

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT-PACKARD CO.,
Petitioner,

v.

U.S. PHILIPS CORPORATION, ORANGE, S.A., TDF SAS, and
INSTITUT FÜR RUNDFUNKTECHNIK GMBH,
Patent Owner.

Case IPR2015-01507
Patent 5,323,396

Before BRIAN J. McNAMARA, SCOTT A. DANIELS, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Hewlett-Packard Co. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–33 (“the challenged claims”) of U.S. Patent No. 5,323,396 (Ex. 1001, “the ’396 patent”). Paper 2 (“Pet.”). U.S. Philips

Corporation, Orange, S.A., TDF SAS, and Institut Für Rundfunktechnik GmbH (“Patent Owner”)¹ timely filed a Preliminary Response. Paper 14 (“Prelim. Resp.”).

We have authority to determine whether to institute *inter partes* review. See 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Upon consideration of the Petition and the Preliminary Response, and for the reasons explained below, we determine that the information presented fails to show a reasonable likelihood that Petitioner would prevail with respect to any of the challenged claims. See 35 U.S.C. § 314(a). Accordingly, we do not institute trial as to any claim of the ’396 patent.

A. Related Proceedings

The ’396 patent has been asserted in *Audio MPEG, Inc. v. Hewlett-Packard Co.*, No. 2:15-cv-00073 (E.D. Va.). Pet. 1; Paper 6, 2. Petitioner also has filed two other Petitions for patents related to the ’396 patent—IPR2015-01505 (U.S. Patent No. 5,777,992) and IPR2015-01506 (U.S. Patent No. 5,539,829).

B. The ’396 Patent and Illustrative Claim

The ’396 patent,² titled “Digital Transmission System, Transmitter and Receiver for Use in the Transmission System,” relates to a “flexible and highly versatile transmission system” in which a “transmitter should be capable of converting wide-band digital signals of different formats” into a

¹ Patent Owner indicates Audio MPEG, Inc. is also a real-party-in-interest in this proceeding. Paper 6, 2.

² The ’396 patent was filed on December 21, 1992, and claims priority to a U.S. application filed June 1, 1990, as well as to two Dutch patent applications filed June 2, 1989 and February 13, 1990, respectively. Ex. 1001, [22], [30], [63].

second digital signal for transmission via a transmission medium, and in which a “receiver should be capable of deriving a wide-band signal of the correct format from said second digital signal.” Ex. 1001, 2:9–26.

Claim 1 of the '396 patent, reproduced below, is illustrative of the challenged claims:

1. A digital transmission system comprising a transmitter and a receiver, for transmitting wide-band digital information having a sample frequency F_s via a transmission medium, and for receiving said information,

said transmitter having an input terminal for receiving said information to be transmitted, in the form of a first digital signal; an output; and a signal source, having an input coupled to said input terminal, for generating and supplying to said output a second digital signal which includes said information, said second digital signal comprising consecutive frames, each frame comprising a plurality of information packets, and each information packet comprising N bits, where $N > 1$,

said receiver comprising a decoder and an output terminal, said decoder having an input for receiving said second digital signal and an output coupled to said output terminal for supplying said wide-band digital information,

characterized in that, in the formula

$$P = \frac{BR}{N} \times \frac{n_s}{F_s}$$

where BR is the bit rate of said second digital signal, and n_s is the number of samples of said information whose corresponding information in said second signal is included in one frame of said second signal,

if P is an integer, the number of information packets in one frame is P , and

if P is not an integer, the number of information packets in a number v of the frames is P' , where P' is the highest integer whose value is less than P ; and the number of information packets in a number w of the other frames is $P'+1$,

the numbers v and w being selected such that the average frame rate of said second digital signal is substantially equal to F_s/n_s , and that each frame comprises at least a first frame portion including synchronizing information.

Ex. 1001, 24:34–25:6, Cert. of Corr.

C. The Applied References and Evidence

Petitioner relies on the following references. Pet. 2–3.

Reference	Date	Exhibit No.
J.P. Chambers, <i>Signalling in Parity: A Brief History</i> , British Broadcasting Corp. (BBC) Research Department Report 1985/15 (Dec. 1985) (“Chambers”)	Dec. 1985	1014
International Organization for Standardization, FIFTH MPEG MEETING REPORT, ISO-IED/JTC1/SC2/WG8N (Feb. 1989) (“MPEG 89-051”)	Feb. 1989	1010
G. Stoll, et al., <i>Masking-Pattern Adapted Subband Coding: Use of the Dynamic Bit-Rate Margin</i> (“MASCAM 1988”)	Mar. 1988	1032

Petitioner further relies on the Declaration of Dr. Nikil Jayant (Ex. 1004, “Jayant Declaration”).

D. The Asserted Grounds

Petitioner sets forth its challenges to claims 1–33 as follows. Pet. 2–3, 22–60.

References	Basis	Claims Challenged
Chambers and MPEG 89-051	§ 103	1, 2, 24–28, 30–33
Chambers, MPEG 89-051, and MASCAM 1988	§ 103	3–23, 29

II. CLAIM CONSTRUCTION

Because we do not reach the obviousness issues, based on our determinations below, no claim construction is necessary.

III. ANALYSIS

Patentability challenges in an *inter partes* review must be “on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Petitioner’s asserted grounds of unpatentability are based on three non-patent references: Chambers, MPEG 89-051, and MASCAM 1988. Pet. 2–3. Patent Owner asserts that Petitioner has not provided sufficient evidence to show that any of these references is a printed publication. Prelim. Resp. 8–18. The dispositive issue in this proceeding is whether Petitioner has made a sufficient threshold showing that Chambers, which is included in each asserted ground of unpatentability, is available as prior art to the ’396 patent.

A. Legal Standard Regarding Prior Art Printed Publications

Petitioner has the initial burden of production of evidence establishing that asserted references are applicable as prior art. *Dynamic Drinkware LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015).

We look to the underlying facts to make a legal determination as to whether a document is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). The determination of whether a document is a “printed publication” under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding its disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004); *see also In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986) (holding that “public accessibility” is the touchstone in determining whether a reference is a “printed publication” under § 102).

To qualify as a printed publication, a document “must have been sufficiently accessible to the public interested in the art.” *In re Lister*,

583 F.3d 1307, 1311 (Fed. Cir. 2009). The party seeking to introduce the reference “should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981) (citation omitted); *see also Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1333 (Fed. Cir. 2009) (holding that a “document is publicly accessible if it ‘has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it’” (citing *In re Wyer*, 655 F.2d at 226)).

B. Whether Chambers is Available as Prior Art

Petitioner asserts that Chambers “qualif[ies] as prior art under at least 35 U.S.C. § 102(b). Specifically, Chambers . . . was published in December 1985, . . . more than a year before the earliest priority date of the ‘396 Patent.” Pet. 3. The Petition, however, points to no specific evidence supporting its assertion that Chambers was published in 1985.³

³ In an email to the Board on December 14, 2015 seeking authorization to file a Reply to Patent Owner’s Preliminary Response, Petitioner asserted that it “was surprised to see [Patent Owner’s] arguments” regarding the prior art status of Chambers and MASCAM 1988 “[b]ecause Patent Owner[] had not ever disputed that Chambers was prior art in previous ex parte reexams, and because Patent Owner[] had submitted MASCAM 1988 as prior art in previous Information Disclosure Statements.” We did not authorize additional briefing on this issue. See Paper 15. We are not persuaded that Patent Owner’s choice not to challenge Chambers’s prior art status in a reexamination proceeding, or Patent Owner’s submission of MASCAM 1988 in an IDS, relieves Petitioner of its initial burden to put forth evidence in this inter partes review proceeding that the documents are available as prior art to the ’396 patent.

On its face, Chambers includes a “December 1985” date, as well as a “BBC RD 1985/15” indication. Ex. 1014,⁴ 1. The fact that a date is printed on the face of a reference, without more, is not enough to establish that the reference was publicly accessible on that date. *See LG Elecs., Inc. v. Advanced Micro Devices, Inc.*, Case IPR2015-00329, slip op. at 13 (PTAB July 10, 2015) (Paper 13); *see also Google Inc. v. ART+COM Innovationpool GmbH*, Case IPR2015-00788, slip op. at 8 (PTAB Sept. 2, 2015) (Paper 7) (“[T]his bare date, without more, does not provide any information about the date [the reference] was publicly accessible.”). Further, the unsupported testimony of Dr. Jayant that “[Chambers] was published in December 1985” (Ex. 1004 ¶ 94) also is insufficient to demonstrate that Chambers was published in December 1985.

Patent Owner argues that the Petition includes no arguments or evidence regarding “whether or how Chambers was distributed, or, if it was distributed, whether that distribution was limited or subject to any confidentiality restrictions.” Prelim. Resp. 12. Although Chambers is dated December 1985 on its face, Petitioner provides no evidence concerning when it was first published or distributed. In particular, Petitioner provides no evidence that the British Broadcasting Corporation (“BBC”) made Chambers publicly available in 1985, or how an interested person would have located it. Petitioner likewise provides no evidence concerning the general publication or distribution policies of the BBC.

Further, as noted by Patent Owner, Chambers includes other information within the document itself that is inconsistent with a

⁴ Citations to Ex. 1014 are to page numbers added by Petitioner at the bottom of each page.

December 1985 publication date. *See* Prelim. Resp. 13. For example, Chambers includes a copyright notice that is nearly 20 years after the alleged December 1985 publication date—namely, “© BBC 2004”. Ex. 1014, 6. Further, the “References” section of Chambers includes at least one citation to a paper apparently published in February 1986, which also is after the alleged December 1985 publication date. Ex. 1014, 18. These dates are inconsistent with the December 1985 date printed on the face of the document, and cast further doubt as to the public availability thereof as of December 1985. Petitioner, however, makes no attempt to address or explain these inconsistencies.

Accordingly, based on the evidence provided in the Petition, we conclude Petitioner has not made a sufficient threshold showing that Chambers is available as prior art in this proceeding.

C. Asserted Grounds of Unpatentability

Each asserted ground of unpatentability relies, in part, on Chambers. Because Petitioner has not met its burden in making a sufficient threshold showing that Chambers is available as prior art to the '396 patent,⁵ Petitioner also has not shown a reasonable likelihood of prevailing on either asserted ground of unpatentability.

⁵ As noted above, Patent Owner also asserts that Petitioner has not made a sufficient showing regarding the prior art status of MPEG 89-051 and MASCAM 1988. Because we determine Petitioner has not made a sufficient showing regarding the prior art status of Chambers, we need not reach the issue regarding MPEG 89-051 and MASCAM 1988.

IV. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition fails to establish a reasonable likelihood that Petitioner would prevail on any alleged ground of unpatentability with respect to the challenged claims of the '396 patent.

V. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), the Petition is *denied* and no trial is instituted.

IPR2015-01507
Patent 5,323,396

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