

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK CORPORATION
and DISH NETWORK L.L.C.,
Petitioner,

v.

CUSTOMEDIA TECHNOLOGIES, L.L.C.,
Patent Owner.

Case IPR2017-00936
Patent 7,840,437

Before MEREDITH C. PETRAVICK, MICHAEL W. KIM, and
KALYAN K. DESHPANDE, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

DISH Network Corporation and DISH Network L.L.C. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 9, 10, and 13–16 of U.S. Patent No. 7,840,437 (Ex. 1001, “the ’437 patent”) on grounds of unpatentability under 35 U.S.C. §§ 102, 103. Paper 1 (“Pet.”). Customedia Technologies, L.L.C. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is 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); *see also* 37 C.F.R. § 42.4(a). Upon consideration of the Petition, Preliminary Response, and the associated evidence, we determine that Petitioner has failed to demonstrate a reasonable likelihood it would prevail with respect to at least one of the challenged claims. Accordingly, and for the reasons that follow, we deny institution of an *inter partes* review.

B. *Related Proceedings*

Petitioner and Patent Owner identify the following district court proceeding concerning the ’437 patent: *Customedia Technologies, L.L.C. v. DISH Network L.L.C.*, Civil Action No. 2:16-CV-00129 (E.D. Tex). Pet. 1; Paper 5, 2. The following proceeding, before the Board, also involves the

same parties and the '437 patent: CBM2017-00019.¹ U.S. Patent No. 8,955,029 ("the '029 patent") is related by continuity to the '437 patent, and the '029 patent is involved in the following proceedings, which also involve the same parties, before the Board: CBM2017-00031, IPR2017-00638, IPR2017-00639.

C. The '437 Patent

The '437 patent discloses that the claimed invention relates generally to "renting or purchasing data products for immediate, on-demand delivery, which may be formatted and transferred to a portable medium for use in any existing playback device." Ex. 1001, 1:29–33. According to the '437 patent, an "information explosion" has created "a serious need for an integrated system that manages and handles the growing amount of information available over the various data feeds and can meet the needs and desires of the end user." Ex. 1001, 1:59–62. The '437 patent purports to solve these problems as follows:

The current invention solves these problems through the use of an integrated information management and processing system that provides for the handling, sorting and storage of large amounts of data that is a user-defined and user resident environment. It allows this management to occur both during and after the actual feed is being received, while also allowing various decisions to be made about the suitability, quality, and other content of the information being received. The invention also has the capability to be securely accessed and utilized from a remote location, including telephone, Internet, and remote

¹ In CBM2017-00019, Petitioner challenged claims 1, 9, 10, and 13–16 of the '437 patent, the same claims at issue here, under 35 U.S.C. § 101 as being directed to an unpatentable abstract idea, and on the same prior art grounds as set forth herein. The Board instituted a covered business method patent review of all challenged claims on the § 101 ground only.

computer/television access. This would allow services to provide virtual user transaction zones.

Ex. 1001, 3:19–30.

D. Illustrative Claim

Petitioner challenges claims 1, 9, 10, and 13–16 of the '437 patent. Claim 1, the only independent claim, is illustrative of the challenged claims, and is reproduced below:

1. A system for the processing, recording, and playback of audio or video data, comprising:
 - a. a receiver apparatus for receiving audio or video data from at least one data feed;
 - b. memory circuitry comprising a storage device built in to the system and which is not removable from the system;
 - c. processing circuitry for processing the data and for storing the processed data in the built in storage device;
 - d. a user interface operatively connected to the processing circuitry for programming which processing functions are to be applied to the received data by the processing circuitry;
 - e. playback circuitry, which reads the data from the built in storage device and which converts the data to electronic signals for driving a playback apparatus; and
 - f. a microprocessor having software programming to control the operation of the processing circuitry and the playback circuitry enabling the recording of rented data and enacting a simulated return of said rented data by deleting or scrambling said data from said built in storage device or blocking further access to said data, and notifying a data supplier of said simulated return.

E. Asserted Grounds of Unpatentability

Petitioner challenges claims 1, 9, 10, and 13–16 as follows:

Reference(s)	Basis	Challenged Claims
Ginter ²	§ 102(b)	1, 9, 10, and 13–16
Ginter and Stefik ³	§ 103(a)	1, 9, 10, and 13–16

Petitioner relies on the Declaration of Anthony Wechselberger (Ex. 1004). Patent Owner relies on the Declaration of Dr. Jay P. Kesan (Ex. 2001).

II. ANALYSIS

A. *Claims 1, 9, 10, and 13–16 as Anticipated by Ginter*

Petitioner asserts that Ginter anticipates claims 1, 9, 10, and 13–16. Pet. 16–30 (citing Exs. 1002, 1004). Patent Owner disagrees. Prelim. Resp. 15–28 (citing Exs. 1002, 2001). In particular, Patent Owner asserts that Petitioner does not account adequately for the “processing circuitry” and the “microprocessor having software programming to control the operation of the processing circuitry” recited in independent claim 1. Prelim. Resp. 15–21. We agree with Patent Owner.

Petitioner asserts that the following disclosures in Ginter account for the recited “processing circuitry”:

The electronic appliance of *Ginter* comprises one or more “conventional general purpose central processing units” (“CPUs”), identified as CPU 654. Ex. 1002 at 125:20–23. “CPU 654 may provide storage, database, and communications services.” *Id.* at 227:3–5. The electronic appliance of *Ginter*

² WO 96/27155, pub. Sept. 6, 1996 (Ex. 1002, “Ginter”).

³ U.S. Patent No. 5,634,012, iss. May 27, 1997 (Ex. 1003, “Stefik”).

further comprises an I/O controller that “permits CPU 654 . . . to read from and write to secondary storage 662.” *Id.* at 186:21–187:2. As discussed above in relation to Limitation [1c], secondary storage 662 comprises the storage device that is not removable from the system. A person of ordinary skill in the art would understand that a CPU is processing circuitry. Ex. 1004 at ¶ 158.

Pet. 18–19.

Petitioner further asserts that the following disclosures in Ginter account for the recited “microprocessor”:

The electronic appliance of *Ginter* has “one or more conventional general purpose central processing units (‘CPUs’) 654 [that] are connected to bus 653.” Ex. 1002 at 185:21–22. These CPUs “may be any centrally controlling logic arrangement, such as for example, a microprocessor, other microcontroller, and/or array or other parallel processor.” *Id.* at 193:14-17. *Ginter*’s appliance includes an operating system that “manages the resources of electronic appliance 600, and provides a commonly used set of functions for programmers writing applications 608 for the electronic appliance.” Ex. 1002 at 226:7–10. Specifically, the operating system may “manage[] the hardware (e.g., CPU(s) and memory(ies)) . . . within one or more general purpose processors within electronic appliance 600” and the “other electronic appliance hardware resources, such as peripheral devices attached to an electronic appliance” such as “keyboard 612, display 614, modem 618, disk drive 620, printer 622, scanner 624.” Ex. 1002 at 226:11–19. It “may also manage secure database 610 and a storage device (e.g., “secondary storage” 652) used to store secure database 610.” Ex. 1002 at 226:20–23.

Pet. 21–22.

Patent Owner asserts that Petitioner impermissibly maps two distinct claim terms, “processing circuitry” and “microprocessor,” to the same CPU 654 of Ginter. Prelim. Resp. 17–20. We agree. See *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1563 (Fed. Cir. 1991) (two distinct claim elements

should each be given full effect). Indeed, to determine otherwise would impermissibly read one of “processing circuitry” and “microprocessor” out of the claim. *See Tex. Instruments Inc. v. U. S. Int’l Trade Comm’n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (explaining claim language cannot be mere surplusage, an express limitation cannot be read out of the claim). Mapping both claim terms to CPU 654 of Ginter is especially problematic for the “microprocessor” limitation, which reads, in context, “a *microprocessor* having software programming to control the operation of the *processing circuitry*” (Claim 1 (emphasis added)).

In making our determination, we acknowledge that Ginter discloses “*one or more* conventional general purpose central processing units (‘CPUs’) 654” Ex. 1002, 185:21–22 (emphasis added). Accordingly, it is plausible that Petitioner intended for one of CPUs 654 to correspond to the recited “processing circuitry” and another of CPUs 654 to correspond to the recited “microprocessor.” We are unpersuaded, however, that Petitioner has articulated that intention with sufficient particularity in the aforementioned portions of the Petition. *See* 35 U.S.C. § 312(a)(3) (“A petition filed under section 311 may be considered only if . . . the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim”).

The aforementioned portion of the Petition concerning the recited “processing circuitry” also cites to paragraph 158 of Mr. Wechselberger’s Declaration. A portion of that paragraph reads as follows:

Ginter’s electronic appliance further comprises an I/O controller for processing and storing the data: “I/O controller 660 permits CPU 654 and SPU 500 to read from and write to secondary

storage 662, keyboard/display 612, 614, communications controller 666, and backup storage device 668.” A person of ordinary skill in the art would understand that the I/O controller is a computer circuitry component that is used to process and store the VDE objects of Ginter in the secondary storage.

Ex. 1004 ¶ 158 (footnote omitted). According to the above, Mr. Wechselberger appears to be mapping I/O controller 660, and not CPU 654, of Ginter to the recited “processing circuitry.” However, in the relevant portion of the Petition, it is unambiguous that Petitioner considers CPU 654, and not I/O controller 660, as corresponding to the recited “processing circuitry.” See Pet. 18–19 (“The electronic appliance of *Ginter* further comprises an I/O controller that ‘permits CPU 654 . . . to read from and write to secondary storage 662.’ . . . A person of ordinary skill in the art would understand that a CPU is processing circuitry.”). We rely on the mapping set forth in the Petition. See 35 U.S.C. § 312(a)(3) (“A petition filed under section 311 may be considered only if . . . the *petition* identifies, in writing and with particularity . . .”) (emphasis added); 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

For the foregoing reasons, we determine that Petitioner has failed to establish a reasonable likelihood it would prevail in showing that at least one of claims 1, 9, 10, and 13–16 is unpatentable as anticipated by Ginter.

*B. Claims 1, 9, 10, and 13–16 as Obvious
over Ginter and Stefik*

Petitioner asserts that a combination of Ginter and Stefik renders obvious claims 1, 9, 10, and 13–16. Pet. 30–44 (citing Exs. 1002–1004). Patent Owner disagrees. Prelim. Resp. 28–42 (citing Exs. 1002, 1003, 2001, 2002). In particular, Patent Owner asserts that Petitioner does not account

adequately for the “processing circuitry” and the “microprocessor” recited in independent claim 1, and also that the ASIC chip of processing means 1200 of *Stefik* cannot correspond to the recited “microprocessor.” Prelim. Resp. 29–32. We agree with Patent Owner.

Petitioner asserts that the following disclosures in *Stefik* account for the recited “processing circuitry”:

Stefik teaches that the hardware of a repository includes “processing means 1200 . . . comprised of a processor element 1201 and processor memory 1202.” Ex. 1003 at 14:13–15. “The processing means 1201 provides controller, repository transaction and usage rights transaction functions for the repository.” *Id.* at 14:15–17. *Stefik* explicitly teaches that “repositories are used to store digital works.” *Id.* at 6:57–58. Claim 1 of *Stefik* includes the element of a “storage means for storing digital works having attached usage rights and fees.” *Id.* at 54:5–6. Moreover, Claim 8 of *Stefik* also recites the step of “storing said digital work and said attached one or more usage rights in a server repository.” *Id.* at 55:25–26. A person of ordinary skill in the art would understand that repository transactions include processing and storing digital data. Ex. 1004 at ¶ 216.

Pet. 32–33.

Petitioner further asserts that the following disclosures in *Stefik* account for the recited “microprocessor”:

As discussed above, *Stefik* teaches that the hardware of a repository may comprise a processing means. Ex. 1003 at 14:13–15. *Stefik* teaches that the functional component of a repository “is typically software executing on the hardware embodiment.” *Id.* at 14:1–3. This functional software “may be embedded in the hardware embodiment such as an Application Specific Integrated Circuit (ASIC) chip.” *Id.* at 14:3–6. A person of ordinary skill in the art would know that an ASIC chip is a microprocessor. Ex. 1004 at ¶ 223. The functional embodiment comprises “an operating system 1301, core repository services 1302, usage

transaction handlers 1303, repository specific functions, 1304 and a user interface 1305.” Ex. 1003 at 14:53–55. *Stefik* further teaches that the operating system “provide[s] the basic services for controlling and interfacing between the basic components of the repository.” *Id.* at 14:59-61. As discussed above, the basic components of the repository include processing circuitry and playback circuitry. *See supra* at VI.C.1.d, VI.C.1.f. Therefore, *Stefik* discloses software to control the processing circuitry and playback circuitry.

Pet. 35.

Patent Owner asserts that Petitioner impermissibly maps two distinct claim terms, “processing circuitry” and “microprocessor,” to the same processing means 1200 of *Stefik*. Prelim. Resp. 29–31. We agree. *See Unique Concepts*, 939 F.2d at 1563 (two distinct claim elements should each be given full effect). Indeed, to determine otherwise would impermissibly read one of “processing circuitry” and “microprocessor” out of the claim. *See Texas Instr.*, 988 F.2d at 1171 (explaining that claim language cannot be mere surplusage, an express limitation cannot be read out of the claim). Mapping both claim terms to processing means 1200 of *Stefik* is especially problematic for the “microprocessor” limitation, which reads, in context, “a *microprocessor* having software programming to control the operation of the *processing circuitry*” (Claim 1 (emphasis added)).

In making our determination, we acknowledge that it is plausible that Petitioner is mapping “processing circuitry” and “microprocessor” to processing means 1200 and processor element 1201, respectively, where processor element 1201 is a component of processing means 1200. We are unpersuaded, however, that Petitioner has articulated that mapping with sufficient particularity in the aforementioned portions of the Petition. *See* 35 U.S.C. § 312(a)(3) (“A petition filed under section 311 may be considered

only if . . . the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim . . .”). Moreover, as each of “processing circuitry” and “microprocessor” are recited as performing functions, if anything, it would appear that both “processing circuitry” and “microprocessor” should be mapped to processor element 1201, which would still be deficient for the reasons set forth above concerning processing means 1200.

Patent Owner also asserts that Petitioner maps the ASIC chip of processing means 1200, which appears to be the same as processor element 1201, of Stefik to the recited “microprocessor,” but that an ASIC chip cannot correspond properly to a “microprocessor.” Prelim. Resp. 31. We agree. Patent Owner cites to a webpage that defines ASIC as follows:

(Application Specific Integrated Circuit) Pronounced “a-sick.” A chip that is custom designed for a specific application rather than a general-purpose chip such as a microprocessor. The use of ASICs improve performance over general-purpose CPUs, because ASICs are “hardwired” to do a specific job and do not incur the overhead of fetching and interpreting stored instructions.

Prelim. Resp. 31 (citing Ex. 2002); *see also Dictionary.com Unabridged*, Random House, Inc. <http://www.dictionary.com/browse/microprocessor> (accessed: June 12, 2017) (Ex. 3001) (microprocessor is “an integrated computer circuit that performs all the functions of a CPU”). Based on the above, we find that an ASIC is not a microprocessor. Against this objective evidence, Petitioner only states that “[a] person of ordinary skill in the art would know that an ASIC chip is a microprocessor” (Pet. 35), and provides a citation to paragraph 223 of Mr. Wechselberger’s Declaration, the relevant

portion of which merely states, similarly, that “[a] person of ordinary skill in the art would appreciate that an ASIC chip functions would include those of a microprocessor,” without further relevant explanation or analysis.

For the foregoing reasons, we determine that Petitioner failed to establish a reasonable likelihood it would prevail in showing that at least one of claims 1, 9, 10, and 13–16 is unpatentable as obvious over Ginter and Stefik.

C. Conclusion

On this record, Petitioner has failed to demonstrate sufficiently “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” We, thus, deny institution of an *inter partes* review.

III. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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