

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS INTERNATIONAL PLC, PACE LTD., PACE AMERICAS, LLC,
PACE AMERICAS HOLDINGS, INC., and PACE AMERICAS
INVESTMENTS, LLC,
Petitioners,

v.

SONY CORPORATION,
Patent Owner.

Case IPR2016-00835
Patent 6,084,643

Before JENNIFER S. BISK, BART A. GERSTENBLITH, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

INTRODUCTION

Patent Owner, listed above, filed a Request for Rehearing (Paper 13, “Request” or “Reh’g Req.”) of our Institution of *Inter Partes* Review (Paper 10, “Institution Decision” or “Inst. Dec.”). The Request contends that we misapprehended the law of 35 U.S.C. § 112 ¶ 6.¹ Reh’g Req. 1. Specifically, Patent Owner asserts that we “mistakenly conflated the recited function of claim 1 of [U.S. Patent No. 6,084,643 (“the ’643 patent”)] as being one and the same with the algorithmic structure linked in the underlying specification.” *Id.* In addition, the Request suggests that an expanded panel hear the case. *Id.* at 3.

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

For the reasons discussed below, Patent Owner’s Request for Rehearing is *denied*.

BACKGROUND

In the Institution Decision, we addressed the construction of the limitation “control means for controlling the transmission signal receiving

¹ Section 4(c) of the Leahy-Smith America Invents Act (AIA) re-designated 35 U.S.C. § 112 ¶¶ 1, 2, and 6 as 35 U.S.C. §§ 112(a), (b), and (f). Because the ’643 patent has a filing date before September 16, 2012 (effective date), we refer to the pre-AIA version of 35 U.S.C. § 112.

means to receive the transmission signal of a channel indicated by the channel number being displayed when the command received by the command receiving means is broken” (the “control means limitation”). Inst. Dec. 4–8. In particular, we agreed with both parties that the control means limitation is written in means-plus-function format pursuant to 35 U.S.C. § 112 ¶ 6 and the function of the term is “controlling the transmission signal receiving means to receive the transmission signal of a channel indicated by the channel number being displayed when the command received by the command receiving means is broken.” *Id.* at 5 (citing Pet. 18; Prelim. Resp. 4). We also agreed with Patent Owner that the corresponding structure of this limitation is a CPU implementing the algorithmic structure described in the specification at least at 7:58–8:10, and equivalents thereof. *Id.* at 7.

We did not, however, agree with Patent Owner’s assertion that “[n]o *inter partes* review can be instituted here because the Petitioners have failed to properly construe a critical means-plus-function term.” *Id.* (quoting Prelim. Resp. 7). Specifically, we were persuaded that “Petitioner has properly given notice that it understands the structure corresponding to the control means limitation to include a CPU programmed to implement the algorithm structure described by the ’643 patent” and that this “understanding is consistent with Petitioner’s analysis of the prior art.” *Id.* at 7–8 (citing Pet. 18–19). When discussing Petitioner’s comparison of the prior art to the control means limitation, we noted that Petitioner “explains that Rosenberger discloses an algorithm equivalent to that disclosed in the ’643 patent” and “explains that Ejima discloses an algorithm equivalent to

that disclosed in the '643 patent.” *Id.* at 11–12 (citing Pet. 23–24; Ex. 1003 ¶¶ 162–165), 14 (citing Pet. 37–38; Ex. 1003 ¶¶ 237–238).

In its Request for Rehearing, Patent Owner argues that Petitioner improperly relied on the prior art’s “generic disclosure of a CPU coupled with the prior art’s alleged disclosure of *functions* equivalent to the recited function of ‘control means,’” but did not include in their discussion the algorithm disclosed in the specification. Reh’g Req. 4. According to Patent Owner, “where Petitioners expressly proposed a construction for the ‘control means’ that did not include any algorithm, it was legal error for the Board to find that Petitioners have ‘properly given notice’” that they understand the meaning of the control means limitation. *Id.* at 10–11. Moreover, our “decision to accept the petition as sufficient to demonstrate a reasonable likelihood of prevailing under these circumstances amounts to a clear misapprehension of the law because the algorithmic structure that forms an integral part of the proper construction of the ‘control means’ cannot be shown through a comparison of functions alone.” *Id.* at 11–12. Patent Owner asserts that “at most, the petition only discusses how the *function* of the ‘control means’” is allegedly disclosed by the prior art and does not show a structurally equivalent algorithm to that disclosed in the '643 patent.

ANALYSIS

Patent Owner agrees with the construction of the control means limitation adopted by the Institution Decision. Reh’g Req. 13–14. In other words, Patent Owner agrees that (1) the claimed function of the control means function is “controlling the transmission signal receiving means to receive the transmission signal of a channel indicated by the channel number being displayed when the command received by the command receiving

means is broken,” and (2) the corresponding structure is a CPU programmed to execute the algorithm described in the specification at least at 7:58–8:10.

Id. This algorithm is described as follows:

Next, at step S16, the CPU 29 judges whether or not the channel up down key 94 finishes the operation. Namely, the CPU 29 judges whether or not a user's finger having been pressed the channel up down key 94 is detached therefrom and the operation is finished. If the channel up down key 94 is continued to be pressed and the operation is judged not to be finished, the step returns to S11 and the processings after step S11 are repeated. This processing can be done quickly. In this embodiment, the processing from step S11 through S16 can be finished in 200 msec to 800 msec. In other words, the processing time is shorter than a time required for the channel selection. Thereby, only the channel number displayed on the screen is changed rapidly.

On the other hand, at step S16, if a user's finger having been pressed the channel up down key 94 is detached therefrom and the operation is judged to be finished, the step goes to step S17 to execute the channel selection processing. In this channel selection processing, the confirmation of the CA (Conditional Access) condition and the decoding of the MPEG data are executed.

Ex. 1001, 7:58–8:10. The steps referred to by the algorithm are shown in the flow chart displayed in Figure 8, which is reproduced below.

FIG. 8

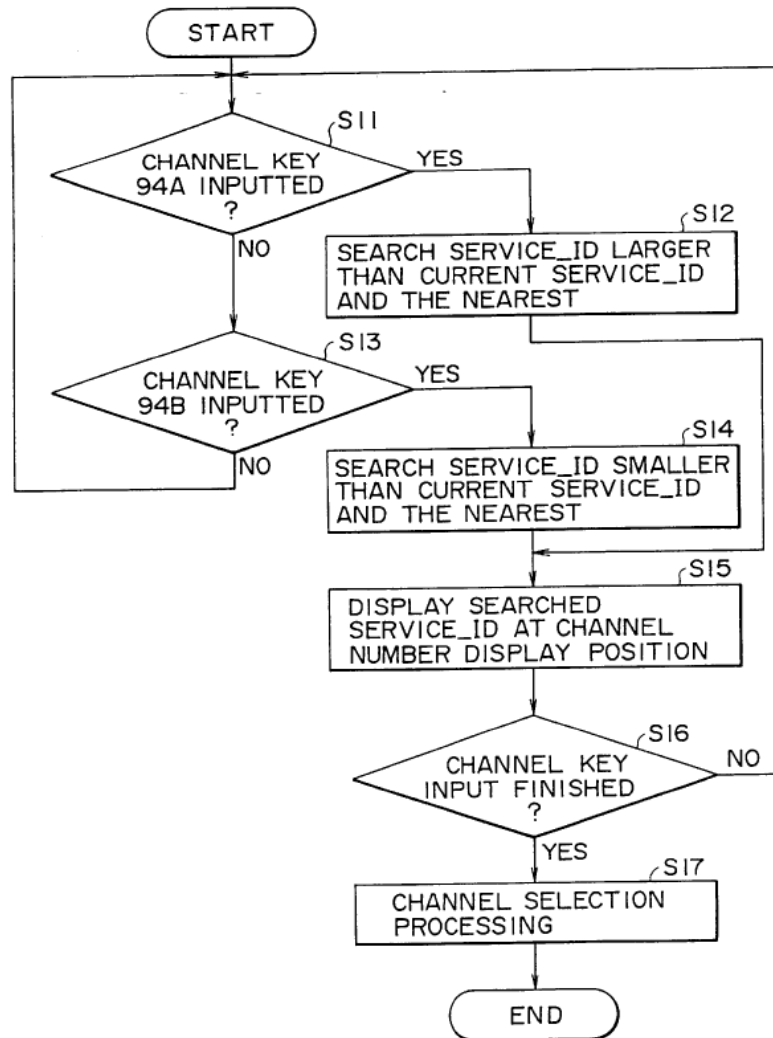


Figure 8 shows a flow chart including step S11, which asks “channel key 94A inputted?” Ex. 1001, Fig. 8. If the answer to that question is yes, flow eventually reaches step S16, which asks “channel key input finished?” If the answer is no, the flow returns to step S11. *Id.* If the

answer is yes, flow moves from step S16 to step S17, “channel selection processing.” *Id.*

Patent Owner asserts in its Request that the Petition “says nothing whatsoever” about the prior art’s discussion of the above algorithm or its equivalent. Reh’g Req. 14. We disagree. The Petition points to the description of a set of steps in Rosenberger for switching program locations using a remote control receiver. Pet. 23–24 (citing Ex. 1007, 3; Ex. 1003 ¶¶ 162–165). In particular, the Petition states that Rosenberger discloses “switching between channels when a remote control up or down key is ‘pressed and held down in the sense of a continuous actuation’” and “[w]hen the user reaches the desired program, the user terminates pressing the button, and microcomputer 9 initiates tuning of the tuner.” Pet. 23 (quoting Ex. 1007, 3).

In addition, the Petition presents a description in Ejima of the steps used by a tuning controller to perform “fast channel processing mode.” Pet. 37–38 (citing Ex. 1010 ¶¶ 20, 26, 38; Ex. 1003 ¶¶ 237–238). In particular, the Petition states that “[d]uring fast channel processing mode, the user continuously presses an up key and can locate their desired channel number by ‘look[ing] at the channel number display on the CRT as it changes sequentially’” and “[o]nce the user releases the up/down key, ‘the channel number at which the key was released is received.’” Pet. 38 (quoting Ex. 1010 ¶ 20).

We do not agree with Patent Owner’s assertion that Petitioner’s arguments are “purely functional prior art mapping” (Reh’g Req. 1) that does not “compare the claimed algorithmic *structure* of a

computer-implemented means-plus-function term with any algorithmic *structure* allegedly disclosed in the prior art.” *Id.* at 4–6. Instead, we understand the Petition to assert the above-described portions of Rosenberger and Ejima directly correspond to the algorithm described in the ’643 patent at 7:58–8:10. For purposes of institution, we found the Petition shows a reasonable likelihood of prevailing on this issue. We are not persuaded otherwise by Patent Owner’s Request. Whether, in fact, Petitioner ultimately meets its burden on this issue is to be determined on the full record as developed at trial.

The Chief Administrative Patent Judge declines Patent Owner’s suggestion for an expanded panel.

Accordingly, it is

ORDERED that Patent Owner’s Request for Rehearing is *denied*.

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Patent 6,084,643

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