

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CPI CARD GROUP INC.,
Petitioner,

v.

GEMALTO S.A.,
Patent Owner.

Case IPR2016-01092
Patent 5,944,833

Before TREVOR M. JEFFERSON, PATRICK M. BOUCHER, and
J. JOHN LEE, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71(d)

In response to Petitioner's challenge of claims 1–26 of U.S. Patent No. 5,944,833 (Ex. 1001, “the ’833 patent”), we instituted *inter partes* review of claims 1–5, 7, 12–14, and 17–26, but did not institute review of

claims 6, 8–11, 15, or 16. Paper 8 (“Institution Decision” or “Dec.”). Petitioner requests rehearing of that portion of our Decision denying institution of those claims on the basis of Griffin or the combination of Griffin and Matsumura. Paper 11 (“Rehearing Request” or “Req. Reh’g”). On rehearing, the burden of showing that the Decision should be modified lies with Petitioner, the party challenging the Decision. 37 C.F.R. § 42.71(d). “The request 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.” *Id.* Petitioner contends that “the Board overlooked the Petitioner’s properly presented alternative claim constructions for two of the three embodiments expressly linked in the specification to the phrase ‘means for decorrelating,’ finding them ‘inconsistent.’” Req. Reh’g 1.

In addressing the functional aspect of construing “means for decorrelating,” recited in each of independent claims 1, 2, and 4, the Petition asserts that “in light of the file history and the express language of the claims, a person of ordinary skill in the art . . . would have understood the claimed function is desynchronizing the execution of instructions by the microprocessor with respect to internal or external signals.” Paper 2 (“Pet.”), 6. Based on the record before us, we adopted that aspect of construing “means for decorrelating,” as advocated by Petitioner, noting that “[t]he explanation provided by the applicant during prosecution is consistent with such a determination, and is supported by testimony of Petitioner’s witness, Nathaniel Polish, Ph.D.” Dec. 7.

In addressing the structural aspect of construing “means for decorrelating,” the Petition identifies three potential structures that it

contends are “linked to the means in the specification.” Pet. 6–16.

Specifically, (1) “the first structure . . . includes a random number generator, an internal clock, and a circuit for using an output of the random number generator to modulate the internal clock to generate a random clock signal,” *id.* at 9; (2) “the second structure . . . include[s] at least a clock, a random number generator, and a circuit which receives inputs of the clock and a random number from the random number generator, and which outputs a random interrupt,” *id.* at 13; and (3) “the third structure . . . include[s] at least a random number generated by a random number generator, a main program, and a secondary program,” *id.* at 16.

With respect to the second potential structure, Petitioner contends that “the random interrupts as described in the specification do not perform the construed and claimed desynchronizing function.” *Id.* at 10. “Accordingly, Petitioner[] respectfully submit[s] that the second structure that generates random interrupts should not be construed as corresponding to the means for decorrelating, as it does not perform the function of desynchronizing the execution of the at least one instruction sequence with respect to the internal or external electrical signals.” *Id.* at 11.

Similarly, with respect to the third potential structure, Petitioner contends that “this third structure that executes random secondary sequences does not perform the construed and claimed desynchronizing function.” *Id.* at 14. “Accordingly, Petitioner respectfully submits that the third structure that executes random secondary sequences should not be construed as corresponding to the claimed means for decorrelating.” *Id.* at 14.

While taking these unambiguous and specific positions that only the first potential structure (random number generator, internal clock, and output

circuit) is disclosed by the Specification to perform the recited function, the Petition nevertheless identifies the components of the second and third structures that it asserts are “linked” to the recited “means for decorrelating.” *Id.* at 12–13, 14–16. Petitioner’s Rehearing Request characterizes these identifications as a presentation of claim constructions “in the alternative.” Req. Reh’g 5.

Notably, the Petition’s challenges of claims 6, 8–11, 15, and 16, are all based on Griffin alone or in combination with Matsumura, rather than on Sprunk. Pet. 4. For these challenges, the Petition contends that Griffin discloses the “third structure.” *Id.* at 41–43. Petitioner observes that, in the original publication of the final rules governing Board trial proceedings, the Office expressly stated that the rules do not prohibit the presentation of alternative claim constructions by a party. *Id.* at 7 (quoting 77 Fed. Reg. 48,680, 48,700 (Aug. 14, 2012) (“The rules do not preclude providing alternative claim constructions in a petition or in later authorized filings.”)). But Petitioner identifies no case in which the Board has *adopted* multiple inconsistent claim-construction positions to apply in the evaluation of different prior art. This proceeding is distinct from those identified by Petitioner as involving means-plus-function claims that were not amenable to construction because of a lack of any structural support. See Req. Reh’g 13–15 (citing *Univ. Remote Control, Inc. v. Univ. Elecs., Inc.*, Case IPR2013-00152, slip op. at 13 (PTAB Aug. 19, 2013) (Paper 8); *Space Exploration Technologies Corp. v. Blue Origin, LLC*, Case IPR2014-01378, slip op. at 8–9 (PTAB March 3, 2015) (Paper 6)). On the record before us, the “means for decorrelating” limitation is amenable to construction through the “first structure” advocated for by Petitioner.

The bases under which the Board is granted authority to review claims of an issued patent in an *inter partes* review proceeding are limited by statute: “A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent *only on a ground that could be raised under section 102 or 103* and only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b) (emphasis added). Nevertheless, Petitioner argues that “the alternative claim constructions should be considered, or, if the inconsistencies in the ’833 Patent render claims 6, 8-11, and 15-16 not amenable to construction under § 112, ¶ 6 as argued in the Petition, the Board should clarify that the refusal to institute the [trial] in relation to these claims is due to their indefiniteness.” In making this argument, Petitioner effectively seeks to circumvent the statutory restriction of § 311(b) and obtain an advisory opinion on the definiteness of claims 6, 8–11, 15, and 16. We decline to provide such an advisory opinion.

The Board’s obligation at this stage is both well-defined and limited—to determine whether the Petition demonstrates “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). In the Institution Decision, we determined that the Petition did not meet that standard with respect to claims 6, 8–11, 15, or 16. Dec. 20–22. In requesting that we make specific findings with respect to its “alternative” claim-construction positions, Petitioner asks that we disregard unambiguous opinions of its own expert. Dr. Polish testifies that “a person of ordinary skill in the art would have also understood from the specification that this third structure that executes random secondary sequences does not perform the claimed function,” that

the third structure “does not perform the function in a manner such ‘that the execution of the at least one instruction sequence is desynchronized with respect to the internal or external electrical signals,’” and that the specification “fails to disclose that the execution of the random secondary sequences causes the execution of any instructions ‘to be desynchronized with respect to the internal or external electrical signals.’” Ex. 1003 ¶ 56.

We recognize that, like Petitioner, Dr. Polish addresses the possibility of a finding that “the ‘means for decorrelating’ includes this third structure for randomly executing secondary sequences.’” *Id.* ¶ 58–60. Nevertheless, after considering the full context of the arguments made in the Petition and the supporting testimony of Dr. Polish, we remain unpersuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its challenges of claims 6, 8–11, 15, and 16 as unpatentable over Griffin alone or in combination with Matsumura.

Accordingly, we are not persuaded that we misapprehended or overlooked Petitioner’s arguments as to the construction of “means for decorrelating” under 35 U.S.C. § 112, ¶ 6, as it relates to the second and third structures.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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