

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MLB ADVANCED MEDIA, L.P.,
Petitioner,

v.

FRONT ROW TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-01127
Patent 8,583,027 B2

Before JUSTIN T. ARBES, MATTHEW R. CLEMENTS, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a)

I. BACKGROUND

Petitioner MLB Advanced Media, L.P. filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1, 3, 4, 7, 9, and 10 of U.S. Patent No. 8,583,027 B2 (Ex. 1001, “the ’027 patent”) pursuant to 35 U.S.C. § 311(a). On October 3, 2017, we instituted an *inter partes* review of all challenges raised in the Petition, namely, claims 1, 3, 4, 7, 9, and 10 on two grounds of unpatentability. Paper 9 (“Dec. on Inst.”); see Pet. 3. Patent Owner Front Row Technologies, LLC subsequently filed a Patent Owner Response (Paper 16, “PO Resp.”) and Petitioner filed a Reply (Paper 29). Patent Owner also filed a Motion to Amend (Paper 25, “Mot.”),¹ Petitioner filed an Opposition (Paper 28, “Opp.”), and Patent Owner filed a Reply (Paper 33, “Reply”). An oral hearing was held on May 21, 2018, and a transcript of the hearing is included in the record (Paper 41, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we grant Patent Owner’s Motion to Amend to the extent it requests the cancellation of claims 1, 3, 4, 7, 9, and 10 of the ’027 patent, and deny the Motion to Amend with respect to proposed substitute claims 19–24.

A. The ’027 Patent

The ’027 patent discloses techniques for “remotely delivering sports and entertainment data to [handheld] devices” and “providing increased viewing opportunities for audiences within and external to venue environments, such as stadiums and concert arenas.” Ex. 1001, col. 2,

¹ Patent Owner refiled its Motion to Amend after the originally filed version was stricken. See Papers 18, 24.

ll. 2–7. The '027 patent states that “[m]ost modern stadiums and live entertainment facilities or arenas . . . typically employ large television screens that receive video images and are linked within the stadium to a plurality of television cameras positioned to capture video images at diverse locations within the stadium.” *Id.* at col. 2, ll. 13–19. However, audience members can only see one view on the screen, the screen may be far away, and the screen may show unwanted information (e.g., advertisements when the audience member would rather watch an instant replay). *Id.* at col. 2, ll. 29–55. “The audience members, therefore, essentially view the large screen at the behest of the camera operator and cannot select their own views or camera angles.” *Id.* at col. 2, ll. 55–58. The '027 patent attempts to solve these problems by providing on-demand video and other information to audience members’ wireless handheld devices. *Id.* at col. 4, ll. 10–22.

Figure 5 of the '027 patent is reproduced below.

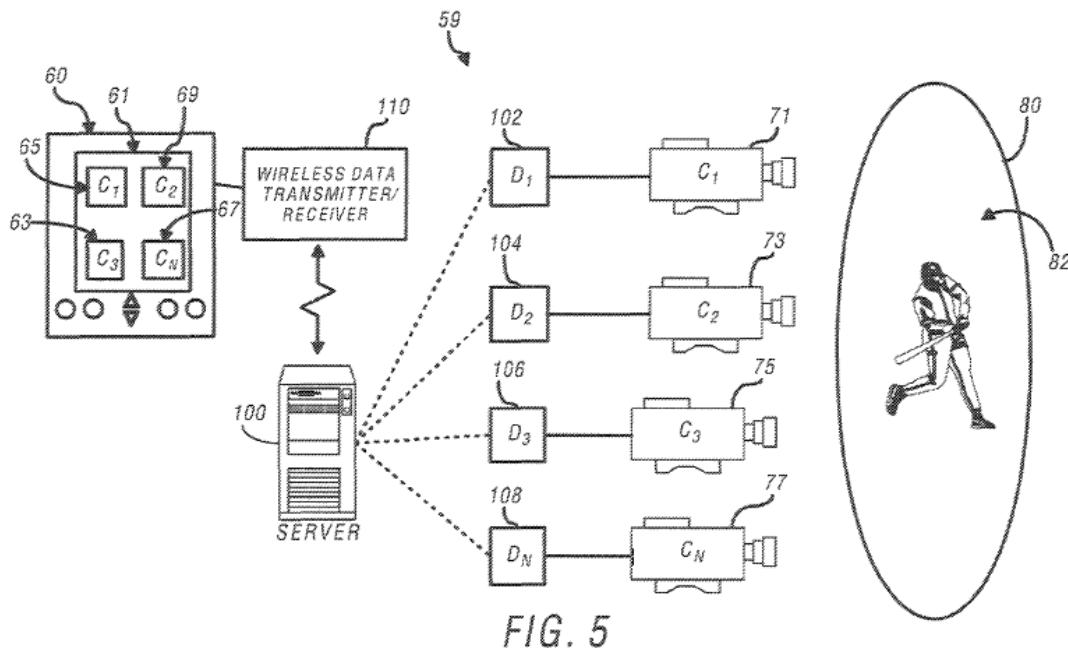


Figure 5 depicts “system 59 that provides multiple perspectives of activity at a venue 80 through a [handheld] device 60 adapted to receive and process real time video data.” *Id.* at col. 11, ll. 5–8. Real time video of baseball player 82 captured by cameras 71, 73, 75, and 77, past video data, and other data are provided wirelessly to handheld device 60. *Id.* at col. 11, ll. 5–52. The ’027 patent further describes determining the location of a user based on communications from the user’s device and authorizing the device to receive a service based on its location. *Id.* at col. 25, ll. 30–61.

B. Illustrative Claim

Claim 1 of the ’027 patent recites:

1. A method for authorizing access by a user of at least one service associated with an event at a venue based on a location of said user as determined by information derived from communication between a computing device in the form of a wireless handheld device carried and utilized by said user and assets of a data communications network, said method comprising:

determining a location of at least one user based on communications of at least one computing device comprised of a wireless handheld device utilized by said at least one user with said data communications network supporting data communications of said at least one computing device;

authorizing said at least one computing device to receive said at least one service based on said location as determined by said data communications network, wherein said at least one service includes streaming video accessed from a server wherein streaming video captured by at least one video camera operating within at least one entertainment venue is processed for delivery to subscribers of the at least one service and wherein said authorizing said at least one computing device further comprising preventing said at least one computing device from receiving said at least one service beyond or within a particular

geographic area based on said location determination by said data communication network.

C. Prior Art

The grounds of unpatentability in the instant *inter partes* review are based on the following prior art:

U.S. Patent No. 6,496,802 B1, filed July 13, 2000, issued Dec. 17, 2002 (Ex. 1032, “van Zoest”);

U.S. Patent Application Publication No. 2010/0122303 A1, filed Oct. 23, 2009, published May 13, 2010 (Ex. 1038, “Maloney”); and

U.S. Patent Application Publication No. 2002/0023010 A1, filed Mar. 20, 2001, provisional application filed Mar. 21, 2000, published Feb. 21, 2002 (Ex. 1028, “Rittmaster”).

D. Grounds of Unpatentability

The instant *inter partes* review involves the following grounds of unpatentability:

Reference(s)	Basis	Claims
Maloney	35 U.S.C. § 103(a) ²	1, 3, 4, 7, 9, and 10
Rittmaster and van Zoest	35 U.S.C. § 103(a)	1, 3, 4, 7, 9, and 10

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 103 and 112. Because the challenged claims of the ’027 patent have an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. §§ 103 and 112.

II. ANALYSIS

A. Original Claims 1, 3, 4, 7, 9, and 10

In the related litigation between the parties, the district court granted a motion for judgment on the pleadings, concluding that the challenged claims in this proceeding (claims 1, 3, 4, 7, 9, and 10 of the '027 patent) are invalid under 35 U.S.C. § 101. Ex. 1048. The U.S. Court of Appeals for the Federal Circuit affirmed the district court's decision, and the Supreme Court of the United States denied Patent Owner's petition for a writ of certiorari. *See Front Row Techs. LLC v. MLB Advanced Media, L.P.*, 697 F. App'x 701 (Fed. Cir. 2017), 2018 WL 1142971 (U.S. Apr. 23, 2018).

Patent Owner states in its Motion to Amend that it “hereby cancels instituted claims 1, 3, 4, 7, 9, and 10 of [the '027 patent] and requests that the Board declare as patentable amended substitute claims 19–24.” Mot. 1; *see also* PO Resp. 1 (stating that Patent Owner's Motion to Amend “canceled claims 1, 3, 4, 7, 9, and 10 and substituted new amended claims 19–24,” and “[s]ubstitute new amended claims 19–24 moot the patentability of the original claims”). Patent Owner confirmed that its Motion to Amend is non-contingent, i.e., Patent Owner seeks to cancel claims 1, 3, 4, 7, 9, and 10 (regardless of any decision in this proceeding as to the patentability of those claims) and substitute claims 19–24 in their place. Paper 36, 2. Accordingly, we grant Patent Owner's Motion to Amend to the extent it seeks to cancel claims 1, 3, 4, 7, 9, and 10.³ *See* 35 U.S.C. § 316(d)(1)(A).

³ Given this disposition, we need not assess the patentability of claims 1, 3, 4, 7, 9, and 10 based on *Maloney*, *Rittmaster*, and *van Zoest*. Petitioner also does not argue that proposed substitute claims 19–24 are unpatentable based on any of these references.

B. Proposed Substitute Claims 19–24

Patent Owner seeks to substitute claims 19–24 for claims 1, 3, 4, 7, 9, and 10, respectively. Mot. 1. Claims 19 and 22 are independent, and recite similar limitations. Claim 19 recites (with underlining indicating language added to claim 1 and brackets indicating language removed from claim 1):⁴

19. A method for authorizing access by a user of at least one service associated with an event at a venue based on a location of said user as determined by information derived from communication between a computing device in the form of a wireless handheld computing device carried and utilized by said user and assets of a wireless data communications network, said method comprising:

connecting a wireless handheld computing device associated with at least one user to the data communications network, the data communication network comprising a wireless data communications network, the wireless data communications network allowing one or more mobile carriers to provide wireless data communications services to said wireless handheld computing device, the wireless data communications network including the use of mobile switching centers, the mobile switching centers having access to one or more network servers and one or more network databases, wherein the wireless data communication network provides for updating of and use of information from the one or more network databases;

determining a location of said wireless handheld computing device associated with said at least one user based on communications of at least one computing device comprised of [[a]] said wireless handheld computing device utilized by said at

⁴ Patent Owner filed with its Motion to Amend a clean copy of the proposed substitute claims (Appendix A), a version showing the changes made to the original claims (Appendix B), and a version showing how certain limitations in the original claims allegedly were reorganized (Appendix C). See 37 C.F.R. § 42.121(b). All citations herein are to the proposed substitute claims as listed in Appendix A. See Mot. 4 (“Appendix A contains a complete listing of amended substitute claims 19–24.”).

least one user, with said wireless data communications network supporting said wireless data communication[[s]] services of said [[at least one]] wireless handheld computing device, wherein the communications between said wireless handheld computing device and the wireless data communications network access information in at least one of the one or more network databases, the one or more network databases including a plurality of wireless handheld computing device information associated with a plurality of users, including said at least one user, and wherein the location of said wireless handheld computing device is determined at least in part according to the wireless handheld computing device information associated with said at least one user stored in the one or more network databases;

authorizing said [[at least one]] wireless handheld computing device, by a security unit of said wireless handheld computing device, to receive [[said]] at least one streaming service based on said location as determined by said wireless data communication[[s]] network, wherein authorizing said wireless handheld computing device based on said location further comprises preventing said wireless handheld computing device from receiving said at least one streaming service at a location beyond or within a particular geographic area, wherein said location beyond the particular geographic area further comprises a location selected from the group of locations comprising a location beyond a particular frequency range and a location outside of a particular geographical area associated with a wireless network;

transmitting for display if authorized, and preventing transmission for display if unauthorized, said at least one streaming service, wherein said at least one streaming service includes streaming video accessed from a server, wherein streaming video is captured by at least one video camera operating within at least one entertainment venue, and wherein captured video is processed for delivery to and display by said at least one user, wherein said at least one user comprises at least one subscriber[[s]] of [[the]] said at least one streaming service [[and wherein said authorizing said at least one computing device further comprising preventing said at least one computing device

from receiving said at least one service beyond or within a particular geographic area based on said location determination by said data communication network]].

1. Level of Ordinary Skill in the Art

Petitioner argues that a person of ordinary skill in the art at the time of the '027 patent would have had “a minimum of a B.S. in Electrical or Computer Engineering and two to three years of experience in the communication industry, including at least some experience in wireless data communications/networks and video transmission,” and would have had “knowledge of conventional communications systems” of the time. Pet. 4 (citing Ex. 1002 ¶¶ 22–23). Patent Owner does not propose a different level of ordinary skill in the art in its Patent Owner Response or Motion to Amend. Based on the record developed during trial, including our review of the '027 patent and the types of problems and solutions described in the '027 patent and cited prior art, we agree with Petitioner’s assessment of the level of ordinary skill in the art and apply it for purposes of this Decision.

2. Claim Interpretation

The Board interprets claims in an unexpired patent using the “broadest reasonable construction in light of the specification of the patent in which [they] appear[.]” 37 C.F.R. § 42.100(b). Under this standard, we interpret claim terms using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir.

1997); see *In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017) (“[The] broadest reasonable interpretation . . . is an interpretation that corresponds with what and how the inventor describes his invention in the specification.”). “Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016).

In the Decision on Institution, based on the parties’ arguments and record at the time, we preliminarily concluded that the preambles of independent claims 1 and 7 were limiting, and concluded that no other claim terms required interpretation. Dec. on Inst. 6–8. The parties did not dispute that interpretation during trial. Claims 19 and 22 are proposed substitutes for claims 1 and 7, respectively. They include additional terms in their respective preambles, but do not remove any language from the original preambles. Accordingly, we adopt our previous analysis for purposes of this Decision and conclude that the preambles of claims 19 and 22 are limiting as well.

As explained herein, the parties make certain arguments regarding the scope of proposed substitute claims 19–24 in their Motion to Amend, Opposition, and Reply, but do not propose specific interpretations for any of the terms at issue. We address the parties’ arguments below, and conclude that no further interpretation is necessary to determine whether Patent Owner’s Motion to Amend should be granted. See *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“Because we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy,’ we need not

construe [a particular claim limitation] where the construction is not ‘material to the . . . dispute.’” (citations omitted)).

3. Claim 19

Before considering the patentability of proposed substitute claims in a motion to amend, we first determine whether the motion meets the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. In *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1305–1306 (Fed. Cir. 2017), a plurality of judges of the en banc Court stated that “the patent owner must satisfy the Board that the statutory criteria in § 316(d)(1)(a)–(b) and § 316(d)(3) are met and that any reasonable procedural obligations imposed by the Director are satisfied.” *See also id.* at 1317 (“To the extent Rule 42.20(c) imposes a burden on the patent owner as the ‘movant,’ it is a burden to show that the amendments do ‘not enlarge the scope of the claims of the patent or introduce new matter’ as required by 35 U.S.C. § 316(d)(3), not a burden to prove the overall patentability of the amended claim.”).

a. Broadening of Scope

A motion to amend “may not enlarge the scope of the claims of the patent.” 35 U.S.C. § 316(d)(3); *see* 37 C.F.R. § 42.121(a)(2)(ii) (“A motion to amend may be denied where . . . [t]he amendment seeks to enlarge the scope of the claims of the patent”); *Western Digital Corp. v. SPEX Techs., Inc.*, Case IPR2018-00082, slip op. at 6 (PTAB Apr. 25, 2018) (Paper 13) (informative) (“[A] patent owner may not seek to broaden a challenged claim in any respect, in the name of responding to an alleged ground of unpatentability. For example, a proposed substituted claim may

not remove a feature of the claim, thus broadening it.”). “A new claim enlarges if it includes within its scope any subject matter that would not have infringed the original patent.” *Thermalloy, Inc. v. Aavid Eng’g, Inc.*, 121 F.3d 691, 692 (Fed. Cir. 1997). After considering the arguments of the parties, see Opp. 3–5; Reply 2–3, and based on the record presented in this proceeding, we conclude that proposed substitute claim 19 improperly enlarges the scope of claim 1 in two respects.

First, proposed substitute claim 19 removes the requirement that streaming video be processed for delivery to multiple “subscribers.” Claim 1 recites “wherein streaming video captured by at least one video camera operating within at least one entertainment venue is processed for delivery to subscribers of the at least one service.” Claim 19 modifies that limitation as follows (with underlining indicating added language and brackets indicating removed language):

wherein streaming video is captured by at least one video camera operating within at least one entertainment venue, and wherein captured video is processed for delivery to and display by said at least one user, wherein said at least one user comprises at least one subscriber[[s]] of [[the]] said at least one streaming service.

Thus, claim 19 covers the situation where captured video is “processed for delivery” to just a single subscriber (i.e., “at least one user, wherein said at least one user comprises at least one subscriber”), which would not be covered by claim 1, which requires that streaming video be “processed for delivery” to multiple “subscribers.”

Patent Owner argues that the term “subscribers” in claim 1 merely “describes a class of ‘user,’” such that claim 1 actually does not require processing streaming video for delivery to more than one subscriber. Reply 3. According to Patent Owner, “[t]he term ‘subscribers’ provides a specific

class or limiting characteristic to the number of users (‘at least one’) recited in the claim. The class of subscribers may be comprised of a single user.” *Id.* As support, Patent Owner cites the Specification of the ’027 patent, which discloses that “[i]n some embodiments, the at least one user can be, for example, a subscriber.” Ex. 1001, col. 4, ll. 59–61, col. 25, ll. 45–47; see Reply 3. Patent Owner also cites a portion of a parent application to the ’027 patent disclosing that “[i]ntelligent wireless networks generally include the use of mobile switching centers (MSCs) having access to network servers and databases . . . for providing applications and data to networks, service providers and service subscribers (wireless device users).” Ex. 1006, p. 46, l. 29–p. 47, l. 2; see Reply 3.

We do not agree. Claim 1 recites a method for authorizing access to a service by “a user,” comprising two steps: (1) determining a location of “at least one user” based on communications of a computing device utilized by the “at least one user,” and (2) authorizing the computing device to receive a service based on the location as determined. The claim further recites, in a “wherein” clause, that “streaming video captured by at least one video camera operating within at least one entertainment venue is processed for delivery to subscribers of the at least one service.” Therefore, regardless of who the “at least one user” may be, the claim expressly requires that “streaming video . . . is processed for delivery to subscribers of the at least one service.” Importantly, claim 1 uses the plural term “subscribers,” rather than the singular term “subscriber” or the phrase “at least one user” used earlier in the claim. See Tr. 6:14–20 (acknowledging that proposed substitute claim 19 removes the term “subscribers”).

Nor are we persuaded that the Specification supports reading out the plural “subscribers” language of claim 1. The Specification discloses exemplary embodiments in which “the at least one user can be, for example, a subscriber.” Ex. 1001, col. 4, ll. 59–61, col. 25, ll. 45–47. In other words, a “subscriber” is a particular type of user. But this single disclosure cannot negate the express language of claim 1, which recites more than just the existence of “subscribers” in general. Namely, the claim requires that streaming video must be “processed for delivery”⁵ to plural “subscribers.”

Patent Owner also argued at the hearing that it incorporated the language of dependent claim 3 into proposed substitute claim 19, and “[i]f original claim 1 required two subscribers, original claim 3 would make literally no sense.” Tr. 6:3–13, 7:1–7. We do not agree. Claim 3, which depends from claim 1, recites that “said at least one user comprises a subscriber.” This language pertains solely to “said at least one user,” i.e., the “at least one user” recited in parent claim 1. Claim 3 limits *that* user (or users) to being a subscriber, whereas in claim 1 the user can be a subscriber or a non-subscriber. Again, though, the limitations in claim 1 pertaining to “at least one user,” such as determining the location of “at least one user,” are separate from the limitation requiring that streaming video be “processed for delivery” to “subscribers.” Claim 1 does not specify any connection between the recited “at least one user” and the recited “subscribers.” Thus, there is no inconsistency in claim 1 requiring

⁵ We need not expressly interpret “processed for delivery” to determine whether claim 19 enlarges the scope of claim 1. Regardless of the phrase’s exact scope, it is a limitation of claim 1—the claimed method is satisfied only when “streaming video . . . is processed for delivery to subscribers of the at least one service.”

processing of streaming video for delivery to multiple “subscribers” and claim 3 requiring the specific “at least one user” referenced in parent claim 1 to be a subscriber. Patent Owner’s interpretation of claim 1 would read all of the limitations as pertaining to “at least one user,” even though the claim uses the plural term “subscribers.” We are not persuaded that such a reading is proper, particularly given the different terminology used.

Second, proposed substitute claim 19 removes the requirement of preventing a computing device from receiving a service beyond or within a particular geographic area “based on said location determination by said data communication network.” Claim 1 recites:

authorizing said at least one computing device to receive said at least one service based on said location as determined by said data communications network, . . . wherein said authorizing said at least one computing device further comprising preventing said at least one computing device from receiving said at least one service beyond or within a particular geographic area based on said location determination by said data communication network.

Proposed substitute claim 19 removes the above “wherein” clause from claim 1. Patent Owner acknowledges that the language is not present, but argues that claim 19 includes the clause “in nearly the same manner as original claim 1.” Reply 2 (emphasis omitted); *see* Tr. 9:22–26 (acknowledging that proposed substitute claim 19 does not use the same language as the “wherein” clause of claim 1). Specifically, Patent Owner points to the “authorizing” step earlier in the claim, Reply 2, which is modified from claim 1 as follows (with underlining indicating added language and brackets indicating removed language):

authorizing said [[at least one]] wireless handheld
computing device, by a security unit of said wireless handheld

computing device, to receive [[said]] at least one streaming service based on said location as determined by said wireless data communication[[s]] network, wherein authorizing said wireless handheld computing device based on said location further comprises preventing said wireless handheld computing device from receiving said at least one streaming service at a location beyond or within a particular geographic area, wherein said location beyond the particular geographic area further comprises a location selected from the group of locations comprising a location beyond a particular frequency range and a location outside of a particular geographical area associated with a wireless network.

Importantly, however, claim 1 recites that “authorizing” reception of a service further comprises “preventing” the computing device from receiving the service beyond or within a particular geographic area “based on said location determination by said data communication network.” Because claim 19 does not include the “based on said location determination by said data communication network” phrase of claim 1, claim 19 covers the situation where a computing device is prevented from receiving a service based on something other than the location determination by the data communication network.

U.S. Patent Application Publication No. 2004/0199635 A1 (Ex. 1049, “Ta”) provides an example of such a situation. See Opp. 4. Ta describes a system for “allocating bandwidth on a per user basis” where a user connects to a control device on a network and the control device authenticates the user “based on a network communication from a network application such as a web browser . . . running on a user device.” Ex. 1049, Abstract, ¶¶ 29, 31. The control device retrieves a profile for the user, initiates and tracks a control session for the user based on, for example, the user’s IP address, establishes rules based on attributes in the user profile, and regulates

bandwidth usage by the user based on the established rules. *Id.* ¶¶ 32–41. For example, the system can drop network communication when a maximum bandwidth limit for the user is reached. *Id.* ¶ 41. The user profile also can include attributes specifying “whether the user can use streaming services.” *Id.* ¶ 84. In that way, Ta discloses a situation where a computing device is authorized to receive services, but subsequently prevented from receiving a service based on a parameter other than a location determination by a data communication network. For example, an attribute in a user profile may specify that the user is not permitted to receive streaming video, or is only permitted to receive a certain amount, such that the user’s device would be prevented from receiving streaming video based on that attribute (which has nothing to do with location). Thus, we are persuaded that claim 19 includes within its scope subject matter that would not have infringed claim 1.

Patent Owner argues that claim 19 is narrower than claim 1, quoting portions of the “wherein” clauses of claims 1 and 19:

Claim 1 Claim Limitation	Claim 19 Claim Limitation
wherein said authorizing said at least one computing device <u>further comprising preventing</u> said at least one computing device from receiving said at least one service beyond or within a particular geographic area	wherein authorizing said wireless handheld computing device based on said location <u>further comprises preventing</u> said wireless handheld computing device from receiving said at least one streaming service at a location beyond or within a particular geographic area

Reply 2. Patent Owner, however, omits the following phrase from its quotation of claim 1: “based on said location determination by said data

communication network.” *See id.* That language is removed in proposed substitute claim 19, making the claim broader than claim 1.

Patent Owner also argued at the hearing that the “based on said location determination by said data communication network” phrase in claim 1 is “basically redundant” because the “authorizing” step as a whole must be “based on said location.” Tr. 10:2–10. We are not persuaded that the original phrase is meaningless. Claim 1 recites “authorizing said at least one computing device to receive said at least one service based on said location as determined by said data communications network,” “wherein said authorizing . . . comprising preventing said at least one computing device from receiving said at least one service beyond or within a particular geographic area based on said location determination by said data communication network.” The fact that different terminology is used for each limitation (“based on said location as determined” and “based on said location determination”) is indicative that both phrases have meaning. *See Becton, Dickinson & Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1257 (Fed. Cir. 2010) (“Claims must be ‘interpreted with an eye toward giving effect to all terms in the claim.’” (citation omitted)); *Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”). Further, “authorizing” reception of a service and “preventing” reception beyond or within a particular geographic area are different actions. It is unclear—and Patent Owner did not explain in its papers or at the hearing—how the latter can be considered a subset of the former.

Moreover, as Petitioner correctly points out, the “preventing” limitation was the basis on which the claims were allowed during prosecution of the ’027 patent. *See* Pet. 7–8; Opp. 3. Following an interview with the applicants, the examiner entered an examiner’s amendment incorporating the “preventing” limitation from pending dependent claim 6, expressly stating that the amendment would “further limit the scope of the invention,” and allowed the claims. Ex. 1039, 7–9. Thus, we are not persuaded that the “based on said location determination by said data communication network” phrase in the “preventing” limitation of claim 1 is meaningless, as Patent Owner contends.

Accordingly, we determine that proposed substitute claim 19 improperly enlarges the scope of claim 1 under 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii) because it removes the requirement that streaming video be processed for delivery to multiple “subscribers” and removes the requirement of preventing a computing device from receiving a service beyond or within a particular geographic area “based on said location determination by said data communication network.”

b. Written Description Support

A motion to amend “may not . . . introduce new matter.” 35 U.S.C. § 316(d)(3); *see* 37 C.F.R. § 42.121(a)(2)(ii) (“A motion to amend may be denied where . . . [t]he amendment seeks to . . . introduce new subject matter.”). New matter is any addition to the claims without support in the original disclosure. *See TurboCare Div. of Demag Delaval Turbomachinery Corp. v. General Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001) (“When [an] applicant adds a claim . . . the new claim[] . . . must find support in the

original specification.”). In order to show that an amendment does not introduce new subject matter, a motion to amend must set forth “[t]he support in the original disclosure of the patent for each claim that is added or amended” and “[t]he support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.”

37 C.F.R. § 42.121(b).

The test for compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, is whether “the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that set forth fully the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). “It is not sufficient for purposes of the written description requirement . . . that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.” *Id.* “One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Id.* “[T]he hallmark of written description is disclosure. . . . [T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad*, 598 F.3d at 1351. Also, the claimed invention does not have to be described *in ipsius verbis* in the specification to satisfy the written description requirement. *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000).

Patent Owner provides, in its Motion to Amend, citations allegedly showing that proposed substitute claim 19 is supported by U.S. Patent Application No. 13/403,231 (Ex. 1003, “the ’231 application”), which issued as the ’027 patent, as well as parent U.S. Patent Application No. 09/708,776 (Ex. 1006, “the ’776 application”) and U.S. Provisional Patent Application No. 60/243,561 (Ex. 1005, “the ’561 provisional”), and argues that the amendments were drafted to mirror nearly identical language in the relied upon applications. *See* Mot. 7–8, 10–11, 13–14 (citations for claim 19 specifically); Reply 3–5; Ex. 1001, col. 1, ll. 9–62 (cross-references to earlier applications).

We focus on the following limitation of claim 19, which Patent Owner labels as “19[c][i]” and “19[c][ii]” in its Motion to Amend (emphases added):

authorizing said wireless handheld computing device, *by a security unit of said wireless handheld computing device*, to receive at least one streaming service based on said location as determined *by said wireless data communication network*, wherein authorizing said wireless handheld computing device based on said location further comprises preventing said wireless handheld computing device from receiving said at least one streaming service at a location beyond or within a particular geographic area.

Claim 19, thus, requires determining a location of the wireless handheld computing device *by the wireless data communication network*, and authorizing reception of a service based on that determined location *by a security unit of the wireless handheld computing device*. In its Motion to Amend, Patent Owner cites paragraphs 53, 86, 90, 91, and 151 of the ’231 application; page 22, lines 7–27, page 36, lines 7–24, page 38, lines 14–30, and page 62, line 25–page 63, line 9 of the ’776 application; and

page 14, line 28–page 15, line 15, page 28, line 32–page 29, line 12, page 29, lines 14–30, and page 52, line 24–page 53, line 7 of the ’561 provisional as allegedly providing support for the “security unit” limitation. Mot. 8, 11, 14. In its Reply, Patent Owner relies on paragraph 53 of the ’231 application and page 22, lines 20–27 of the ’776 application. Reply 4.

We have reviewed the full applications relied upon by Patent Owner and the parties’ arguments regarding the “security unit” limitation of proposed substitute claim 19. See Opp. 6–7; Reply 4–5. Based on the record presented in this proceeding, we conclude that the relied upon applications do not provide sufficient written description support for the “security unit” limitation of proposed substitute claim 19.⁶

Paragraph 53 of the ’231 application is the only portion of the application that mentions a “security unit,” and describes security unit 36 of hand held device 11 as follows:

Hand held device 11 can be configured to permit images, such as television broadcast images, to be displayed on display 18 for a user to view. Hand held device 35 thus includes an image-processing unit 35 for processing images transmitted as data to hand held device 11 through wireless unit 17. A tuner

⁶ Similar to “processed for delivery” addressed above, we need not expressly interpret “security unit” to determine whether there is sufficient written description support for proposed substitute claim 19. See Opp. 14–16 (arguing that the term is a means-plus-function limitation under 35 U.S.C. § 112, sixth paragraph, and is indefinite); Reply 4–5 (arguing that the term is not indefinite because the Specification describes a “security unit” as a “software module”). Regardless of the term’s exact scope, the claim expressly requires that the recited authorizing be performed “by a security unit of said wireless handheld computing device.” Therefore, we need only determine whether the relied upon applications provide sufficient written description support for some component of the wireless handheld computing device performing the recited authorizing.

unit 34, implemented as either a single tuner or a plurality of tuners, may be linked through internal bus 26 to CPU 10. Additionally, a security unit 36 may be utilized to process proper security codes to thereby ensure that data transferred to and from hand held device 11 may be secure and/or permitted. Security unit 36 may be implemented as an optional feature of hand held device 11. Security unit 36 can also be configured with routines or subroutines that are processed by CPU 10, and which prevent wireless data from being transmitted/received from hand held device 11 beyond a particular frequency range, outside of a particular geographical area associated with a local wireless network, or absent authorized authorization codes (e.g., decryption).

Ex. 1003 ¶ 53, Fig. 1; *see also* Ex. 1001, col. 7, ll. 44–61 (identical disclosure in the issued '027 patent); Ex. 1006, p. 22, ll. 7–27 (identical disclosure in the '776 application).

Paragraph 53 does not disclose security unit 36 “authorizing” hand held device 11 to receive a service “based on [its] location as determined by [the] wireless data communication network,” as required by claim 19. Indeed, the only potential mention of location is the paragraph’s disclosure in the last sentence that security unit 36 can prevent wireless data from being received “beyond a particular frequency range” or “outside of a particular geographical area associated with a local wireless network.” Ex. 1003 ¶ 53. Neither disclosure, however, indicates that authorization is based on a location as determined by a wireless data communication network. The parties dispute whether “frequency range” refers to distance or, for example, “a range of frequencies” on which wireless data can be received. *See* Opp. 7–9; Reply 5. Even assuming (without deciding) that “beyond a particular frequency range” relates to physical location, though, the cited paragraph does not explain what entity determines any location(s) that would be used

to assess whether hand held device 11 is beyond a certain distance from another point, or how such a determination would be performed to authorize or prevent reception.

The phrase “outside of a particular geographical area associated with a local wireless network” in paragraph 53 is similarly silent as to what entity determines any location that would be used, or how it would be determined that hand held device 11 is outside of or within an area to authorize or prevent reception. It also is limited to an area “associated with a local wireless network.” In challenging the original claims of the ’027 patent, Petitioner’s declarant, Paul S. Min, Ph.D., testified as to how a person of ordinary skill in the art would have understood the same paragraph in another parent application of the ’027 patent, U.S. Patent Application No. 13/314,385 (Ex. 1012, “the ’385 application”):

According to the ’385 application, the security unit is used to “process proper security codes.” So when the ’385 application states that the security unit can “prevent wireless data from being transmitted/received from hand held device 11 . . . outside of a particular geographic area associated with a local area network,” it is merely indicating that the wireless [local area network (LAN)] is secured with password protection. In other words, this section of the ’385 [application] suggests that the data is broadcast only over the wireless LAN, and that a handheld device cannot connect to the wireless LAN unless a proper password is entered and processed by the security unit. It does not suggest that a communications network determines a location of a handheld device or authorizes a handheld device to receive streaming video based on such a location.

Ex. 1002 ¶ 54 (emphasis omitted). We agree with Dr. Min’s reading, as it is consistent with the limited disclosure in paragraph 53.⁷ Paragraph 53 introduces security unit 36 by stating that its function is to “process proper security codes” to ensure that data transfer to and from hand held device 11 is “permitted,” and states that security unit 36 can prevent wireless data from being received “outside of a particular geographical area associated with a local wireless network,” without stating how or by what any location is determined to decide whether hand held device 11 is authorized to receive a service. *See* Ex. 1003 ¶ 53, Fig. 1 (labeling 36 as “Security Codes”). Dr. Min’s reading also is consistent with paragraph 151, also relied upon by Patent Owner for support, which discloses a hand held device using a code to gain access to a wireless network within a “stadium venue.” *See id.* ¶ 151; Mot. 8; *see also* Ex. 1003 ¶ 149 (disclosing that “a wireless network may be limited geographically to the stadium venue 701 itself and the immediate surrounding area”).

We are not persuaded that the brief disclosure in paragraph 53 of the ’231 application, which is mirrored in the ’776 application, is sufficient to show that the applicants were in possession of the subject matter recited in proposed substitute claim 19, including a “security unit of said wireless handheld computing device” that authorizes reception of a service “based on said location as determined by said wireless data communication network.” We have reviewed the other portions of the applications cited by Patent

⁷ Patent Owner in its Reply does not address Dr. Min’s testimony, which Petitioner cited in its Opposition to the Motion to Amend. *See* Opp. 7. Also, neither party submitted new declarant testimony in connection with the briefing on Patent Owner’s Motion to Amend.

Owner and do not see any disclosure that would support an arrangement where a security unit of a wireless handheld computing device performs such authorization. *See* Mot. 8, 11, 14. Paragraphs 86, 90, and 91 generally describe communication with a hand held device over a wireless network, including via “RF (Radio Frequency) broadcasts,” which may require that the hand held device “possess decryption capabilities or the like in order to be authorized to receive transmissions from the venue.” Ex. 1003 ¶¶ 86, 90, 91. The paragraphs, however, do not describe any component of the hand held device that performs authorization to receive a service, how authorization would occur, or whether authorization is based on anything to do with location. Nor do they disclose any particular capabilities of the hand held device that are “like” decryption. *See id.* ¶ 86. Similarly, paragraph 151, as explained above, discloses communication with a hand held device over a wireless network at a stadium venue:

Hand held devices may also be owned by the patrons themselves which they bring into the stadium venue for their use by permission of the venue promoter or stadium owners in return for the payment of a fee by the patron. In return for the fee, the venue promoter or stadium owner can provide the patron with a temporary code which permits them to access the wireless network associated with the venue itself, such as wireless network 152 described herein. Patron-owned devices may utilize smart card technology to receive authorization codes (e.g., decryption) needed to receive venue-provided video/data. . . .

Id. ¶ 151. Paragraph 151 merely indicates that a “temporary code” may be required for the user to access the wireless network at the stadium venue or that “authorization codes (e.g., decryption)” may be needed to receive data. *Id.* It does not describe in any detail how authorization would occur, whether authorization is based on anything to do with location, or how and

by what entity a determination of location would be made. These paragraphs also are present in the '776 application and '561 provisional, as cited by Patent Owner in its Motion to Amend. *See* Mot. 8, 11, 14.

Accordingly, we determine that proposed substitute claim 19 improperly introduces new matter under 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii). None of the relied upon '231 application, '776 application, and '561 provisional provide written description support for proposed substitute claim 19, which recites that a “security unit of said wireless handheld computing device” authorizes reception of a service “based on said location as determined by said wireless data communication network.”

c. Conclusion

For the reasons stated above, we conclude that proposed substitute claim 19 enlarges the scope of claim 1 and introduces new matter.⁸ Accordingly, Patent Owner’s Motion to Amend is denied as to claim 19 pursuant to 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii).

4. Claims 20–21

Claims 20 and 21 depend, directly or indirectly, from claim 19 and are proposed substitutes for claims 3 and 4, respectively. As explained above, we conclude that parent claim 19 enlarges the scope of claim 1 and introduces new matter. *See supra* Section II.B.3. Accordingly, we also deny

⁸ Because either of these determinations is dispositive with respect to claim 19, we need not assess any of Petitioner’s other arguments in its Opposition to the Motion to Amend. *See* Opp. 7–33.

Patent Owner's Motion to Amend with respect to proposed substitute claims 20 and 21.

5. Claims 22–24

Independent claim 22 is a proposed substitute for claim 7, and includes many of the same limitations as independent claim 19. For example, claim 22 recites the following (with underlining indicating language added to claim 7 and brackets indicating language removed from claim 7):⁹

displaying said at least one streaming service, wherein said at least one streaming service includes streaming video accessed from a server and sent to the wireless handheld computing device over the wireless data communication network, wherein streaming video is captured [[by at least one]] from multiple angles by multiple video cameras operating within at least one entertainment venue and is processed for simultaneous delivery to, and display by said user, wherein said user comprises at least one subscriber[[s]] of the at least one streaming service [[and wherein said instructions for authorizing said at least one computing device further comprising instructions for preventing said at least one computing device from receiving said at least one service beyond or within a particular geographic area based on said location determination by said data communication network]].

Similar to claim 19, claim 22 enlarges the scope of claim 7 by eliminating the requirements of processing streaming video for delivery to multiple “subscribers” and of preventing reception beyond or within a particular geographic area “based on said location determination by said data

⁹ Patent Owner's Appendices B and C recite “said at least one user [sic]” rather than “said user.” We understand this to be a typographical error, and refer to the claim as listed in Appendix A.

communication network.” *See supra* Section II.B.3.a. In addition, claim 22 recites (with underlining indicating added language and brackets indicating removed language):

authorizing said [[at least one]] wireless handheld computing device, by a security unit of the wireless handheld computing device, to receive said at least one streaming service based on said location as determined by said wireless data communications network, wherein authorizing said wireless handheld computing device further comprises preventing said wireless handheld computing device from receiving said at least one streaming service at a location beyond or within a particular geographic area, wherein said location beyond the particular geographic area further comprises a location selected from the group of locations comprising a location beyond a particular frequency range and a location outside of a particular geographical area associated with a wireless network, wherein authorizing further comprises transmitting the at least one authorization code to the wireless handheld computing device;

Similar to claim 19, claim 22 recites that a “security unit of the wireless handheld computing device” authorizes reception of a service “based on said location as determined by said wireless data communications network,” which we conclude does not have sufficient written description support in the applications relied upon by Patent Owner. *See* Mot. 8–9, 12–13, 15–16; Reply 4–5; *supra* Section II.B.3.b.

Accordingly, we deny Patent Owner’s Motion to Amend with respect to proposed substitute independent claim 22, as well as claims 23 and 24, which depend, directly or indirectly, from claim 22 and are proposed substitutes for claims 9 and 10, respectively.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Amend is *granted* to the extent it requests the cancellation of claims 1, 3, 4, 7, 9, and 10 of the '027 patent, and *denied* as to proposed substitute claims 19–24.

This is a final 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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