at a subscriber station. Ex. 1003, 6:61–67.

Figure 1, below, is illustrative of the system.

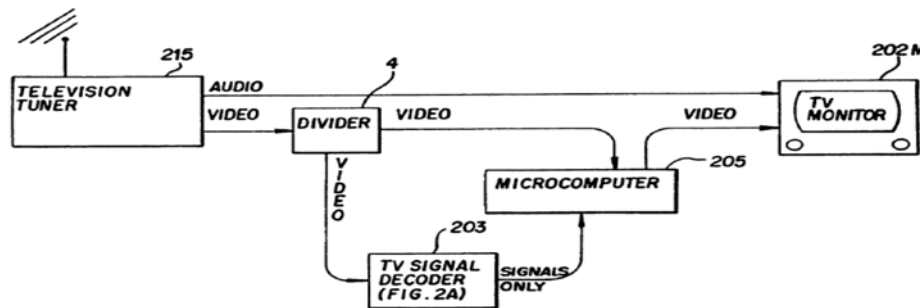


FIG. 1

Figure 1 “is a block diagram of a video/computer combined medium receiver station.” Ex. 1003, 9:39–40. The subscriber (receiver) station includes television tuner 215 for receiving a broadcast transmission, divider 4, TV signal decoder 203, microcomputer 205, and TV monitor 202M. Microcomputer 205 sends a query to a remote data source, and after receiving data from that source, generates graphics from that data that can be combined with the television broadcast video signal displayed by TV monitor 202M. *Id.* at 10:56–11:37; 236:65–237:20.

The ’243 patent provides an example of combining a graph of the market performance from a “Wall Street Week” program and financial data specific to each subscriber. In other words, monitor 205 displays “Wall Street Week” at the same time it displays previously stored data from another remote source that contains data about a user’s stock portfolio. *Id.* at 14:13–39. Microprocessor 205 accesses a floppy disk that holds a data file containing a portfolio of financial instruments owned by the specific subscriber at that subscriber station. During a program broadcast, microcomputer 205 also receives instruction signals embedded in the “Wall Street Week” programming transmission. *Id.* at 14:23–37. The embedded signals include a set of control instructions to control microcomputer 205 at each subscriber station. *Id.* at 13:1–14:38.

In response to the embedded signals, microcomputer 205 enters information at the video RAM of the graphics card for graphing the subscriber’s portfolio information. *Id.* at 13:44–65. A subsequent embedded signal instructs the microcomputer to overlay the graphic

information onto the received video broadcast and transmit the combined information to TV monitor 202M, thereby displaying a dual graph showing a subscriber's portfolio performance relative to the overall market performance generated during the "Wall Street Week" show. *Id.* at 14:23–36.

Figure 1C below, reproduced from the '243 patent, depicts such an overlay:

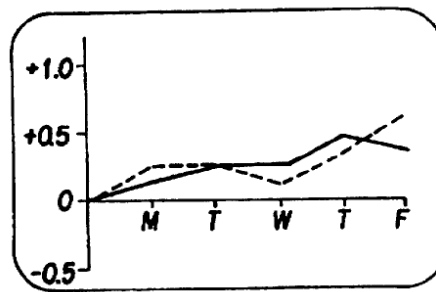


FIG. 1C

Figure 1C above depicts a dual graph representing an individual subscriber's portfolio performance overlaid on the Wall Street Week graph that represents overall market performance. As an example of creating the instruction signal to stimulate the overlay, during the broadcast of Wall Street Week, after the host describes overall market performance,

the host says, "[a]nd here is what your portfolio did." At this point, an instruction signal is generated at said program origination studio, embedded in the programming transmission, and transmitted. . . . Said signal instructs microcomputer[] 205 . . . to overlay composite video information and transmit the combined information to TV monitor [205].

Id. at 14:23–33.

C. Challenged Claim

13. A method of providing data of interest to a receiver station from a first remote data source, said data of interest for use at said receiver station in at least one of generating and outputting a receiver specific datum, said method comprising the steps of:

[a] storing said data at said first remote data source;

[b] receiving at said remote data source a query from said receiver station;

[c] transmitting at least a portion of said data from said first remote data source to said receiver station in response to said step of receiving said query, said receiver station selecting and storing said transmitted at least a portion of said data and;

[d] transmitting from a second remote source to said receiver station a signal which controls said receiver station to select and process an instruct signal which is effective at said receiver station to coordinate presentation of said at least a portion of said data with one of a mass medium program and a program segment presentation sequence.

Id. at 300:14–33; *see also* Pet. 8–9 ([a]–[d] nomenclature added by Petitioner).

D. Asserted Prior Art References

Ciciora, U.S. 4,233,628 (Nov. 11, 1980) (Ex. 1006).

Millar et al., GB 1,370,535 (Oct. 16, 1974) (“Millar,” Ex. 1009).

Summers et al., U.S. 4,306,250 (Dec. 15, 1981) (“Summers,” Ex. 1010).

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Reiter et al., U.S. 4,751,578 (June 14, 1988) (“Reiter,” Ex. 1025).

Petition for Rulemaking, CBS, Inc., Fed. Commc’n Comm. (July 29, 1980)
(the “CBS Petition,” Ex. 1007).

Joseph Blatt et al., *The Promise of Teletext for Hearing-Impaired Audiences*,
IEEE TRANSACTIONS ON COMMUNICATIONS, vol. CE-26, 717–722 (Nov. 1980)
(“Blatt,” Ex. 1008).

S. Fedida, *Viewdata*, WIRELESS WORLD, vol. 83, no. 1494, 32–36 (Feb.
1977) (“Fedida I,” Ex. 1026).

S. Fedida, *Viewdata–2* WIRELESS WORLD, vol. 83, no. 1495, 52–54 (Mar.
1977) (“Fedida II,” Ex. 1027).

S. Fedida, *Viewdata–3*, WIRELESS WORLD, vol. 83, no. 1496, 65–69 (Apr.
1977) (“Fedida III,” Ex. 1028).

E. Challenges Instituted Against Claim 13

Basis	References
§ 102(e)	Reiter
§ 103(a)	Summers, Fedida, ¹ and the CBS Petition, Blatt, or Millar
§ 103(a)	Ciciora, and the CBS Petition, Blatt, or Millar

Dec. on Inst. 36.

¹ “Fedida” collectively refers to the three-part collection of articles in *Wireless World* by Fedida, listed above: Fedida I (Ex. 1026), Fedida II (Ex. 1027), and Fedida III (Ex. 1028).

II. ANALYSIS

A. Claim Construction

The claims of an unexpired patent are interpreted using the broadest reasonable interpretation (“BRI”) in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1276–79 (Fed. Cir. 2015) (concluding that “Congress implicitly adopted the broadest reasonable interpretation standard in enacting the AIA” and that “the standard was properly adopted by PTO regulation”), *cert. granted, Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). A claim term generally carries its “ordinary and customary meaning”—the meaning that the term would have to a person of ordinary skill in the art in question in view of the specification. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The outcome in this case would not be altered under a court claim construction standard pursuant to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

The parties dispute the construction of certain terms recited in step d of challenged claim 13. Claim 13, step d, recites four claim terms that require claim construction:

[d] transmitting from a second *remote* source to said receiver station a *signal* which controls said receiver station to select and process an *instruct signal* which is effective at said receiver station to *coordinate presentation* of said at least a portion of said data with one of a mass medium program and a program segment presentation sequence.

1. Coordinate Presentation

Patent Owner contends that “to coordinate presentation” means “to place or arrange in a proper position relative to each other in time, location, fashion of playing or manner of presentation *based on a defined relationship between the content of the data and the programming.*” PO Resp. 22 (emphasis added); Ex. 2009 ¶ 78. Petitioner disagrees and contends that Patent Owner asserted in a prior litigation involving claim 13 that the term “coordinate” should be given its ordinary meaning, “to place or arrange (things) in proper position relative to each other. The term ‘[c]oordinate’ may relate to time, location (place), fashion of playing, or manner of presentation.” Pet. 18–19 (citing Ex. 1018 (the “Atlanta lawsuit”), 3).² The Institution Decision employs the Atlanta lawsuit construction. *See* Dec. on Inst. 9–11.

Patent Owner does not address the finding in the Institution Decision, or Petitioner’s contention that Patent Owner advanced a claim construction in the Atlanta lawsuit that conflicts with its claim construction presented here. *See* Dec. on Inst. 9–11; PO Resp. 15–24. Patent Owner cited the Atlanta lawsuit in a prior reexamination proceeding involving the ’243 patent and urged that the construction was “relevant.” *See* Dec. on Inst. 9–10 & n.3; Prelim. Resp. 16–17 n. 5 (citing Ex. 1005, 868–69) (indicating that the district court adopted the above construction).

² *Personalized Media Commc’ns, LLC v. Scientific-Atlanta, Inc.*, No. 1:02-cv-824-CAP (N.D. Ga. March 5, 2005) (Special Master’s Report and Rec.).

Rather than relying on a claim construction advanced in the Atlanta lawsuit, Patent Owner relies on a prior *ex parte* Board decision involving a related patent (which also discloses the same or similar “Wall Street Week” example of Figure 1C) and construing the claim phrase “a coordinated display using said generated image and said video image.” Prelim. Resp. 17 (citing Ex. 2005, 3–4, “the ’1837 Reh’g Decision”)³; PO Resp. 20–21.

Relying on the ’1837 Reh’g Decision, which held that a “coordinated display” means “a display where the images used in the display are displayed dependent on a defined relationship between the content of the images” (Ex. 2005, 3), Patent Owner submits that Petitioner’s construction is too broad, because it merely requires any simultaneous display of data and a program unrelated to the content of the program. See PO Resp. 21. Contrary to Patent Owner’s position, however, unlike the claim involved in the ’1837 Reh’g Decision, claim 13 does not require using two images, let alone a relationship between images in terms of content. Rather, claim 13 requires a coordinated presentation of data and a program. The ’1837 Reh’g Decision reveals that the distinction is critical.

Furthermore, the record does not show that the Board considered the Atlanta lawsuit claim construction in reaching the ’1837 Reh’g Decision. See *Power Integrations, Inc. v. Lee*, 797 F.3d 1318, 1324 (Fed. Cir. 2015) (remanding to the Board because “the board failed to acknowledge the

³ *Ex Parte Harvey*, Appeal 2007-001837 (Serial No. 08/470,571), Dec. on Req. for Reh’g (BPAI June 26, 2009).

district court's claim construction or to assess whether [the district court's] interpretation of the term 'coupled' was consistent with the broadest reasonable construction of the term").

Without remarking on the Atlanta lawsuit claim construction, the Board panel in the '1837 Reh'g Decision interpreted a different claim phrase, "a coordinated *display using* said generated *image and* said video *image.*" Ex. 2005, 2 (emphases added). In reaching its claim construction, the Board responded to appellant's argument in that Rehearing Request that the Board erred in its interpretation "by failing to give the words '*coordinated*' and '*using*' different meanings." Ex. 2005, 3 (emphases added).

Of course, the Board in the '1837 Reh'g Decision construed the claim terms involved there in the context of surrounding terms in light of the specification, including the coordinated display of using two images. See, e.g., Ex. 2005, 3 (taking into account the context of "using" and "coordinated" based on applicant's arguments asserting error and citing the "Wall Street Week" example). Furthermore, rather than tracking claim 13, the disclosed "Wall Street Week" example more closely tracks the narrower claim language of the claim involved in the '1837 Reh'g Decision.

In its rehearing request that culminated in the '1837 Reh'g Decision, Patent Owner argued that "common usage would require that, if the display of the Subject Claims required no more than using the two images at the same time (in any fashion), the claim limitation at issue should read, 'a display consisting of said generated image and said video image.'"

Ex. 3001, 4. Patent Owner also persuaded the Board in the '1837 Reh'g Decision that the Board had misconstrued the claim involved there because the initial claim construction (prior to the rehearing decision) "*does nothing more than give the words 'coordinated' and 'using' the very same meaning.*" This conflicts with the obligation to give each word in the claim its own meaning." See Ex. 3001, 4 (emphasis added) ("By equating 'coordinated' and 'using', the Decision reads the claim word, 'coordinated' completely out of the claim, which is plain error."). In contrast, claim 13 does not recite both words, "using" and "coordinated."

Therefore, even without considering the Atlanta lawsuit, Patent Owner's prosecution history arguments imply that claim 13 should not be narrowed by disclaimer. Based on Patent Owner's prosecution arguments, any disclaimer about the claim phrase at issue in the '1837 Reh'g Decision simply does not unambiguously limit claim 13, because claim 13 does not closely track the same "Wall Street Week" example, involves a broader claim, and does not recite both "using" and "coordinated." "An ambiguous disclaimer . . . does not advance the patent's notice function or justify public reliance, and the court will not use it to limit a claim term's ordinary meaning." *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1286, 1287 (Fed. Cir. 2005) ("There is no 'clear and unmistakable' disclaimer if a prosecution argument is subject to more than one reasonable interpretation, one of which is consistent with a proffered meaning of the disputed term."). Given the difference between the claims involved in the two proceedings, and the arguments advanced by Patent Owner with respect to the narrower

claim not involved here, Patent Owner did not disclaim clearly a claim term involved in this proceeding. *Cf. Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1368–69 (Fed. Cir. 2007) (construing claim language based on statements made during prosecution of parent application regarding similar claim language).

With respect to the Atlanta lawsuit, as noted in the Institution Decision,

. . . Patent Owner characterizes its proposed definition as consistent with the plain and ordinary meaning of the disputed term and with the term as construed in the Atlanta lawsuit. *See* Prelim. Resp. 16–17, n.5. . . . For example, Patent Owner cites to dictionaries as evidence that the plain and ordinary meaning of “coordinate” is “to place or arrange in proper order or position;” “to place in harmonious relation or action;” or “to place in proper order or relation.” *See* Prelim. Resp. 18 (quoting Ex. 2002, Ex. 2004). These cited definitions and determination in the Atlanta lawsuit lack a specific reference to a relationship based on relative content.

Dec. on Inst. 11–12.

Tracking the ordinary meaning advanced by Patent Owner in its Preliminary Response, as noted in the Institution Decision quoted above, nothing in the ’243 patent Specification shows that the claimed “coordinat[ed] presentation” must involve a display of an image and data related in content to that image. Rather, the ’243 patent Specification describes several relevant deficiencies in the prior art, implying the ’243 patent solves those deficiencies, and several relevant objectives. *See* Ex. 1003, 3:31–9:37.

Examples of relevant alleged deficiencies in the prior art include the ability to control the timing of viewing of overlays, “the capacity to cause the video players to record programming from any source,” and the “capacity to operate under control of instructions transmitted by broadcasters.” *Id.* at 3:30–39, 3:67–4:1, 4:3–5. The prior art also allegedly has “no capacity for coordinating the programming content transmitted by any given peripheral system with any other programming transmitted to a television receiver.” *Id.* at 4:32–36.

Relevant objectives of the invention include “combined medium programming” and “causing computers to generate and transmit programming, and for causing receiver apparatus to operate on the basis of programming and information received at widely separated times.” *Id.* at 6:40–52. The ’243 patent announces “great potential for combining the capacity of broadcast communications media to convey ideas with the capacity of computers to process and output user specific information.” *Id.* at 1:57–60. As an example, the Specification describes “[h]ereinafter” referring to “‘combined’ media” as “the new media” that results from, for example, the combination of “general information” for large audiences (e.g., stock market performance) from a television broadcaster with “information of specific relevance to each particular user” (e.g., “your stock portfolio went down”). *Id.* at 1:60–67. Even in this example, a display layout or configuration does not vary depending on relative content.

Furthermore, in contrast to any possible definition implied by the “[h]ereinafter” reference in a specific example disclosed in the ’243 patent

Specification, claim 13 does not recite “combined media,” and it broadly recites using “data of interest.” Within the broad objectives of the ’243 patent and even in the specific example noted, a display layout does not differ depending on the relative content between specific computer and general television information. Rather, as outlined above, the Specification generally describes combining information stored at a computer (which may or may not be user specific) and television programs (perhaps implying the use of signals associated with the television program to aid in combining the information and program).

Accordingly, several factors tilt against narrowing the claim from its plain and ordinary meaning (in view of the Specification) based on the ’1837 Reh’g Decision, including the (1) broader scope of claim 13 (relative to the claim at issue in the ’1837 Reh’g Decision), (2) different claim phrases recited in the two claims, (3) contradictory arguments by Patent Owner before different tribunals (i.e., the Atlanta lawsuit and the Board), (4) the lack of a close example or clear disclaimer in the Specification applicable to claim 13, (5) broad objectives for combining content from different sources as described in the Specification, and (6) the lack of clarity as to what Patent Owner disclaimed during prosecution relative to claim 13. *See Tempco Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 978 (Fed. Cir. 2014) (The “court also observes that the PTO is under no obligation to accept a claim construction proffered as a prosecution history disclaimer, which generally only binds the patent owner.”); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279 (1877) (patents are procured *ex parte*; the public is not bound

by decision of the Patent Office to issue a patent); *Switzer v. Sockman*, 333 F.2d 935 (CCPA 1964) (decision made during *ex parte* examination not binding in subsequent interference involving application in which holding was made); *Sze v. Bloch*, 458 F.2d 137, 140 (CCPA 1972) (same).

Consistent with the '243 patent Specification, and taking into account prior arguments by Patent Owner, regardless of whether or not the content of data of interest and the program relate to each other, a proper (coordinated) relative position of the two would include a simultaneous presentation of data of interest and a program. Such a simultaneous presentation may include an overlay, or a separate window, for example, of some form of the data (e.g., a graph) with the program, as discussed in connection with Figure 1C.

The particular content relationship between the data and program may be discernable by the presentation thereof. As noted in the Institution Decision:

[I]n the '1837 Reh'g Decision, the Board indicated that an example of coordinating a display of text with a broadcast video image includes closed-captioning: "It appears that the display of closed-captions for a television program would have a defined relationship to the television program image so as to constitute a 'coordinated display.'" Ex. 2005, 4. Patent Owner's citation to the '1837 Reh'g Decision indicates agreement with the Board's reasoning there. See Prelim. Resp. 17.

Dec. on Inst. 12 n.5 (quoting Ex. 2005, 4).

Patent Owner does not dispute this finding, as quoted above, that closed-captioning, as described in the '1837 Reh'g Decision, would satisfy

the “coordinated presentation” under Patent Owner’s narrower claim construction. *See id.*; PO Resp. 17–21.

Based on the foregoing discussion, in light of the prosecution history, Atlanta litigation, the ’243 patent Specification, and other factors noted above, “coordinate presentation” means “to place or arrange data of interest and a program in a proper position relative to each other in time, location, fashion of playing, content, or manner of presentation.” In other words, a “proper” presentation may or may not include one in which a viewer is able to discern that the content of the data and program are related, as in, for example, closed-captioning.

2. Signal, Instruct Signal

Claim 13 recites a “signal which controls said receiver station to select and process an instruct signal.” Claim 13 also requires the “instruct signal” to be “effective” to “coordinate presentation” of “data” with a “program.” The ’243 patent Specification does not define the terms “signal” and “instruct signal,” which are related as set forth in claim 13. In the Institution Decision, the panel initially construed an “instruct signal” as a signal that “coordinates presentation of data with a program.” Dec. on Inst. 14. Although the parties do not dispute that specific construction explicitly, in light of various arguments presented pointing to the language of claim 13, the construction is slightly modified to track the language of claim 13 as follows: an “instruct signal” is “effective” to “coordinate presentation” of “data” with a “program.”

As described above in Section I.B (Introduction, '243 patent), as an example of creating an “instruction signal” to stimulate the overlay of a stock portfolio, during the broadcast of “Wall Street Week,” after the host describes overall market performance,

the host says, “[a]nd here is what your portfolio did.” *At this point, an instruction signal is generated at said program origination studio, embedded in the programming transmission, and transmitted. . . . Said signal instructs microcomputer[] 205. . . to overlay composite video information and transmit the combined information to TV monitor [205].*

Id. at 14:23–33 (emphasis added).

As the passage implies, the statement by the host somehow causes something at a studio (i.e., television station) transmitter to generate the “instruction signal,” and then later, at the user’s receiver,

[s]aid [instruction] signal is identified by decoder, 203; transferred to microcomputer 205, and executed by microcomputer, 205, at the system level as the statement, “GRAPHICS ON.” Said [instruction or instruction derived] signal instructs microcomputer, 205, at the PC-MicroKey 1300 to overlay the graphics information in its graphics card onto the received composite video information and transmit the combined information to TV monitor 202M.

Id. at 14:24–33.

In these passages as quoted above, the '243 patent Specification does not describe explicitly what “transmitting . . . a signal” entails, which claim 13 recites. The passages quoted above imply, for that specific example, that the programming transmission may itself constitute, or include, the claimed “signal,” and that the transmission also includes the claimed “instruct signal”

as an “embedded” signal (i.e., perhaps via some modulation type within the television broadcast). For example, after the host says its triggering phrase about “your portfolio,” “[a]t this point, [somehow] an instruction signal is generated at said program origination studio, embedded in the programming transmission.” *Id.* at 14:23–33. Later in the processing of the transmitted “instruction signal,” it becomes a “GRAPHICS ON” statement “at the system level,” such that (apparently) it is effective to coordinate an “overlay [of] the [stored] graphics information in its graphics card onto the received composite video information and transmit the combined information to TV monitor 202M.” Ex. 1003, 14:24–33.

Therefore, based on these passages describing the “Wall Street Week” embodiment, the “programming transmission” appears to correspond to, or include, the claimed “signal [of claim 13] which controls said receiver station to select and process an instruct signal,” wherein the “instruction signal” also is embedded in, or included with, the “programming transmission” or “signal” of claim 13. *See id.* at 14:24–33. Patent Owner’s description of the claimed invention relies on the same “Wall Street Week” example, but Patent Owner does not explain what constitutes the claimed signal clearly, if at all. For example, Patent Owner ambiguously states that “[t]he same receiver station could be controlled by *an instruct signal* received from another source (*e.g.*, a programming source) *to select and process an instruct signal* that is effective at the receiver station to provide the ‘Wall Street Week’ coordinated presentation.” PO Resp. 8 (citing Ex. 1002, 19:5–20:11) (emphasis added). That description agrees somewhat

with the above analysis that shows that an “instruct signal” may have various forms depending on the stage of processing, but it conflates one “instruct signal” with another and fails to address the “signal” of claim 13. In another description, Patent Owner states that “[i]n response to another transmitted instruction, the microcomputer of the receiver station automatically overlays” a user’s stock portfolio graph with “content common to all viewers on the show,” and transmits the combined graph and content to a monitor. PO Resp. 6. Patent Owner does not mention the “signal” in this latter description or explain how it relates to the “instruction signal.”

Based on the foregoing discussion, and in light of the claim language, a signal may or may not include part of a program transmission, and the instruct signal may or may not be part of the same program transmission. In addition, claim 13 does not specify that the instruct signal must come from a second remote source.

3. Remote

Petitioner contends that the broadest reasonable interpretation of “remote” encompasses the “remote” controls disclosed in the art. Pet. Reply 5 (citing Ex. 1036 ¶ 28). In addition to relying on the ’243 patent Specification, Petitioner cites, for analogous support, *Brookhill-Wilk 1, LLC v. Intuitive Surg., Inc.*, 334 F.3d 1294, 1297, 1302 (Fed. Cir. 2003) (construing “remote location” to encompass locations in the same room, and concluding that lower court erred by construing “remote location” as “a location outside the operating room where the patient undergoing surgery is

located”). The *Brookhill-Wilk* court did not apply the broadest reasonable construction, which applies here, but nonetheless, construed “remote” consistent with the manner that Petitioner advances: i.e., a remote control can be local.

Petitioner also argues as follows:

Indeed, the ’243 patent twice refers to a “remote keyboard.” (Ex. 1003 at 4:12; 4:28.) Although the ’243 patent refers to “remote geographic stations” (7:44), it does not require any particular distance. Even the word “geographic” in PMC’s construction would not differentiate between miles and feet.

Pet. Reply 3 (citing Ex. 1036 ¶ 29).

Patent Owner contends that “**local** is the very opposite of **remote**.” PO Resp. 24. Patent Owner also argues that “[t]he ’243 Patent and the ’490 Patent Specification distinguish a remote station from a local peripheral device, such as a keyboard or a remote control unit, referring to such a device as ‘local input.’” *Id.* at 23 (citing Ex. 1003, 152:33–37; Ex. 1002, 20:23–27). Patent Owner concludes that “[a] ‘local’ device is **at** the receiver station; a ‘remote’ device is **not at** the receiver station—it is somewhere else.” *Id.* at 24. Patent Owner also argues that “[t]he ’243 Patent, for example, describes remote stations as stations that are in ‘geographically separate locations.’ (Ex. 1003 at 221:50–53.) Similarly, the related ’490 Patent Specification describes that its stations have the capability to transmit data to a remote sites, which are at different ‘geographic location or locations.’” *Id.* at 23 (citing Ex. 1002, 8:46–55; 1:49–53; 3:20–25). Patent Owner also contends that Petitioner’s declarant, Dr. Neuhauser, supports

Patent Owner's position by agreeing that a keyboard constitutes part of a receiver station. *See id.* at 24.

Petitioner's construction is consistent with the '243 patent Specification and the ordinary meaning of the term. The term "remote" encompasses the normal meaning of "remote keyboard" in the context of a remote control that the '243 patent Specification describes. *See* Ex. 1003, 4:12; 4:28. Essentially, the remote keyboard is remote, even though it may be at or near a local station, because it provides automatic wireless control of electronic equipment from an undefined distance to that equipment at the local station. *See id.* Petitioner also points out that remote controls were ubiquitous in 1987, and the '243 patent does not exclude these ubiquitous remote controls from the ordinary meaning of "remote" at the time of the invention. *See* Pet. Reply 4; Ex.1036 ¶ 28 (noting that Reiter, Ex. 1025, 3:54–57, Summers, Ex. 1010, 6:35–40, and other references refer to a "remote control"). Dr. Neuhauser and Petitioner also persuasively explain that Patent Owner's assertion that Dr. Neuhauser supports the Patent Owner's position takes Dr. Neuhauser's testimony out of context. *See* Ex. 1036 ¶¶ 33–34 (explaining that Dr. Russ conflates alternative embodiments advanced by Dr. Neuhauser).

As Petitioner contends, at best, "the patent inconsistently uses 'local' to refer to both devices that are physically part of the station, as well as 'local television and radio stations.'" Pet. Reply 5 (citing Ex. 1003, 3:40–44, 16:16–19, 22:3–10, 180:19) (discussing "widely separated local broadcast stations"). Patent Owner's arguments do not clarify these

inconsistencies in a manner that shows that the term “remote” excludes the wireless “remote keyboard,” as disclosed in the ’243 patent, and other similar ubiquitous remote control devices for controlling relatively local receiver equipment. *See* Ex. 1003, 4:12; 4:28. Claim 13 also does not recite a geographically separate or local receiver that otherwise may have precluded a remote source from also being part of that local receiver.

In addition, the ’243 patent Specification employs the term “remote” by itself, and also with the term “geographically separate locations,” thereby indicating the two terms do not necessarily mean the same thing. *See* Ex. 1003, 4:12; 4:28, 221:50–53. Consistent with the rationale and holding of *Brookhill-Wilk*, 334 F.3d at 1297, 1302, nothing in the ’243 patent limits the term “remote” to any specified distance, and the term “remote,” as used in the ’243 patent, includes wireless devices that artisans of ordinary skill termed a “remote control” device prior to, and concurrent with, the time of the invention. *See* Ex.1036 ¶ 28 (noting that Reiter, Ex. 1025, 3:54–57, Summers, Ex. 1010, 6:35–40, and another prior art reference each refer to a “remote control” wireless device); 1003, 3:40–44 (describing a “remote keyboard” in the vicinity of, and controlling, a television receiver).

B. Priority

The prior art status of Reiter (filed May 28, 1985) under 35 U.S.C. §102(e) hinges on the priority date for the ’243 patent with respect to claim 13. Petitioner contends that the earliest priority date for the ’243 patent is September 11, 1987. Pet. 9. The ’243 patent was filed as a CIP (continuation-in-part) application through a chain of continuing applications

purportedly having a priority date of November 3, 1981—the filing date of the earliest-filed ancestor patent in the chain, U.S. Patent No. 4,694,490. *See* Ex. 1002 (“the ’490 patent”). Patent Owner contends that the priority date of the ’243 patent is “the November 3, 1981 filing date of the ’490 [p]atent.” PO Resp. 8. The parties agree that the latest possible priority date for claim 13 of the ’243 patent is September 11, 1987. *See id.* at n.1; Pet. 9.

For the reasons that follow, Patent Owner has not rebutted Petitioner’s initial showing that the ’243 patent, a CIP, is not entitled to the earlier filing date of the ’490 patent.

1. Transmitting a Portion of Data in Response to a Query

According to Petitioner, the claim phrase “transmitting *at least a portion* of said data from said first remote data source to said receiver station in response to said step of receiving said query, said receiver station *selecting and storing said transmitted at least a portion of said data*,” lacks original support in the ’490 patent specification. Pet. 14 (emphases added to claim 13).

The relevant portion of the ’490 patent specification, as filed in 1981, follows:

Each weekday, microcomputer, 205, receives, [at] about 4:30 PM, by means of a digital information channel, all closing stock prices applicable that day. It may receive these directly or it may automatically query a data service for them in a predetermined fashion. It records those prices that relate to the stocks in its stored portfolio.

Ex. 1002, 19:35–41; PO Resp. 10 (quoting the passage).

Patent Owner contends that

[a]s seen, the 1981 [’490 patent s]pecification describes that, in many cases, the receiver station receives only *a portion* of the data stored at the remote data source and that in response to a query, only the stocks “applicable that day” are transmitted and received at a receiver station. (*Id.* at 19:35–41 ([“]It may receive these directly or **it may automatically query a data service for [all closing stock prices applicable that day] in a predetermined fashion. It records those prices that relate to the stocks in its stored portfolio.**”)[])]

Prelim Resp. 12 (quoting Ex. 1002 as noted, emphases and additions by Patent Owner); see PO Resp. 10 (discussing the same passage).

In the Institution Decision, we determined that Patent Owner’s position about priority was not persuasive on that limited record. We reasoned that according to the cited passage in the (1981) ’490 patent specification, and according to Patent Owner’s arguments, each receiver stores only a subset of the data (i.e., “those prices that relate to the stocks in its stored portfolio”) that the remote source transmits (i.e., “all closing stock prices applicable that day”), but claim 13 requires the receiver to store all the transmitted data. *See* Dec. on Inst. 16. That is, claim 13 recites “transmitting *at least a portion* of said data from said first remote data source to said receiver station *in response to said step of receiving said query*, said receiver station *selecting and storing said transmitted at least a portion of said data.*” Ex. 1003, 300:22–26 (emphases added). In essence, in claim 13, the receiver’s query controls the portion of data transmitted to the receiver. In contrast, in the ’490 patent specification, the transmitter controls the data—it sends all the stock data for a given day, and the receiver

then culls and records subscriber stock data from that transmitted data. *See* Ex. 1002, 19:35–41; Prelim. Resp. 12 (as quoted above, Patent Owner adding information to show that the ’490 patent discloses querying for “[**all closing stock prices applicable that day**]”).

Patent Owner advances several reasons for original written descriptive support. *See* PO Resp. 10–11. First, Patent Owner contends that Dr. Neuhauser, Petitioner’s declarant, agrees with Patent Owner that the passages discussed above in the ’490 patent specification fairly teach to a skilled artisan the notion of transmitting only stock information pertaining to a user’s portfolio. PO Resp. 12 (citing Ex. 2011, 57:18–58:2). Contrary to Patent Owner’s argument, however, as Petitioner points out, Dr. Neuhauser was not testifying about the ’490 patent specification. Pet. Reply 6. Rather, the deposition shows that the line of questioning concerned “the ’243 patent,” specifically, spanning the following column and lines: 236:65—237:10. *See* Ex. 2011, 48:5–50:16. Dr. Neuhauser verifies this. Ex. 1036 ¶¶ 18–19 (stating “I responded based only on the ’243 patent”; “I had not reviewed the ’490 patent prior to my deposition and I did not attempt to testify about it in any way”; and, “this passage” relates to the ’243 patent).

Second, Patent Owner argues that “Dr. Russ further explains that this concept of storing all of the data was well known by November 3, 1981.” PO Resp. 12 (citing Ex. 2009 ¶ 52). As Petitioner points out, however, written description support requires more than what may be known by, or obvious to, other ordinarily skilled artisans. Pet. Reply 6–7. Under the written description requirement of 35 U.S.C. § 112, first paragraph, “the

applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991) (emphasis omitted). Testifying about what was known, without more, fails to show that the ’490 patent applicants conveyed with reasonable clarity that they possessed the step of querying for a specified set of data, as opposed to simply querying for a data dump of all closing stock prices to be filtered at the receiver.

Third, Patent Owner advances the buffering theory. Under this theory, the receiver of the ’490 patent inherently *temporarily* stores in a buffer, and filters, “the all-stock data” it receives (and then presumably discards unwanted stock data). *See* PO Resp. 12 (citing Ex. 2009 ¶ 58). Even if such buffering is inherent, it fails to show requisite support for claim 13. As Petitioner explains, claim 13 requires *storing and also presenting* all the transmitted data: Claim 13 recites “presentation of *said* at least a portion of said data,” which refers back to “transmitting at least a portion of said data” and “storing said transmitted at least of portion of said data.” *See* Pet. Reply 7 (emphases added to claim 13 by Board). The ’490 patent does not describe presenting buffered information and Patent Owner does not so contend. Rather, according to Patent Owner’s argument, that buffered information would have been filtered out and discarded (i.e., not stored further for presentation). *See* Pet. Reply 7; PO Resp. 12.

Fourth, Patent Owner advances the query theory as follows. PO Resp. 11–12. Patent Owner contends that the ’490 patent specification discloses

querying for data, and a skilled artisan at the time of the '490 patent invention would have understood that a query can be selective. *See id.* Petitioner and Dr. Neuhauser respond to this theory, including testimony by Dr. Russ, and persuasively show that it does not show support for claim 13 in the '490 patent specification. Ex. 1036 ¶¶ 12–20.

In particular, Dr. Neuhauser testifies regarding the '490 patent as follows:

There is no disclosure of a query or series of queries that would ask only for those stock prices that are relevant to a particular user's portfolio. In this citation, one of skill in the field would understand that the word "applicable" does not refer to the particular stock prices relevant to a given user, but rather to all the stocks that have closing prices on a given day. Dr. Russ's interpretation as expressed in paragraph 51 [of Ex. 2009] would render the last sentence of the citation at '490 19:35–41 meaningless because closing stock prices would have already been selected, so no consideration of the user's specific portfolio would be required.

Ex. 1036 ¶ 17 (discussing Ex. 1002, 19:35–41; Ex 2009).

As Petitioner and Dr. Neuhauser persuasively contend, the cited passage at column 19 in the '490 patent refers to querying for, and receiving, all closing stock prices for a given day. In the phrase "all closing stock prices applicable that day," "applicable that day" means "that [given] day," rather than applicable to a specific user's portfolio. After receiving all the prices for that day, the receiver filters out and "records those prices that relate to the stocks in its stored portfolio." *See* Ex. 1002, 19:35–41. In other words, the '490 patent's disclosed receiver does not control what the

transmitter sends—the receiver filters and records what the transmitter sends it. *See also* Prelim. Resp. 12 (as quoted above, Patent Owner adding information to show that the '490 patent discloses querying for “[**all closing stock prices applicable that day**]”).

Finally, in a footnote, Patent Owner advances the stock broker theory. Under this theory, a stock broker downloads all the closing price stock data according to the '490 patent. PO Resp. 12 n.2. Petitioner responds in another footnote: “PMC argues that the '490 disclosure could address the unusual situation where the data source contains only the stocks in the [stock broker]’s portfolio. (Resp. at 12 n.2.). If so, the '490 [patent] would not disclose transmitting ‘at least a portion’ of the stored data.” Pet. Reply 7 n.3. Petitioner’s response is persuasive. Claim 13 requires transmitting “*at least a portion of the stored data.*” Hence, the '490 patent must provide support for transmitting a range of stored data, from some to all of the stored data. Patent Owner’s stock broker theory does not show support in the '490 patent for transmitting merely some of the closing stock price data in response to a query for it, as claim 13 requires.

2. Disclaimer

Petitioner also contends that in response to a double patenting rejection during prosecution of the '243 patent, Patent Owner twice argued that the '243 patent does not claim continuity to the '490 patent specification. *See* Pet. 15–16 (citing Ex. 1004, 127, 192). Patent Owner does not dispute Petitioner’s contention.

Rather, Patent Owner contends that it made the argument in “error” and attempted to clarify the record. Prelim. Resp. 14; *see also* PO Resp. 15 (Patent Owner contending that it “corrected that statement during prosecution”). Patent Owner also argues that the Examiner could not have relied on the statement because priority is “irrelevant to an *In re Schneller* analysis.”⁴ PO Resp. 15. Patent Owner specifically argued during prosecution that

the examiner’s rejection . . . under the Schneller double patenting theory . . . is improper because the present application does not claim the benefit of [prior] applications Thus, there could never have been a basis for claiming the present subject matter in those applications.

Ex. 1004, 127. In other words, in addition to not seeking priority during prosecution, Patent Owner conceded “*a basis for claiming the present subject matter*” in its earlier filed ’490 patent specification, rendering the Examiner’s reliance thereon reasonable. *See* Ex. 1004, 127, 192 (emphasis added).

Notwithstanding Patent Owner’s other arguments, Petitioner persuasively shows that Patent Owner fails to establish that it sufficiently corrected its disavowal of priority and support during the original prosecution of the ’243 patent application. *See* Pet. Reply 9 (“PMC never

⁴ Under *In re Schneller*, 397 F.2d 350 (CCPA 1968), the Examiner rejected then-pending claims on the premise that there was no reason why Patent Applicant could not have presented the claims in the earlier application, thereby implicitly asserting written description support therefor. *See* Ex. 1004, 221; PO Resp. 14.

advised the examiner that it was withdrawing its prior disclaimer, or that the double patenting rejection should be revisited.”); PO Resp. 14–15. Patent Owner contends it corrected any “error,” regarding its disavowal of priority, but the Examiner only requested a clarification as to “[n]umerous references listed in the IDS [Information Disclosure Statement] . . . *subsequent to applicant’s latest effective filing date of 9/11/87*, therefore, the relevancy of these references is unclear.” Ex. 1004, 70 (emphasis added). In response to the Examiner’s request, Patent Applicant’s allegedly corrective comment during prosecution presents no clear clarification: It repeats the Examiner’s statement about “the effective filing date of 9/11/87,” states that applicant “eliminated those patents and publications after the effective filing date for the present application,” and follows that with “Applicants’ understanding that the effective [sic] for the present application is 11/3/81.” See Ex. 1004, 48. Given the Examiner’s position asserting the later effective filing date “of 9/11/87,” Patent Applicant’s self-serving “understanding,” absent an amendment to request continuation status (as opposed to the ’243 patent application’s continuation-in-part status), or some other action requiring responsive input by the Examiner, failed to clarify the record.

Contrary to other characterizations about its alleged clarification during prosecution of the ’243 patent, as Petitioner argues, Patent Owner filed an IDS, subsequent to its “understanding,” and agreed to eliminate references after the effective filing date, which included dozens of references post-dating the alleged Nov. 3, 1981 date. See Ex. 1004, 23–24; Pet. Reply

9; PO Resp. 15.⁵ Patent Owner’s statement in a reply brief during a reexamination proceeding involving the ’243 patent also fails to clarify the disclaimer made during the original prosecution. PO Resp. 15 (citing Ex. 1005, 139). Even if the statements made during the reexamination in a reply brief somehow override the original prosecution disavowal, Patent Owner’s reply brief statement that “the Examiner has not contested the priority in the Answer,” fails to acknowledge Patent Owner’s other reply brief statement that “[t]he Examiner asserts that the issue of priority is moot as intervening references are not relied upon in any of the rejections.” Ex. 1005, 139. Patent Owner fails to explain how a moot issue clarifies a disavowal. See PO Resp. 15.

3. Program

In its final priority challenge, Petitioner contends that Patent Owner impermissibly broadened the definition of the term “programming” in an amendment to the ’243 patent Specification. Pet. 10–13 (citing Ex. 1003, 6:37–40, 206:35–50; 274:28–34, Fig. 7). Petitioner contends that “satellite receiver circuitry” also was newly added to accommodate the broader definition. See *id.* at 12–13 (citing Ex. 1003, 206:35–50; 274:28–34, Fig. 7).

⁵ Patent Owner’s assertion during prosecution on March 6, 1998, that it attached a corrected and substitute IDS as Appendix B, fails to show what it eliminates as references—there does not seem to be an Appendix B filed, or if one was filed, it does not show any corrections. See Ex. 1004, 48, 51–60 (showing an IDS dated March 6, 1998, wherein the Examiner only considered references on the first page of the IDS, Ex. 1004, 51). In any event, the IDS fails to clarify anything.

The record shows that the term “programming” was initially described in the ’490 patent specification as “mean[ing] everything transmitted over television or radio” and thereafter was broadened in the ’243 patent Specification to include “everything that is transmitted electronically.” *Compare*, Ex. 1002, Abstract, *with* Ex. 1003, 6:37–40; *see* Pet. 11–13.

Patent Owner fails to clarify whether or not the broader definition of “programming” applies to the claim term “mass medium program” as recited in claim 13. *See* PO Resp. 13–14. Patent Owner does not dispute that “the 1981 Specification [i.e., the ’490 patent specification] describes the term ‘programming’ differently than the 1987 Specification.” PO Resp. 13. Relying on prior Board decisions, and focusing on the term “program” instead of “mass medium program” as recited in claim 13, Patent Owner equivocally states that “[e]ven if there was a legal basis for Petitioners’ argument, there is no dispute that claim 13’s ‘*program*’ is supported by the ’490 Patent Specification.” *Id.* at 14 (emphasis added).

Patent Owner also argues that “[t]here is no legal or factual basis for” Petitioner’s theory, but Patent Owner fails to respond to Petitioner’s reliance on *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306–1311 (Fed. Cir. 2008) (concluding that original specification does not support a claim that receives a broader construction based on later-filed new matter defining a term of the claim). *See* PO Resp. 13–14; Pet. Reply 8; Pet. 10. Patent Owner’s reliance on what occurred in other Board decisions concerning related patent reexaminations, even if those are relevant, simply does not account for the holding in *Power Oasis*. *See* PO Resp. 13–14 (citing Ex.

2006, 13–16, Ex. 2003, 20–21); Pet. Reply 8 (arguing that the relied-upon Board decisions do not address *Power Oasis*). Based on the foregoing discussion, Patent Owner has not rebutted Petitioner’s showing that *Power Oasis* governs the analogous situation here: Patent Owner impermissibly broadened the term “mass medium program,” as recited in claim 13, relative to the narrower definition of “programming” in the ’490 patent specification, by later amending and broadening its definition for the term “programming” in the ’243 patent Specification.

4. Summary

For the three independent reasons outlined above, Petitioner sufficiently establishes that the earliest priority date for claim 13 of the ’243 patent is September 11, 1987. Patent Owner has not shown that it is entitled to an earlier priority date. Accordingly, Reiter constitutes prior art.

C. Anticipation Ground: Reiter

1. Reiter’s Teachings

Reiter discloses an electronically controllable television system that can be updated with programming information through a microcontroller. Ex. 1025, Abstract. Figure 2 of Reiter follows:

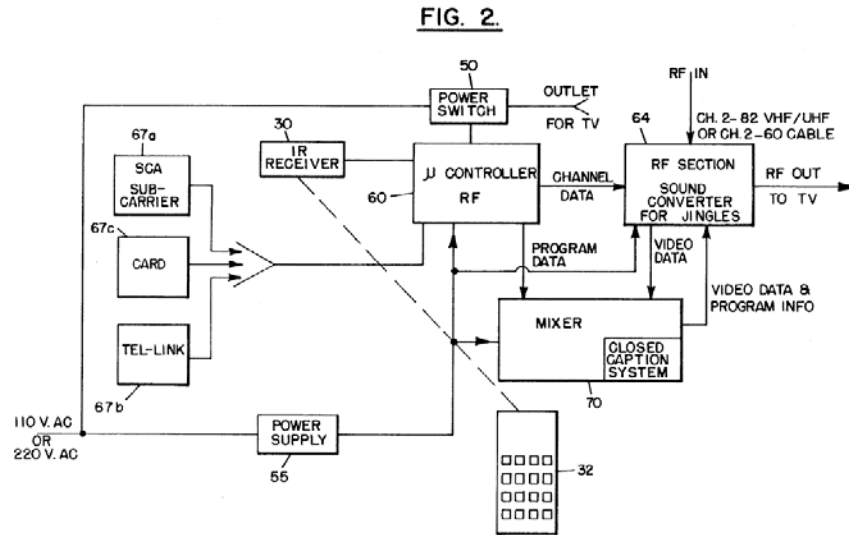


Figure 2 shows remote control 32 for controlling inputs to television mixer 70 via IR receiver 30 and controller 60. Ex. 1025, 3:54–56, 4:18–24. Remote control 32 can direct microcontroller 60 to output information contained in a random access memory (RAM) to be mixed with television signals and output on the television screen in a particular format, including “output formats such as window or overlay format, or a full screen display.” See *id.* at 4:9–29, 4:63–5:15.

Displayable information provided to the RAM, or other memory, may be obtained over telephone linkage 67b by automatically “dial[ing] the central computer.” *Id.* at 4:48. Specific “information regarding television scheduling, local movie listings, railroad schedules, local sporting events, theater listings, etc.” may all be accessed from the central computer in this manner. *Id.* at 4:40–43.

When contact is made between the central computer and box 15 via the modem at input port 25, the computer can download all the relevant information into the RAM of microcontroller 60,

thereby providing “updated” information This information may then be processed and accessed in accord with the remote control instructions of the television viewer.

Id. at 4:48–56.

2. Analysis of Reiter

Petitioner asserts that Reiter anticipates claim 13. Pet. 54. Relying on its declarant, Dr. Neuhauser (Ex. 1001), Petitioner asserts that “TEL-LINK” 67b in Figure 2 of Reiter provides a link to a central computer that sends data downloads, including guide schedules and other data of interest, to Reiter’s RAM pursuant to a query from Reiter’s subscriber system. *See* Pet. 55–57 (citing Ex. 1025, Abstract, 2:62–3:3, 4:44–54, 5:22–54; Ex. 1001 ¶¶ 171–173). Petitioner reads the preamble and steps [a]–[c] of claim 13 onto this disclosure in Reiter. *See id.* at 54, 56–57. According to Petitioner’s claim chart, and claim 13, these claim steps require sending data of interest stored at a first remote computer to a receiver station in response to a query from the receiver station, which stores the data. *See* Pet. 57.

Step [d] of claim 13 requires transmitting a signal from a second remote source, which controls the receiver station to process an instruct signal effective to coordinate presentation of said at least a portion of the stored data with a program. Petitioner reads the second remote source signal on signals transmitted by Reiter’s remote control, and the instruct signal on signals thereafter processed by Reiter’s microcontroller. *See* Pet. 55–58 (citing Ex. 1025, 1:18–58, 2:19–29, 2:45–47, 3:18–21, 3:54–57, 4:18–21, 4:65–5:2, 5:14–27, 5:37–46, 6:39–51, 7:40–50; Ex. 1001 ¶¶ 177–181).

The record supports Petitioner’s contentions, as outlined above and as discussed further below. According to our review of the record, Petitioner has shown by a preponderance of the evidence that Reiter anticipates claim 13.

i. Second Remote Source

Patent Owner contends that Reiter’s remote control does not constitute a second remote source. PO Resp. 25–26; *see* Ex. 1025 (Fig. 2, remote control 32). Patent Owner’s argument rests on claim construction and does not rebut Petitioner’s showing based on the reasons discussed above. *See* Section II.A.3 (Claim Construction); Pet. Reply 20–21. In summary, as explained in the Claim Construction section, the plain and ordinary meaning of a remote source includes a remote control, which is consistent with the ’243 patent Specification, and nothing in the ’243 patent specifies a minimum distance requirement for a remote control source or disclaims known remote control devices such as Reiter’s. *See* Section II.A.3 (Claim Construction).

ii. Instruct Signal Effective to Coordinate Presentation of Data and Programming

Patent Owner argues that Reiter does not “explicitly or inherently disclose[] a signal from a second remote source that controls the receiver station **to select and process an instruct signal.**” PO Resp. 26. Patent Owner contends that Reiter’s program data refers to TV content and does not coordinate presentation data and programming. *See id.* at 26–30 (citing Ex. 2009 ¶¶ 105, 107, 109, 117). Patent Owner also contends that Petitioner

improperly conflates program data and an instruct signal, and fails to show that Reiter's system processes and executes instructions. *See id.* at 26–28.

Petitioner responds as follows:

[A]s Neuhauser explained, Reiter discloses transmitting signals from the remote control unit 32 to the IR receiver 30 that control the system display and are used to select output format and the data to be displayed. (Ex. 1001 ¶ 178) (citing Ex. 1025 at 3:54–57; 4:18–21; 4:47–5:2; 5:57–6:3). The signal transmitted from the remote control causes the microprocessor to select and process instructions stored in ROM which are the claimed “instruct signals.” (*Id.* ¶ 179.) Alternatively, as shown in Figure 2, the microprocessor instructions cause the production of “instruct signals” that are transmitted on the line labeled “program data.” (*Id.*; Ex. 1036 ¶ 41.)

Pet. Reply 21.

Petitioner's description above of Reiter's system, in the context of claim 13, is persuasive, as the record supports it, according to the citations above and as explained further below. Patent Owner's argument and evidence do not rebut the showing. *See* PO Resp. 26–30 (citing Ex. 2009 ¶¶ 105, 107, 109, 117). Patent Owner does not dispute that, pursuant to remote control input by a viewer, Reiter's remote control device sends a signal that ultimately controls the receiver to display viewer-selected RAM storage information to an overlay or window with the chosen television program or movie. *See* Ex. 1025, Abstract; 6:39–7:2, Ex. 2009 ¶¶ 105–117). Patent Owner also does not dispute that, after the viewer selects specific stored and downloaded information in the RAM via the second remote source (i.e., remote control 32), “in accord with instructions from the

microcontroller, [the mixer] properly mixes the requested information with the rf [(radio frequency)] video data being received.” *See* Ex. 1025, 6:44–46; PO Resp. 26–30 (citing Ex. 2009 ¶¶ 105–117).

In essence, Reiter’s system responds to a remote control signal instigated by a user, which necessarily causes the TV system to respond and select an “instruct signal effective . . . to coordinate presentation” of the TV overlay data (e.g., “specific critical reviews of movies,” “television scheduling information,” “local theater . . . showings and time schedules, as well as community events, railroad time schedules, local sports events, etc.”) with the “television program he is currently watching.” Ex. 1025, 5:39–45, 6:37–38.

As Petitioner summarizes, “Reiter explains that the microcontroller sends the mixer instructions that indicate how the overlay is to be arranged (i.e. scroll or new window) and which data is to be included.” Pet. Reply 22 (citing Ex. 1025, 6:38–51; Ex. 1001 ¶ 178). The record supports Petitioner in this regard also: In Reiter, microcontroller 60 controls the process based, in part, on inputs from remote control 32. *See* Ex. 1025, 5:7–13 (mixing stored RAM and television RF data in accordance with microprocessor instructions), 6:25 (advertising information “sent by the microcontroller”), 6:42–54 (“The determined information located by the microcontroller is then controllably sent to the mixer which, in accord with instructions from the microcontroller, properly mixes the requested information with the rf video data being received from the antenna or cable. In addition, at 160 and 165 [see Fig. 3], the mixer is told by the viewer, via instructions from the

microcontroller, whether to scroll . . . or whether and when to display new full windows or screens of information.”).

In other words, as Dr. Neuhauser explains and Petitioner contends in response to Patent Owner’s arguments, the “PROGRAM DATA” line in Figure 2 of Reiter includes microcontroller control signals that go to mixer 70 to control it, as Reiter describes, and the microcontroller (or microprocessor) selects and processes instructions stored in memory. *See* Pet. Reply 21; PO Resp. 27; Ex. 1025, 6:38–51, Fig. 2; Ex. 1001 ¶¶ 179–80; Ex. 1036 ¶¶ 41–42 (selecting and processing instructions “is exactly what a microcontroller is designed to do”); Ex. 1025, 4:9–28 (microcontroller or microprocessor uses RAM or other memory).

The above-noted descriptions in Reiter of microcomputer instructions for forming integrated viewing, including an overlay or other integrated display, correspond to the “instruction signal” as disclosed in the ’243 patent, a form of which ultimately becomes a “GRAPHICS ON” statement “at the system level,” and is effective to coordinate an “overlay [of] the [stored] graphics information in its graphics card onto the received composite video information and transmit the combined information to TV monitor 202M.” Ex. 1003, 14:24–33; *see also supra* Section I1.A.2. (Claim Construction of Signal, Instruct Signal).

Patent Owner also argues that a superimposed programming schedule “onto any screen of the television programming is not a *coordinated* presentation” because the “BPAI found that ‘merely superimposing . . . the stock performance in Hedger (p. 564), at a certain location on the display of

the television program, where the television image has no defined relationship to the content of the television program’ . . . is **not a coordinated display**.” PO Resp. 28–29 (quoting Ex. 2005, 3–4, emphasis by Patent Owner).

Patent Owner’s argument relates to the ’1837 Reh’g Decision and claim construction. It is not persuasive for reasons outlined above. See *supra* Section II.A.1 (Claim Construction). In the ’1837 Reh’g Decision, as explained in Section II.A.1 above, the Board analyzed a different claim term in a different context (i.e., “coordinated display” using images as opposed to a “coordinated presentation” of data and an image). As also explained above, the Board’s prior claim construction in the ’1837 Reh’g Decision does not limit the language of claim 13. See *supra* Section II.A.1 (Claim Construction). Furthermore, although that prior Board opinion does not bind the claim construction here for reasons stated above in Section II.A.1, the Board’s opinion also does not appear to address whether or not the prior art reference to Hedger discloses or suggests superimposing individual stock information in a display during a program *with similar content*, for example, a program about the stock market. See Ex. 2005, 3–4. This lack of clarity presents another reason why *Tempo Lighting’s* observation regarding prosecution history disclaimer applies here. See 742 F.3d at 978 (The “court also observes that the PTO is under no obligation to accept a claim construction proffered as a prosecution history disclaimer, which generally only binds the patent owner.”).

In addition, Patent Owner does not dispute that relating content in the manner of closed captions satisfies its narrow claim construction. *See supra* Section II.A.1. Similar to a closed-captioning situation, Reiter's disclosure provides for a television programming guide that necessarily includes a program the viewer currently is viewing, thereby relating the superimposed content thereof the program. *See* Ex. 1025, 4:40–56 (disclosing a query for, and subsequent downloading of, “television scheduling” and “local movie listings,” and thereafter, a display of selected information using a remote control device). As indicated, related content includes Reiter's movie listings: In Reiter, pursuant to a remote control signal, the microcontroller can perform searches for “local movie theater movies” and movies on the television, which may be displayed in an “integrated” display and “listed together by time for particular days.” *See* Ex. 1025, 6:63–71. Moreover, in Reiter, the viewer generally can select any subset of information and direct its format for display with a program. *See* Ex. 1025, 5:16–6:63.

Therefore, even if content must be considered under a narrow claim construction, Reiter's system allows related content to be displayed via scrolling, a window, or an overlay, as specified by a user. *See* Ex. 1025, 6:39–51. Nevertheless, Patent Owner characterizes Reiter's display as a “possible occurrence” of a similar overlay, and contends that

an anticipation case cannot be sustained by conjecture or daydreams about what *might* happen if somebody did something, someday. Further, the mere display of information in the programming guide that, by happenstance, relates to the television programming does not satisfy the claim limitation, which requires that an **instruct signal** specifically place or

arrange the program and data in a proper position relative to each other in time, location, fashion of playing, or manner of presentation based on a defined content relationship.

PO Resp. 30.

Contrary to Patent Owner’s argument, a program schedule display that includes a currently viewed program or lists local and television movies is not “happenstance” in Reiter—Reiter discloses a schedule guide of programs for viewing, including necessarily includes programs currently being viewed. Ex. 1025, Abstract, 2:30–37, 6:34–38 (describing “updatable television programming information” and “whether a window format . . . or a television overlay format. . . . , the viewer may continue to view the television program he is currently watching”). As Dr. Neuhauser explains, the guide also explains when “the current program will end.” Ex. 1001 ¶ 181 (discussing Reiter’s television schedule data); Ex. 1025, 6:35–38 (“In [the window and overlay format] situations, the viewer may continue to view the television program he is currently watching.”). Dr. Neuhauser also persuasively describes how a similar overlay or window display of “a critical review of movies or shows” during the viewing of that show or movie, constitutes another example of coordinated display that includes related content. See Ex. 1001 ¶ 181 (discussing and quoting Reiter, Ex. 1025, 5:37–46).

Patent Owner also contends that Reiter “fails to explicitly disclose that television scheduling information is stored at the central computer.” PO Resp. 31 (citing Ex. 2009 ¶ 112). This argument pertains to the claim 13 requirement of storing, receiving, and transmitting data from “a first remote

data source.” Contrary to this argument, the record supports Petitioner’s contention that Reiter discloses downloading the programming data from a remote central computer. Pet. Reply 22 (citing Ex. 1025 at 2:67–68; 4:50–51); Ex. 1025, 4:40–51 (“televising scheduling . . . can . . . be provided on a central computer” and “download[ed]”). As Petitioner explains, downloading information “provided on” the central computer necessarily requires storing that information on the central computer. Pet. Reply 22 (citing 1001 ¶ 171; Ex. 1036 ¶ 46); Ex. 1025, 4:40–44. Dr. Russ’s testimony does not address the “provided on” and “download[ed]” language in Reiter. See Ex. 2009 ¶¶ 111–13. Furthermore, Dr. Russ’s testimony admits that the central computer “may retrieve” and “forward” the information, necessarily implying at least temporary (buffer) storage at the central computer. See Ex. 2009 ¶ 113.

Based on the foregoing discussion, Petitioner shows by a preponderance of evidence that Reiter anticipates claim 13.

*D. Obviousness Ground: Summers in View of Fedida, and
the CBS Petition, Blatt, or Millar*

1. Summers’s Teachings

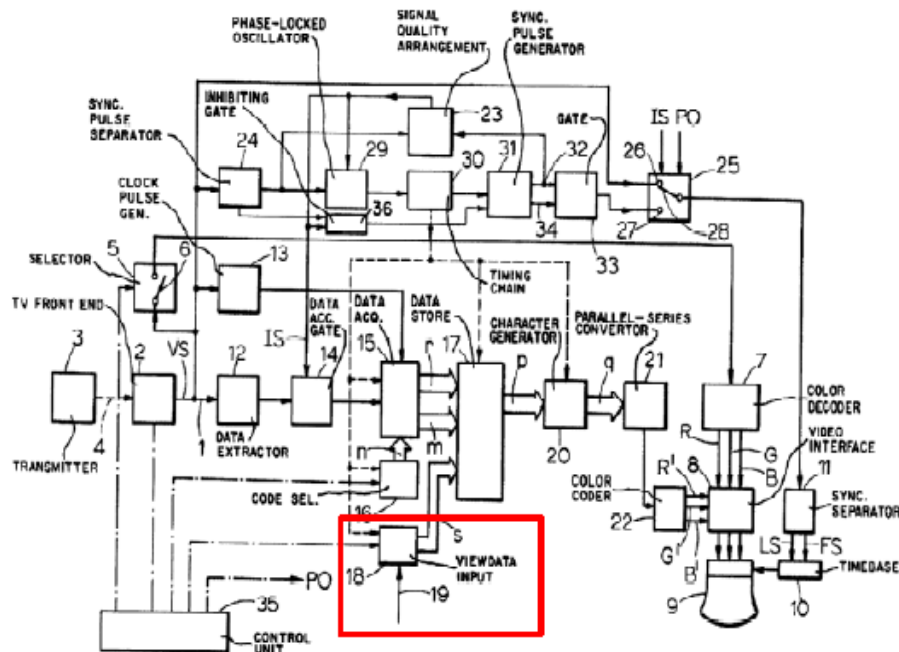
Summers discloses a system in which television receivers display “stored data . . . received either from a television video signal, or from a normal telephone transmission line.” Ex. 1010, 1:49–52. The former is known as teletext or Teletext data, and the latter, Viewdata. See *id.* at 3:11–16, 50–62.

According to Summers,

[t]he possibility can also exist for displaying such message information [which is produced from coded data pulses] concurrently with a television picture, for instance as sub-titles or captions which are superimposed on the television picture. The television receiver arrangement is also adapted to receive and display message information received from another source, such as Viewdata information as transmitted over a telephone line in the experimental British Post Office Viewdata System (see *Wireless World*, February-May, 1977).

Ex. 1010, 3:7–16 (citing Fedida’s *Wireless World* articles, Exs. 1026–28, *see supra* note 1).

A version of Summers’s sole figure as annotated by Petitioner follows:



Pet. 31 (annotating with a box around Viewdata input 18, 19). Summers’s annotated figure above highlights a Viewdata input, over telephone line 19,

which is connected for viewing text characters in the television system of Summers. *See* Ex. 1010, Abstract, 2:46–55.

2. *Fedida's Teachings*

As noted above, Summers cites Fedida, which generally describes a typical Viewdata system. Exs. 1026–28; Ex. 1010, 3:7–16; *supra* note 1. For example, according to Fedida II, a “[V]iewdata adaptor” transmits queries to a Viewdata computer (connected to data banks through a telephone link) and receives the requested data in response to those queries. Ex. 1028, 65; *supra* note 1.⁶

3. *The CBS Petition*

The CBS Petition explains, as background, that “[t]eletext is the generic term for systems that transmit alphanumeric information (letters, numbers, [and] characters) to the home television receiver.” Ex. 1007, 2. The CBS Petition also explains that the alphanumeric information may “appear as letters, numbers and graphics on the television screen.” *Id.* The information transmits simultaneously with the normal television picture information in specific scanning lines in the vertical blanking interval (VBI). *Id.* The information may include pages of information that “[v]iewers can request . . . at any time in any sequence.” *Id.* Further, “[t]eletext could provide *exceptionally efficient captioning to the hearing-impaired community.*” *Id.* at 6 (emphasis added).

⁶ The page number refers to the original page number of the article.

The CBS Petition discloses using “conceal” and “reveal” codes in “Mode 2” to cause a television receiver to display and position a subtitle or closed-caption text at the appropriate time in the program. *See id.* at 112. Captions may be “in various languages, forming classes.” *Id.* “After all varieties of a given caption are sent, one additional record is sent with the conceal flag low This single command causes all decoders *which have been storing a class of captions to display it.*” *Id.* (emphasis added). The CBS Petition also explains that its proposed system would be compatible with videotex (e.g., Viewdata): “Moreover, teletext receivers, manufactured pursuant to these standards, can be made compatible with later systems, such as videotex – a complementary two-way information system using a telephone set connection.” *Id.* at 7; *see also* Ex. 1001 ¶¶ 82, 89–90 (discussing the CBS Petition and Mode 2). The CBS Petition discloses other uses, including checking on local traffic conditions, finding “headlines and sports scores . . . programmed and updated and available to the teletext user upon request.” *Id.* at 6. The various uses were predicted to help drive down volume costs for the decoder market “rather than being limited to those desiring specialized captioning.” *Id.*

4. Blatt’s Teachings

Blatt discloses that “[m]ost teletext systems afford the captioner complete freedom in the screen placement of text.” Ex. 1008, 719 ¶ 2. Blatt also describes providing a range of selectable font sizes, different languages, and background and foreground color, which in addition to “variable placement,” indicates which character is speaking. *See id.* at 719 ¶¶ 2–3.

5. Millar's Teachings

Millar discloses closed-captioning and discloses that the digital data can be recorded “to enable later use of the signal or at least the data signal portion.” Ex. 1009, 2:93–95. Millar also discloses “[m]arkers” in the transmitted signal to create a box for displaying the alphanumeric information in various ways, including simple superposition. *Id.* at 2:87–90.

6. Analysis

Petitioner provides a detailed explanation, including a claim chart, and testimony by Dr. Neuhauser, to explain how the combined teachings of Summers, Fedida, and the CBS Petition, Blatt, or Millar, renders obvious claim 13. *See, e.g.*, Pet. 39–41 (claim chart); Ex. 1001 ¶¶ 118–126. Petitioner generally relies on the Viewdata teachings in Summers, as amplified by the discussion thereof in the secondary teachings, including Fedida and the CBS Petition, Blatt, or Millar, as satisfying the preamble and steps [a]–[c] in claim 13. *See id.* at 39–40. In other words, data transmitted over a telephone line from “another source, such as Viewdata,” which Summers describes in part by citing to Fedida’s Viewdata three-part series (*see supra* note 1), corresponds to providing data of interest from a first remote source, and storing that data at the receiver station, as set forth in claim 13. *See* Ex. 1010, 3:11–16 (citing “*Wireless World*, February–May 1971”); *supra* note 1 (Fedida’s *Wireless World* three-part series, Exs. 1026–28); Pet. 32 (discussing Fedida III, Ex. 1028), 41–42 (claim chart).

Addressing step [d], Petitioner explains that the television broadcast station in Summers constitutes a second remote source, and that the

television signal and synchronization information transmitted with the television broadcast video in Summers corresponds to the “signal” that controls the receiver to select an “instruction signal,” as recited in claim 13. For example, Petitioner states that “Summers uses the synchronization information to coordinate the television display with the message information.” Pet. 41.

Under a second alternative regarding the claimed “signal” transmitted from a second remote source, Petitioner reasons that Summers’s remote control constitutes a second remote source, which “may also be used to cause the system to overlay the Viewdata information with the television program.” *Id.* In other words, the instruct signal need not come from the second remote source, according to claim 13, and the remote signal would be separate from the instruct signal. *See supra* Section II.A.2 (Claim Construction).

Under a modification impacting both alternatives, Petitioner relies on the CBS Petition to suggest modifying Summers’s “instruct signal which is effective to coordinate presentation” of the Viewdata with the television broadcast. *See* Pet. 36–37 n.9 (citing other Board decisions in a related patent application: Ex. 1024, 37 (underlying ’1837 Board Decision of the ’1837 Reh’g Decision, finding in dicta, that the CBS Petition, not relied upon, discloses a similar instruction signal, for example a reveal code, to “cause[] a caption to be displayed”), 45 (same), 57 (same), 66–67 (same); Ex. 1021, 4 (the ’1837 Reh’g Decision discussing closed-captioning as a

coordinated display); Ex. 1020,142 n. 12, 143–145 (discussing Mode II captioning in the CBS Petition)); *id.* at 42 (claim chart).

In other words, regarding step [d], Petitioner asserts that the CBS Petition teaches, or suggests in systems, such as that of Summers, control “instructions that affect the layout of the display.” Pet. 42 (quoting Ex. 1007, 140, and citing *id.* at 66–68, 111–112). Petitioner further asserts that the CBS Petition teaches using codes “to control the color, location, underlining or flashing of text.” Pet. 42 (citing Ex. 1007, 66–68; Ex. 1022, 41–54 (discussing the CBS Petition))⁷; Ex. 1001 ¶¶ 104–106, 147–149)). Petitioner explains that the CBS Petition discloses that its system is compatible with videotext systems, such as Viewdata, and that “[t]he closed captioning text received *is stored in memory until the system receives an instruction to display the data.*” Pet. 40 (citing Ex. 1007, 114; Ex. 1001 ¶¶ 98–99, 141–142) (emphasis added), 38 (describing CBS Petition’s “videotex” and Summers’s Viewdata systems as known two-way videotext systems). Petitioner’s analysis of the claimed “instruct signal” reasonably corresponds to the disclosed “GRAPHICS ON” “instruction signal” as disclosed in the ’243 patent, which is effective to coordinate an “overlay [of] the graphics information in its graphics card onto the received composite

⁷ Exhibit 1022 is another related Board reexamination decision, which also includes findings regarding the CBS Petition, *Personalized Media Commc’ns, LLC*, Appeal 2007-004044 & 2008-000334 (BPAI June 30, 2008). There, the Board found that Mode 2 includes “user specific” or personal captions, as a user can pick its choice of language and other options for a caption to be displayed. Ex. 1022, 44–45.

video information and transmit the combined information to TV monitor 202M.” Ex. 1003, 14:24–33; *see also supra* Section I1.A.2. (Claim Construction of Signal, Instruct Signal).

As an alternative to the CBS Petition teachings, and noting that Summers itself discloses closed-captioning and at least suggests its use via Viewdata, Petitioner relies on Millar or Blatt as teaching providing cues or codes in a television broadcast to control the timing and positioning of subtitle and closed-captioning information. *See* Pet. 38–42.

By way of summary, Petitioner reasons that

[a]s further explained in the Neuhauser declaration, one of skill in the art would have been motivated *to obtain and store closed captioning and other information relating to a program in advance of the program broadcast* by querying a database because it would expand the amount of information that could be supplied (*e.g.* additional languages or other program-related notes) and would allow users to be charged for the service.

Pet. 39 (citing Ex. 1001 ¶ 151) (emphasis added).

The record supports Petitioner’s contentions, as outlined above, according to our review of the record, including the citations above, and as further explained below.

In response, Patent Owner argues that the combination fails to suggest an “instruct signal which is effective at said receiver station to coordinate presentation” of data and a program, as set forth in claim 13, step [d]. *See* PO Resp. 45–46. Patent Owner reasons that “[t]he output of timing chain 30 [in Summers] does not control how the two components of the display—television programming from color decoder 7 and data from the Viewdata

source—are combined.” *Id.* at 47. According to Patent Owner, “[t]he pulses do not include any information, much less instructions.” *Id.* at 46.

According further to Patent Owner, “simple clock pulses, such as those outputted from Summers’s timing chain 30, do not coordinate presentation because they have no control over the placement or arrangement of data and/or programming within the screen.” *Id.* at 47. Patent Owner also contends that

it is not obvious to a person of ordinary skill in the art how closed captioning retrieved from Viewdata data could be coordinated with the television programming because there is no readily apparent manner to synchronize the display of closed captioning lines received from the Viewdata with incoming television programming transmissions received from a television source.

Id. at 49.

According further to Patent Owner, “Summers discloses a teletext receiving station capable of processing pages of teletext information transmitted in the vertical blanking interval (VBI) of the television programming transmission and displaying the teletext information with the programming.” *Id.* at 44 (citing Ex. 1010, 2:67–3:15). Patent Owner also acknowledges that “[t]he television receiver system in Summers can be adapted to receive and display Viewdata information received over a telephone line.” *Id.* (citing Ex. 1010, 3:10–16).

Patent Owner essentially argues that a skilled artisan would not have had a sufficient reason, and would have been unable, to obtain closed captioning or sub-titles from a Viewdata source, by using signals from a television broadcast, notwithstanding that Summers describes using

Viewdata, at least suggests using it for “sub-titles or captions” in the same passage, and further, uses coded data pulses from a television broadcast signal that point to stored data in data store 17. *See* Ex. 1010, 3:6–16, 4:28–55; *see also* PO Resp. 49 (“Summers, however, does not describe how the receiver station operates to display Viewdata information. (Ex. 2009 at ¶ 136.) It certainly does not describe how the receiver station would operate to display closed captioning data.”).

Petitioner replies as follows:

[Patent Owner] does not dispute that Summers discloses receiving synchronization information from the television signal, which is a second remote source. ([PO] Resp. at 46.) [Patent Owner] also does not dispute that the synchronization signals cause the timing chain 30 circuit to output local synchronization signals that control the timing of character generator 17. (*Id.*; Ex. 1010, Fig. 1; 4:56–63; Ex. 1001 ¶¶ 130–31.) Nor can it, as this is what Summers says. (Ex. 1010, 2:49–55.) Accordingly, the synchronization signals trigger and, once processed through the timing chain, are effective to coordinate the text and video. (*Id.* at 6:61–7:14; Ex. 1001 ¶¶ 130–31.)

Pet. Reply 15.

Petitioner also contends that “there is no dispute that Summers and CBS suggest that closed caption information could be delivered through a two-way query-based system such as Viewdata.” Pet. Reply 10. According to Petitioner, CBS suggests how to make the modification to Summers, and employ videotext data, including Viewdata that had been pre-stored as a source of closed captioning data. *See* Pet. 38–40; Pet. Reply 13 (discussing

reveal codes in a TV signal as a mechanism to capture pre-stored closed caption data).

The record, including the citations above, supports Petitioner’s contentions and rationale for combining the references, as further explained below. Contrary to Patent Owner’s argument, as noted above, Summers specifically states that

[t]he possibility can also exist *for displaying such message information* [which is produced from coded data pulses] *concurrently with a television picture, for instance as sub-titles or captions which are superimposed on the television picture.* The television receiver arrangement is also adapted to receive and display message information received from another source, such as Viewdata information as transmitted over a telephone line in the experimental British Post Office Viewdata System (see *Wireless World*, February-May, 1977).

Ex. 1010, 3:5–16 (citing Fedida’s *Wireless World* articles, Exs. 1026–28, *see supra* note 1) (emphasis added).

Summers specifically discloses selecting “Teletext or Viewdata message information.” Ex. 1010, 6:49. Summers also discloses “that there can now be *an intelligible super-imposed display on the picture display of any pre-stored data*, such as channel information as may be generated by a television remote control device.” *Id.* at 2:43–45 (emphasis added).

“*[S]tored data* which is for display may have been received either from a normal television signal, *or from a normal telephone transmission line.*” *Id.* at 1:49–52 (emphases added). Summers also discloses “selective use of . . . synchronising signals . . . to cause the display of a[l]phanumeric text *or other message information* concurrently with . . . normal picture

information.” *Id.* at 2:50–55 (emphasis added). Summers describes using “coded data pulses . . . in the video signal” to produce “alpha-numeric text or other message information.” *Id.* at 3:5–6.

In other words, in Summers’s system, both teletext data and Viewdata may be pre-stored. Ex. 1010, 1:49–53 (“stored data which is used for display may have been received either from a television video signal, or from a normal telephone transmission line”); 4:28–45 (data store 17 stores Viewdata, Teletext data, and other sourced data from a cassette tape). “[A]ny pre-stored data” may be combined as a superimposed display on the picture display of a television program. *Id.* at 2:43–44. As described in the previous sentence and paragraph, Summers, even without the CBS Petition, discloses, or at least suggests, that the coded data pulses in the television stream can cause the selection of pre-stored data, regardless of where the pre-stored data came from (i.e., Viewdata or teletext). *See also* Ex. 1010, 4:20–55 (describing data store).

Patent Owner also contends that selecting this pre-stored data would not constitute a coordinated presentation, because the pre-stored data would have no defined relationship to the content of the television program. *See* PO Resp. 48. This claim construction argument also is not persuasive for reasons explained above. *See supra* Section II.A.1 (Claim Construction). It also fails to acknowledge that closed captioning satisfies even Patent Owner’s narrow claim construction. *See id.* Furthermore, even if the prior art combination would not have rendered obvious closed captioning, stored data may simply constitute generic information about a famous historical

event, for example, the Battle of Gettysburg, or simple “channel information,” either one selected by a user as data of interest to be displayed during the same time that either a television show or movie about that battle ensues, or some other show listed in the channel information guide ensues. *See* Ex. 1010, 1:49–52 2:40–45, 3:7–16 (selecting pre-stored data for concurrent viewing); Ex. 1001 ¶ 101 (viewer calls up a page using the system as modified by the CBS Petition); Ex. 1007, 5 (calling up a page). Similar to the Reiter disclosure, these scenarios satisfy our claim construction of a coordinated presentation, because the viewer would “be able to discern that the content of the data and program are related,” even if the content would not be as closely timed and related in content with the show as closed-captioning data would be. *See* Section II.A.1 (Claim Construction).

No reasonable dispute exists over the fact that Summers and the CBS Petition show that teletext, and videotext systems such as Viewdata, were compatible systems and that closed captioning was well-known, at least as a standard teletext feature. *See, e.g.*, Ex. 1010, 3:7–16; Ex. 1007, 7; Ex. 1001 ¶¶ 82, 89–90 (discussing the CBS Petition and Mode 2); Pet. 37 n.9 (citing prior Board decisions, Ex. 1024, 37, 45, 57, 66–67; Ex. 1021, 4; Ex. 1020, 142 n.12, finding that the CBS Petition is an instruction which causes a caption to be displayed). Therefore, even under a narrower construction that requires closed captioning for the television broadcast (which Patent Owner concedes satisfies its claim construction), Petitioner persuasively explains how the combination involving Summers and CBS suggests a television

signal with coded instruction signals that would be able to pull pre-stored data that came from a Viewdata source for viewing as closed captioning data concurrently with a television program.

As Petitioner also explains, the CBS Petition employs multiple data fields to indicate location, flashing, color, and also, selectable languages as pre-stored closed-captioning data. *See* Pet. Reply 13; Ex. 1007, 72; Ex. 1001 ¶¶ 106, 154. As discussed above, Summers itself discloses similar “coded data pulses” for the “possibility” of providing superimposed “subtitles or captions.” Ex. 1010, 3:5–10, 3:29–30 (“coded data pluses representative of the message information”). Even if Summers does not disclose the argued feature, the combination of Summers and the CBS Petition suggests modifying similar pulse codes in each reference to indicate what stored Viewdata page to display as closed captioning data (pre-stored or otherwise). Pet. Reply 12 (citing Ex. 1007, 146; Figs. 19–20, discussing how reveal and conceal codes transmitted with a broadcast “tell the receiver when to display the stored closed captioning data it previously received”); Ex. 1001 ¶¶ 82, 89–90, 106, 150–154 (discussing how the CBS Petition provides a wide range of closed-captioning options and suggests the option of charging for the service if using Viewdata).

In summary, Summers alone, or with the CBS Petition, at least suggests that closed caption information, as a Viewdata page, could be sent in advance of a program to be viewed and stored. *See* Pet. Reply 12–13; Dec. on Inst. 29–30 (summarizing proposed ground in terms of pre-stored data); Ex. 1001 ¶¶ 150–154. As Petitioner persuasively explains, “[t]o

ensure that the proper captions were displayed at the proper time, one of skill in the art would merely need to index the codes.” Pet. Reply 12 (citing Ex. 1036 ¶¶ 68–70). As Petitioner persuasively adds, “[s]uch a simple indexing system is basic computer science and would have been obvious.” *Id.* at 13 (citing Ex. 1036 ¶¶ 68–71).

Under Petitioner’s alternative theory, which the record supports, Summers’s remote control constitutes a second remote source to transmit a signal “which controls said receiver station to select and process an instruct signal which is effective . . . to coordinate presentation,” as set forth in claim 13. In other words, Summers discloses that its second remote source 35 can be used to select “any pre-stored data” as “text or other message information concurrently with . . . normal picture information.” Ex. 1010, 2:43–45, Fig. 1.

Both alternatives suggest a signal to control Summers’s receiver (as modified by CBS) to select and process an instruct signal to coordinate specified pre-stored Viewdata and a program, either by selecting and processing the coded pulses out of the transmission stream, as Summers teaches, or by selecting and processing the coded pulses by matching the code to pre-stored Viewdata location data, or by selecting and processing that Viewdata, which later invokes downstream timing pulses to synchronize the closed-captioning display. Either way provides pre-stored Viewdata closed captioning or more generic program information to appear as superimposed information with the television broadcast. In either case, notwithstanding Patent Owner’s arguments regarding the alleged lack of an

instruct signal in Summers's timing chain pulses (*see* PO Resp. 47–48), the combined signal and instruct signal of the combination closely tracks, and at least suggests, the disclosed signal and instruction signal, wherein the instruct signal causes a selection of pre-stored data, and the system then coordinates the presentation of that data with a program. In other words, as disclosed in the '243 patent, an instruction signal of some form ultimately later becomes a downstream "GRAPHICS ON" statement "at the system level," and one of those or both are effective to coordinate an "overlay [of] the [stored] graphics information in its graphics card onto the received composite video information and transmit the combined information to TV monitor 202M." Ex. 1003, 14:24–33; *see also supra* Section I1.A.2. (Claim Construction of Signal, Instruct Signal).

Patent Owner also contends that Summers's remote control unit 35 (advanced as a "second remote source" according to claim 13 under Petitioner's alternative theory as discussed immediately above) is not "geographically remote" from Summers's receiver station and therefore is not a "second remote source." PO Resp. 45. This claim construction argument is not persuasive for the reasons explained above. *See supra* Section II.A.3 (Claim Construction). In summary, the '243 patent Specification, consistent with the normal meaning of a "remote" control device, does not preclude Summers's "hand-held remote control device of any suitable known form." *See* Ex. 1010, 6:35–36. Furthermore, even if "geographically remote" is an implied limitation somehow, claim 13 does not further imply any degree of what that constitutes. Moreover, Summers's

remote control device includes “any suitable” degree of power with which to facilitate varying degrees of remoteness. *See id.*; *See supra* Section II.A.3 (Claim Construction).

Therefore, on this record, an artisan of ordinary skill at the time of the alleged invention would have recognized that synchronization signals in a television broadcast or in a remote control as Summers teaches or suggests, or, modified similar signals according to cueing or control signals for coordinating close caption or subtitle information as Millar, Blatt, or the CBS Petition teaches, could have been used to coordinate the display of a television broadcast with any pre-stored data—including stored Viewdata—in place of stored Teletext data.

Regarding further reasons to combine advanced by Petitioner, as discussed, Summers discloses using “any pre-stored data,” which includes Viewdata. Summers cites Fedida, which discloses a typical system that includes querying for Viewdata information to be stored for later viewing. *See supra* note 1; Ex. 1028, 65. Millar and Blatt respectively disclose choosing stock information and choosing from a variety of specialized captions, albeit with a teletext system. *See* Pet. 40–41 (citing Ex. 1008, 718–719; Ex. 1009, Fig. 1, 1:25–36, 2:–58; Ex. 1001 ¶¶ 100–101, 123–126, 143–144).

Petitioner advances several persuasive reasons for modifying Summers in order to provide viewers the ability to query for data of interest from a Viewdata source, for example, to expand the amount of available information and allow users to be charged for the information. *See* Pet. 39

(citing Ex. 1001 ¶ 151); Ex. 1001 ¶108; Ex. 1007, 6 (CBS petition discussing costs of desired information and equipment). Dr. Neuhauser further explains that downloading information, including different language captions, in the television broadcast, requires bandwidth, and downloading in bulk from a different source over a telephone line, thereafter to be synchronized by television signals, provides an efficient method of obtaining desired information. *See* Ex. 1001 ¶¶ 108–109, 150–154.

The record supports Petitioner as to this rationale and Patent Owner does not sufficiently challenge it. For example, as noted, Summers discloses an “intelligible superimposed display on the picture tube of any pre-stored data,” thereby suggesting that artisans of ordinary skill knew that pre-storing data of interest from different sources presented advantages, as Dr. Neuhauser contends. *See* Ex. 1010, 2:42–45; Ex. 1001 ¶¶ 108–109, 150–154.

Notwithstanding Patent Owner’s arguments, including evidence by Dr. Russ, and by Mr. Gerald Holtzman, Esq., who testifies about secondary considerations of non-obviousness, discussed below, based on the discussion above, Petitioner sets forth sufficient articulated reasoning with factual underpinning to show, by a preponderance of evidence, that claim 13 would have been obvious. Based on the foregoing discussion and the further discussion below of secondary considerations of nonobviousness, the combination of Summers, Fedida, and either the CBS Petition, Millar, or Blatt, would have rendered obvious claim 13.

*E. Obviousness Ground: Ciciora in View of
the CBS Petition, Blatt, or Millar*

Initially, Patent Owner contended that Ciciora is redundant to Summers, and any grounds based thereon should be dismissed. Prelim. Resp. 47–48. After a review of the arguments at this stage, Ciciora and Summers present the same or similar issues. Therefore, there is no need to reach the ground based on Ciciora.

F. Secondary Considerations of Non-Obviousness

Factual inquiries for an obviousness determination include secondary considerations based on objective evidence of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The totality of the evidence submitted may show that the challenged claims would not have been obvious to one of ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). Secondary considerations may include any of the following: long-felt but unsolved needs, failure of others, unexpected results, commercial success, copying, licensing, and praise. *See Graham*, 383 U.S. at 17; *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

To be relevant, evidence of nonobviousness must be reasonably commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (citing *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971)); *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000) (stating the presumption that commercial success is due to the

patented invention applies “if the marketed product embodies the claimed features, *and is coextensive with them*”) (emphasis added); *Therasense, Inc. V. Becton, Dickinson & Co.*, 593 F.3d 1325, 1336 (Fed. Cir. 2010) (finding no long-felt need because the claims were broad enough to cover devices that did not solve the problem). In *MeadWestVaco Corp. v. Rexam Beauty and Closures, Inc.*, 731 F.3d 1258 (Fed. Cir. 2013), the court held that a district court erred by considering “secondary considerations of non-obvious [that] involved only fragrance-specific uses, but *the claims now at issue are not fragrance-specific.*” *Id.* at 1264 (emphasis added); *see also In re Law*, 303 F.2d 951, 954 (CCPA 1961) (“Thus, assuming the affidavits are a proper showing of commercial success, they do not show commercial success of dockboards covered by the appealed claims which are not limited to the bead of claim 13.”).

In a related requirement, there must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). “Nexus” is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). The burden of showing a nexus lies with the patent owner. *Id.* Showing nexus requires showing that any alleged success is not due to prior art or unclaimed features. *Ayst Techs., Inc. v. Emtrak, Inc.*, 544 F.3d 1310, 1316 (Fed. Cir. 2008) (“[E]ven though commercial embodiments . . . have enjoyed commercial success, Ayst’s

failure to link that commercial success to the features of its invention that were not disclosed in Hesser undermines the probative force of the evidence pertaining to the success of Asyst's and Jenoptik's products."); *Ormco, Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006) ("[I]f the commercial success is due to an unclaimed feature of the device, the commercial success is irrelevant. So too if the feature that creates the commercial success was known in the prior art, the success is not pertinent."); *Tokai Corp. v. Easton Enters., Inc.*, 632 F.3d 1358, 1369 (Fed. Cir. 2011) ("If commercial success is due to an element in the prior art, no nexus exists."); *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed.Cir.1997) ("asserted commercial success of the product must be due to the merits of the claimed invention *beyond what was readily available in the prior art*")(emphasis added).

Here, Patent Owner argues that commercial success (licensing), long-felt but unresolved need, and industry praise indicate that claim 13 would not have been obvious to a person of ordinary skill in the art. PO Resp. 51–56. According to the line of cited cases *supra*, see, e.g., *Tokai*, 632 F.3d at 1369, *Ormco*, 463 F.3d at 1312, because *Reiter* anticipates claim 13, no nexus exists—i.e., any success would be due to what is in the prior art. Assuming for the sake of argument *Reiter* does not anticipate claim 13, we address the evidence.

1. Commercial Success: Licensing

Citing testimony by its declarant, Mr. Holtzman, Patent Owner argues that its licensing program demonstrates commercial success and establishes

that claim 13 would not have been obvious. PO Resp. 51–52 (citing Ex. 2012). Patent Owner asserts that “[t]he ’243 Patent along with other patents issued to the inventors have had tremendous licensing success.” *Id.* at 51 (citing Ex. 2012). Patent Owner further asserts that “[t]hese patents have been licensed in agreements providing payments exceeding \$350M and involving more than a dozen licensees.” *Id.* Patent Owner states that “[Patent Owner] has licensed the ’243 Patent to numerous industry leaders, including Cisco, Sony, DirectTV, Motorola, Scientific-Atlanta LLC, Pegasus, DISH Network Corporation, and The Weather Channel.” *Id.*

Petitioner replies that PMC has not submitted the licenses, Mr. Holtzman would not discuss the specific terms of the licenses, Mr. Holtzman acknowledges that the licenses are portfolio licenses involving the Harvey patent family and not limited to the ’243 patent, and that Mr. Holtzman acknowledges that the licenses resulted from settlements of litigation not involving the ’243 patent. Pet. Reply 23–24 (citing Ex. 1038, 25:22–26:4, 61:11–62:6; Ex. 2012 ¶¶ 12–22). Based on these factors and others, Petitioner contends that the evidence lacks a nexus. *See id.*

The record supports Petitioner. Patent Owner fails to meet its burden of showing nexus. In cases in which the proffered evidence of commercial success constitutes licenses, rather than sales of products embodying the invention, the licenses may have been taken only because they were less expensive than defending an infringement suit or for other business reasons. *See EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 908–09 (Fed. Cir. 1985) (“[I]t is not unusual to see astute businessmen capitalize on [a

licensing program for an otherwise invalid patent] by erecting a temporarily successful licensing program thereon. . . . They sometimes succeed because they are mutually beneficial to the licensed group or because of business judgments that it is cheaper to take licenses than to defend infringement suits, or for other reasons unrelated to the unobviousness of the licensed subject matter.”).

Mr. Holtzman notes that some of the licenses to the “’243 Patent family,” or “the ’243 Patent, among other patents,” included a “substantial payment” in “settlement of litigation” or with knowledge of pending *inter partes* reviews. See Ex 2012 ¶¶ 16–24. Mr. Holtzman also contends that some companies made equity investments in addition to licenses, and also “many of the license amounts are orders of magnitude above the cost of defense in an infringement action.” *Id.* ¶¶ 25–26.

Similar to the license scenario characterized in *EWP Corp.*, this testimony about “substantial payments” relative to “cost of defense,” and equity investments, lacks a requisite factual support and fails to delineate anything specific to the ’243 patent family or the ’243 patent, let alone a sublicense for challenged claim 13 of the ’243 patent. It is entitled to little weight. Even affording it some weight, the testimony does not address whether or not any settlement or license has anything to do with the particular merits of challenged claim 13. The testimony, at face value, at most shows that a license to the whole ’243 patent family may cost substantially more than defending any litigation with respect to one of the patents in the ’243 patent family, but it does not even mention specific

litigation for the '243 patent or relative cost for a license thereto. Also, litigation typically advances with certain risk, whereas a license provides at least a temporary certain outcome, thereby producing a business incentive for a license. *See EWP Corp.*, 755 F.2d at 908–09.

The tenuous testimony fails to show “affirmative evidence of nexus.” *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1324 (Fed. Cir. 2004). Patent Owner must demonstrate “a nexus between the *merits of the invention* and the licenses of record,” otherwise the evidence of licenses garners little weight. *In re GPAC Inc.*, 57 F.3d at 1580 (emphasis added) (citation omitted). “[W]ithout a showing of [a] nexus, ‘the mere existence of . . . licenses is insufficient to overcome the conclusion of obviousness.’” *In re Antor Media Corp.*, 689 F.3d 1282, 1293 (Fed. Cir. 2012) (quoting *Iron Grip Barbell*, 392 F.3d at 1324).

In *In re GPAC Inc.*, 57 F.3d at 1580, the court found that “in affidavits reciting the license history of the '111 patent, GPAC did not establish which claims(s) of the patent the licensing program incorporates, GPAC has not shown that licensing of [applicant’s] invention arose out of recognition and acceptance of the subject matter claimed.” Like the applicants with licenses in *EWP Corp*, *GPAC*, and *Antor Media*, Patent Owner has not shown a nexus to the challenged “subject matter claimed”: Mr. Holtzman’s testimony generally lists patent family licenses, revenue, and settlements, but does not discuss the merits of challenged claim 13 or relate that to any particular license for the '243 patent in the portfolio of licenses. *See PO Resp. 60* (citing Ex. 2012). In other words, the license portfolio goes to the

whole '252 patent family and the reexamined '243 patent includes 20 claims, but Petitioner challenges only one of the '243 patent claims.

The cited testimony of Mr. Holtzman does not establish whether a specific license (or sub-license) for claim 13 of the '243 patent occurred because of the merits of claim 13, the merits of unchallenged claims, for other patented inventions in the family or patent, or for other economic reasons related to the whole '243 patent family. The evidence at best implies that some settlements included licenses for the '243 patent family perhaps to avoid some litigation for a patent or patents in the family, or that equity investments may have occurred based on the company itself, PMC. *See* Ex. 2012 ¶¶ 8–27. Mr. Holtzman's summary coalesces with our summary: "This success is attributable not to any particular feature itself, but rather to the combination of features of PMC's inventions." *Id.* ¶ 27.

Accordingly, Patent Owner's licensing program evidence is afforded little weight in showing that any one of the challenged claims in the '243 patent would not have been obvious.

2. Industry Praise

Patent Owner argues that the '243 patent has generated industry praise, because a third party (Ocean Tomo, LLC) conducted a study and evaluated the "value" of certain patents. PO Resp. 51–53. According to Patent Owner,

[a]s part of this study, the firm assessed the value of each patent using a number of different value factors to determine a PatentRatings IPQ score that objectively rated each patent. Approximately 220,000 issued patents were analyzed to

determine a PatentRatings IPQ score, with the median of the scores being 100. According to the study, the top rated inventor with 16 patents in the wireless field was John Harvey, inventor of the '243 Patent. The firm found that the patents, all members of the '243 Patent family, had an average PatentRating IPQ score of 235.7, placing them in the top 0.1% of the approximate 220,000 active U.S. utility patents granted in 2010.

Id. at 52–53 (citing Ex. 2013; Ex. 2012 ¶¶ 29–31).

Patent Owner further argues that citation of a patent by other patent holders in their patent filings (i.e., “forward citations”) is a measure of recognition and value. *Id.* at 53–54 (citing Ex. 2012 ¶ 32, Ex. 2014; Ex. 2015, 31 .13; Ex. 2031). According to Patent Owner, “[m]embers of the '243 Patent family have been cited by several hundred U.S. and foreign patents. This recognition by others is strong objective indicia of the significance of the patent that weighs against obviousness.” *Id.* at 54 (citing Ex. 2012 ¶ 32).

Petitioner persuasively points out that Ocean Tomo, a financial institution, does not constitute a relevant industry for praise of the invention, and its website states that “[n]o direct statistical correlation has been established between IPQ scores and . . . validity” Pet. Reply 24 (quoting Ex. 1034, 3). The website also states that the IPQ scores should not be used to establish patentability or validity. *See* Ex. 1034, 3. Petitioner also contends persuasively that the number of forward citations relates to the “300+ column disclosure” of the '243 patent rather than unobviousness of any claim.” *Id.*

Industry praise for an invention may provide evidence of nonobviousness where the industry praise is linked to the claimed invention. *See Geo. M. Martin Co. v. Alliance Mach. Sys. Intern. LLC*, 618 F.3d 1294, 1305 (Fed. Cir. 2010); *Asyst Tech’n, Inc.*, 544 F.3d at 1316. Similar to its commercial success evidence, Patent Owner does not provide a sufficient analysis explaining how the cited studies by a financial institution or “forward citations” constitute industry praise for any technical unknown feature of challenged claim 13, or show how it would have been unobvious. The reexamined ’243 patent includes 20 claims, 306 columns, and over 200 pages of information, and includes much background information. *See Ex. 1003, 195, 228.* Patent Owner’s argument fails to show how its alleged evidence of value or praise, which goes to the whole ’243 patent family, distinguishes over many citations to, and great reviews of, popular text books or journal articles.

Patent Owner does not show a nexus to relevant industry praise for a product, or anything else, and also does not show that any evidence of praise is reasonably commensurate in scope with, and covered by, a challenged claim. *See Bayer Healthcare Pharms., Inc. v. Watson Pharms., Inc.*, 713 F.3d 1369, 1377 (Fed. Cir. 2013) (finding that brief discussions of Patent Owner’s product in journal articles “fall well short of demonstrating true industry praise” and reasoning that “industry praise of what was clearly rendered obvious by published references is not a persuasive secondary consideration”). Challenged claim 13 does not cover all information disclosed in all the patents of the ’243 patent family—information that

allegedly, at least in part, constitutes the object of praise. Any alleged praise is not linked to the claimed invention, rather, even if it does constitute industry praise, it is linked to the whole '243 patent family. *See Geo. M. Martin Co.*, 618 F.3d at 1305.

Patent Owner has not established a sufficient nexus between the merits of the claimed invention of the challenged claims in the '243 patent and the alleged industry praise. Accordingly, Patent Owner's evidence of secondary considerations based on industry praise is entitled to little or no weight.

3. Long-Felt but Unsolved Need

Citing testimony by Dr. Russ, Patent Owner argues that “the inventors of the '243 Patent recognized that there was a long-felt need to provide a communications system with expanded capabilities, while overcoming inherent limitations of existing teletext systems and related systems.” PO Resp. 54 (citing Ex. 2009 ¶¶ 172–188). Patent Owner also describes alleged differences between the prior systems and the “Harvey inventions.” *Id.* at 55. Petitioner contends that Patent Owner fails to show a long-felt need and fails to show a nexus. Pet. Reply 24 (citing Ex. 1036 ¶¶ 83–87; Ex. 2009 ¶ 23). Similar to its licensing and other evidence, Patent Owner cites almost the identical evidence in other related cases, without addressing a specific claim feature of a challenged claim. *See, e.g.*, IPR2014-01533, Paper 27, 55–56.

Patent Owner must show that any evidence of long-felt need “demonstrates both that a demand existed for the patented invention, and

that others tried but failed to satisfy that demand.” *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1082 (Fed. Cir. 2012). As Dr. Neuhauser testifies, addressing Dr. Russ’s testimony, Patent Owner offers little or no persuasive evidence that others tried and failed to provide a system that satisfies a demand met by something claim 13 addresses and that was not in the prior art. *See* Ex. 1036 ¶¶ 83–87.

Dr. Russ persuasively explains that to the extent teletext and Viewdata were not successful, it was for business reasons, including lack of government support, but not for technical reasons, and not because of “problems that would be addressed by what claim 13 covers.” Ex. 1036 ¶¶ 85–86. Dr. Russ also persuasively explains that these prior art systems provided for personalized viewing—i.e., data of interest as required by claim 13. *Id.* at ¶¶ 84–86; *see Tokai Corp.*, 632 F.3d at 1369 (“If commercial success is due to an element in the prior art, no nexus exists.”).

Patent Owner also asserts that the “Harvey inventions” provided “for bill[ing] . . . for the consumption of enriched environment,” made “personalization practical,” and provided for distributed processing and processing of local user specific data. PO Resp. 53–54. Claim 13 does not require billing or distributed processing, and fails to quantify any degree of personalization, beyond a “data of interest,” rendering evidence of long-felt need not reasonably commensurate in scope with claim 13. *See Therasense, Inc.*, 593 F.3d at 1336 (finding no solution to a long-felt need because the claims were broad enough to cover devices that did not solve the alleged problem); *MeadWestVaco Corp.*, 731 F.3d at 1258 (error to consider

“secondary considerations of non-obvious [that] involved only fragrance-specific uses, but *the claims now at issue are not fragrance-specific*”).

As discussed, claim 13 recites “data of interest,” but Patent Owner fails to explain how any alleged solution for processing “data of interest” or other alleged features reasonably within the scope of claim 13 goes beyond what prior art systems like Viewdata, teletext, Summers, or Reiter provided. Users of these prior art systems selected data of interest according to the analysis above. *See, e.g.*, Ex. 1007, 72; Ex. 1001 ¶ 103; Ex. 1010, Abstract, 2:40–45 (selecting any pre-stored information).

In addition, even if claim 13 requires billing, Dr. Neuhauser persuasively testifies that loading captions or other data via a Viewdata link for pre-storing would have provided a means for billing for it (i.e., charging for the data by its bulk amount). *See* Ex. 1001 ¶ 154; Ex. 1036 ¶¶ 83–87 (discussing prior art systems as providing cited features); Ex. 1007, 6 (discussing cost); *Tokai Corp.*, 632 F.3d at 1369 (“If commercial success is due to an element in the prior art, no nexus exists.”). In any event, claim 13 covers billing and non-billing. Therefore, claim 13 lacks a nexus to, and is not reasonably commensurate in scope with, evidence of non-obviousness related to billing, and any such evidence fails to show a solution to a long-felt need. *See Therasense, Inc.*, 593 F.3d at 1336; *MeadWestVaco Corp.*, 731 F.3d at 1258.

Accordingly, Patent Owner’s evidence of a long-felt but unmet need is entitled to little weight.

4. Summary of Analysis of Secondary Considerations of Non-Obviousness

Patent Owner failed to demonstrate a sufficient nexus between the claimed invention and any commercial success or industry praise. Patent Owner also failed to demonstrate a long-felt but unmet need for the claimed invention. Considering the cited evidence as a whole, Petitioner has shown by a preponderance of evidence that claim 13 would have been obvious.

III. CONCLUSION

Petitioner has shown by a preponderance of the evidence that Reiter anticipates, and the combination of Summers, Fedida, and the CBS Petition, Blatt, or Millar, would have rendered obvious, claim 13 of the '243 patent.

IV. ORDER

For the reasons given, it is

ORDERED that, by a preponderance of the evidence, claim 13 of the '243 patent is unpatentable; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Patent 5,887,243

For PETITIONER:

Brenton Babcock
Kent Shum
Colin Heideman
Joseph Cianfrani
Jeremy Anapol
KNOBBE MARTENS OLSON & BEAR, LLP
2BRB@knobbe.com
2cbh@knobbe.com
2kns@knobbe.com
2JSC@knobbe.com
2JAA@knobbe.com

For PATENT OWNER:

Stephen Schreiner
Phong Dinh
Jennifer Albert
Eleanor Yost
Ce Li
GOODWIN PROCTER LLP
sschreiner@goodwinprocter.com
pdinh@goodwinprocter.com
JAlbert@goodwinprocter.com
EYost@goodwinprocter.com
cli@goodwinprocter.com

Thomas Scott
PERSONALIZED MEDIA COMMUNICATIONS LLC
tscott@pmcip.com